

Issuing number: 8-5-2020-003823597
Issuing date: 03/08/2020

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

NOTIFICATION OF EX OFFICIO PROVISIONAL REFUSAL
TO THE INTERNATIONAL BUREAU OF WORLD INTELLECTUAL PROPERTY ORGANIZATION (WIPO)
UNDER RULE 17(1) OF THE COMMON REGULATIONS

1. Office Making the Notification:

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

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

1491293 (27/08/2019)

3. Trade Mark:



4. Name and Address of the Holder:

Individual entrepreneur Tiutkova Alina Andreevna
ulitsa imeni Marshala Chuykova, d. 39, kv. 84, RU-400005 Volgograd, Russian Federation

5. Goods/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 refused by the ground(s) for the Provisional Refusal and to grant protection for the remaining goods/services.

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

03/08/2020(03/10/2020)

7. Grounds for the Decision:

- ☒ Lack of distinctiveness
- ☐ Conflict with another person's earlier application(s) and/or registration(s)
- ☐ Vagueness and/or broadness of the designated goods/services
- ☐ Unconformity to "a single application for a single trademark rule"
- ☒ Other grounds

※ Please refer to item 9 for the details

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

Article 33(1)(iii), Article 33(1)(vii), Article 34(1)(xii)

9. Details of the Provisional Refusal:

This International Registration is not eligible for registration due to the following ground(s):

(Ground1)

The applied-for mark is devoid of any distinctiveness to enable consumers to recognize whose goods it indicates according to the below provisions of the Korean Trademark Act.

A mark is considered descriptive if it consists solely of a sign indicating, in a common way, the origin, quality, raw materials, efficacy, use, quantity, shape (including shape of packaging) or price of goods/services or the method or time of producing/processing/using them. [Article 33(1)(iii), Korean Trademark Act]

And a mark which can not be recognized by the consumers as the source of the goods lacks distinctiveness. [Article 33(1)(vii), Korean Trademark Act]

Further, where a mark is used by many people or where it is unfair to grant exclusive rights for a mark to one person in view of the public interest, such mark shall be regarded to fall under the definition of marks stipulated in the above-mentioned Article 33(1)(vii). [Part IV, Chapter 7, Korean Trademark Examination Standards]

The applied-for mark consists of an acronym “**Angel Cakes**” which is merely descriptive since it would be perceived among consumers without further reflection as “**a kind of sponge cake**” indicated above.

Moreover, it neither creates any other meaning nor has any other elements which might be perceived as a source of the product except the idea indicated above and such mark should be used by many people in the related field of commerce, therefore, it is unfair to grant an exclusive right to one person in view of the public interest.

Therefore, it is decided that the applied-for mark is merely descriptive and lacks the distinctiveness to enable consumers to recognize whose goods it indicates.

However, this refusal ground could be overcome if the applicant deletes the underlined goods and/or services listed below.

* Goods/services of the applied-for mark in relation to this ground:

[Class 30] Baozi [stuffed buns]; bread rolls; cakes; pastries; macaroons [pastry]; gingerbread; petits fours [cakes]; tarts; tortillas.

[Class 43] Accommodation bureau services [hotels, boarding houses]; rental of temporary accommodation; rental of meeting rooms; tourist home services; hotel reservations; temporary accommodation reservations; hotel services; snack-bar services; café services; cafeteria services; motel services; rental of cooking apparatus; rental of chairs, tables, table linen, glassware; rental of drinking water dispensers; restaurant services; self-service restaurant services; reception services for temporary accommodation [management of arrivals and departures]; food sculpting; canteen services; holiday camp services [lodging]; bar services; providing campground facilities; food and drink catering; washoku restaurant services; udon and soba restaurant services.

(Ground2)

Regarding ‘some’ of the designated goods, the mark is liable to mislead or deceive consumers on the quality or efficacy and use of the goods. [Article 34(1)(xii), Korean

Trademark Act]

In this case, "Angel Cakes" of the proposed mark, when used on the goods which are not related to "a kind of **sponge cake**", is liable to mislead or deceive consumers on the quality, use of the services to be related to "a kind of **sponge cake**".

However, this ground for refusal could be reviewed if the applicant deletes the refused goods listed below (the underlined services).

* Goods/services of the applied-for mark in relation to this ground:

[Class 30] Baozi [stuffed buns]; bread rolls; cakes; pastries; macaroons [pastry]; gingerbread; petits fours [cakes]; tarts; tortillas.

[Class 43] Accommodation bureau services [hotels, boarding houses]; rental of temporary accommodation; rental of meeting rooms; tourist home services; hotel reservations; temporary accommodation reservations; hotel services; snack-bar services; café services; cafeteria services; motel services; rental of cooking apparatus; rental of chairs, tables, table linen, glassware; rental of drinking water dispensers; restaurant services; self-service restaurant services; reception services for temporary accommodation [management of arrivals and departures]; food sculpting; canteen services; holiday camp services [lodging]; bar services; providing campground facilities; food and drink catering; washoku restaurant services; udon and soba restaurant services.

10. Guidance for the response:

It is suggested that you may choose one of responses as below

A. Response before KIPO

- (1) In order to respond to this provisional refusal before KIPO directly [Article 66(1), Korean Trademark Act], the holder of the International Registration is obliged to be represented by a licensed attorney who is entitled to represent third parties in the Republic of Korea. [Article 6, Korean Trademark Act]
- (2) Time limit is within two months from the date on which the notification of this provisional refusal is issued. The holder may request an extension of time to submit a written opinion/amendment to KIPO. The extension can be permitted twice for a period of one month respectively. The request for extension must be made within the given time limit. [Article 17(1)(i), Korean Trademark Act]

B. Response before WIPO

The holder may submit a limitation of the list of goods and/or services (MM6 form) before WIPO directly within the given time limit. [Rule 25 (1)(a)(ii), Common Regulations]

11. Official Seal or Signature by the Office:

KIPO Examiner KIM, Nam Yong 

<< 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 8113 or Fax: (82) (42) 472 3507

Extract from the Korean Trademark Act

Article 3 Persons Entitled to Registration of Trademark

(1) Any person who uses or intends to use a trademark in the Republic of Korea may obtain registration of his/her trademark: Provided, That no employee of the Korean Intellectual Property Office or the Intellectual Property Trial and Appeal Board shall obtain registration of a trademark while he/she is in office, except by inheritance or bequest.

Article 6 Trademark Manager of Non-Resident

(1) Except where a person who is not domiciled or does not have his/her place of business in the Republic of Korea (hereinafter referred to as "non-resident") resides in the Republic of Korea, the non-resident (in cases of a corporation, referring to the representative thereof) may follow trademark-related procedures or bring a lawsuit against measures taken by an administrative authority in accordance with this Act or an order issued under this Act only through a person who is domiciled or has his/her place of business in the Republic of Korea (hereinafter referred to as "trademark manager") as an agent managing the trademark of the non-resident.

(2) A trademark manager shall represent his/her principal in a lawsuit with respect to trademark-related procedures or a disposition made by an administrative authority in accordance with this Act or an order issued under this Act, within the scope of authority delegated to him/her.

Article 220 Service on Non-Resident

(1) Where a non-resident has a trademark manager, any document to be served on such non-resident shall be served on his/her trademark manager: Provided, That the foregoing shall not apply where an examiner notifies an applicant for international trademark registration of grounds for rejection via the International Secretariat pursuant to Article 190.

(2) Where a non-resident does not have a trademark manager, any document to be served on such non-resident may be sent by registered airmail.

(3) Where a document is sent by registered airmail pursuant to paragraph (2), such document shall be deemed served on the date the document is sent.

Article 33 Requirements for Trademark Registration

(1) Trademark registration may be obtained, excluding the following trademarks:

1. A trademark consisting solely of a mark indicating, in a common manner, the common name of the goods;
 2. A trademark used customarily in connection with the goods;
 3. A trademark consisting solely of a mark indicating, in a common manner, the place of production, quality, raw materials, effect, usage, quantity, shape, price, method of production, method of processing, method of use or time of the goods;
 4. A trademark consisting solely of a conspicuous geographical name, the abbreviation thereof, or a map;
 5. A trademark consisting solely of a mark indicating a common surname or name according to the method in common use;
 6. A trademark consisting solely of a simple and readily available mark;
 7. In addition to trademarks under subparagraphs 1 through 6, a trademark which is unrecognizable for consumers to identify which goods related to whose business it indicates.
- (2) Even if a trademark falls under any of paragraph (1) 3 through 6, where such trademark is recognizable to consumers as a trademark indicating the source of goods of a specific person as a result of using the trademark before filing an application for trademark registration, trademark registration may be granted limited to the goods on which such trademark is used.
- (3) Even if a mark falls under paragraph (1) 3 (limited to place of production) or 4, where such mark is a geographical indication for specific goods, an applicant may obtain registration of a collective mark with geographical indication for goods using such geographical indication as designated goods (referring to the goods designated pursuant to Article 38 (1) and the goods additionally designated pursuant to Article 86 (1); hereinafter the same shall apply).

Article 34 Trademarks Ineligible for Trademark Registration

(1) Notwithstanding Article 33, none of the following trademarks shall be registered:

1. Any of the following trademarks, which is a national flag of a country, an insignia of an international organization, etc.:

(a) Any trademark identical or similar to the national flag, the national emblem, the colors, medals, decorations or insignias of the Republic of Korea, or seals or signs used for supervision or certification by the Republic of Korea or public institutions;

(b) Any trademark identical or similar to any national flag of a country of the Union to the Paris Convention for the Protection of Industrial Property (hereinafter referred to as the "Paris Convention"), of a member of the World Trade Organization, or of a Contracting Party to the Trademark Law Treaty (hereafter in this paragraph, referred to as "countries of the Union, etc.");

(c) Any trademark identical or similar to the title, abbreviated title, or mark of the Red Cross, the International Olympic Committee, or a renowned international organization: Provided, That where such organization has applied for trademark registration of its title, abbreviated title, or mark, trademark registration may be obtained;

(d) Any trademark identical or similar to coats of arms, flags, medals, decorations or badges of the countries of the Union, etc. designated by the Commissioner of the Korean Intellectual Property Office after notification by the World Intellectual Property Organization pursuant to Article 6-3 of the Paris Convention, or titles, abbreviated titles, coats of arms, flags, medals, decorations or badges of inter-governmental international organizations which countries of the Union, etc. have joined: Provided, That where an inter-governmental international organization which the countries of the Union, etc. have joined applies for trademark registration of its title, abbreviated title, or mark, trademark registration may be obtained;

(e) Any trademark identical or similar to seals or signs used for supervision or certification by countries of the Union, etc. designated by the Commissioner of the Korean Intellectual Property Office after notification by the World Intellectual Property Organization pursuant to Article 6-3 of the Paris Convention or their public organizations, which is used for the goods identical or similar to those for which such seals or signs are used;

2. Any trademark which falsely indicates a relationship with a state, race, ethnic group, public organization, religion, or famous deceased person, or which slanders, insults, or is likely to defame any of them;

3. Any trademark identical or similar to a famous mark, which is a mark indicating nonprofit business or public service of a state, public organization, or any of its agencies and a non-profit corporation: Provided, That where such state, etc. has applied for trademark registration of its mark, trademark registration may be obtained;

4. Any trademark whose meaning, content, etc. conveyed to consumers is likely to harm public order, such as being contrary to moral norms, the prevailing moral sense of ordinary people, where the trademark itself is used or the trademark is used for goods;

5. Any trademark consisting of a mark identical or similar to a medal, certificate of merit or decoration awarded at an exhibition held by or with the approval of the Government of the Republic of Korea or at an exhibition held by or with the approval of the government of a foreign country: Provided, That where a person who has been awarded at such exhibition uses such mark as part of the trademark for the awarded goods, trademark registration may be obtained;

6. Any trademark containing the name, title, or trade name, portrait, signature, seal, literary name, stage name, pen name of a prominent person, or his/her abbreviated title: Provided, That where the consent of such person has been obtained,

trademark registration may be obtained;

7. Any trademark used for goods identical or similar to the designated goods, which is identical or similar to the registered trademark of another person (excluding any registered collective mark with geographical indication) based on first to file;

8. Any trademark used on goods recognized as identical to the designated goods, which is identical or similar to a registered collective mark with geographical indication of another person based on first to file;

9. Any trademark identical or similar to a trademark (excluding a geographical indication) widely recognized by consumers as indicating the goods of another person, which is used on goods identical or similar to the goods of another person;

10. Any trademark identical or similar to a geographical indication of another person widely recognized by consumers as indicating the goods of a specific region, which is used on goods recognized as identical to the goods using such geographical indication;

11. Any trademark likely to cause confusion with goods or business of another person remarkably recognized by consumers or to dilute their distinctiveness or reputation;

12. Any trademark which is likely to mislead consumers about the quality of goods or deceive consumers;

13. Any trademark which is identical or similar to a trademark (excluding a geographical indication) recognized as indicating the goods of a specific person by consumers in the Republic of Korea or overseas, which is used for unlawful purposes, such as unjust enrichment or inflicting loss on the specific person;

14. Any trademark which is identical or similar to a geographical indication recognized as indicating the goods of a specific region by customers in the Republic of Korea or overseas, which is used for unlawful purposes, such as unjust enrichment or inflicting loss on any legitimate users of such geographical indication;

15. Any trademark consisting solely of the three-dimensional shape, color, combination of colors, sound, or smell, which is essential (in cases of services, referring to cases essential for the use and purpose thereof) to secure the function of goods intended to obtain trademark registration or of the package of such goods;

16. Any trademark intended to be used on wine or distilled beverages, which consists of a geographical indication of the place of production of wine or distilled beverages or contains such geographical indication in a member of the World Trade Organization: Provided, That where a legitimate user of the geographical indication applies for registration of a collective mark with geographical indication under Article 36 (5) by designating the relevant goods as the designated goods, he/she may obtain trademark registration;

17. Any trademark which is identical or similar to the name of a variety registered pursuant to Article 109 of the Act on the Protection of New Varieties of Plants, which is used for goods identical or similar to the name of such variety;

18. Any trademark which is identical or similar to a geographical indication of another person registered pursuant to Article 32 of the Agricultural and Fishery Products Quality Control Act, which is used on goods recognized as identical to the goods using such geographical indication;

19. Any trademark which is identical or similar to a geographical indication of another person protected in accordance with a bilateral or multilateral free trade agreement which has come into effect, concluded by the Republic of Korea with a foreign country or foreign countries, or which consists of or contains such geographical indication, used on goods deemed identical to the goods using such geographical indication;

20. Any trademark for the registration of which an applicant applies on goods, which is identical or similar to such trademark, while he/she is aware that another person uses or intends to use the trademark through a contractual relationship, such as partnership or employment, or business transactional relationship, or any other relationship;

21. Any trademark for the registration of which any person who has or had a contractual relationship, such as partnership or employment, business contractual relationship, or any other relationship with a person who holds the right to the trademark registered, which is identical or similar to the trademark registered in a State party to the treaty, applies on goods by designating goods identical or similar to the goods on which the trademark is designated as the designated goods without the consent of the person who holds the right to the trademark.

(2) Whether paragraph (1) and an applicant for trademark registration (hereinafter referred to as "applicant") correspond to another person under the relevant provision shall be determined based on the time a decision corresponding to any of the following is made (hereinafter referred to as "decision on whether to grant trademark registration"): Provided, That in cases falling under paragraph (1) 11, 13, 124, 20 and 21, whether an applicant corresponds to another person under the relevant provision shall be determined based on the time an application for trademark registration is filed:

1. Decision to reject trademark registration under Article 54;

2. Decision to grant trademark registration under Article 68.

(3) Where a trial to revoke trademark registration is requested because a trademark right holder or a person who uses a trademark of such trademark right holder falls under Article 119 (1) 1 through 3 and 5 through 9, and he/she falls under any of the following after the date such lawsuit is commenced, he/she may obtain trademark registration only where he/she applies for registration of a trademark identical or similar to such trademark (limited to where he/she intends to obtain trademark registration again by designating identical or similar goods (in cases of a collective mark with geographical indication, referring to goods deemed identical) as the designated goods) after three years from the date he/she falls under any of the following:

1. Where trademark rights are extinguished upon expiry;

2. Where a trademark right holder relinquishes trademark rights or abandons some of the designated goods;

3. Where a trial decision to revoke trademark registration is final and conclusive.

(4) None of the provisions of paragraph (1) 8 and 10 shall apply to homonymous collective marks with a geographical indication.

Article 35 First to File

(1) Where at least two applications for trademark registration are filed on different days with respect to the same or similar trademark to be used on the same or similar goods, only the first person who files an application may obtain registration of such trademark.

Article 38 One Application for One Trademark

(1) Any person who intends to file an application for trademark registration shall file an application for each trademark by designating at least one category of goods in accordance with the classification of goods.

(2) Specific goods belonging to the category of goods under paragraph (1) shall be prescribed and announced by the Commissioner of the Korean Intellectual Property Office.

(3) No classification of any category of goods under paragraph (1) shall be construed as prescribing the range of similarity of goods.

Article 54 Decision to Reject Trademark Registration

Where an application for trademark registration falls under any of the following, an examiner shall decide to reject trademark registration:

1. Where a trademark fails to meet the definitions of a trademark, collective mark, geographical indication, collective mark with geographical indication, certification mark, certification mark with geographical indication, or business emblem under Article 2 (1);

2. Where a trademark is in violation of the treaty;

3. Where a trademark cannot be registered pursuant to Articles 3, 27, 33 through 35, 38 (1), the latter part of Article 48 (2), paragraph (4) or (6) through (8) of the aforesaid Article;

4. Where a person is not entitled to registration of a collective mark, certification mark and business emblem under Article 3;

5. In cases of an application for registration of a collective mark with geographical indication, the articles of incorporation of an organization

actually do not permit persons to join the organization as its members, such as the prohibition of persons from joining the organization in accordance with the articles of incorporation, or impracticable conditions for joining the organization are stipulated in the articles of incorporation;

6. Where all or some of the matters concerning the use of a collective mark prescribed by Presidential Decree are not stated in the articles of incorporation under Article 36 (3), or all or some of the matters concerning the use of a certification mark prescribed by Presidential Decree are not stated in the articles of incorporation or the rules under paragraph (4) of the aforesaid Article;

7. In cases of an application for registration of a certification mark, the articles of incorporation actually do not permit persons who may use such certification mark to use it, such as the prohibition of persons from using it in accordance with the articles of incorporation or the rules without justifiable grounds, or impracticable conditions of use thereof are stipulated in the articles of incorporation or the rules.

Article 55 Notification of Grounds for Rejection

(1) Where an examiner intends to decide to reject trademark registration pursuant to Article 54, he/she shall notify an applicant of grounds for rejection (referring to grounds provided in any of the subparagraphs of the aforesaid Article; hereinafter referred to as "grounds for rejection") in advance. In such cases, the applicant may submit a written opinion about grounds for rejection within a period prescribed by Ordinance of

the Ministry of Trade, Industry and Energy.

(2) Where an examiner notifies an applicant of grounds for rejection pursuant to paragraph (1), he/she shall specify the grounds and basis for rejection of each of the designated goods.

(3) An applicant who fails to submit a written opinion within a period under the latter part of paragraph (2) may apply for continuing trademark-related procedures and submit a written opinion addressing the grounds for rejection within two months from the expiration date of such period.

Article 115 Trial against Decision to Dismiss Amendment

Where a person who receives a decision to dismiss an amendment under Article 42 (1) appeals against such decision, he/she may request a trial within 30 days from the date he/she is served with a certified copy of such decision.

Article 116 Trial against Decision to Reject

Where a person who receives a decision to reject trademark registration, decision to reject registration of additional designated goods or decision to reject registration of the conversion of the classification of goods (hereinafter referred to as "decision to reject") under Article 54 appeals against such decision, he/she may request a trial within 30 days from the date he/she is served with a certified copy of such decision to reject.

Korean Trademark Act URL: <http://www.kipo.go.kr/eng/>