

Information on Procedures before the Office of the designated Contracting party for Madrid Protocol Applicants

December 2015

		KOREA (KIPO)
1. When filing an application: Points to be noted when filling an MM2 format		
1.1 Applicant (Item 2 of MM2)		
1.1.1	Points to be noted when writing information about an applicant (Item 2(a), (b) and (f) of MM2 or of any equivalent form or equivalent electronic form)	None
1.2 Claim of priority (Item 6 of MM2)		
1.2.1	Is partial priority allowed, which is a claim of priority based on part of a basic application? (Yes/No)	Yes
1.2.2	Are multiple priorities allowed, which is a claim of priority based on multiple basic applications? (Yes/No)	Yes
1.3 Mark (Item 7 to 9 of MM2)		
1.3.1	Category of marks which can be registered (e.g. collective mark, certification mark guarantee mark)	Collective mark Certification mark
1.3.2	Are there certificates required according to category specified in Item 1.3.1? (Yes/No) If a required certificate exists, time and method of submission	Yes. Collective mark: the articles of association providing matters concerning the use of the collective mark Certification mark: the articles of association in cases of a corporation and the covenants in cases of a non-corporation
1.3.3	Types of non-traditional trademarks that are eligible for registration (three-dimensional, sound,	Three-dimensional shape, Any color that is not combined with others, the combination of colors, any hologram, movement or other item that can be visually recognized;

	single color, position, trade dress, etc) and their requirements.	Any item expressed realistically with a sign, letter, figure, or by any other visual means among items that cannot be recognized visually such as sounds and odors
1.3.4	Is description of a mark required? (Yes/No) If yes, examples of such a description	Yes
1.3.5	What an applicant should do if he/she is required to provide a description of his/her mark in question, but such a description cannot be specified in a MM2 format?	Submit an additional statement of the trademark before or after receiving refusal
1.3.6	Is there a standard character system? (Yes/No) If yes, what characters belong to the system? (Item 7(c) of MM2)	No
1.3.7	Points to be noted for Item 8 of MM2 (COLOR CLAIMED)	No specifics to be noted except for a color trademark that is not combined with others which requires a statement of the trademark
1.3.8	Points to be noted for Item 9 of MM2 (MISCELLANEOUS INDICATIONS)	No specifics
1.4 Description of goods and services (Item 10 of MM2)		
1.4.1	Points to be noted for describing designated goods and services	Should be in compliance with the NICE Classification and KIPO's similar group codes
1.4.2	A link to a website to verify whether indications of goods and services are acceptable to an Office	http://www.kipo.go.kr/kpo/user.tdf?a=user.html.HtmlApp&c=31064&catmenu=m02_09_03_01&version=10
1.5 Declaration of intention to use marks		
1.5.1	Is a declaration of intention to use a mark in question required? (Yes/No) If required, how to submit such a declaration	Not mandatory but under following circumstances, an examiner asks intention to use the mark a. When an individual designates a good or a service business requiring large capital or facilities

		<p>b. When an applicant files a trademark application on lots of dissimilar kinds of goods/services which are unrelated each other</p> <p>c. When it is suspicious that an application is filed to register a trademark without intention for actual use or prevent others from registering the mark</p>
1.6 Additional features		
1.6.1	(If any [ex. Seniority])	
2. Procedures after a notification of the territorial extension is received at an Office of a Contracting Party		
2.1 Gazettes published by an Office		
2.1.1	Are gazettes published by an Office? (Yes/No)	Yes
2.1.2	If yes, what are included in gazettes?	<p>Refer to The TRADEMARK ACT http://elaw.klri.re.kr/kor_service/lawView.do?hseq=30765&lang=ENG</p> <p>(a) Name and address of the applicant (in cases of a corporation, its title and the location of its place of business);</p> <p>(b) Trademark (in cases of a sound trademark, odor trademark or any other visually unrecognizable trademark, "no sample" shall be entered);</p> <p>(c) Designated goods and classification of categories ;</p> <p>(d) Number and date of the application (in cases of an international application deemed an application for trademark registration, the number of international registration, and the date of international registration or the date of subsequent designation</p> <p>(e) Number and date of the public notice on application;</p> <p>(f) In cases of a trademark under Article 2 (1) 1 of the Act, the indication that it is such trademark;</p> <p>(g) Registration number of registered trademark to which designated goods are to be added, or number of the trademark registration application (limited to an additional registration application for designated goods);</p> <p>(h) Matters, other than those prescribed in items (a) through (g), which are related to a trademark registration application or additional registration application for designated goods;</p> <p>(i) Purport indicating that it falls under Article 6 (2) of the Act (limited to application for trademark registration made a decision of publication by falling under the same paragraph);</p> <p>(j) Summary of the articles of association or agreement under Article 9 (4) or (5) of the Act (limited to cases of collective marks, geographical collective marks, certification marks, and geographical certification marks);</p> <p>(k) Purport indicating that it is a geographical collective mark or geographical certification mark (limited to cases of a geographical collective mark or geographical certification mark);</p> <p>(l) Explanation on the trademark involved, if it is a trademark under Article 2 (1) 1 (b) or (c) of the Act;</p> <p>(m) Matters concerning ex officio correction under Article 24-3 of the Act;</p> <p>(n) In cases of a sound trademark, odor trademark or any other visually unrecognizable trademark, visual expression under Article 9 (3) of the Act for the relevant trademark;</p>

		(o) In cases of a sound trademark, a sound file conforming to the visual expression under Article 9 (3);
2.1.3	If yes, is there a link to a website?	ENFORCEMENT DECREE OF THE TRADEMARK ACT http://elaw.klri.re.kr/kor_service/lawView.do?hseq=25242&lang=ENG TRADEMARK ACT http://elaw.klri.re.kr/kor_service/lawView.do?hseq=30765&lang=ENG
2.2 Substantive examination		
2.2.1	Does an Office conduct substantive examination? (Yes/No)	Yes
2.2.2	If substantive examination is conducted, will there be an <i>ex officio</i> examination under i) absolute and ii) relative grounds for refusal be examined by <i>ex officio</i> ?	Yes
2.2.3	Does an Office issue partial refusals?	No
2.2.4	Information on examination standards (a link to a website)	ENFORCEMENT DECREE OF THE TRADEMARK ACT http://elaw.klri.re.kr/kor_service/lawView.do?hseq=25242&lang=ENG TRADEMARK ACT http://elaw.klri.re.kr/kor_service/lawView.do?hseq=30765&lang=ENG
2.3 Opposition		
2.3.1	i) A starting date and ii) a period to file an opposition	i) Application publication date ii) 2 months
2.3.2	Who can raise an opposition?	Anyone
2.3.3	Can an opposition be filed before or after a statement of grant of protection is sent? Such a statement is based on Rule 18ter of the Common Regulations.	i) No ii) At the time of application publication
2.4 Third party observations/ Information submission system		
2.4.1	Is there third party observations/ information submission system?	Yes
2.4.2	If yes, i) A starting date and	i) No starting date

	ii) a period to submit observations/ Information?	ii) Any time before registration or refusal is determined (grant of trademark rights protection or provisional refusal is issued)
2.4.3	If yes, Person who can submit observations/information?	Anyone
2.5 Notification of provisional refusal		
2.5.1	Languages used to notify a provisional refusal	English
2.5.2	A period between a day when a notification of territorial extension was sent to an Office and a day when a notification of a provisional refusal is sent (12/18 months)	18 months
2.5.3	Is there a declaration made in accordance with Article 5(2)(c) of the Madrid Protocol? (Yes/No) Note: Notification of that such a provisional refusal may be notified based on opposition after the lapse of period of 18-month	Yes
2.5.4	An average processing time between a day when territorial extension is notified and a day when a First Office Action is made	5.6 months (2014) 5.8 (as of Sep, 2015)
2.5.5	i) A starting date, ii) a period and iii) an ending day of a time limit to respond to a notification of a provisional refusal. Note: Examples of “i) a day on which the computation begins” are a day when an Office sent a notification of a provisional refusal; a day	i) Provisional refusal notification is transmitted ii) 2 months (subject to extension) iii) Date on which the KIPO Commissioner receives (in case of post mail, the date when a postage stamp is put on)

	<p>when the International Bureau sent a notification of a provisional refusal; and a day when a holder received a notification of a provisional refusal.</p> <p>Note: Examples of “iii) an ending day” are a day when a holder sent his/her response; and a day when an Office received a response.</p>	
2.5.6	<p>Is it possible to extend a time limit to respond to a notification of a provisional refusal? (Yes/No) If yes, how long such a time limit can be extended, and how can such an extension be requested?</p>	<p>Yes. Up to twice / one month each Submit a request for extension</p>
2.5.7	<p>Is it always necessary to arrange a local representative when responding to a notification of a provisional refusal? (Yes/No)</p>	<p>Yes</p>
2.5.8	<p>Can a holder directly submit his/her response to an Office when responding to a notification of a provisional refusal? (Yes/No)</p>	<p>No</p>
2.5.9	<p>Can submitting a MM6 form to request a limitation be regarded as a domestic procedure for amendment? (Yes/No)</p>	<p>Yes</p>
2.5.10	<p>If a MM6 submission is regarded as a response to a</p>	<p>A MM6 form must be filled and submitted to the IB within a time limit to respond to a notification of a provisional refusal</p>

	<p>provisional refusal, are there any points to be noted such as a time limit for submission?</p> <p>(For example, such points may include that a MM6 form must be filled and submitted to the IB within a time limit to respond to a notification of a provisional refusal, or that a notification of a limitation must be sent from the IB to an Office within a time limit of response.</p>	
2.6 Trial/Appeal against examiner's decision of refusal		
2.6.1	When can demand for an appeal against examiner's decision of refusal be made?	Within 30 days after receiving the provisional refusal notification
2.6.2	What is the competent authority for such appeal?	IP Trial and Appeal Board of KIPO
2.6.3	Information on appeal against examiner's decision of refusal (a link to a website)	
3. Procedures after confirmation of grant of protection in designated contracting parties		
3.1 Registration		
3.1.1	Other than a statement of grant of protection which is a notification based on Rule 18ter of the Common Regulations, is any notification of a decision of registration sent based on domestic laws? (Yes/No) If yes, to whom (a holder/an IB representative) will it be sent?	<p>Yes</p> <p>A holder or a local representative</p>

3.1.2	<p>i) Is a registration certificate automatically issued? (Yes/No) If yes, to whom (a holder/ an IB representative) will it be sent?</p> <p>ii) If a certificate is not issued automatically, is it possible to make a request so that a certificate will be issued? (Yes/No) If yes, how will it be requested?</p>	<p>Yes</p> <p>A holder or a local representative</p>
3.1.3	<p>Points to be noted for registration</p> <p>(For example, payment of fee)</p>	<p>No specifics</p> <p>(no fees)</p>
3.1.4	<p>Points to be noted for the purpose of maintaining the registration such as submitting a affidavits of continued use in commerce</p>	<p>No specifics</p> <p>(no fees)</p>
3.2 Replacement		
3.2.1	<p>Does an Office require a request to operate procedure for ‘taking note’ of an international registration?</p>	<p>Yes</p>
3.2.2	<p>Timing when a request to operate procedure for ‘taking note’ of an international registration is allowed (while an application being processed, post-registration, etc.)</p>	<p>After registration</p>
3.2.3	<p>Does it cost to “take note”?</p>	<p>No</p>
3.2.4	<p>When will it be decided to replace a registration in question?</p>	<p>At the time when registration is determined</p>

3.2.5	Can a replaced national registration and an international registration coexist?	Yes
4. Others		
4.1 Trial/Appeal for invalidation		
4.1.1	Time period for filing an invalidation	5 years
4.1.2	Person who can demand a trial/appeal for invalidation	Interested party
4.1.3	What is the competent authority for such trial/appeal?	IP Trial and Appeal Board of KIPO
4.1.4	Procedure relating to a trial/appeal for invalidation (a link to a website)	
4.2 Trial/Appeal for cancellation of registered trademark not in use		
4.2.1	Time period for filing a non-use cancellation	No limits
4.2.2	Person who can demand a trial/appeal for cancellation of registered trademark not in use	Interested party
4.2.3	What is the competent authority for such trial/appeal?	IP Trial and Appeal Board of KIPO
4.2.4	Procedure relating to a trial/appeal for cancellation of registered trademark not in use (a link to a website)	
4.3 Trial/Appeal for cancellation of trademark registration due to unfair use by owner of a trademark right or licensee		
4.3.1	Time period for filing an unfair use cancellation	Within three years after the date on which the alleged facts disappear
4.3.2	Person who can demand a trial/appeal for cancellation of trademark registration due to unfair use by owner of a trademark right or licensee	Anyone
4.3.3	What is the competent	IP Trial and Appeal Board of KIPO

	authority for such trial/appeal?	
4.3.4	Procedure relating to a trial/appeal for cancellation of trademark registration due to unfair use by owner of a trademark right or licensee	In accordance with Ordinary Trial Procedure
4.4 Other information relating to a trial/appeal		
4.4.1	Other information relating to a trial/appeal	
4.5 Invalidation of the effects of an international registration in part or in whole		
4.5.1	Where the effects of an international registration in a designated Contracting Party are cancelled in part or in whole because of a trial/appeal for invalidation etc, the timing when a notification of invalidation per Rule 19 of the Common Regulations will be sent to the International Bureau	Once the registration division receives the final judgment (e.g. invalidation, etc.) from the IP Trial and Appeal Board of KIPO, we notify it to the IB after recording it in the KIPO registration.
4.6 Transformation of an international registration into national or regional applications under Article 9quinquies of Madrid Protocol		
4.6.1	Points to be noted for transformation (If any) An amount of a fee if such a fee needs to be paid	No specifics The fees are the same as local registration.
4.7 Additional features		
4.7.1	(If any [ex. Conversion])	
5. Madrid Protocol declarations		
5.1	Article 5(2)(b) of the Protocol (extension to 18 months of the refusal period) (Yes/No)	Yes
5.2	Article 5(2)(c) of the Protocol (possible notification of refusals)	Yes

	based on an opposition after the 18-month time limit) (Yes/No)	
5.3	Article 8(7)(a) of the Protocol (individual fees) (Yes/No)	Yes
5.4	Article 9 ^{quarter} of the Agreement and that of the Protocol (Common Office of several Contracting States) (Yes/No)	Yes
5.5	Article 14(2)(d) of the Agreement (in respect of international registrations effected under the Agreement prior to the date of accession of the Contracting Party concerned, no subsequent designation) (Yes/No)	N/A
5.6	Article 14(5) of the Protocol (in respect of international registrations effected under the Protocol prior to the date of accession of the Contracting Party concerned, no subsequent designation) (Yes/No)	No
5.7	Rule 7(2) of the Common Regulations (declaration of intention to use the mark) (Yes/No)	<p>Not mandatory but under following circumstances, an examiner asks intention to use the mark</p> <ul style="list-style-type: none"> a. When an individual designates a good or a service business requiring large capital or facilities b. When an applicant files a trademark application on lots of dissimilar kinds of goods/services which are unrelated each other c. When it is suspicious that an application is filed to register a trademark without intention for actual use or prevent others from registering the mark

5.8	Rule 17(5)(d) of the Common Regulations (notwithstanding the fact that all procedures before the Office may not have been completed, notification to the International Bureau by the Office of decisions concerning refusals) (Yes/No)	No re-examination system
5.9	Rule 17(5)(e) of the Common Regulations (<i>ex officio</i> provisional refusals not open to review before the Office) (Yes/No)	No re-examination system
5.10	Rule 20bis(6)(a) of the Common Regulations (recording of licenses not provided for in the domestic law, so that the recording of licenses in the International Register has no effect) (Yes/No)	No
5.11	Rule 20bis(6)(b) of the Common Regulations (recording of licenses provided for in the domestic law, but the recording of licenses in the International Register has no effect) (Yes/No)	Yes
5.12	Rule 34(2)(b) of the Common Regulations (the Office accepts to collect and forward fees to the International Bureau) (Yes/No)	No
5.13	Rule 34(3)(a) of the	No

	Common Regulations (individual fee payable in two parts) (Yes/No)	
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