

Application Procedure for Trademarks

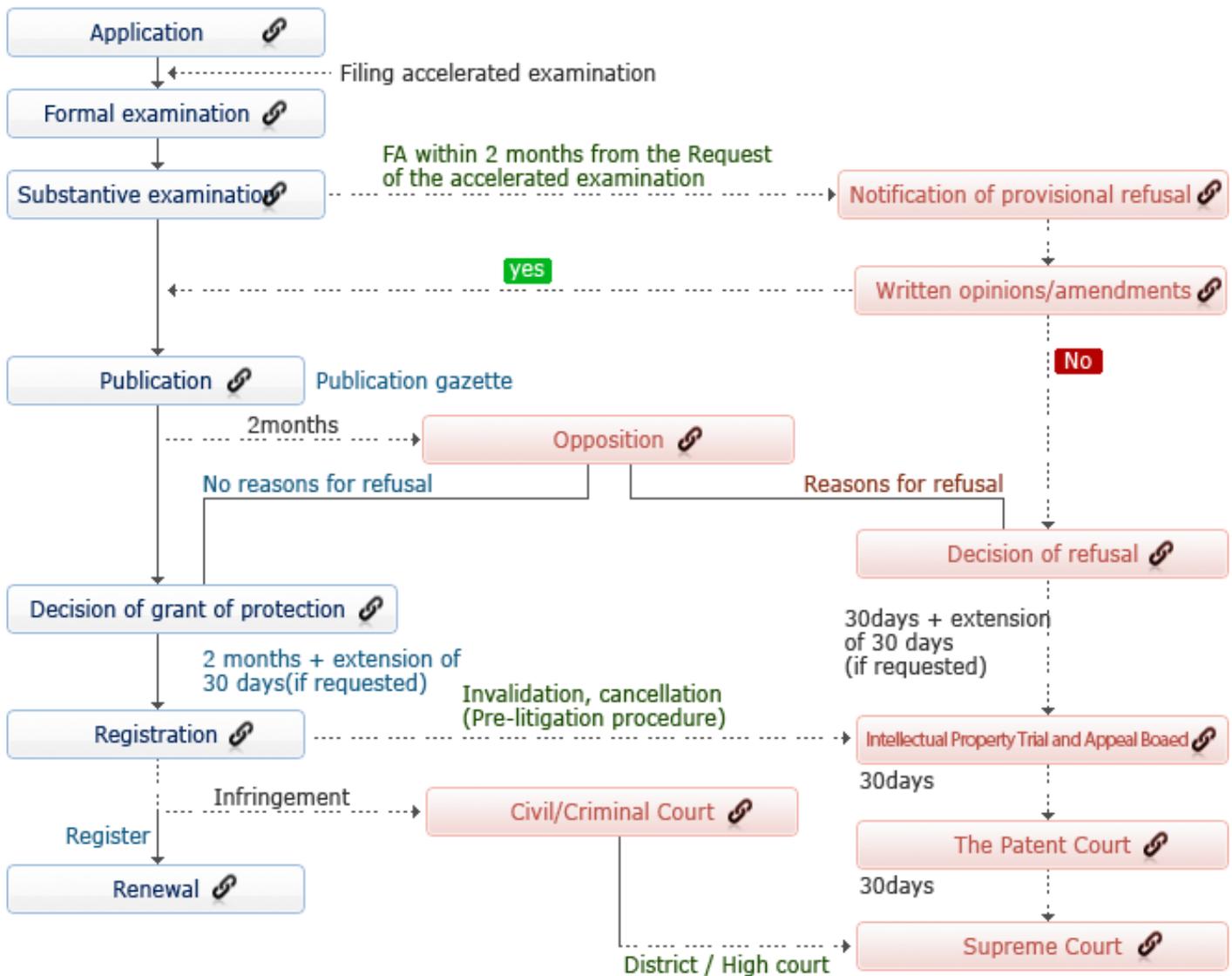
Overview

Trademarks are protected in the Republic of Korea under the Trademark Act; and for such protection, marks should be registered with the Korean Intellectual Property Office (KIPO). The use of a trademark is not a prerequisite for filing an application for the registration of a trademark. Although the Trademark Act does not protect unregistered marks, it does provide protection of well-known or famous marks by restricting the registration of an identical or similar mark. There is no course of action against infringement of a well-known or famous unregistered trademark under the Trademark Act, but action may be pursued under the Unfair Competition Prevention Act.

The Korean Trademark Law is characterized by :

- i) First-to-File Rule;**
- ii) Substantive Examination;**
- iii) Opposition**

* Click on the button marked () in the flow chart below to see description for each procedure.



Filing an Application

(i) Applicant

Any person who uses or intends to use a trademark in the Republic of Korea may file an application for the registration of a trademark. Although the Korean Trademark Act has adopted a registration system, the applicant should have a bona fide intent to use his/her trademark in the Republic of Korea. Nonetheless, trademarks which are not used must also be registered. Such trademarks, however, will be subject to cancellation if they remain unused for three or more consecutive years after their registration.

(ii) Document Required

For a trademark application, the following documents should be submitted to KIPO:

- (a) an application stating the following: the name and address of the applicant (including the name of an executive officer, if the applicant is a juristic person); the trademark; the designated goods and class thereof; the date of submission; and the country and filing date of the priority application, if the right of priority is

claimed;

(b) 10 specimens of the trademark (8cm x 8cm or smaller in size);

(c) the priority document if the right of priority is claimed; and

(d) a power of attorney, if necessary.

Only document (a) must be submitted at the time of filing the trademark application. The name of an executive officer of the applicant may be added later on the applicant's own initiative or in response to a notice of amendment issued from KIPO.

If the applicant fails to submit specimens of the trademark or power of attorney at the time of filing the trademark application, KIPO will issue a notice of amendment with a designated time limit to the applicant. The priority document must be submitted within 3 months from the filing date of the trademark application in the Republic of Korea. This time limit cannot be extended.

(iii) Designation of Goods: Nice Classification

A person who desires to file a trademark application must designate the goods/services for which the trademark is to be used in accordance with the Nice Classification of Goods or Services for the Purpose of Registration of Marks. The Republic of Korea adopted the Nice Classification on March 1, 1998.

A trademark application may be filed for the registration of a trademark for goods which fall under several classes in accordance with the Nice Classification. In this case, the applicant must pay additional fees for each classification.

(iv) Claim of Priority

The right of priority can be claimed in a trademark application for an applicant whose country of origin is part of the Paris Convention or under a bilateral agreement between the two relevant governments or on a reciprocal basis. In order to enjoy the priority right, an application should be filed in the Republic of Korea within 6 months from the filing date of the priority application. The priority document should be submitted to KIPO within 3 months from the filing date of his/her application.

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Formal Examination

The application will be returned to the submitter without an application number and will be treated as if it had never been submitted in any of the following circumstances:

(i) where the kind of the application is not clear;

(ii) where the name or address of a person (or juristic person) who takes the procedure (i.e. the applicant) is not described;

(iii) where the application is not written in Korean;

(iv) where a specimen of the trademark is not attached to the application paper;

(v) where the designated goods are not described in the application paper; or

(vi) where the application is submitted, by a person who has no address or place of business in the Republic of Korea, without coming through a patent agent in the Republic of Korea.

Once the application has satisfied such requirements, KIPO assigns an application number and examines it against the formality requirements of the Trademark Act. If anything is found missing or wrong, the commissioner of KIPO will issue a notice of amendment with a specified time limit to the applicant. If the applicant does not comply with the requests for amendment, the trademark application will be nullified.

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Substantive Examination

(i) Initiation of Examination

Unlike patent or utility model applications, trademark applications are automatically examined in order of their filing date. However, under Article 53(2) of the Trademark Act, the commissioner of KIPO may grant priority to trademark applications which satisfy certain requirements. The examination of a trademark application generally takes about 5 months from its filing date.

(ii) Requirement for Registration

For a trademark to be registered under the Trademark Act, it should meet the following requirements:

- (a) It should fall under the definition of a trademark prescribed in the Trademark Act;
- (b) It should be distinctive so as to serve as an indication of goods or if it is not inherently distinctive, it should have acquired a secondary meaning;
- (c) It should not fall into any of the categories of trademarks unable to be registered as prescribed in the Trademark Act.

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Publication

If an examiner does not find any grounds for rejection of a trademark application, or he/she decides the rejection has been overcome by the applicant's response (argument and/or amendment), he/she shall render a decision to publish the trademark application.

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Opposition

Once a trademark application is published in the official gazette, the "Trademark Publication Gazette," any person may file an opposition within two months (non-extendable). A notice of opposition containing a brief

statement on the grounds for opposition must be submitted within the first thirty days. Then, the opponent may amend, add or supplement the grounds for opposition within the next thirty days.

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Decision of grant of protection

Decision to register a trademark is the administrative measure which means that it has suitable requirements for a trademark registration as a result of the examination of the trademark application by the examiner, thus an applicant can receive establishment registration of a trademark right.

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Registration

Upon decision of the trademark registration, an applicant can apply for establishment registration of the trademark right after paying the registration fee within the specified period.

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Civil/Criminal Court

The legal remedies against infringement of a trademark right or exclusive license mainly include civil injunctions, claims for damages, claims for credit recovery, and possible punishment for the infringer based on criminal liability. Actions against infringement are generally treated as civil or criminal actions and are therefore not under the jurisdiction of the patent court.

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Renewal

The duration of the protection of a trademark right is 10 years from the date of registration of the trademark, which may be renewed every 10 years. For the renewal of a trademark registration, an application for the renewal should be filed with KIPO. Once a renewal application has been duly filed, the trademark registration is deemed to have been renewed on the expiration date of the original registration.

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Notification of provisional refusal

In the event that the trademark registration application is included in the grounds for rejection, the grounds for rejection are informed in writing and the opportunity to submit the argument is granted for a specified period of time.

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Written opinions/amendments

An applicant may reconcile the grounds for rejection by submitting evidence or opinions in support of their argument within the predetermined period, or by submitting an amendment to delete the designated trademark infringing on the cited trademark.

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Decision of refusal

In the event that the examiner finds grounds for rejection stated in the Trademark Act and informs the applicant by submitting the written opinion, but the applicant does not amend the grounds for rejection, the examiner may decide to reject the application.

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Intellectual Property Trial and Appeal Boaed

In the event an applicant receives and objects to a decision of rejection which is relevant to the trademark registration, additional registration of the designated products, and registration of trademark classification transformation, he/she can appeal to the Intellectual Property Trial and Appeal Boaed within thirty days from the date of delivery of the certified copy of the decision of rejection.

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Patent Court

The patent court decides upon actions against a trial decision of the Intellectual Property Trial and Appeal Boaed and actions for cancellation of trial decisions of the Species Protection Appeals Committee in the Ministry of

Agriculture and Forestry. The representative patent litigations of the patent court include appeals of trial decisions of the Intellectual Property Trial and Appeal Board on the grounds for rejection, patent invalidation, trademark registration cancellation, and request for trials.

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Supreme Court

The Supreme Court of Korea, the highest institution of the judicial branch, delivers the final ruling of a trial unless a new trial is applied for.

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Trademark Examination Policy Division