

Issuing number: 8-5-2016-005073030
Issuing date: 19/12/2016

34, chemin des Colombettes P.O.Box 181211
Geneva 20, Switzerland
World Intellectual Property
Organization(WIPO)International Bureau

PROVISIONAL REFUSAL BASED ON AN OPPOSITION
TO THE INTERNATIONAL BUREAU OF WORLD INTELLECTUAL PROPERTY ORGANIZATION (WIPO)
UNDER RULE 16(1)(b) and 17(3) OF THE COMMON REGULATIONS

1. Office Making the Notification:

Korean Intellectual Property Office (KIPO)
189 Cheongsu-ro, Seo-gu, Daejeon Metropolitan City, 35208, Republic of Korea

2. International Registration Number (Date of Registration/Subsequent Designation):

1261461 (22/05/2015)

3. Name and Address of the Holder:

SWATCH AG (SWATCH SA) (SWATCH LTD)
Jakob-Stämpfli-Strasse 94 CH-2502 Biel/Bienne Switzerland

4. Facts about the Opposition:

An opposition against the above mentioned international registration published on the date of 06/09/2016 has been filed claiming that the international registration should not be protected in the Republic of Korea. The details concerning the opposition are as follows.

(1) Name and address of the opponent : Apple Inc.(1 Infinite Loop, Cupertino, California 95014, U.S.A.)

(2) Opposition period : 06/09/2016 ~ 06/12/2016

(3) Filing date of the opposition : 28/10/2016

(4) List of the goods/services on which the opposition is based :

※ Please refer to item 10

5. Goods and/or Services Affected by this Provisional Refusal:

All the designated goods/services

※ Please note that there is no provision in the Korean Trademark Act allowing the examiner to delete Ex Officio the designated goods/services affected by the ground(s) for the Provisional Refusal and to grant protection for the remaining goods/services.

6. Grounds for this Provisional Refusal:

※ Please refer to item 10

7. Provisions of the Korean Trademark Act applicable to the Grounds:

Previous Korea Trademark Act(before the revision under No. 14033 of the Act on February 29, 2016), 7(1)(xii)

8. Date on which the Provisional Refusal was pronounced (Time Limit):

19/12/2016(19/02/2017)

9. Guidance as to Future Procedure:

Where the holder receives this notification, he/she may submit to the KIPO, through a representative whose address is in the Republic of Korea, an answer to the opposition in writing within two months from the date on which this provisional refusal was pronounced (see item 8). Article 27(1) of the previous Korean Trademark Act(before the revision under No. 14033 of the Act on February 29, 2016).

Regarding the time limit, the holder may request the extension of time to submit an answer to KIPO. The extension will be granted twice for a period of one month, respectively. This request should be made within the given time limit through the above representative.

10. Details of the Provisional Refusal:

An opposition has been filed claiming that, regarding 'all' of the designated goods/services, the examiner refuses registration because the proposed mark is identical with a trademark which is famous to consumers at home or abroad, and is used with an unjust intention such as to obtain unfair profits or to cause damage to that person. Previous Korea Trademark Act(before the revision under No. 14033 of the Act on February 29, 2016), 7(1)(xii).

The proposed mark "**ONE MORE THING**" is identical with "ONE MORE THING" which are well-known among consumers at home or abroad, and is used with unjust purposes of obtaining unfair profits or inflicting harm on a particular person.

* Goods/Services of the proposed mark refused under this ground

– All the designated goods/services

11. Official Seal or Signature by the Office:

KIPO Examiner MOON, Ki Kwon 

<< Information >>

If the holder has any questions or needs assistance in responding to this notification, please contact the examiner.

E-mail: kipomadrid@korea.kr, telephone: (82) (42) 481 8335, fax: (82) (42) 472 3507

Extract from the Korean Trademark Act

(the previous Act before the revision under No. 14033 of the Act on February 29, 2016)

Article 3 Persons Entitled to Register a Trademark

A person who uses or intends to use a trademark in the Republic of Korea is entitled to trademark registration; however, employees of the Korean Intellectual Property Office or employees of the Intellectual Property Tribunal are not entitled to register trademarks during their employment at the office or tribunal except in the case of inheritance or a bequest.

Article 5-3 Trademark Administrators for Nonresidents

(1) No one who does not have an address or place of business in the Republic of Korea (hereinafter referred to as "nonresident") may, except where such nonresident (referring to a representative in cases of a corporation) is sojourning in the Republic of Korea, undergo trademark-related procedures or file an action against any disposition issued by an administrative agency pursuant to this Act or an order under this Act, without a representative for trademarks who has an address or place of business in the Republic of Korea (hereinafter referred to as "trademark administrator").

(2) A trademark administrator shall, within the extent of power delegated to him/her, represent the principal in a trial on trademark-related procedures or any disposition made by an administrative agency pursuant to this Act or an order under this Act.

Article 5-14 Extension, etc. of Periods

(1) For persons in areas with poor transportation service, the Commissioner of the Korean Intellectual Property Office or the President of the Intellectual Property Trial and Appeal Board (IPTAB) may, upon request or ex officio, extend the period for amending the reasons, etc. mentioned in a written objection to trademark registration under Article 26 and the period for requesting a trial under Article 70-2 or 70-3.

(2) When having determined the period for trademark-related procedures pursuant to this Act, the Commissioner of the Korean Intellectual Property Office, President of the Korean Intellectual Property Trial and Appeal Board (IPTAB), presiding administrative trademark judge or examiner may, upon request, shorten or extend such period, or may extend such period ex officio. In such cases, the Commissioner of the Korean Intellectual Property Office, etc. shall determine whether to shorten or extend the period so as not to unduly infringe on an interest of any interested party in the relevant procedures.

(3) When having determined the deadline for trademark-related procedures pursuant to this Act, the presiding administrative trademark judge or examiner may change the deadline upon request or ex officio.

Article 6 Requirements for Trademark Registration

(1) Trademark registration may be obtained except any of the following cases:

(i) where the trademark consists solely of a mark indicating, in a common way, the usual name of the goods;

(ii) where the trademark is customarily used on the goods;

(iii) where the trademark consists solely of a mark indicating, in a common way, the place of production, quality, raw materials, efficacy, use, quantity, shape (including the shape of the packaging), price, production method, processing method, usage or using time of the goods;

(iv) where the trademark consists solely of a conspicuous geographical name, an abbreviation of it or a map;

(v) where the trademark consists solely of a mark indicating, in a common way, a common surname or a title;

(vi) where the trademark consists solely of a simple and commonplace mark; or

(vii) in addition to the cases mentioned in sub-paragraphs (i) to (vi) of this Article, where the trademark does not enable consumers to discriminate whose goods are indicated.

(2) Notwithstanding a trademark falls under paragraphs (1)(iii) to (vi) of this Article, where the trademark has become, as a result of using it before the application for registration under Article 9 of this Act, especially recognized by consumers whose goods are indicated, it may be registered for the designated goods (i.e. designated goods and supplementary designated goods as defined in Articles 10(1) and 47(2) (iii) of this Act. The same shall apply hereinafter.) on which the trademark has been used;

(3) Notwithstanding a mark falls under paragraph (1)(iii) (restricted to 'the place of production') or (1)(iv) of this Article, where the mark is a geographical indication on specific goods, it may be registered as a collective mark for a geographical indication for the designated goods on which the geographical indication has been used.

Article 7 Unregistrable Trademarks

(1) Notwithstanding Article 6, trademark registration may not be obtained in any of the following cases:

(i) trademarks that are identical or similar to the following: the national flag, the national emblem, military flags, medals, decorations or badges of the Republic of Korea; the national flags or emblems of foreign countries; the medals, decorations or badges of the countries of the union of the Paris Convention for the Protection of Intellectual Property (hereinafter referred to as 'the Paris Convention'), the

members of the World Trade Organization or the contracting parties to the Trademark Law Treaty; the names or marks of the Red Cross, Olympic organizations or other well-known international organizations; seals or signs that are used for supervision or certification by the Republic of Korea, the countries of the union of the Paris Convention, the members of the World Trade Organization, the contracting parties to the Trademark Law Treaty or the public organizations of these;

(ii) trademarks that falsely indicate a connection with, or that criticize, insult or are liable to defame any nation, race, ethnic group, public organization, religion or well-known deceased person;

(iii) trademarks that are identical or similar to well-known marks that indicate nonprofit businesses of a nation, a public organization or its agencies or a public corporation, or that indicate nonprofit public services; However, this provision does not apply where the nation, the public organization or its agencies, the public corporation or the body of nonprofit public services applies to register its own marks;

(iv) trademarks that are liable to disturb public order or morality;

(v) trademarks comprising a mark that is identical or similar to a medal, certificate of merit or decoration awarded at an exhibition held

by or with the authorization of the government of the Republic of Korea or of the government of a foreign country; However, this provision does not apply where the person who has been awarded the medal, certificate of merit or decoration use it as part of the trademark on the goods for which the medal, certificate of merit or decoration was awarded at the exhibition;

(vi) trademarks containing the name, title, trade name, portrait, signature, seal, literary name, stage name, pen name or an abbreviation thereof of a well-known person, unless the consent of the person concerned has been obtained;

(vii) trademarks that are identical or similar to another person's registered trademark (excluding a registered collective mark for a geographical indication) when the former are applied for registration after the latter has been registered and when the former are to be used on goods that are identical or similar to the designated goods of the latter;

(vii^{bis}) trademarks that are identical or similar to another person's registered collective mark for a geographical indication when the former are applied for registration after the latter has been registered and when the former are to be used on goods that are identical with the designated goods of the latter;

(viii) trademarks that are identical or similar to another person's registered trademark (excluding a registered collective mark for a geographical indication) when not more than a year has elapsed since the date on which the latter trademark right expired (that is, in case of a trial decision invalidating a trademark registration, the date on which the trial decision became final) and when the former are to be used on goods that are identical or similar to the designated goods of the latter;

(viii^{bis}) trademarks that are identical or similar to another person's registered collective mark for a geographical indication when not more than a year has elapsed since the date on which the right of the registered collective mark for a geographical indication expired (that is, in case of a trial decision invalidating the registration of a collective mark for a geographical indication, the date on which the trial decision became final) and when the former are to be used on goods that are identical with the designated goods of the latter;

(ix) trademarks that are identical or similar to a trademark (excluding a geographical indication) that is especially recognized among consumers as to indicate the other person's goods, when the former are to be used on goods that are identical or similar to those of the person;

(ix^{bis}) trademarks that are identical or similar to another person's geographical indication that is especially recognized among consumers as to indicate a certain region's goods, when the trademarks are to be used on goods that are identical with those using the geographical indication;

(x) trademarks that are liable to cause confusion with the goods or services of another person's that are especially recognized among consumers;

(xi) trademarks that are liable to mislead or deceive consumers on the quality of the goods;

(xii) trademarks that are identical or similar to a trademark that is especially recognized among consumers inside or outside the Republic of Korea as to indicate the goods of a particular person, and that are used with unjust purposes such as to obtain unfair profits or to inflict harm on that person;

(xii^{bis}) trademarks that are identical or similar to a geographical indication that is especially recognized among consumers inside or outside the Republic of Korea as to indicate the goods of a certain region, and that are used with unjust purposes such as to obtain unfair profits or to inflict harm on the legitimate users of that geographical indication;

(xiii) trademarks that consist solely of three-dimensional shapes which are essential for securing the functions of goods to be registered or their packaging;

(x iv) trademarks that consist of, or include, a geographical indication of the origin of wines or spirits in a member state of the World Trade Organization, to be used on wines, spirits or the like; However, this provision does not apply where a legitimate user of a geographical indication applies to register a collective mark for the geographical indication designating the relevant goods under Article 9(3) of this Act.

(x v). Any trademark which is identical or similar to a name of varieties registered pursuant to Article 109 of the Act on the Protection of New Varieties of Plants, and which is to be used for goods identical or similar to such name of varieties;

(x vi). Any trademark which is identical or similar to another person's geographical indication registered pursuant to Article 32 of the Agricultural and Marine Products Quality Control Act, and which is to be used for goods identical or recognized as identical to the goods using such geographical indications;

(x vii). Any trademark which is identical or similar to another person's geographical indication protected pursuant to free trade agreements that have been concluded between the Republic of Korea and foreign countries in a bilateral or multilateral manner and come into effect, or any trademark which consists of or contains such geographical indications and is to be used for goods identical or recognized as identical to the goods using such geographical indications;

(x viii). Any trademark, identical or similar to another person's trademark, which has been applied for registration for the identical or similar goods in the knowledge, through contractual relations such as partnership and employment, business relations, or other relations, that the trademark is being used or prepared for use by such person.

(2) Paragraph (1)(vi), (vii), (vii^{bis}), (viii), (viii^{bis}), (ix), (ix^{bis}), and (x) shall apply to relevant trademarks at the time of an application for trademark registration: Provided, That whether an applicant for trademark registration (hereinafter referred to as "applicant") corresponds to a person under the relevant provision shall be determined at the time of a decision on whether to grant or reject trademark registration (hereinafter referred to as "decision on whether to grant or reject trademark registration").

(3) Where a requester for a trial for revocation of trademark registration on the ground of Article 73(1)(iii) is identical to an applicant of such trademark registration, any of the following subparagraphs applies after the date of request for a trial for such revocation, whether the relevant application for trademark registration falls under paragraph (1)(vii), (vii^{bis}), (viii) or (viii^{bis}) shall be determined at the time of a decision on whether to grant or reject trademark registration, notwithstanding the main sentence of paragraph (2)

(i) Where a period under the proviso to Article 43 (2) elapses;

(ii) Where a trademark rights holder relinquishes all of his/her trademark rights or some of designated goods under Article 59;

(iii) Where a trial decision on revocation of trademark registration under Article 73(1)(iii) becomes final and conclusive.

(4) Paragraph (1) (viii) and (viii^{bis}) shall not apply to any of the following cases:

(i) Where a registered trademark has not been used for one year or more retrospectively after trademark rights became invalid;

(ii) Where an appropriate applicant applies for trademark registration, after a trial decision on invalidation or revocation becomes final and conclusive by reason that a registered trademark violates the provision of paragraph (1) (vi), (ix), (ix^{bis}), (x), (xi), (xii) and (xii^{bis}) of this Article or Article 8 or 73(1)(vii);

(iii) Where an application for trademark registration is made after the period of six months under the proviso to Article 43 (2) expires without any application for the registration for renewal of the duration of registered trademark rights;

(iv) Where a trademark subject to registration contains a mark identical or similar to a registered trademark for which a trial for revocation under Article 73(1)(iii) has been requested;

(v) Deleted.

(5) Where a trial for revocation of trademark registration is requested on the grounds that it falls under Article 73(1) (ii), (iii) and (v) through (xiii), and any of the following subparagraphs applies after the date of request for such trial, neither the trademark rights holder nor any person who uses the trademark may apply for the registration of trademarks identical or similar to an extinguished trademark for goods identical or similar to the designated goods (in cases of a geographical collective mark, referring to goods identical or recognized as identical to the designated goods) unless they make an application for trademark registration after three years from the date on which any of the following subparagraphs becomes applicable:

(i) Where trademark rights are extinguished due to the expiry of the duration;

(ii) Where a trademark rights holder abandons some of trademark rights or designated goods;

(iii) Where a trial decision on revocation of trademark registration becomes final and conclusive.

(6) The provisions of paragraph (1) 7-2, 8-2, and 9-2 shall not apply between homonymous geographical collective marks.

Article 8 First-to-File Rule

(1) Where two or more applications for registration are filed on different dates for identical or similar trademarks that are to be used on identical or similar goods, only the applicant having the earlier filing date may obtain registration for the trademark.

Article 10 A Single Application for a Single Trademark

(1) The person seeking to register a trademark shall file an application for each trademark, designating one or more classes of goods from the classification of goods prescribed by ordinance of the Ministry of Commerce, Industry and Energy. In this case, goods and services may be designated together in a single application.

(2) The classes of goods referred to in paragraph (1) of this Article may not be construed to decide the scope of the similarity of goods.

Article 23 Decision to Refuse Trademark Registration and Notification of Reasons for Refusal

(1) The examiner shall refuse trademark registration in any of the following cases:

(i) where the trademark is unregistrable under the proviso of Article 3, Articles 6 to 8, 10(1), 12(2) (second sentence), (5) and (7) to (9) of this Act or Article 25 of the Patent Act applied under Article 5 of this Act;

(ii) where the trademark violates a treaty;

(iii) where the trademark is identical or similar to a trademark registered in the territory of a country that is a party to a treaty and has been filed by a person who is an agent or a representative (or who was an agent or a representative within one year before the filing date) of the owner of the trademark, without any rightful reason such as obtaining the owner's authorization, for designated goods that are identical or similar to those of the owner's trademark. However, this provision applies only when an opposition or information under Article 22(3) of this Act has been filed by the owner;

(iv) where the trademark does not conform to the definition of a mark under Article 2(1)(i) to (iii) or (iv) of this Act; or where, in the case of a collective mark for a geographical indication, the geographical indication and the mark do not conform to the definitions of a geographical indication or a mark under paragraphs (ii^{bis}) and (iii^{quater}) of the Article 2(1) of this Act;

(v) where, in case of an application to register a collective mark for a geographical indication, a person, who conducts business activities such as producing, manufacturing or processing goods that are eligible for the geographical indication, is in fact prohibited from joining an association by the articles of association, or by provisions in the articles of association providing conditions for subscription that are too difficult for the person to fulfill and so on;

(vi) where the articles of association, referred to in Article 9(3) of this Act, fail to mention all or some of the provisions that govern the use of the collective mark as prescribed by Presidential Decree.

(2) When refusing trademark registration under paragraph (1) of this Article, the examiner shall notify the applicant of the reasons for refusal and give the applicant an opportunity to submit a written opinion within a designated period.

Article 70^{bis} Trial against Decision of Refusal

Any person dissatisfied with a decision to refuse registration of a trademark, to refuse supplementary registration of designated goods, to refuse to renew the term of a registered trademark or to refuse registration of the reclassification of goods (hereinafter referred to as 'a decision of refusal') may file a request for trial within thirty days from the date of receiving a certified copy of the decision of refusal.

Article 70^{ter} Trial against a Decision to Reject an Amendment

Any person dissatisfied with a decision to reject an amendment under Article 17(1) may file a request for trial within thirty days from the date of receiving a certified copy of the decision.

Article 92-3 Service of Documents on Nonresidents

(1) If a nonresident has a trademark administrator, the document to be served on the nonresident shall be served on the trademark administrator: Provided, That the foregoing shall not apply where an examiner notifies the applicant for the international registration of trademarks of the grounds for rejection through the International Bureau under Article 86-24.

(2) If a nonresident does not have a trademark administrator, the document to be served on the nonresident may be sent by registered air mail.

(3) When a document is sent by registered air mail pursuant to paragraph (2), it shall be deemed served on the date it is sent.