

**Document on technical and procedural aspects relating
to the registration of collective marks**

- Korean Trademark Act has no provisions about the certifications marks yet, but KIPO has been introducing a system of certifications marks in the Trademark Act.

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KOREAN INTELLECTUAL PROPERTY OFFICE

□. PROCEDURAL ASPECTS RELATING TO THE REGISTRATION OF COLLECTIVE MARKS

1. GENERAL

Except as otherwise stipulated in the Trademark Act, the provisions in this Act that are related to trademarks apply to service marks, collective marks and business emblems.

The principles applicable to trademark registration application and other procedural requirements include: (i) the “putting it in writing” principle, (ii) the principle of formality, (iii) the principle of “Korean only,” (iv) the first□to□file principle, (v) the principle of fee□for□service, and (vi) the principle of “one trademark per application.” As registration of trademarks is not allowed unless in accordance with these principles, these principles also have the nature of the procedural requirements for trademark registration.

2. APPLICATION PROCEDURES

- (1) Any person intending to obtain a trademark registration is required to file an application with the KIPO, disclosing the following:
 - (i) The name and address of the applicant (or if the applicant is a corporation, the name and the location of its place of business);
 - (ii) the name and the address or the location of the place of business of the attorney acting for and on behalf of the applicant, if any (or if the attorney is a patent law firm, the name and the address of its office as well as the name(s) of the attorney(s) on the record),
 - (iii) a trademark,
 - (iv) designated goods and their classes,
 - (v) the gist of the claim for priority considerations, if any, and the name of the country in which the first application is filed, as well as the date of such application; and
 - (vi) any other statements as prescribed by the Decree of the MOCIE and/or the Enforcement Regulations of the Act.

- (2) A person seeking to register a collective mark shall file an application to register

a collective mark stating the matters above-mentioned and accompanied by the articles of association that govern the use of the collective mark, as prescribed by Presidential Decree.

- (3) 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.

3. AMENDMENT PROCEDURES

(1) By an amendment order

Where any application, request or other procedure for a trademark falls under any of the following, KIPO or the KIPT is required to order an applicant to amend it within a fixed period (Article 13 of the Act):

- (i) where the requirements of Article 3(1) of this Act or Article 6 of the Patent Act, as applied under Article 5 of this Act, have not been complied with;
- (ii) where the formalities requirements prescribed in this Act or by ordinance under this Act have not been complied with; or
- (iii) where the fees required under Article 37 have not been paid.

(2) Voluntary amendment by the applicant

An applicant may voluntarily amend any procedural defects despite the lack of an amendment order given by KIPO or the KIPT.

4. MODIFICATION PROCEDURES

"Modification of an application" refers to the *pro-forma* modification of an application within the confines of the Trademark Act while the identity and the substance of the applicant are maintained. It refers to the conversion among trademark applications, service mark applications and collective mark applications into one for trademark registration (Art. 19 of the Act).

5. PROCEDURES OF CLAIMING PRIORITY

(1) Priority claimed at the time of the application for registration

Although priority arises at the time of the formal application within Country 1, it is merely a potential right. Therefore, in order to reap the benefits of priority, one is required

to claim priority at the time of the application for trademark registration in Country 2 (Art. 4 D. of the Paris Convention).

(2) Filing of documents evidencing priority

Any person claiming priority at the time of filing for trademark registration must file:

(i) with KIPO, (ii) within three months of the filing of an application, (iii) the certified copies of the documents specifying the date of the initial application, trademark and designated goods as recognized by the government of the country in which it was filed (Art. 20 (4) of the Act). If such person fails to file the above documents within such period, the claim for priority loses its effect (Art. 20 (5) of the Act).

6. EXAMINATION PROCEDURES

(1) KIPO must recognize the date on which an application for trademark registration is received by it as the date of application for trademark registration except (Art. 9□2 (1) of the Act):

- (i) where the reason for seeking to obtain a trademark registration is not clearly stated;
- (ii) where the name of the applicant is not stated, or such statement is not clear enough to identify the applicant;
- (iii) where the trademark for which registration is sought is not indicated in the application or such indication is not clearly discernable as a trademark;
- (iv) where designated goods are not stated; and
- (v) where the application is not prepared in Korean.

(2) Where an application for trademark registration falls under any of the above items (i) through (v), KIPO must order the applicant to supplement the application within a reasonable period of time (Art. 9□2 (2) of the Act). Where the applicant has supplemented his application either by a supplementation order within a prescribed period of time or voluntarily, the date on which the applicant filed a procedural supplement must be deemed as the date of filing for trademark registration (Art. 9□2 (4) of the Act).

(3) Any person objecting to the non□acceptance (or rejection) of documents by KIPO may seek remedies by instituting administrative appeals under the Administrative Appeals Act or administrative suits under the Administrative Litigation Act.

- (4) KIPO or the KIPT is required to examine whether trademark applications, requests or other documents have been duly prepared (*i.e.* formal requirements) and order that any defects discovered therein be amended. More specifically, KIPO or the KIPT must order that amendments be made within a prescribed period of time when: (i) filing is in violation of the provision of Article 3 (1) of the Patent Act (violation of the capacity provision) or of the provision of Article 6 thereof (violation of power of attorney), applicable *mutatis mutandis* under the provision of Article 5 of the Trademark Act; (ii) filing is in violation of the formalities as prescribed by the Act or an order under the Act; or (iii) the fees payable under the provision of Article 37 of the Act have not been paid.
- (6) 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 above-mentioned 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). In rendering a decision to deny a trademark application on certain grounds for refusal, the examining attorney must notify the applicant of such grounds for refusal in advance and afford the applicant an opportunity to file an opinion within a prescribed period (Art. 23 (2) of the Act). In which case, if the grounds for refusal concern, in whole or in part, two or more classes of designated goods, then the examining attorney must state specific grounds for each class of designated goods (amended in Jan. 2007).

7. PUBLICATION PROCEDURES

(1) Publication decision

The examining attorney must render a decision to publish a trademark application where no grounds for refusal have been found (Art. 24 (1) of the Act); provided, however, that the decision to publish an application must be deferred until thirty days after a certified copy of a decision to reject a pre-publication amendment, if any, is served, and the examination of the application must be suspended until a final decision is rendered in a proceeding, if any, and finally brought by the applicant against said decision to reject the amendment.

(2) Service of a certified copy of a decision; publication

If a decision to publish an application is rendered, KIPO must have a certified copy of the decision served upon the applicant and then publish the application in the Official Gazette (Art. 24 (2) of the Act).

(3) Accessibility

KIPO must make a trademark application and any other documents attached thereto accessible to the public at its office for a period of two months from the date of publication (Art. 24 (3) of the Act).

8. OPPOSITION PROCEDURES

(1) An opposition may be filed within two months of the date of publication (Art. 25 (1) of the Act), which is made invariable by law and thus may not be extended. The Act as amended in January 2007 extended the period of opposition, from thirty days to two months from the date of publication.

(2) Any person intending to oppose a trademark application is required to file an opposition as well as provide necessary evidence with KIPO (Art. 25 (2) of the Act):

(3) An opposer may amend such grounds for opposition and present evidence as stated in his opposition within thirty days of the expiry of the period of opposition.

(4) Service of a copy of an opposition; granting of an opportunity to file a response
Upon the receipt of any opposition to trademark application, the examining attorney must have a copy of the opposition served upon the applicant and grant him the opportunity to file a response (Art. 27 (1) of the Act).

(5) The examining attorney must render a decision on the opposition(s) after the expiration of the period in which oppositions may be filed and amended, as well as, the period in which the applicant may file a response. If the opposer has failed to file grounds for opposition and provide evidence, then the examining attorney may make a decision to reject the opposition (Art. 27 (3) of the Act).

(6) No proceeding may be brought against a decision on the opposition. The purpose of this is to expedite the examination procedures, as the applicant may contest the decision through a proceeding against the refusal decision, and the opposer may contest a decision through an invalidation or cancellation proceeding

9. REGISTRATION PROCEDURES

- (1) Any person seeking to obtain registration of a trademark, additional registration of designated goods or renewal of a trademark, must pay a trademark registration fee within the period of payment prescribed by ordinance of the Ministry of Commerce, Industry and Energy (Art. 34 of the Act)
- (2) Upon request, the Commissioner of the Korean Intellectual Property Office may extend the period for paying trademark registration fees under Article 34(3) by not more than thirty days.
- (3) KIPO must issue to the trademark owner a trademark registration certificate upon the registration of a trademark (Art. 40 (1) of the Act). In addition, KIPO must have the certificate returned and corrected or issue a new certificate upon request or *ex officio* if the certificate is not consistent with the entries in the trademark register. Certificates include: trademark registration certificates, service mark certificates, trademark/service mark certificates, collective mark certificates and business emblem certificates.

10. PRE-LITIGATION PROCEDURES

A trademark proceeding is a pre-litigation procedure administered prior to reaching the court of last resort by the Korean Intellectual Property Tribunal, an administrative body, where substantive law is interpreted and applied to resolve disputes on the establishment, modification and lapse of rights to trademarks or to outline their scope. This type of administrative procedure has been established to allow the KIPT, being in possession of professional and technical expertise and experience, to have trademark disputes resolved by a panel of judges in a rational manner.

(1) Appeal from refusal

“Appeal from refusal” refers to a proceeding brought before the KIPT by any person, who is dissatisfied with a decision to refuse a trademark application, moving that the refusal be reversed and his mark be registered (Art. 70-2 of the Act).

A petition for an appeal proceeding against a refusal must be filed within thirty days of the service of a certified copy of the refusal decision (the latter part of Art. 70-2 of the Act); provided, however, that for the benefit of a person residing in an area that is remote or difficult to access, such period may be extended *ex officio* or upon the request of the petitioner

Any person desiring to file an appeal proceeding against a refusal of a trademark application must submit a petition including such statements as prescribed in the Act to the KIPT and pay a proceeding fee (Art. 79 (1) of the Act).

Upon the filing of a proceeding against a refusal, the refusal does not become final and the applicable application stays pending. Within thirty days of the filing of a proceeding against refusal, the designated goods and trademark may be amended within a certain extent that does not modify the essentials of the first application for trademark registration as to matters specified in the ground for refusal (Art. 15□3 of the Act).

Any person dissatisfied with a decision rendered by the KIPT may lodge a lawsuit seeking to reverse the decision before the Patent Court of Korea within thirty days of the service of a certified copy of the decision (Art. 86 (2) of the Act; Arts. 186 (1) and 186 (2) of the Patent Act *mutatis mutandis*).

(2) Appeal from rejection of amendment

“Appeal from rejection of amendment” refers to a proceeding brought before the KIPT by any person who is dissatisfied with a decision to reject an amendment to an application that has been rendered on the ground that such amendment modifies the essentials of the application. The appeal moves to reverse the rejection and proceed examination in reliance on the application for trademark registration or reclassification of designated goods as so amended (Arts. 70□3 and 79 (1) of the Act).

A petition for an appeal proceeding against a rejection of an amendment must be filed within thirty days of the service of a certified copy of the rejection decision (the latter part of Art. 70□3 of the Act); provided, however, that for the benefit of a person residing in an area that is remote or difficult to access, such period may be extended *ex officio* or upon the request of the petitioner (Art. 5 of the Act; Art. 15 (1) of the Patent Act *mutatis mutandis*). Furthermore, if the person entitled to file the petition was not able to comply with the above period for petition due to an event that is not attributable to such person, then he may subsequently file the petition within fourteen days of the day on which such event ceases to exist unless one year has elapsed since the expiry of the above period (Art. 17 of the Act).

Any person desiring to file an appeal proceeding against a rejection of an amendment must submit a petition including such statements as prescribed in the Act to the KIPT and pay a proceeding fee (Art. 79 (1) of the Act).

Any person dissatisfied with a decision rendered by the KIPT may lodge a lawsuit seeking to reverse the decision before the Patent Court of Korea within thirty days of the service of a certified copy of the decision (Art. 86 (2) of the Act; Arts. 186 (1) and 186 (2) of the Patent Act *mutatis mutandis*).

(3) Proceeding to invalidate trademark registration

“Proceeding to invalidate trademark registration” refers to a proceeding where if a panel of judges of the KIPT finds a trademark registration defective, then they will extinguishes a trademark registration retroactively or prospectively in accordance with proceeding procedures.

The Trademark Act provides a negative list of grounds for the invalidation of a trademark registration, including the cases where the trademark registration or additional registration of designated goods has been recorded in violation of important statutory requirements, or the denunciation, modification or signing of a treaty occurring after registration has rendered it impossible to recognize the trademark registration (Art. 71 (1) of the Act). The grounds for the invalidation of trademark registrations may be classified into either intrinsic grounds and *ex post facto* ones according to the date on which they came into existence; or time-barred ones and non-time barred ones (Art. 76 (1) of the Act).

An invalidation proceeding may be filed within the duration of a trademark registration as well as after the lapse thereof (Art. 71 (2) of the Act). The damage caused due to the loss of goodwill of a trademark user that has accumulated through the use of a mark for a long period of time far outweighs the damage to third parties caused due to the exercise of potentially conflicting rights. To prevent the former damage and ensure legal certainty through early resolution of legal rights, it is provided that an invalidation proceeding may not be brought against a trademark registration violating the private interest provisions of Articles 7 (1) 6 through 7 (1) 9, 7 (1) 14 and 8 of the Act if five years have elapsed since the date of registration of the mark (Art. 76 (1) of the Act).

After a KIPT decision invalidating a trademark registration becomes final, no person may file a proceeding in reliance on the same facts and evidence of the case. This is to prevent two contradictory decisions from being rendered in the same case. This provision, however, does not apply if the final KIPT decision is a dismissal (Art. 77 of the Act; Article 163 of the Patent Act *mutatis mutandis*).

Trademark rights are deemed not to have arisen from the outset if a decision invalidating a trademark registration becomes final. If the invalidation of a trademark registration becomes final on a ground that it came to exist after the registration of a mark, the rights to the mark lapse from the point at which the registered trademark pertains to such ground onward, not retroactively to the date of registration (Art. 71 (3) of the Act); provided, however, that if such point may not be pinpointed, the trademark rights lapse from the date of registration of the announced invalidation proceeding, on which the filing of the proceeding is published in the trademark register (Art. 71 (4) of the Act).

If trademark rights lapse, any licenses and pledges incidental to the trademark rights lapse as well.

If a registered trademark lapses due to a final decision invalidating it, any trademark identical or similar to said registered trademark designating identical or similar goods is not registrable if the application for its registration is filed within one year of the day on which said decision becomes final (Art. 7 (1) 8 of the Act); provided, however, that the provision of Article 7 (1) 8 is not applicable and thus an exception is made and such trademark is registrable in any of the following cases (Art. 7 (4) of the Act):

(i) where said registered trademark had not been used for more than one year as of the date on which the rights to it lapse; (ii) where a decision invalidating a registered trademark on the ground of violation of the provisions of Articles 7 (1) 6, 7 (1) 9, 7(1) 10, 7 (1) 11, 7 (1) 12 or 8 of the Act becomes final and thereafter the legitimate applicant files for the registration of it again; (iii) where the registration of a trademark is filed for after a period of six months under the provisions of the proviso of Article 43 (2) of the Act and has elapsed since its previous registration was not renewed; (iv) where petitioner in a cancellation proceeding applies for trademark registration under the provisions of Articles 8 (5) and 8 (6) of the Act (amended in 2007); and (v) where an application for trademark registration is filed after the period in which petitioner in a cancellation proceeding may obtain trademark registration under the provisions of any Subparagraph of Article 8 (5) of the Act (amended in 2007).

(4) Proceeding to cancel a trademark registration

“Proceeding to cancel a trademark registration” refers to a proceeding where a panel of judges of the KIPT prospectively extinguishes a trademark registration if the registration is once validly established and later falls within the scope of certain statutory grounds (Art. 73 of the Act).

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

(i) cancellation of a trademark registration due to illegitimate use by the trademark owner thereof (Art. 73 (1) 2 of the Act); (ii) cancellation of a trademark registration due to nonuse of a registered trademark (Art. 73 (1) 3 of the Act); (iii) cancellation of a trademark registration due to the violation of requirements for the transfer of the registration (Art. 73 (1) 4 of the Act); (iv) grounds for cancellation pertinent to the use of collective marks (Arts. 73 (1) 5, 73 (1) 6, 73 (1) 10, 73 (1) 11 and 73 (1) 12 of the Act); (v) cancellation of a trademark registration that is filed by an attorney in fact of a foreign trademark owner without the consent of the trademark owner (Art. 73 (1) 7 of the Act); (vi) cancellation of a trademark registration due to an act of creating confusion or misunderstanding by a licensee (Art. 73 (1) 8 of the Act); and (vii) cancellation of a trademark registration that may create confusion or misunderstanding as a result of the transfer of a similar trademark (Art. 73 (1) 9 of the Act).

These grounds for cancellation related to a collective mark registration are specifically discussed below.

- (□) Art. 73 (1) 5 of the Act provides for yet another ground for cancellation: where a member of a collective organization holding a collective mark has allowed a non-member to use the collective mark in contravention of the articles of incorporation of the organization
- (□) Article 73 (1) 6 provides a ground for cancellation: where any modification to the articles of incorporation made after the registration of the collective mark might create misunderstanding as to the quality of goods or confusion with the goods related to any business of another person among general consumers.
- (□) Article 73 (1) 10 provides a ground for cancellation: where a holder of a collective mark willfully omitted to take reasonable measures against any non-member who causes misunderstanding as to the quality of goods or confusion with the goods associated with another person’s business among consumers by using the collective mark.

A trademark registration lapses prospectively from the point at which a KIPT decision to cancel the registration becomes final and conclusive (Art. 73 (7) of the Act).

Any trademark owner or user of a registered trademark may not obtain the registration of any trademarks identical or similar to said registered trademark within three years if there is a petition for a cancellation proceeding against said trademark on any of the grounds as set forth in Articles 73 (1) 2, 73 (1) 3, 73 (1) 5 and 73 (1) 5 through 73(1) 12 of the Act and thereafter:

- the period as set forth in the proviso of Article 43 (2) of the Act has expired – the trademark registration has lapsed due the expiration of the trademark registration;
- the trademark owner abandons part of his trademark rights or designated goods; or
- there is a final decision to cancel the registration of said trademark.

Petitioner taking the priority of application for six months (Art. 8 (5) of the Act)

To ensure the substantial effect of the cancellation proceeding based on nonuse, the Trademark Act stipulates that only a petitioner may seek to obtain the registration of a mark identical or similar to a lapsed trademark for goods identical or similar to those designated for the lapsed trademark for a period of six months (amended in Jan. 2007) if the petitioner filed a cancellation proceeding and thereafter:

- (i) the period as set forth in the proviso of Article 43 (2) of the Act has expired – the trademark registration lapsed due the expiration of the trademark registration;
- (ii) the trademark owner abandoned part of his trademark rights or designated goods; or
- (iii) there was a final decision to cancel the registration of said trademark.

A final KIPT decision to cancel a trademark registration causes the registration to lapse, where any application filed by any third person for the registration of an identical or a similar trademark in relation to identical or similar designated goods within one year of the lapse is refused. This is to prevent the confusion as to the source of goods as stock of goods bearing a cancelled mark may be circulated in the market for a certain period and the goodwill embodied in said mark may remain in the memory of general consumers.

11. LITIGATION PROCEDURES

Any person dissatisfied with a decision rendered by the KIPT may institute a lawsuit with the Patent Court (Art. 86 (2) of the Act; Art. 186 (1) of the Patent Act *mutatis mutandis*). A lawsuit to reverse a KIPT decision must be lodged within thirty days of the service of a certified copy of the decision (Art. 86 (2) of the Act; Art. 186 (3) of the Patent Act *mutatis mutandis*). Although this thirty-day period is peremptory and may therefore not be reduced or extended (Art. 86 (2) of the Act; 186 (4) of the Patent Act *mutatis mutandis*), the presiding judge may extend the period *ex officio* for the benefit of any person residing in an area that is remote or difficult to access (Art. 86 (2) of the Act; 186 (5) of the Patent Act *mutatis mutandis*). The above period is deemed to start on the date immediately following the day on which the copy of the decision is served (Art. 5 of the Act; Art. 14-1 of the Patent Act *mutatis mutandis*).

Taking the whole purport of pleading and the result of the investigation of evidence into consideration, the court must determine, by its free conviction, the truthfulness of the allegation of facts on the basis of the idea of social justice and equity in accordance with principles of logic and experience (Art. 187 of the Civil Procedure Act). If a lawsuit is deemed mature enough to produce a judgment, the court closes oral proceedings and pronounces a judgment on a date designated by the presiding judge (Art. 191 of the Civil Procedure Act). In which case, judgment must be pronounced within two weeks of the date on which oral proceedings were concluded; even if a case is complicated or other extraordinary circumstances exist therein, pronouncement of a judgment may not be delayed by more than four weeks from the day on which oral proceedings were concluded (Art. 192 (1) of the Civil Procedure Act). The Patent Court must render a judgment dismissing the petition if it is found to be without merit, or reverse the applicable decision by judgment if the petition is deemed to have merit (Art. 86 (2) of the Act; Art. 189 (1) of the Patent Act *mutatis mutandis*).

A final appeal may be instituted with the Supreme Court against a judgment rendered by the Patent Court (Art. 86 (2) of the Act; Art. 186 (3) of the Patent Act *mutatis mutandis*). The Act, however, has no particular provisions for final appeal procedures. Therefore, the final appeal procedures for ordinary civil suits may be deemed to be applicable thereto pursuant to the provisions of Articles 8 (1) and 8 (2) of the Administrative Litigation Act and Articles 425, 396 and 397 (1) of the Civil Procedure Act. An appeal against a judgment rendered in a lawsuit to reverse a KIPT decision may be brought by filing

of a petition with the Patent Court within two weeks of the day on which a certified copy of the judgment is served; provided, however, that such appeal may be brought even prior to the service of the copy. As is the case with civil litigation, the period in which a final appeal may be filed is extended from fourteen to thirty days for any person performing procedural acts outside the country (Art. 5 of the Administrative Litigation Act).

< GENERAL PROCEDURES OF TRADEMARKS APPLICATIONS IN REPUBLIC OF KOREA >

