



WIPO | MADRID

The International
Trademark System

Understanding Examination and Refusal Procedures in the IP Office of the Republic of Korea

Madrid System Webinar

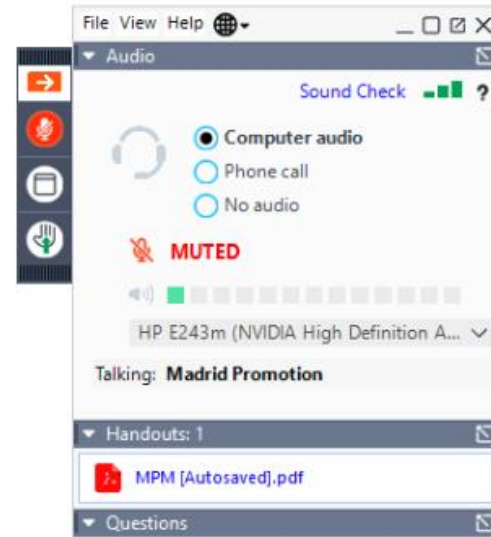
Kijoong SONG

Fellow, Madrid Operations Division

Geneva

July 29, 2020

How to use GoToWebinar

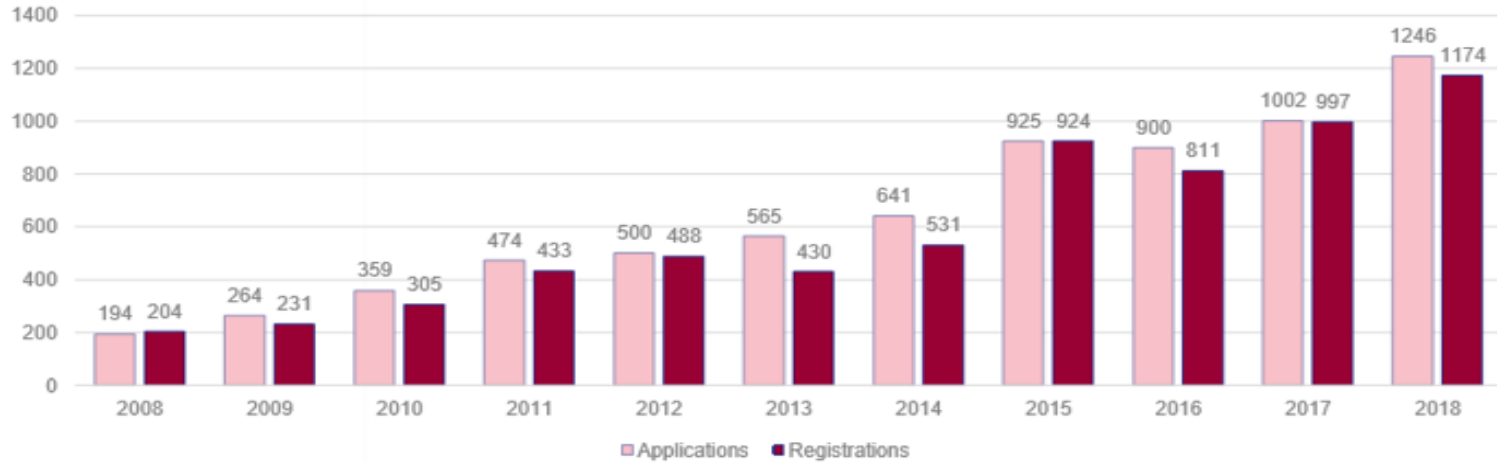


Structure of the Webinar

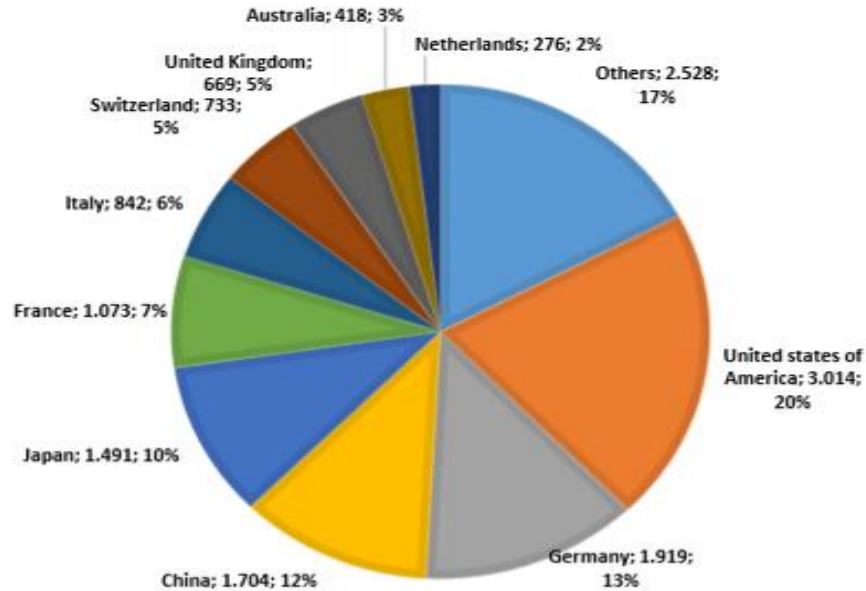
- Presentation: Understanding Examination and Refusal Procedures in the Republic of Korea
- Interactive questions during the webinar
- Q & A session
- Presentation slides available for download
- Recording will be uploaded on the [Madrid Webinar page](#)
- Short survey to provide feedback

Statistics

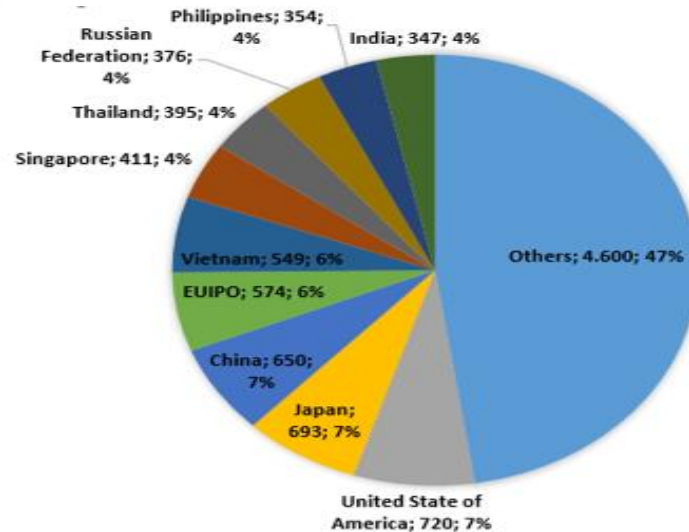
Int'l Applications & Registrations : KR



Country of Holder's KR designations



KR Holders' Top Designated Country

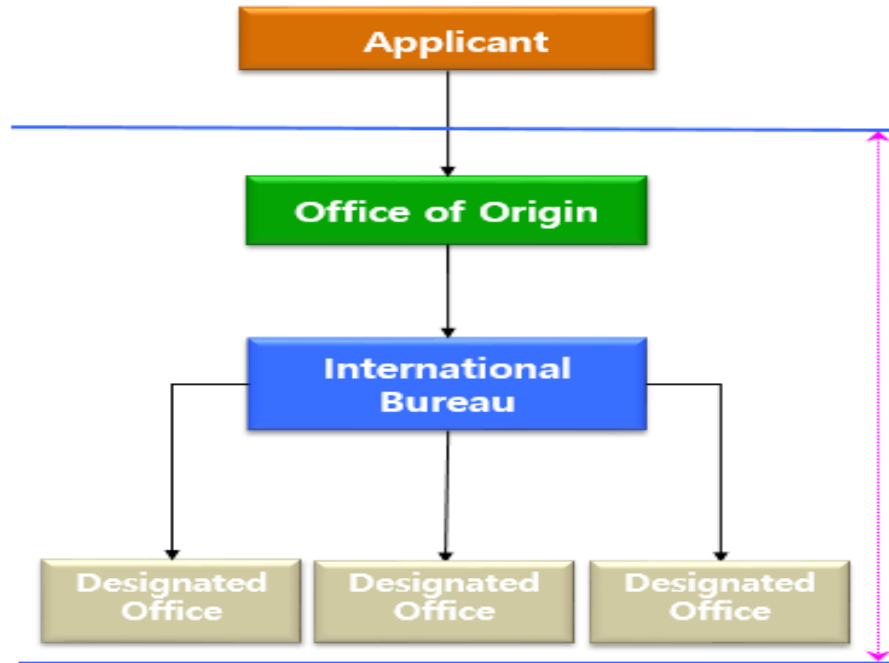


Question 1

- Which country is the top filer through the Madrid protocol to the Republic of Korea in 2019?
 - The United States
 - China
 - EU

How to Avoid Provisional Refusals

Main Roles of Each Office



Office of Origin

- ✓ **Formal requirements**
(Mark, G&S, Entitlement to file, etc.)
- ✓ **Certifying Int. Application based on Basic Requirement**

International Bureau

- ✓ **Examination of Int. Application**
(Formality, NICE classification, Fee)
- ✓ **Translation (E/F/S)**
- ✓ **International Registration**

Designated Office

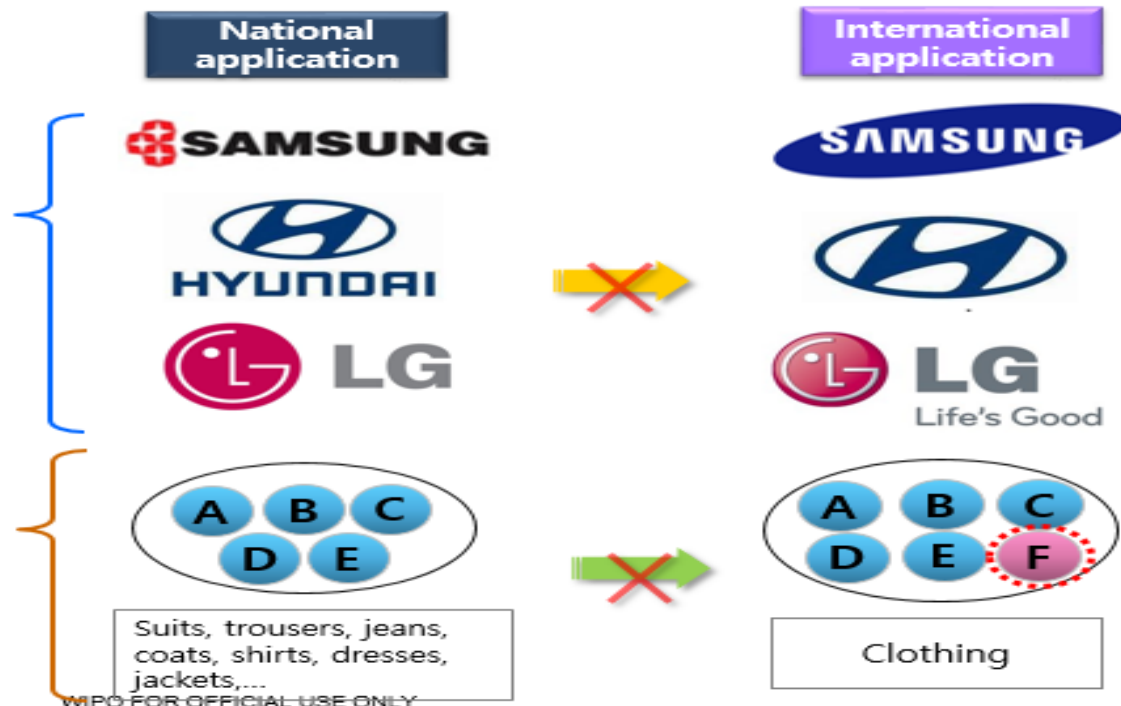
- ✓ **Substantive examination**
- ✓ **Grant/Refusal of trademark protection** in their own territory

Examination by Office of Origin

Basic requirement

- ✓ Mark on Int. Application: identical with the mark of National App./Reg.

- ✓ G&S on Int. Application: not broader than G&S on National App./Reg.



Examination by Office of Origin

10 **GOODS AND SERVICES**

(a) Indicate below the goods and services for which the international registration is sought.
Please use font "Courier New" or "Times New Roman", size 12 pt, or above

Class	Goods and services
09	Computer operating programs, recorded; Computer software, recorded; Computer game program.
16	Inking ribbons; Calenders.
38	Information about telecommunication.

e.g. EM, CN, PH,
GB, US, JP

(b) The applicant wishes to limit the list of goods and services in respect of one or more designated Contracting Parties, as follows:
Please use font "Courier New" or "Times New Roman", size 12 pt, or above

Contracting Party	Class(es) or list of goods and services for which protection is sought in this Contracting Party
US	09 Computer operating programs, recorded.
JP	16, 38

If the space provided is not sufficient, check the box and use a continuation sheet

(a) Lists of goods and services

- Nice classification (11th edition)
- Semicolon (;) between each goods
- Goods of the international ≤ Goods of the basic

- Using the alphabetical list of goods and services of International Classification, or WIPO electronic tools (G&S manager)

(b) Limitation of goods and services

- Limitation of some of G&S to some of the designated countries
- In US: limited to "computer operating program recorded" in class 09
- In JP: limited to class 16, 38

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Examination by Office of Origin

(a) INSTRUCTIONS TO DEBIT FROM A CURRENT ACCOUNT

The International Bureau is hereby instructed to debit the required amount of fees from a current account opened with the International Bureau (if this box is checked, it is not necessary to complete (b)).

Holder of the account: Account number:

Identity of the party giving the instructions:

(b) AMOUNT OF FEES (see Fee Calculator: www.wipo.int/madrid/en/fees/calculator.jsp)

Basic fee: 653 Swiss francs if the reproduction of the mark is in black and white only and 903 Swiss francs if there is a reproduction in color. (For international applications filed by applicants whose country of origin is a Least Developed Country, in accordance with the list established by the United Nations (www.wipo.int/ldc/en/country), 63 Swiss francs if the reproduction is in black and white only and 99 Swiss francs if there is a reproduction in color.)

Complementary and supplementary fees:

Number of designations for which complementary fee is applicable	Complementary fee	Total amount of the complementary fees
..... x	100 Swiss francs	= CHF

Number of classes of goods and services beyond those	Supplementary fee	Total amount of the supplementary fees
..... x	100 Swiss francs	= CHF

Individual fees (Swiss francs):

Designated Contracting Parties	Individual fee	Designated Contracting Parties	Individual fee
.....
.....
Total individual fees		= CHF	

GRAND TOTAL (Swiss francs)

(c) METHOD OF PAYMENT

Identity of the party effecting the payment:

Payment received and acknowledged by WIPO

WIPO receipt number:

Payment made to WIPO bank account

IBAN No. CH51 0483 0048 7080 8130 0
Compte Suisse, CH-1211 Geneva 20
Swift BIC: CRESCH2280A

Payment made to WIPO postal account

IBAN No. CH03 0900 0000 1200 5000 8
Swift BIC: POFKCHBE

In case of holders having a current account opened with the IB (the IB will debit the fee)

Basic fee

- Mark in black and white: 653 CHF (least developed countries: 65 CHF)
- Mark in color: 903 CHF (least developed countries: 90 CHF)

Complementary and supplementary fee (the designated countries, non-available individual fee)

- Complementary fee: 100 CHF for each designated country
- Supplementary fee: 100 CHF for each class in excess of 3 classes

Individual fee (instead of complementary/supplementary)

- Fee amounts depended on each country
- * see the website (www.wipo.int/madrid/en/fees)

Remittance to WIPO's bank account or postal account

- Indicating the bank account of the remitter and the date when the payment was made


Examination by the IB(WIPO)

Irregularity notice for missing fee

WORLD INTELLECTUAL
PROPERTY ORGANIZATION

34, chemin des Colombettes, P.O. Box 24, CH-1211 Geneva (Switzerland)
 WIPO - rue des Nations 15, CH-1202 GENEVE
 801 229 Avenue des Nations (BOSN) - Cour de Justice Bank, Geneva
 CH-1201 GENEVE, CH-1202 GENEVE, CH-1203 GENEVE
 Tel: 41-22-733 2011 Fax: 41-22-733 2020
 E-mail: info@wipo.int Internet: www.wipo.int

Madrid Agreement
and
Madrid Protocol



M. Randy King
Hope BalGouff Hartman, LLC
1720 Peachtree Street, N.W.,
Suite 2010
Atlanta GA 30309
United States of America

26 January 2011

NOTICE CONCERNING AN INTERNATIONAL APPLICATION

ATTENTION:

The irregularity(ies) indicated in this notice is/are to be remedied by the office of origin. However, the irregularity concerning the fees may be remedied by either the applicant or the Office of origin.

Re.: International application based on application N° 85076855 for the mark **TRUE COOK PLUS** in the name of **Microwave Science JV, LLC**

Date of receipt of the international application by the Office of origin: 3 January 2011 by the International Bureau: 3 January 2011

Our ref.: EN-I/580008001/JY
Office ref.: A0022708 85076855 00

Examiner: JIN-OU YOO
Telephone N°: (41-22) 338 3721
E-mail: intreg_mail@wipo.int

We acknowledge receipt of the above-mentioned international application.

IB OFFICE

Time limit: 3 months from the issuing date (26th of Jan. 2011)

WIPO reference No.

Geneva, 26 January 2011

Annex to the irregularity notice concerning the international application based on the national application or the national registration No 85076855

Our ref.: EN-I/580008001/JY
Office ref.: A0022708 85076855 00
Applicant ref.:

Swiss Francs

Basic fee where no reproduction of the mark is in color (Protocol application):	CM	653.00
Individual fee / supplementary fee (Protocol application):	CM	310.00
Individual fee (Protocol application):	EM	620.00
Individual fee / supplementary fee (Protocol application):	EM	1,311.00
Individual fee (first part):	JP	452.00
Individual fee / supplementary fee (first part):	JP	340.00
Individual fee (Protocol application):	KR	428.00
Individual fee (Protocol application):	KR	1,165.00
Total due:		5,079.00

To date, your payment is:

- payment 11/0001947 on 18/01/2011	3,142.00
Balance in our favour	1,937.00
<PAYMENT-INFO>	

Missing fee

Examination by the IB(WIPO)

Irregularity notice based on Rule 13

- ❖ **Broad and incorrect terms for the NICE classification purposes**
 - ✓ Reply via Office of origin to the IB
 - ✓ Time limit: **3 months** from the issuing date

- ❖ **If failing correction, the terms will be registered as appearing with the special indication made by IB**
 - ✓ e.g. "herbal tea *(the terms considered too vague by the International Bureau – Rule 13(2)(b) of the Common Regulations)*"

IRREGULARITY (IES) CONCERNING THE INDICATION OF GOODS AND SERVICES: TO BE REMEDIED BY THE OFFICE OF ORIGIN

1. The International Bureau considers that the following term(s) of the list of goods and/or services is/are too vague for the purposes of classification (Rule 13):

- (1) "herbal tea" (class 30)
- (2) "flavoring syrups and powders for beverages" (class 30)
- (3) "office and institutional coffee supply services" (class 43)

The International Bureau suggests therefore the following:

- (1) "non-medicinal herbal tea" (class 30)
- (2) "flavorings, other than essential oils, for beverages" (class 30)
Kindly note that the terms "syrups for beverages" and "syrups and other preparations for making beverages" belong to class 32 in WIPO for the Nice Classification purposes. (See the position S/1129 of the 9th edition of the alphabetical list of the International Classification of Goods and Services.)
- (3) "office catering services for the provision of coffee" (class 43)

Broad terms from applicants

Suggestions made by IB

Misspelling from applicants

4. The International Bureau considers that the following terms of the list of goods and/or services are linguistically incorrect (Rule 13):

- "excisers for medical purposes" (class 10)

The International Bureau suggests therefore the following:

- "exercisers for medical purposes". (class 10)

TIP 1

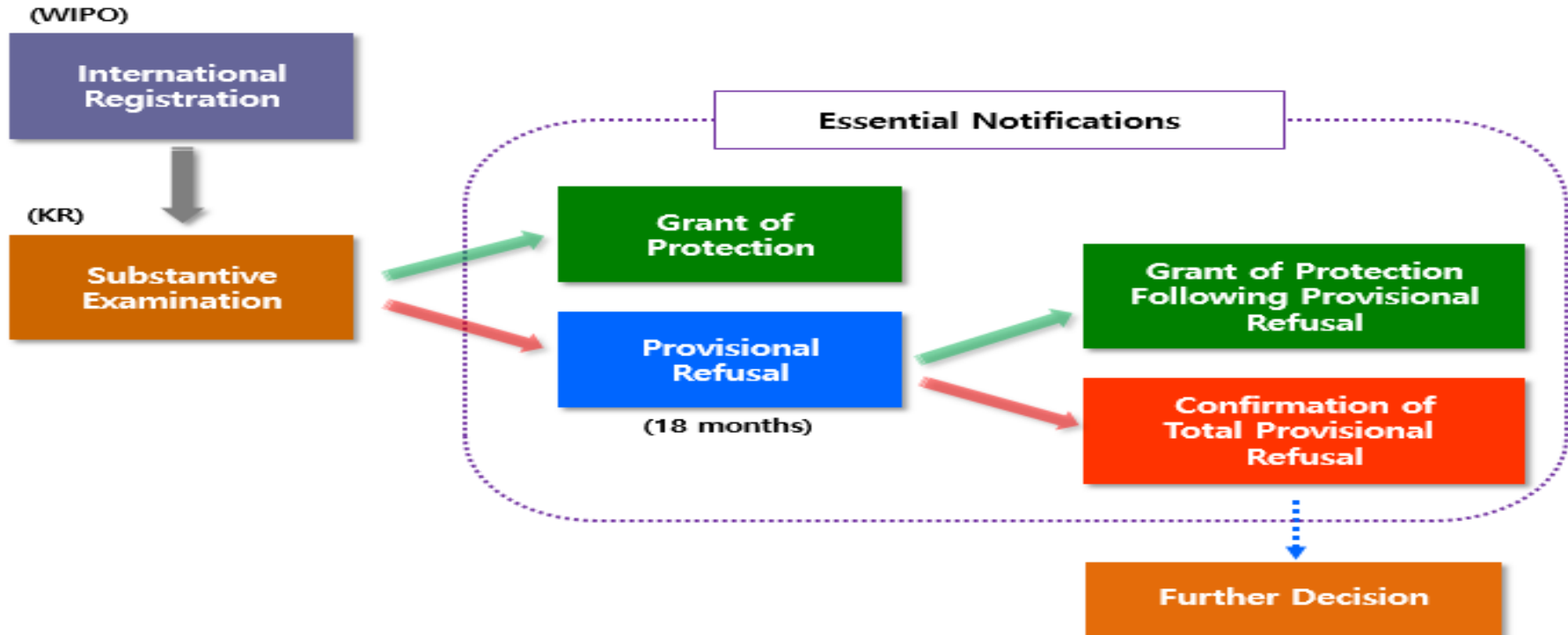
: Search Acceptable Indication of Good & Services

The screenshot displays the WIPO Madrid Goods & Services Manager interface. The browser address bar shows the URL <https://webaccess.wipo.int/mgs/>. The page header includes the WIPO IP PORTAL logo, a MENU button, the text "Madrid Goods & Services Manager", a "Covid-19 Update" notification, and links for HELP, ENGLISH, LOGIN, and the WIPO logo. Below the header, there are utility buttons: Import list, Export list, Print list, Delete list, Display preferences, and Translate into... The main content area is divided into a left sidebar and a main panel. The sidebar has a "Browse" tab and a "Search" tab. The search input field contains the text "fan". Below the search field, there is a checkbox for "NICE only" and a section titled "59 results in class(es)" with a sub-total of "7 | 9 | 11 | 20 | 40 | 44". A list of search results is shown, including "centrifugal fans", "fans for engines", "fans for motors", "radial fans", "ceiling fans", "electric fans", "fan heaters", "roof fans", "ventilating fans", "hand fans", "axial fans for industrial purposes", and "axial flow fans". The main panel shows a class number "7" and a description: "Machines, machine tools, power-operated tools; motors and engines, except for land vehicles; machine coupling and transmission components, except for land vehicles; agricultural implements, other than hand-operated hand tools; incubators for eggs; automatic vending machines." Below this description, the text "fans for engines" is highlighted in green.

TIP 1

- Avoid Vague, Linguistically Incorrect, Incomprehensible Indications

Main Roles of Designated Office



Substantive Examination Flow at KIPO



Question 2

- Time limit to file Opposition in Korea?
 - 1 month
 - 2 Months
 - 3 Months


Examination Criteria on Distinctiveness

- Common name of the goods
- Used customarily in connection with the goods
- Descriptive (quality, effect, usage, etc.)
- Well known Geographical name
- Common surname
- Simple and readily available mark

Examination Criteria on Distinctiveness

- Marks consisted of 2 foreign letters and less
- Marks consisted of 2 numbers and less or it's combination with arithmetic signs
- Marks consisted of combination with 1 foreign letter and 1 number

Comparison with Other Offices

IRN	Mark	Distinctiveness Decision			
			US	JP	EUIPO
1273251	3S	<u>N.Accept.</u>	Accept.	<u>N.Accept.</u>	Accept.
1342412	3E	<u>N.Accept.</u>	Accept.	<u>N.Accept.</u>	Accept.
1326540	R3	<u>N.Accept.</u>	Accept.	<u>N.Accept.</u>	Accept.
1314558	M8	<u>N.Accept.</u>	Accept.	-	Accept.

Comparison with Other Offices

1 Refusal on the ground of distinctiveness

<Refusal Cases>

Presentative Cases	EUIPO	JPO	KIPO	CNIPA	USPTO	Remarks
HOMESAFE (1184010)	○	×	×	×	○	It is non-distinctive by misleading as to the quality of the goods or services (similarly examined by Korea, Japan, and China).
OP9 (1163533)	○	×	○	×	×	The mark merely describes a feature, ingredient or characteristics of applicant's goods (similarly examined by Japan, China, and U.S.).

Comparison with Other Offices

2 Refusal on the ground of distinctiveness

<Refusal Cases>

Presentative Cases	EUIPO	JPO	KIPO	CNIPA	USPTO	Remarks
 (1108281)	O	O	X	X	X	The main part of the trademark, "GRAND WINES", misleads as to the quality of the goods or services (similarly examined by Korea, China, and U.S).
MicroCapture (1115820)	X	O	X	O	O	It is perceived intuitively by consumers as an object that can catch or obtain even the smallest things (similarly examined by Korea and Europe).

Comparison with Other Offices

3 Refusal on the ground of previously similar marks



<Refusal Cases>

Presentative Cases	EUIPO	JPO	KIPO	CNIPA	USPTO
 (1192421)	○	X 	X 	○	X 
 (1159264)	○	○	X  	X  	X 
APAMAN (1111006)	○	○	X  	X  	○

Comparison with Other Offices

4 Refusal on the ground of over-broad or vague products

<Refusal Cases>

Presentative Cases	EUIPO	JPO	KIPO	CNIPA	USPTO	Remarks
 (1201552)	O	X	X	X	O	[Class 16] gift cards → note cards used with gifts (JAPAN) [Class 25] hats → top hats; rain hats (KOREA) [Class 35] 'Retail and wholesale services' is not acceptable (CHINA)
 (1107106)	O	X	X	O	X	[Class 14] goods in precious metals or coated therewith, not included in other classes; → accessories in precious metals or coated therewith; [Class 18] goods made of these materials and not included in other classes; → bags of leather; (KOREA)

TIP 2

: Search Prior Marks in Advance

Perform a trademark search by text or image in brand data from multiple national and international sources, including trademarks, appellations of origin and official emblems. V: 2020-07-20 16:6

Data from San Marin available Over 3,700 records added | Data from Albania available Over 10,000 records added | Data from Ukraine available Over 209,000 records added | Data from Serbia available Over 56,000 records added | Data from Kazakhstan available Over 67,000 records added | Data from Bhutan available Over 19,000 records added | Free webinars/INN searches in the Global Brand Database Webinar | Data from Madagascar available Over 20,000 records added

SEARCH BY: Brand Names Numbers Dates Class Country

Text: e.g. wipo OR ompf, "trial", ompf-

Image Class: e.g. 05.07.13, apple AND tree

Goods/Services: e.g. footwear, comput*

CURRENT SEARCH: BRAND samsung

FILTER BY: Source Image Type Status Origin App. Year Expiration

Source	Image	Type	Status	Origin	App. Year	Expiration					
AE TM	153	AL TM	8	AU TM	334	BH TM	28	BN TM	30	BT TM	4
BW TM	9	CA TM	234	CH TM	82	CL TM	134	CR TM	50	DE TM	98
DK TM	11	DZ TM	30	EE TM	8	EG TM	52	EM TM	686	ES TM	52
FR TM	115	GE TM	11	GH TM	8	GM TM	21	ID TM	150	IL TM	90
IB TM	13	IT TM	61	JO TM	58	JP TM	156	KE TM	59	KH TM	41
KR TM	1,864	KW TM	10	KZ TM	44	LA TM	32	MA TM	43	MD TM	10

Display: List | Value - asc

Brand	Source	Status	Relevance	Origin	Holder	Holder Country	Number	App. Date	Image Class	Nice Cl.	Image
SAMSUNG	JP TM	Active	29	JP	三星電子株式会社	JP	4917981	2005-03-24			
SAMSUNG	JP TM	Active	27	JP	三星物産株式会社	JP	4430639	1997-04-23		2, 4, 5, 18, 20, 28, 39, 41	
SAMSUNG	JP TM	Active	27	JP	三星電子株式会社	JP	4397832	1997-04-15			14, 38
SAMSUNG	JP TM	Active	27	JP	三星電子株式会社	JP	4346059	1993-03-11			9
SAMSUNG, GREEN, SSD, SAMSUNG	JP TM	Active	27	JP	三星電子株式会社	JP	5481828	2011-06-30	VC 05.03, VC 26.01, VC 26.02, VC 26.03, VC 26.04, VC 26.07, VC 26.11		9
SAMSUNG 1 77~	JP TM	Active	27	JP	三星電子株式会社	JP	5733662	2014-04-11			9, 14
SAMSUNG 1 77~	JP TM	Active	27	JP	三星電子株式会社	JP	5721614	2014-04-11			9, 14
SAMSUNG, GREEN, DDR3, SAMSUNG	JP TM	Active	27	JP	三星電子株式会社	JP	5481827	2011-06-30	VC 05.03, VC 26.01, VC 26.02, VC 26.03, VC 26.04, VC 26.07, VC 26.11		9

TIP 3

: Pay Attention to KIPO Examiner's
Suggestions

TIP 4

: Refer to KIPO published Examination Guideline for Similar Goods

https://www.kipo.go.kr/kpo/HtmlApp?c=3089&catmenu=m04_02_02_12

[제1류/G1006] 비(세)외로운 미생물	
상품의 범위	
<ul style="list-style-type: none"> 미생물제제(의료용 및 수의약품은 제외) 타류 : 타류사전에 속하는 상품(예시) 의료용 미생물, 의료용 미생물제제(제1류/G1006) 	
포함되는 상품(예시)	
<ul style="list-style-type: none"> 곰팡이를 효모 밀양제 과학용 또는 실험실용 미생물 과학용 또는 실험실용 세포 과학용 또는 실험실용 형질전환용 미생물 농업생산용 종자 유전자 농업용 미생물제 동물매기물 부패용 세균제제 물처리용 미생물 미생물 배양액(의료용 및 수의약품은 제외) 미생물제제(의료용 및 수의약품은 제외) 바이오(또는)생산물 바이오메스 바이오용 또는 비-수의의약품 바이오용 연구용 동물혁신자 바이오용 연구용 항생유전자 바이오용 토양미생물제 	<ul style="list-style-type: none"> nutrients for yeast for industrial purposes microorganisms for scientific or laboratory purposes cells for scientific or laboratory purposes microorganisms for character orange for scientific or laboratory purposes genes of seeds for agricultural production microorganism preparations for surgical purposes preparations for the decomposition of animal waste microorganisms for use in water treatment cultures of microorganisms, other than for medical and veterinary use preparations of microorganisms, other than for medical and veterinary use biomass for producing bio fuels biocidal preparations other than for medical or veterinary use animal culture used for research other than for medical purposes soil microorganisms other than for medical purposes

<ul style="list-style-type: none"> 식물제초제용 세균 식물원기균 세균(세균양균) 면역관과리용 미생물 면역관과리용 효모(미생물) 유용미생물(C/M)이 첨가된 퇴비용 미생물 후하용(화처리용) 세균학적 제제 토양미생물제제 폐수처리용 세균 폐수처리용 세균(세균양균) 	<ul style="list-style-type: none"> bacteria for use in food manufacture yeast for addition to food products microorganism for acidified maintenance acidic microorganisms used in food manufacture microorganisms for fertilizer adding effective microorganism (EM) bacteriological preparations for acidification soil microorganisms bacteria for wastewater treatment bacterial cultures for wastewater treatment
---	---

[제1류/G1007] 식물성장조성제, 식물용 미량원소제제, 토질개량제	
상품의 범위	
<ul style="list-style-type: none"> 식물성장을 촉진하기 위한 농업용 화학제 식물의 병을 예방하기 위한 농업용 화학제 위에 속하는 농업용 화학제 또는 화학적 용질 	
타류 : 타류사전에 속하는 상품(예시)	
<ul style="list-style-type: none"> 퇴비(제1류/G1011) 미생물제제(의료용 및 수의약품은 제외)(제1류/G1006) 산중제, 산과제, 제초제(제1류/G1004) 	
포함되는 상품(예시)	
<ul style="list-style-type: none"> 식물용 인자억제화합제 식물용 질병 예방제 영양분용 토양보양제 과실성장조성제 과실숙성조성용 호르몬 	<ul style="list-style-type: none"> plant suppressing chemicals for use on crops chemical preparations to prevent diseases affecting cereal plants soil cultivators for soil culture fruits growth regulating preparations hormones for accelerating the ripening of fruit

Question 3

- What ground for provisional refusal is the most common in Korea?
 - Prior right on Similarity
 - Distinctiveness of Marks
 - Indication of G&S

More information

■ Madrid Member Profiles

<https://www.wipo.int/madrid/memberprofiles/#/>

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Q&A Session about the Webinar

Jin-Ou YOO

Examiner, Madrid
Operation Division

Kijoong SONG

Fellow, Madrid
Operations Division

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