

Welcome kit

for European SMEs on
examination requirements
for trade mark applications
in South Korea



Contents

- 1. Introduction /03**
- 2. Features Module /04**
 - 2.1 Main similarities and differences in examination practice /04
 - 2.2 Unique features /06
 - 2.2.1 Similar group codes /06
 - 2.2.2 Patent customer number /09
 - 2.2.3 Priority examination /11
- 3. Proceedings /12**
 - 3.1 Trade mark examination process /13
 - 3.2 Refusal – appeal procedure /17
 - 3.3 Representation /17
 - 3.4 Fees /18
- 4. Examination /19**
 - 4.1 Classification /20
 - 4.2 Trade mark registration requirements /24
- 5. Effects of Changes /35**
 - 5.1 Virtual goods /35
 - 5.2 Partial refusal system /35



1. Introduction

The objective of this Welcome kit is to raise awareness among European SMEs (small and medium-sized enterprises) of the Korean trade mark and the requirements to obtain it. Given the increase of borderless businesses, such as the metaverse and global online markets, SMEs with little knowledge of intellectual property (IP) need to know how to quickly obtain IP rights in overseas markets.

This kit helps European SMEs understand the KIPO (Korea Intellectual Property Office) examination requirements and thus communicate more effectively with Korean attorneys to secure trade mark protection in the internal market of South Korea. We have selected and provided a summarised overview of the main issues from the perspective of a European SME.

The structure of the Welcome kit

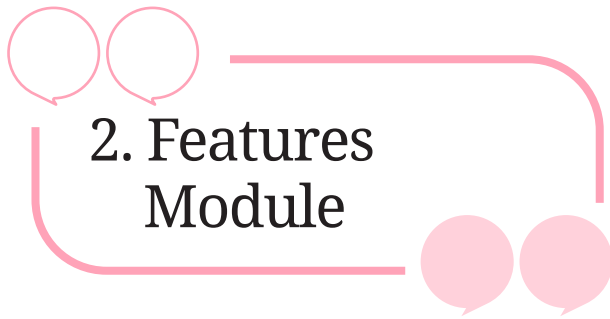
	Features	Proceedings	Examination key	Change response
Modules	Main differences & unique system	Procedural information	Key points in the grounds for refusal in practice	Specific needs in response to changes



This document has been developed within the framework of the TM5¹. It is not intended to replace the KIPO guidelines. The key examination module briefly introduces major cases and examples, focusing on the frequently used grounds for refusal.

To prepare an accurate and detailed Korean trade mark application, apart from consulting this Welcome kit, European applicants are encouraged to seek legal advice from their Korean representatives by referring to the up-to-date original text of the guidelines. These are publicly available on the KIPO website: www.kipo.go.kr/en

¹ TM5 is the name given to the multilateral cooperation forum of the five largest trade mark offices in the world, the China National Intellectual Property Administration (CNIPA), the European Union Intellectual Property Office (EUIPO), the Japan Patent Office (JPO), the Korean Intellectual Property Office (KIPO), and the United States Patent and Trademark Office (USPTO).



2. Features Module

2.1 Main similarities and differences in examination practice

	EUTM	Korean trade mark system
Date of filing	The date on which the documents containing the information specified in Article 31(1) are filed with the Office by the applicant, subject to payment of the application fee within 1 month of filing those documents.	The date an application for trade mark registration is delivered to the Commissioner of the Korean Intellectual Property Office.
Seniority	✓	×
Search report	✓	×
Scope of examination	Formalities, Classification, Absolute Grounds	Formalities, Classification Absolute Grounds, Relative Grounds
Grounds for refusal	Absolute grounds are examined ex officio, third-party observations are possible after publication, before registration. Relative grounds for refusal are only examined ex officio when an opposition/ cancellation is filed.	Absolute grounds for refusal and relative grounds for refusal should be examined ex officio; examiners should perform an obligatory search for prior marks.
Disclaimer	×	×

	EUTM	Korean trade mark system
Opposition	<p>Term: within 3 months from publication date.</p> <p>Scope of grounds: Relative grounds for refusal.</p> <p>*The applicant can file a request for proof of use, requiring the opponent to prove that any earlier mark registered for more than 5 years has been genuinely used.</p>	<p>Term: within 2 months from publication date.</p> <p>Scope of grounds: any grounds for refusal.</p> <p>*Any person may file a formal objection.</p>
Division of Application/ registration	✓	✓
Duration of registration	10 years from the date of filing of the application.	10 years from the date of registration and establishment.
Term of renewal	Within 6 months before expiration of the registration; within 6 months after expiration upon payment of an additional fee.	Within 12 months before expiration of the period of protection; within 6 months after expiration upon payment of an additional fee.
Transfer	<p>An EU trade mark may be transferred, separately from any transfer of the undertaking, in respect of some or all of the goods or services for which it is registered.</p> <p>An assignment of the EU trade mark should be made in writing and requires the signature of the parties (except when it is a result of a judgment).</p>	<p>Can be transferred by dividing it for each of the designated goods. In such cases, similar designated goods are transferred en bloc.</p> <p>Where trade mark rights are owned jointly, no joint owner may transfer their stake or establish a pledge on their stake without the consent of all of the other joint owners.</p>
Use requirement	Non-use for more than 5 years following registration makes the trade mark registration vulnerable to cancellation.	Non-use for more than 3 years preceding the initiation of a cancellation action makes the trade mark registration vulnerable to cancellation.

2.2 Unique features

2.2.1 Similar group codes

Q&A



Q. What is a 'similar group'?

A. Unlike the European trade mark system, KIPO recommends that a trade mark examiner examine ex officio both absolute and relative grounds for refusal at the same time, and notify the decision on these grounds together.



For a speedy examination process, goods and services are classified and then grouped into similar group codes to determine whether they are identical or similar. Goods and services are classified from Classes 1 to 45 according to their function or use based on the Nice Classification. Those belonging to a specific class are further classified into similar group codes by KIPO.

Examples of similar groups:

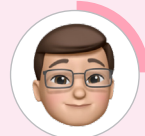
Nice Class	Similar Group Codes	Goods
Class 33	G0601	Soju, makgeolli
	G0601	Wine, whiskey, brandy
	G0601	Ginseng liquor, mushroom liquor

Q&A



Q. If goods have the same group code, are they presumed to be similar to each other even if their class is different?

A. Yes. In principle, if certain goods or services have the same group code, they are presumed to be similar to each other, even if they are in different classes.



Example:

G1302	Class 3	Tooth pastes
	Class 21	Tooth brushes

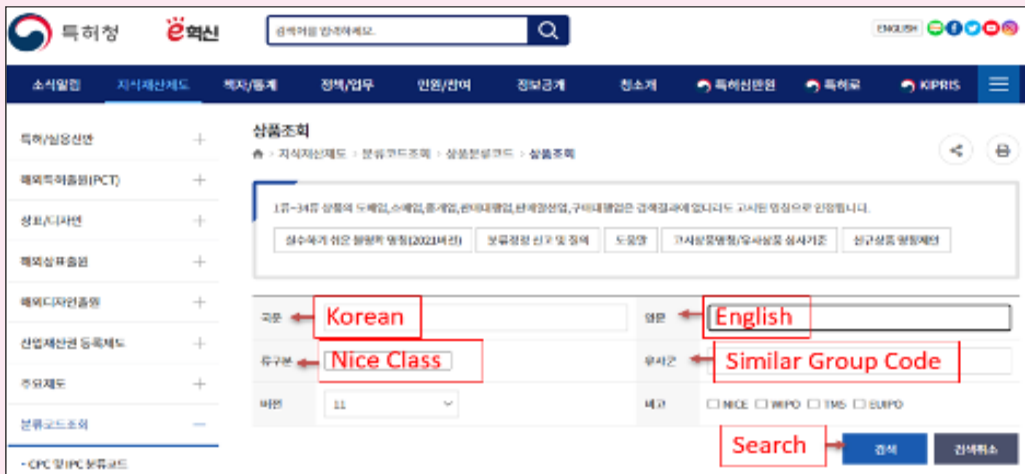
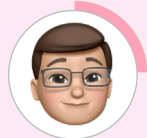
Cosmetics (Class 3)	G1201 (Cosmetics), S120802 (Beauty care services), S120907 (Beauty school services)
Clothing (Class 25)	G430301, G450101, G450102, G4502, G4503, G450401, G4513





Q. Where can I find information about similar group codes?

A. You can find this information in the Goods Search section of the KIPO website. You can also search to see in which group your goods and services belong.



When searching for the name of a product or service, it is recommended to search with a specific name rather than a broad name in order to obtain more accurate information on the similar group code.

Broad terms	Specific terms	Similar Group Codes
Goggles (Class 9)	snow goggles	G3405 (Glasses)
	virtual reality goggles	G390803 (Computers)
	dust protective goggles	G450603 (Face protection shields)



Q&A



Q. What kind of information can users get from a similar group?

A. When a trade mark application is filed, similar groups are established for the designated goods and services. The group code makes it easier for applicants to identify potential conflicting trade marks when conducting a preliminary trade mark search prior to filing a trade mark application. This can be an important reference when checking whether the trade mark applied for is already registered. If there is an opposition by a previous trade mark holder to your trade mark application, you can get an idea whether the goods and services are in conflict by checking their group codes. The group codes can also help you decide whether it may be best to divide your application and proceed with the goods and services that are not in conflict.

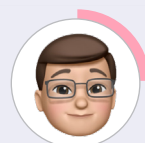


2.2.2 Patent customer number



Q. What is a patent customer number and what are its advantages and characteristics?

A. The patent customer number is a unique 12-digit number that a person starting a trade mark-related procedure receives upon registering their personal information with the KIPO. The customer number enables applicants to have an overview of all their IP rights in KIPO's system.

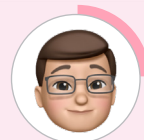


When carrying out procedures with the Korean Intellectual Property Office, including trade mark applications, the patent customer number must be entered in the applicant's column for all applications.



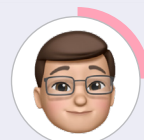
Q. Are foreign natural persons also issued with a patent customer number?

A. Yes. In order to carry out any procedure, including a trade mark registration application, foreign natural persons also need to obtain a patent customer number. In special cases where, for example, a foreign natural person does not have an address in South Korea, the number can be issued through a representative. However, for electronic payment, a joint certificate must also be issued; this can be done through the Korea Information Certificate Authority (signate.com).



Q. What should I do if there is a change in my customer information (address, etc.)?

A. If an applicant's contact information has changed and this has not been updated in the system, they may miss a notification or an urgent communication from a government authority (e.g. in the event that their representative has had an accident). Accurate address information is also required for the payment of registration renewal fees. Applicant information can be changed through a representative, but foreign applicants can also do it themselves by visiting: www.patent.go.kr.



Evidence required when amending applicant information:

Foreign natural persons	Certificate of nationality, certificate of priority, certificate of alien registration, other documentary evidence.
Foreign corporations	The certificate of change of name and address from the relevant competent authority, the notarised declaration of the change of name or address, or the certificate of domestic business office registration.

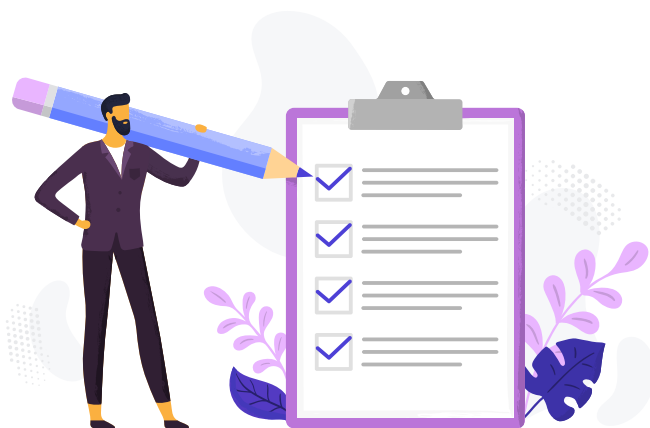
2.2.3 Priority examination

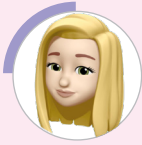
Q&A



Q. What is prioritised examination and what are its main advantages?

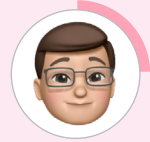
A. The prioritised examination system refers to a system whereby, if a trade mark applied for meets certain requirements, it will be prioritised for examination over other applications. The Trademark Act allows applicants to apply for prioritised examination with documents proving the required facts if it is in the public interest or if there are special circumstances affecting the applicant. This can generally halve the time it takes to register an application. If you will be entering the South Korean market imminently, you can take advantage of this.





Q. Under what circumstances can I apply for prioritised examination?

A. Under the Trademark Act, if certain conditions are met, an applicant or an interested party who has filed an application for a trade mark with supporting documents may apply for prioritised examination. For more detailed conditions, please refer to Article 12 of the Enforcement Decree of the Trademark Act. For foreign SMEs, this can be useful as they can enjoy the benefits of prioritised examination simply by proving the progress of their international applications or the fact of use.



The following cases are usually approved for prioritised examination:

- when it is clear that the applicant is using or preparing to use the trade mark applied for for all the designated goods;
- when an application is filed that is the basis of an international application in accordance with the Madrid Protocol, and the international registration date or post-designation date is registered in the international register pursuant to the Madrid Protocol;
- when an application is filed that is the basis for claiming priority under a treaty, or when it accompanies a priority claim that is still ongoing at a foreign patent office.

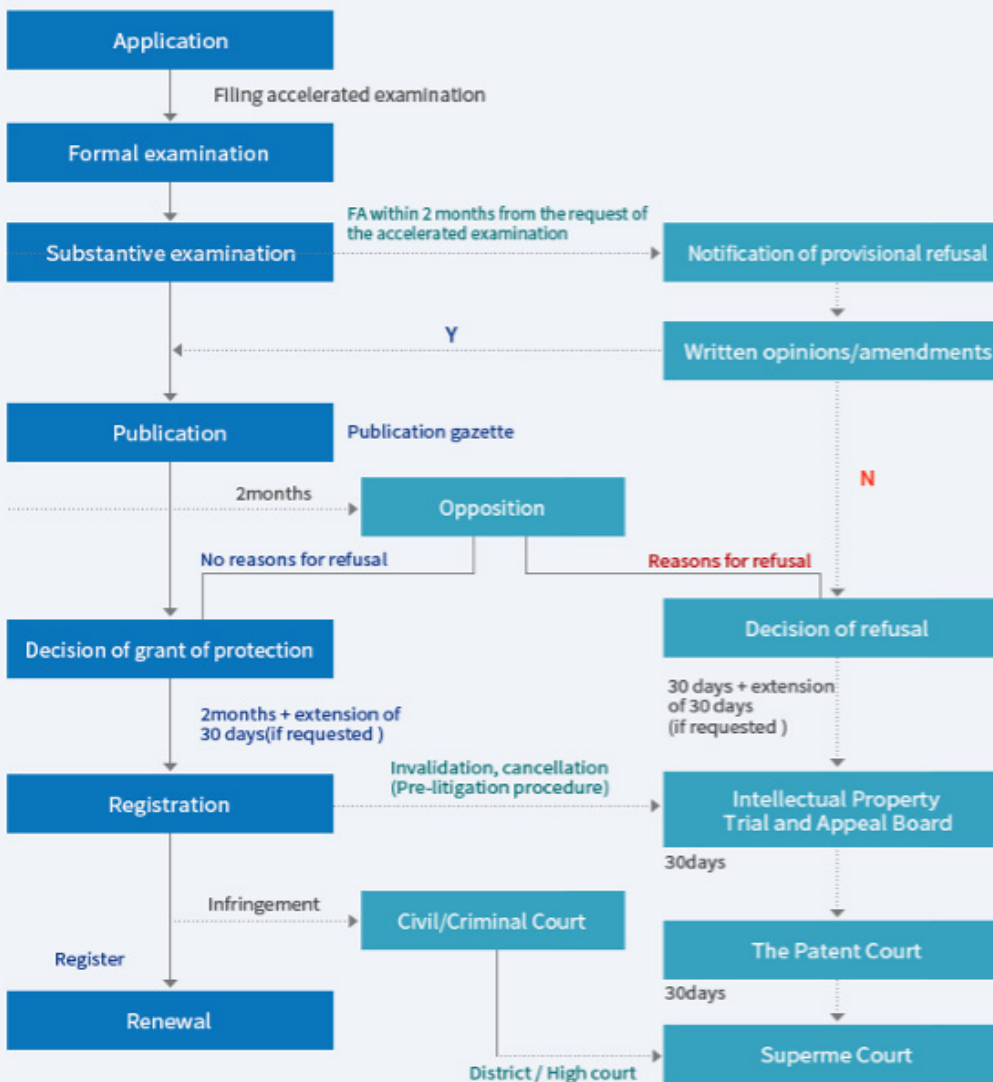
In the event of priority, the practical benefits of applying for prioritised examination must be reviewed with the help of a representative. The application fee for prioritised examination is KRW 160 000 for each class of goods. This must be paid separately from the application fee.



3. Proceedings

3.1 Trade mark examination process

The KIPO examination workflow



Primary examination process

Formality review

Application documents, in particular the payment of fees, the power of attorney and the content of the submitted documents are checked by the application division.

Substantive examination

The examiner verifies that the registration requirements have been met. If an absolute or relative ground of refusal is identified, a notice is sent to the applicant with a deadline to respond. If the objection cannot be remedied the application is refused.

Publication of application

If no grounds for refusal have been identified and/or any existing grounds for refusal have been resolved, the details of the application will be published.

Opposition

Anyone can oppose a published trade mark application within 2 months from the date of publication. The application for opposition must comply with certain requirements that are outlined in the application form. In particular, the grounds for opposition must be stated and the necessary evidence attached. Once the parties have had the opportunity to submit a written response on the grounds for opposition, a decision will be issued. The opponent cannot appeal against an opposition decision, even if the opposition is denied. However, the opponent may request that the registration be invalidated after the trade mark is registered.



Checking the progress of the examination of an application

Anyone can check the progress of examination procedures through the KIPRIS website operated by KIPO: (eng.kipris.or.kr/enghome/main.jsp). This database is open to the public and can be used by anyone without logging in.

Applicants can also check the status of their applications and track the different stages of the examination process through the website Teukheoro (www.patent.go.kr) using their application number.

There are two ways to check the progress of an application on Teukheoro. One way is to log in to Teukheoro as a user to check the applications relevant to you. Or, if you log in to Teukheoro using a joint certificate, you will see a pop-up window where you can check pending applications, as shown in the screenshot below.

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나의 현황

출원/심사	등록	심판	PCT
<ul style="list-style-type: none"> 전자서명대상 17건 통지서 마감기한 0건 심사청구대상 0건 청구명위유예기한 0건 우선권명세서류 제출기한 0건 심사적수예정 0건 	<ul style="list-style-type: none"> 전자서명대상 1건 통지서 마감기한 0건 실정등록대상 0건 연차등록대상 0건 종속기간결산대상 0건 분할납부대상 0건 	<ul style="list-style-type: none"> 전자서명대상 0건 통지서 마감기한 0건 심판청구대상 0건 	<ul style="list-style-type: none"> 통지서 마감기한 0건

특허현황

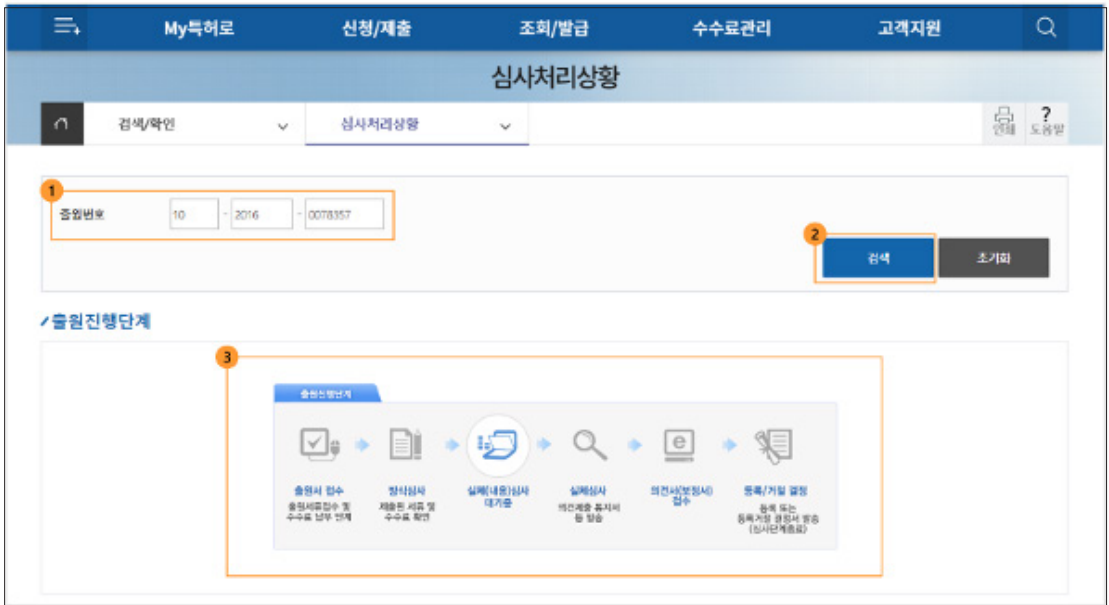
필자별	권리별
<ul style="list-style-type: none"> 출원/심사 27건 등록 0건 심판 0건 	<ul style="list-style-type: none"> PCT 0건 국제상표 0건

특허	디자인	상표	실용신안
특허 10건	디자인 0건	상표 17건	실용신안 0건

제출건내

사용자등록/변경	출원신청	증명서발급	수수료관리
<ul style="list-style-type: none"> 신청결과조회 0건 	<ul style="list-style-type: none"> 제출결과조회 6건 	<ul style="list-style-type: none"> 신청결과조회 7건 증명서수신청 6건 	<ul style="list-style-type: none"> 납부내역조회 0건 납부내역조회(증명서) 0건 자동납부내역조회 0건

The other way is to search by application number. To check your application's progress, go to the 'Search/Confirmation-Examination Status' tab shown below, enter the application number (1), and click on 'Search' (2). After you click on Search, you will be shown which stage the application is at (3): 'Application received' - 'Formality review' - 'Pending substantive (content) examination' - 'Substantive examination' - 'Opinion received (amendment)' - 'Registration/refusal decision issued'. The advantage of this method is that you can check the progress of your application without logging in.



3.2 Refusal – appeal procedure

Refusal

If an examiner finds grounds for refusal that are stipulated in the Trademark Act and sends the applicant a written notification, a refusal may be issued if the applicant does not address the grounds for refusal.

If the grounds for refusal are not remedied, the application will be refused in its entirety, or for part of the goods and services (as of 4 February 2023).

Appealing against a refusal decision

If an applicant receives a refusal decision regarding a trade mark application, an appeal may be filed with the Intellectual Property Trial and Appeal Board within 30 days of the date on which the certified copy of refusal is delivered. The fee for appealing against a refusal is KRW 240 000 per class of goods.

If the applicant disagrees with the Intellectual Property Trial and Appeal Board's decision, this decision may be appealed before the Patent Court. This appeal must be filed within 30 days of the date on which a certified copy of the Intellectual Property Trial and Appeal Board's decision to refuse the appeal is delivered. If the applicant disagrees with the Patent Court's decision, an appeal may be filed with the Supreme Court.

3.3 Representation

In what circumstances is the appointment of a representative necessary?

A foreign corporation or foreign natural person with a residential or business address in South Korea can apply for a patent customer number and trade mark registration without a representative.

A foreign corporation or foreign natural person with no residential or business address in South Korea, however, must appoint a representative in order to apply for a patent customer number and manage the trade mark registration procedure.

- A foreign corporation is a corporation established under the laws of a country other than South Korea, which has its head office or main office in a foreign country (i.e. the place from where the business is managed is not located in South Korea).
- A foreign natural person is a natural person who does not hold South Korean citizenship.

How do I appoint a representative?

When the application process has to be carried out by a representative, you can (1) appoint a representative individually for a specific case (specific trade mark application, etc.); or (2) use a comprehensive power of attorney system that grants comprehensive representation rights to a specific representative without specifying the case in advance.

Applicants who wish to appoint a representative for individual applications must submit a representative appointment report through the Teukheoro website after appointing a representative. Once the agent is appointed, they will represent the applicant during the application process.

Applicants who choose the comprehensive power of attorney system must apply to register for a comprehensive power of attorney through Teukheoro after appointing a representative. The power of attorney for the relevant procedure comes into effect as soon as the person who has been granted with the designated number for comprehensive power of attorney indicates the unique number in documents submitted to the Korean Intellectual Property Office.

3.4 Fees

Application fee: KRW 62 000 per class of goods plus an additional fee for designated goods (KRW 2 000 per goods item if there are more than 20 goods items in a given category).

If the applicant only uses the names of goods designated by the Korean Intellectual Property Office, the fee is reduced from KRW 62 000 to KRW 56 000 per class of goods. Using these designated names may also prevent the goods from being refused.

A registration fee must be paid separately from the application fee.

Registration fees: KRW 211 000 per class of goods plus an additional fee for designated goods (KRW 2 000 per goods item if there are more than 20 goods items in a given category).

Term renewal fees: KRW 310 000 per class of goods plus an additional fee for designated goods (KRW 2 000 per goods item if there are more than 20 goods items in a given category).

For the registration and term renewal fees, an additional local tax of KRW 9 120 is charged.

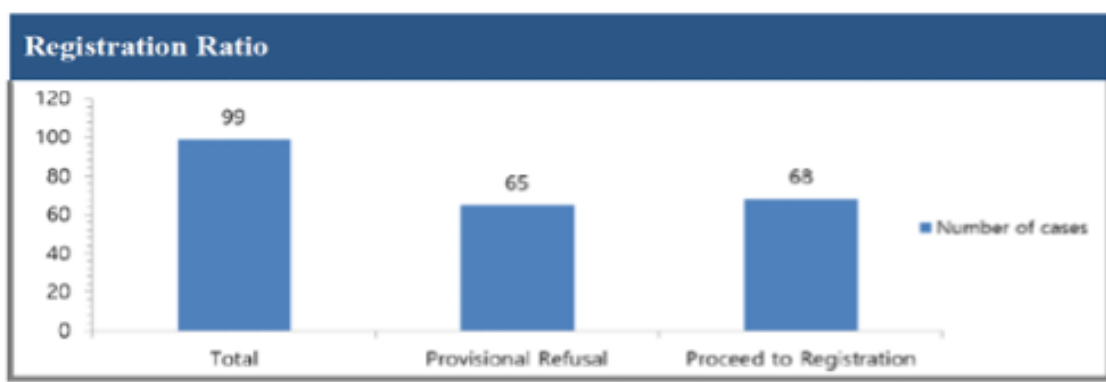
Fee pages for Teukheoro: www.patent.go.kr/smart/jsp/ka/menu/fee/main/FeeMain01.do

4. Examination

This chapter explains the main criteria for examination. For more information, please refer to the Trademark Examination Guidelines and Product Classification Examination Guidelines provided on the KIPO website: www.kipo.go.kr

The most frequent types of refusal in Korean trade mark examinations are down to goods and services with unclear or overly broad names, marks that are identical or similar to preceding marks, or marks that are devoid of distinctive character⁽²⁾.

An analysis of 99 samples at the Korean Intellectual Property Office showed the most common grounds for refusal.



Refusal Grounds & Number of Cases

Grounds	Provisional Refusal	Final Refusal
Comprehensiveness and the lack of clarity of goods/services	30	10
Similarity to the first filed or registered marks	24	12
Non-distinctiveness of the mark	23	18
Famous marks	1	1
Deceptive marks	1	0
Ascertainment of intent to use	1	0

² KIPO (2021), Comparative Analysis on TM5 Trademark Examination Results.

4.1 Classification

What is classification?

Every application contains a list of goods and services. The list must be classified in accordance with the Nice Classification, with each class represented by a class heading (goods from Classes 1 to 34, and services from Classes 35 to 45).

It is very important to apply for the classes of goods and services that are aligned with your business' current and future interests because it will have a direct influence on the protection of your trade mark.

This examination is based on the 'Standard Classification of Goods and Services' and the 'Examination Guidelines for Similar Goods & Services' published by KIPO every year.

South Korea shows the highest number of refusal cases based on comprehensiveness and the lack of clarity of goods/services. If the purpose, material, condition, or operation of the product is unclear, the KIPO issues a provisional refusal against a trade mark application but the applicant can overcome this provisional refusal by amending the application with more specific and clear descriptions of the goods/services.

Applicants are advised to consult the [Goods and Service Search section](#) which contains pre-approved terms and relevant resources. These terms will be accepted for classification purposes and will prevent potential issues in this area. Applicants can search for terms in English.

상품조회
🏠 > 지식재산제도 > 분류코드조회 > 상품분류코드 > 상품조회

1류~34류 상품의 도매업, 소매업, 중개업, 판매대행업, 판매물산업, 구매대행업은 검색결과에 나타나도 표시된 명칭으로 인정됩니다.

실수하기 쉬운 불명확 명칭(2021버전) 분류상징 신고 및 장의 도용알 고시상용명칭/유사상품 심사기준 신규상품 명칭제언

국문: 영문:

류구분: 유사군:

버전: 11 비교: NICE WIPO TMS EUIPO

검색결과: 201건

연번	류	명칭	유사군	NICE	WIPO	TMS	EUIPO
1	1	가구 제조용 접착제 adhesives for use in the manufacture of furniture	G1002		<input checked="" type="radio"/>	<input checked="" type="radio"/>	<input checked="" type="radio"/>



How to avoid classification errors

• Identification of goods and services

Comprehensive identifications, whether broad or narrow, may be acceptable if they are included in the 'Standard Classification of Goods and Services'. However, special caution needs to be taken as some of them may not be acceptable.

- The term 'broadly-comprehensive identification' refers to those goods/services that contain various goods/services that belong to multiple similar groups within a single class or multiple classes. For example, Class 3 Bleach and other laundry detergent [G1001, G1002, G1301] → Acceptable, and includes household bleach [G1001], laundry starch [G1002] and laundry soap [G1301].
- The term 'narrowly-comprehensive identification' refers to goods/services that contain several goods/services that belong to a single similar group within a single class. For example, Class 3 Cosmetics → Acceptable, and includes non-medicated cosmetics, cosmetics using natural ingredients and cosmetics for bathing.
- Comprehensive identifications which are unclear in their use, material and method are unacceptable. For example, Class 5 Medicine → Not acceptable as its range should be limited, such as medicines for humans, medicines for animals, etc.

• Use of Punctuation Marks

The incorrect use of punctuation marks may result in goods being separated or incorrectly classified contrary to the applicant's wishes.

- A comma [,] must be used to separate each of the designated goods (e.g. Class 3: Cosmetics, toiletry articles, perfume).
- A slash [/] needs to be used when similar designated goods are consecutively listed within the acceptable scope (e.g. Class 29: Meat/fish/poultry and game).
- Round Brackets [()] must be used when an indication is homonymous and its meaning needs to be clarified, when the scope of goods concerned is limited or needs to be limited, or when the goods concerned need to be clarified or explained (e.g. long (長) chair, air pistol (toy), disinfectant (excluding soap). Please note that curly brackets and square brackets are not acceptable (e.g. Canopy {excluding the ones for camping}).

- **Avoid using registered trade marks as identifications of designated goods and services**

When another person’s trade mark is used as an identification of a designated good/service, the identification concerned will need to be deleted or replaced by another term upon the request of an examiner.

For example, Class 9 computer program for Samsung →Not acceptable because Samsung is a registered trade mark.

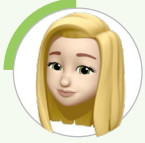
- **Identification of a designated service must be explicitly indicated**

Specifications such as *wholesale services, retail services, sales agency services, sales arrangement services, commodity brokerage, repair services, alteration services, installation services, maintenance services or academy management business* will not be accepted because the scope of the services is unclear.

The designated service has to be indicated with a specific and clear title, such as ‘retail services for specific goods’ or ‘repair services for products which can be classified in the same product group’. For the ‘scope of the same product group’, the actual transactions of the goods concerned, the relevant scope in terms of consumers and channels of distribution will need to be considered.

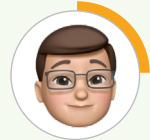
Not Acceptable	Acceptable
wholesale services, retail services, sales agency services, sales arrangement services, commodity brokerage	Furniture retail services, furniture wholesale services, furniture sales agency services, furniture sales arrangement services, furniture brokerage services
repair services, alteration services, installation services, maintenance services	Furniture repair services, bag alteration services, fire alarm installation services, computer hardware maintenance services

Q&A



Q. Can I check on my own whether the terms used for goods and services registered in the EU can be used and registered in Korea?

A. Yes. There may be differences in the goods and service terms that can be registered in different countries. Through the 'Translation Tools' function in [TMclass](#), it is possible to check whether the terms in English can be registered when translated into Korean.

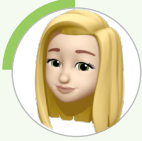


Class	Source term (en)	Target term (ko)	KIPo
0	class	교실	
0	class robe	교실복	✓
0	Unwrought class	직접공 교실	✓
10	class letters	교실용 필자	✓
10	class pens	교실용 필기구	✓
0	class album	교실앨범	✓



4.2 Trade mark registration requirements

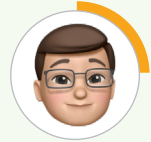
Q&A



Q. What requirements need to be met for a trade mark to be registered?

A. In South Korean trade mark examination, a mark applied for can be registered only when it meets certain requirements.

South Korea's trade mark system allows examiners to determine the eligibility for trade mark registration ex officio upon reviewing what the European trade mark system specifies as absolute and relative grounds for refusal.

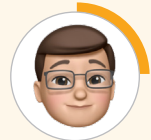


Q. What are the absolute requirements for trade mark registration and what are common grounds for refusal?

A. 1. Non-distinctive marks. Since the most important function of a trade mark is to distinguish one product from another, a mark must have distinctive character in order to be registered as a trade mark. Under the Trademark Act, 'trade mark distinctiveness' refers to the degree of distinctiveness that a trade mark has when placed on a product and whether it helps traders or general consumers recognise whose product it is. In general, the decision on whether a trade mark can be considered distinctive is made in relation to designated goods; each subparagraph of Article 33(1) of the Trademark Act lists the non-exhaustive grounds for refusal of registration due to their lack of distinctiveness when compared to other goods. Descriptive marks fall into the category of non-distinctive marks.

2. Generic names of goods. Trade marks consisting only of marks that display the generic name of a product in a common way.

3. Generic trade marks. A mark commonly used for a certain kind of good in the same industry/market sector.



- 4. Descriptive trade marks.** Trade marks that only indicate the place of origin, quality, raw materials, efficiency, use, quantity, shape, price, production method, processing method, usage method or time of production of the good(s)/service(s) in a commonly used way.

(Indication of origin) Indicates the origin of a product.

(Indication of quality) Indicates the quality and excellence of a product.

(Indication of ingredients) Indicates the name of a product when used as the raw material of another product.

(Indication of efficiency) Refers to a trade mark that indicates the effects or performance of a product.

(Indication of use) Refers to a trade mark that indicates how a product is used.

(Indication of quantity) e.g. 2 pairs, 100 metres, etc.

(Indication of shape and form) Refers to a product's shape, form, size, etc.

(Indication of production, processing or business method) Refers to a trade mark that indicates how the product or service is produced, processed or used.

(Indication of time) Indicates when a product is, or should be, used

Descriptive trade marks also include prominent geographical names, their abbreviation or maps, that is, marks that indicate a prominent geographical name that will be recognised by consumers.

- 5. Common last name or title.** Refers to the common last name of a natural person or a title indicating a legal entity, organisation or trade name.
- 6. Simple and common marks.** Refers to a mark whose composition is simple and common (e.g. 123, ONE, TWO, ß).
- 7. Other indistinctive marks.** Commonly used slogans, mottoes, greetings, etc. (e.g. Believe it or not, I can do, www).

In addition to the reasons falling under subparagraphs 1 to 6, all cases in which the degree of distinctiveness is deemed to be weak are included in subparagraph 7.

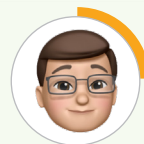
Of these, the clauses pertaining to descriptive trade marks (subparagraph 4) and other trade marks in subparagraph 7, where the consumer cannot identify whose business the trade mark on a product is related to, are often cited as grounds for refusal.

KIPO has **relatively strict criteria for non-distinctive marks.**



Q. How are descriptive marks determined?

A. The decision on whether a mark is descriptive is made in relation to the designated goods. However, the decision does not take into account whether it is actually being used in trade. Even if the use of the mark is indirect or implied in relation to the designated goods, it can be considered descriptive if it is used in a way that is directly indicative of the characteristics or qualities related to the goods.



Examples of indications of efficiency:

Designated goods	Trade mark	Designated goods	Trade mark
Computers	Efficient Network (2003HU151)	colours, dyes	Glass Deco (2003HU2133)
lipsticks, nail varnish	Color Wearing 2002HU2402	credit card services	BLACKCARD (2011HEO10955)

Examples of indications of raw materials:

Designated goods	Trade mark
fishing bait	GLUTEN 글루텐 (2005HU1356)

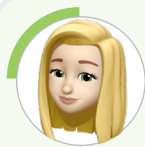
Examples of indications of use:

Designated goods	Trade mark	Designated goods	Trade mark
water dispensers for household use	WATERLINE (2007HU3402)	software for sending and receiving email services, etc.	SOCIAL HUB (2012HU481)

Examples that are not indications of use:

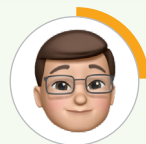
Designated goods	Trade mark
containers for side dishes, etc.	 COOK LOCK (2008HEO6284)

Q&A



Q. How are figurative marks determined?

A. When designing a figurative mark (a combination of a phrase/words with decorative elements), in accordance with Article 33(1) of the Trademark Act, a mark can only be registered if it is not regarded as a descriptive or simple and common mark.

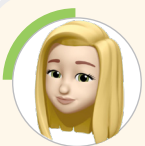


Examples of figurative marks recognised as indications of use:

Designated goods	Trade mark
skin disease medication	 (2003HEO2423)

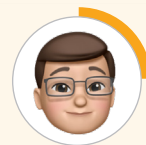
For figurative marks, check whether any graphical features are common in the real world, and whether their design features go beyond simple and common characters or symbols. They should be figurative to the extent that they catch the attention of general consumers as an indication of commercial origin.

A mark can be distinctive when a non-distinctive element is combined with other distinctive phrases or elements. However, it is subject to refusal if it is absorbed (swallowed up) by a simple, common mark.



Q. When is a mark displayed in a commonly used way?

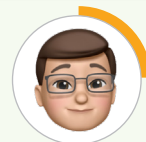
A. A 'mark displayed in a commonly used way' refers to 'a mark composed of printed or handwritten Korean, Chinese or Latin characters'. Even if a generic name is included, if it is only part of the mark and is incorporated into a more distinctive mark constituting an inseparable whole, its distinctiveness may be recognised as a whole. However, this does not apply to cases in which two or more descriptive marks are simply combined.





Q. What are the linguistic criteria for descriptive marks?

A. In principle, descriptive marks written in a language other than Korean (whether written in a foreign language alone or combined with Korean) must be transliterated or translated into Korean, and the transliteration or translation must be checked to ensure that it complies with the Trademark Act.



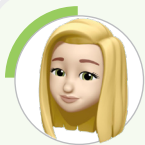
The question as to whether a trade mark in a foreign language corresponds with the Trademark Act (including the Article governing descriptive marks, etc.) is determined based on whether the trading industry or general consumers will recognise its meaning in a transliterated or translated form.

Examples of descriptive marks in foreign languages:

Designated goods	Trade mark	Decision
home repairs for the poor	HABITAT FOR HUMANITY (1997HU3296)	'HABITAT' is not widely known to the general public, but since it has an objective meaning, it will be viewed as a directly descriptive mark in the trading world.
	maquillée (2011HEO10474)	Meaning 'make-up' in French, will be viewed as a descriptive mark if it is used for make-up in the context of the beauty industry.

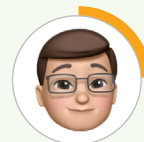
This is deemed to be the case if the mark is extremely similar to an English word that will be easily recognised by general consumers in South Korea, or if the two words will be easily recognised as words with the same or similar meaning. For example, given that AUTOMATIQUE is recognised as a variant of AUTOMATIC, distinctiveness is not recognised for vehicles.

Q&A



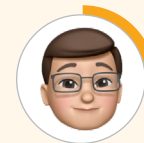
Q. How is distinctiveness determined?

A. Distinctiveness is determined at the time of taking a decision. In the case of a combined mark, it is determined based on the entire mark and from the perspective of general traders or consumers of the designated goods. Usually, this will be determined based on the average perception among the general public.



Q. What are the relative requirements for trade mark registration and what are the consequences?

A. Even if a trade mark has been found to be distinctive for the goods, it may be necessary to deny the registration of the trade mark if granting trade mark rights of an exclusive nature would infringe on the public interest or the interests of others. Article 34 of the Trademark Act provides the relevant rules.



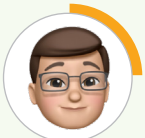
There are more cases of provisional refusal at KIPO than at the other TM5 offices for reasons of identity or similarity to existing trade marks.







Q. What is the similarity of a trade mark and how is it determined?

A. 'Similarity of trade marks' refers to cases where, although two trade marks are neither completely identical nor recognised as being the same in terms of the common concept in the trading world, traders or general consumers can misperceive or confuse the source of the goods because the trade marks are similar in at least appearance, sound or concept, and are being used for the same or similar goods.



The similarity of trade marks is determined based on the possibility of causing confusion regarding the source of the goods based on consumers overall impression of the appearance, sounds, concepts, etc. of the trade marks that are being used for the same or similar goods. Though two marks are similar in some aspects, their differences and their overall impression may still make confusion regarding the source of the goods unlikely. Conversely, though there are differences in each element, trade marks may still be considered similar if, when considered as a whole, any similarity is deemed likely to cause confusion among general consumers or traders. To sum up, trade marks may be considered not similar when viewed as a whole despite their coincidence in certain aspects.

Example:

Case	Prior Mark	Comments
<p>HiSense (1164392)</p>	 (flow by hisense)	The mark cannot be accepted because it sounds the same as "hisense", the dominant part of the prior mark.
<p>INVISIBLE 'SCREEN (1161007)</p>		The mark cannot be accepted because they are similar in sound and meaning to prior mark

Sound

Similarity in the sound of the marks must be determined in light of the relevant public. In particular, in the case of fanciful trade marks that do not convey any concept, the aural similarity may be the most important determining factor.

In determining the aural similarity of trade marks in foreign characters, not only the sounds for Koreans should be taken into account, but also the representative sounds for the foreign consumers in question.

- **Word marks.** In general, similarity is determined by comparing the words at the start of a sound. In the case of trade marks with foreign-language characters, in principle, trade marks written in English follow English pronunciation rules unless there are special circumstances to pronounce them otherwise. However, if a pronunciation other than English is commonly used for certain goods, such as the German pronunciation of pharmaceuticals or the French pronunciation of cosmetics, it will be accepted as such.
- **Figurative marks.** If there is a natural name that is commonly used, such as a type of animal or plant, it will be accepted as such. However, in the case of a trade mark that only consists of elements that do not evoke any special names, similarity will be determined based mainly on appearance rather than sound.

Examples of marks with a similar sound:

REVILLON ≈ REVLON, TVC ≈ TBC, EVOL ≈ EPOL, TOBY ≈ TOPY
DANYL ≈ DAONIL, ADEFLOX ≈ ADOPRON, SAUFNEN ≈ SAFUNENSO

Examples of marks with a dissimilar sound:

SOLAR ≠ polar, TBC ≠ CBC

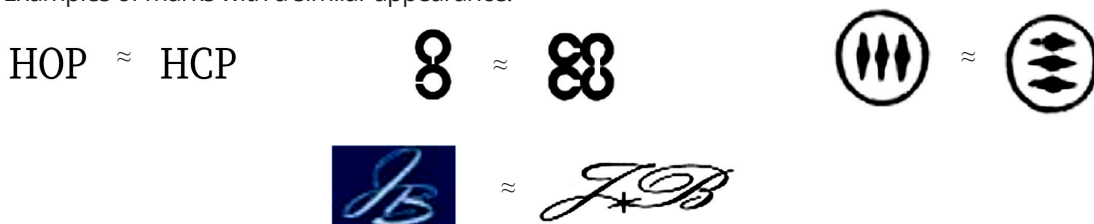


Appearance

'Appearance' refers to the external shape of the trade mark, including the symbols, letters, figures, etc. displayed on the mark. Similarity of appearance is determined by establishing whether the external shape may cause a misperception or confusion. Similarity should, in principle, be determined by observing the appearance intuitively and in isolation.

Although determining the similarity of appearance mainly concerns symbols, figures, three-dimensional shapes or trade marks that combine colours with the aforementioned, the composition and form of the letters of word marks should also be taken into account.

Examples of marks with a similar appearance:



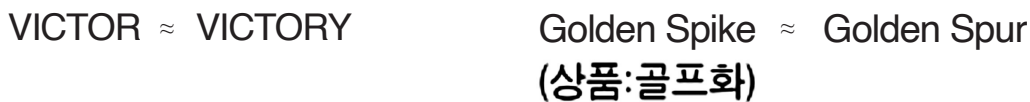
Examples of marks with a dissimilar appearance:



Concept

'Concept' refers to the meaning that a trade mark has, and, as with the sound, it stems from the principal part of the trade mark. In trade marks with words that have a certain meaning, if the sound is similar, then the concept is usually similar as well. When a word with a certain meaning is combined with a modifier, such as an adjective, it is, in principle, regarded as similar in concept to a word without a modifier. However, trade marks that are made up of coined words that do not have any meaning cannot be said to have a concept. These types of trade mark are therefore not subject to this comparison, and similarity must be determined based on other factors.

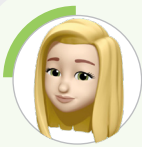
Examples of marks with a similar concept:



Examples of marks with a dissimilar concept:

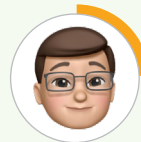


Q&A



Q. What is a combined trade mark and how is similarity determined?

A. 'A 'combined trade mark' is a trade mark consisting of a combination of letters, symbols, figures, and three-dimensional shapes and colours, either individually or in combination. For example, this concerns not only a combination of letters and figures, but also cases in which different letters are combined. Accordingly, a considerable number of marks may fall under this category.



Similarity of combined trade marks is determined by considering the degree of combination. This does not apply where it is obvious that the combination of each constituent part of a trade mark results in an overall noticeably different appearance, sound or concept. Specifically, in the case of a trade mark in which figures and letters or letters and letters are inseparably combined, similarity is determined based on the sound generated from the whole.

However, even with combined trade marks, if there are dominant elements that will attract the consumer's attention, similarity is determined by focusing on comparing these elements. Where two or more distinctive sounds appear in one trade mark, similarity is determined by comparing and contrasting the sounds.

Where word characters are combined, trade marks consisting of a combination of adjectives and nouns are, in principle, considered similar to trade marks made up solely of nouns that are not combined with adjectives.

Examples of marks that are similar due to a combination of nouns and adjectives:

STAR ≈ SUPER STAR MAGIC SALON ≈ SALON
매직 살롱 ≈ 살롱

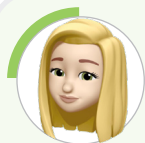
A trade mark consisting of different word elements is considered to be similar to a trade mark consisting of only one of these words if this meaning can be perceived separately. However, this does not apply where the combined phrase results in a new concept.

Examples of similar marks combined with two phrases

COSMO WIND ≈ COSMO asics ≈ TIGON
TIGON ≈ 타이건

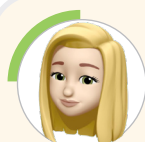
Examples of dissimilar marks combined with two phrases:

SUNSTAR ≠ SUNMOON FREEPORT ≠ OLDPORT



Q. How is the similarity of the designated goods determined?

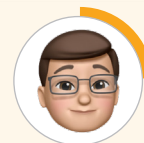
A. Whether or not the designated goods are similar is determined based on the usual perception of market transactions by referring to the similarity of the group codes, taking into account the properties of the goods, such as quality, shape, use, production section, sales section, range of consumers, etc. (product criterion No 10).



Q. What issues can arise after trade mark registration?

A. Even though a trade mark has been registered, it may be cancelled (in the event of non-use, from the date the cancellation request was submitted) or invalidated (as if it had never existed).

Non-use is the most common reason for a request for cancellation, while identity or similarity with an earlier trade mark is the most common reason for a request for invalidity.





5. Effects of Changes

This chapter presents recent developments and major changes to the examination criteria that may have a significant impact on users.

5.1 Virtual goods

How are virtual goods examined?

KIPO is expanding the scope of goods' specifications by recognising the combined form of 'virtual + real goods', such as 'virtual clothing' and 'virtual shoes'. However, given the ambiguity of the scope of the goods, the term 'virtual goods' alone is not recognised as an acceptable specification.

- **Determining similarity between virtual goods.** Virtual goods that would not be similar in their physical form are assumed to be dissimilar. Even though they have similar group codes, as with the real goods, they are individually determined based on characteristics.
- **Determining similarity between virtual and real goods.** Virtual goods and real goods are deemed dissimilar due to the differences in their characteristics, sales channels, etc. However, if a trade mark applied for is similar to a well-known earlier trade mark, further examination will be carried out to verify whether there is a possibility of confusion with the existing trade mark.

5.2 Partial refusal system

If the refusal only affects part of the goods, what about the remaining goods of the application to which the grounds for refusal do not apply?

As of 4 February 2023, applications for trade mark registrations filed with KIPO will be subject to the partial refusal system. Accordingly, if the grounds for refusal only apply for certain designated goods in a trade mark application, the applicant may obtain trade mark registration for the other goods not subject to the grounds for refusal. The applicant does not need to take additional measures to remove the goods. However, any trade mark application filed before 3 February 2023 will be regarded as a single unified application, meaning that even if the grounds for refusal apply to only some of the designated goods, the application may be refused in its entirety.

