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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 REGULATIONS

1. Office of the Designated Contracting Party:

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

2. International Registration/Subsequent Designation No. (International Registration/Subsequent Designation Date):

1664726 (28/10/2021)

3. Trademark:



4. Name and Address of the Holder:

Solera Global Technology Limited
Capitol House, Bond Court Leeds LS1 5EZ United Kingdom

5. Goods/Services Affected by this Provisional Refusal:

All the designated goods/services

※ This is a total provisional refusal. The effect of this provisional refusal covers all the designated goods/services. Please be noted that a grant of protection for the partial designated goods/services is not allowed. [Act 54, Korean Trademark Act]

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

18/07/2023(18/09/2023)

7. Grounds for the Decision:

- Lack of distinctiveness
- Likelihood of confusion with others' earlier marks
- 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 Refusal:

Article 34(1)(vii), Article 38(1)

9. Details of the Provisional Refusal:

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

The applied-for mark is identical or similar to the registered mark (see below) which was applied for registration in the Republic of Korea prior to the International Registration date of the applied-for mark. [Article 34(1)(vii), Korean Trademark Act]

More specifically, "SOLERA", one of the dominant portions of the applied-for mark is identical/similar to "SOLERA", that of the registered marks presented below in sound and/or meaning.

However, this refusal ground could be overcome if the applicant amend it not to include any goods and/or services within the scope of the goods and/or services of the registered marks.

□ Information concerning the earlier mark

- Filing number : 4520160001038
- Filing date : 02/02/2016
- Korean registration number : 4500701100000
- Korean registration date : 12/12/2016
- Name and address of the owner : Solera Holdings, Inc.
1500 Solana Blvd., Bldg. 6, Ste. 6300, Westlake, TX 76262, U.S.A.
- Goods/services :

[Class 09] 다운로드 가능한 전자 출판물 (차량 보험/추돌 복구/차량 구조/차량 재활용 분야의 뉴스레터 성격임), 다운로드 가능한 컴퓨터 소프트웨어 (자동차/차량/화재/건강 산업 분야에서 지능형 추정 시스템 소프트웨어와의 상호작용을 위해 차량 인식 및 차량과 시설물 손실 가치평가/평가/손해 추정/검사/복구/복구 작업흐름/추적/소비자 만족 추적을 위한 모바일 기기에 사용하는 것임), 다운로드 가능한 컴퓨터 어플리케이션 소프트웨어 (자동차/차량/화재/건강 산업 분야에서 지능형 추정 시스템 소프트웨어와의 상호작용을 위해 차량 인식 및 차량과 시설물 손실 가치평가/평가/손해 추정/검사/복구/복구 작업흐름/추적/소비자 만족 추적을 위한 모바일 기기에 사용하는 것임), 다운로드 가능한 컴퓨터 소프트웨어 (피고용인 할당을 위해 작업흐름/수익/사업성장의 분석 및 조절을 위한 것임), 다운로드 가능한 컴퓨터 어플리케이션 소프트웨어 (피고용인 할당을 위해 작업흐름/수익/사업성장의 분석 및 조절을 위한 것임), 퍼포먼스 추적을 위한 다운로드 가능한 컴퓨터 소프트웨어, 퍼포먼스 추적을 위한 다운로드 가능한 컴퓨터 어플리케이션 소프트웨어, 차량 부품 재고 추적을 위한 다운로드 가능한 컴퓨터 소프트웨어, 차량 부품 재고 추적을 위한 다운로드 가능한 컴퓨터 어플리케이션 소프트웨어, 다운로드 가능한 컴퓨터 소프트웨어 (차량 부품 주문/고객 데이터 공유 및 자동차/차량/화재/건강 산업에서 보험업자/차량 및 시설물 복구 시설/감정업자/구조 요원/재활용업자 및 차량과 시설물 소유주 사이의 금융거래를 처리/완료/조화 시키기 위한 데이터 베이스를 관리하기 위한 것임), 다운로드 가능한 컴퓨터 어플리케이션 소프트웨어 (차량 부품 주문/고객 데이터 공유 및 자동차/차량/화재/건강 산업에서 보험업자/차량 및 시설물 복구 시설/감정업자/구조 요원/재활용업자 및 차량과 시설물 소유주 사이의 금융거래를 처리/완료/조화 시키기 위한 데이터 베이스를 관리하기 위한 것임), 자동차량 부품 분야의 다운로드 가능한 매뉴얼, 자동차량 부품 분야의 다운로드 가능한 기록된 매뉴얼, 다운로드 가능한 지시 매뉴얼 (자동차량 복구 및 차량 추돌 복구 분야임), 다운로드 가능한 기록된 지시 매뉴얼 (자동차량 복구 및 차량 추돌 복구 분야임),

[Class 35] 비용가격평가업 (즉, 자동차 및 시설물 손해의 현금가치 추정업), 중고 차량 부품의 위치에 관한 거래 정보제공업, 온라인 검색 가능한 데이터베이스 제공업 (중고 및

재활용된 차량 부품의 위치 및 비용에 대한 정보목록이 있는 것임), 온라인 데이터베이스 관리업, 자동차 소매업자를 위한 광고업/마케팅업/우편 광고업/홍보업 (즉, 자동차의 판매/판매 후/서비스/관리/재구매 시기의 광고업/마케팅업/우편 광고업/홍보 제공업), 보험회사에 대한 비즈니스 리스크 평가 정보제공업, 온라인 검색가능한 데이터베이스 제공업 (타인의 구매를 위한 중고 및 재활용된 차량 부품의 위치 및 비용 목록을 포함하는 것임), 전자 행정 고지서 처리업 성격의 전자 납부 지원 서비스업, 타인을 위한 차량 손해 보험 청구의 보험청구 감사업, 전자 고지서 처리업 (자동차/건축/보험 분야의 고지서를 위한 것임), 차량 및 시설물 손해 보험청구 감사 서비스업, 자동차 기술자를 위한 거래 정보제공업, 고객 관계 관리업 (정보제공업 성격임), 상업적 목적의 고품질 미터 데이터 수집 및 분석업 (재산 및 차량 복구 분야의 공급자 및 수요자의 이용/만족/품질/재정 측정을 제공하기 위한 것임), 비용 절감업 (자동차/건축/보험 분야에서 상품의 구입/청구/설치를 위한 것임), 보험사 알선 관련 관리업 (자동차/건축/보험 분야에서 상품의 구입/청구/설치를 위한 것임), 컴퓨터 데이터베이스의 전자 납부관련 재정 기록 데이터 유지관리업, 상업적 목적의 고품질 미터 데이터 수집 및 분석업, 기업 정보제공업 (고객 만족 정보제공업 성격으로 보험 청구 및 글로벌 네트워크를 통해 자동차 복구/빌딩 재건축 및 복구 분야에서 해당 청구에 따라 일하는 벤더에 관한 것임),

[Class 36] 보험 상담업 (즉, 차량추돌 및 시설물복구청구의 처리 및 관리분야의 상담업), 보험 청구 관리 및 처리업 (즉, 타인을 위해 차량 및 시설물 손해 보험청구의 검토/관리/처리업), 재무 평가업 (즉, 차량 및 시설물 손실 평가 서비스업, 복구비용 감정업, 차량 및 시설물 손해의 현금가치 추정업), 재무정보제공업 (보험청구 및 해당 청구에 따라 글로벌 컴퓨터 네트워크를 통해 자동차 복구 및 빌딩 재건축 및 복구분야에서 작업을 완성하는 벤더와 관련된 것임), 보험 상담 서비스업 (즉, 보험계정 가입서에 대한 리스크 평가 분석 제공업), 재무 리스크 평가 및 관리 서비스업 (즉, 사고/구속/기타 운전 위반에 관한 운전 기록 관련 공개기록의 데이터베이스에 기반으로 보험업자에게 예상 재무 리스크 분석 및 정보를 제공하고, 리스크 변수를 가능하고 리스크 가치를 평가하기 위한 데이터를 포함하며 우편번호 및 지리 지역으로 검색가능한 데이터베이스를 기반으로 보험업자에게 예상 재무 리스크 분석 및 정보를 제공하는 것임), 보험서비스업 (즉, 개인 및 사업체가 현재 혹은 특정 날짜에 보험을 가지고 있는지 확인하기 위한 보험 정책 검증임), 화재 및 차량 보험 계약 서비스업, 보험 재산 및 피해자 보험관련 정보제공업 및 온라인 컴퓨터 데이터베이스 제공업 (보험 재산 및 피해자 보험 분야로 보험 리스크를 가능/평가/보고하기 위한 것임), 고지서 납부 서비스업, 고지서 납부 데이터의 전자 납부 처리 서비스업, 자동차/건설/보험분야의 재무업, 보험 청구 및 지급 데이터의 전자 처리업 (차량 및 시설물의 손해에 대한 것임), 보험위험 관리를 위한 정보 데이터베이스 및 온라인 컴퓨터 데이터베이스 제공업 (보험가입 재산 및 피해자 보험관련 보험 리스크를 가능/평가/보고하기 위한 목적임), 보험위험 관리를 위한 보험계약가입서에 대한 재정 리스크 감정 분석업, 보험위험 관리를 위한 보험업자의 재정 리스크를 확인하기 위한 데이터의 분석 및 수집업 (운전 기록/차량 정보/자동화 차량 운전자 정보에 관한 데이터임),

[Class 37] 자동차 수리 또는 관리관련 컴퓨터 데이터베이스 제공업 (차량 손해 진단/자동차 기술자에 의한 사용을 위한 복구 및 유지작업 분야임),

[Class 42] 다운로드 불가능한 온라인 컴퓨터 소프트웨어의 임시 사용제공업 (자동차 보험 및 자동차 수리분야에서 피고용인 효율을 증진하고 전반적 퍼포먼스 및 수익을 증

진시킴)을 위한 중요 비즈니스 퍼포먼스 지표의 데이터를 수집 및 분석하기 위한 것임), 다운로드 불가능한 소프트웨어 제공업 (차량 복구 서비스업자 및 차량 소유주 사이의 차량 복구 상태를 추적 및 보고하기 위한 것임), 컴퓨터 소프트웨어 플랫폼을 포함한 서비스형 플랫폼 제공업 (차량 복구 서비스업자 및 차량 소유주 사이의 차량 복구 상태관련 추적/업데이트/보고서 작성을 위한 것임), 웹사이트 제공업 (자동화 차량/자동화 차량의 운전자와 승객/운전 기록/차량 정보와 관련하여 사용자가 정보를 취득할 수 있는 기술을 선보이는 것임), 컴퓨터 서비스업 (즉, 자동화 차량/자동화 차량 운전자/운전 기록에 대한 정보의 전자 저장업), 자동차/차량/화재/건강 산업에서 이용되는 다운로드 불가능한 컴퓨터 소프트웨어 제공업 (차량 인식 및 차량과 시설물 손실 가치평가/평가/손해 추정/검사/복구/복구 작업흐름/추적/소비자 만족 추적 및 자동차/차량/화재/건강 산업의 보험업자/차량 및 구조 복구 시설/감정업자/구조 요원/재활용업자 및 차량과 시설물 소유주 사이의 금융거래를 처리/완료/조화 시키기 위한 것임),

[Class 45] 공개 차량 기록을 관련 컴퓨터데이터베이스로부터 정보제공업 (사고 및 구속 기록이 있는 비공개된 운전자 운전 기록과 단체 안전 및 규제 준수 목적의 차량 등록 정보와 관련된 것임), 공공의 안전과 규제 준수 목적의 운전자 감시 서비스업 (차량 소유주 및 조작원이 사업용 운전자의 교통 위반을 추적하게 하는 온라인 및 다운로드 불가능한 컴퓨터 프로그램의 제공을 통한 것임),

- Reproduction of the mark:

SOLERA

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

[Class 09] Computer software and application software, recorded or downloadable, for database management, vehicle fleet information, electronic logging and reporting of regulatory compliance information, vehicle and parts identification and loss valuation, vehicle repair information, damage detection, guided image capturing and image analytics, and tracking information on insurance coverage, claims, and management, all for use in connection with automotive and other motorized vehicles, and transportation and distribution industries; computer software and application software, recorded or downloadable, for customer data management and analysis, sales and pricing data management and analysis, accounting and inventory management, website and digital marketing tools, relating to marketing and advertising in connection with automotive or other motorized vehicles, and transportation and distribution industries; security and safety devices for automotive and other motorized vehicles in the nature of electronic sensors and cameras to detect and prevent security risks; accident prevention devices for automotive and other motorized vehicles in the nature of electronic sensors, GPS tracking devices, and internet of things (IoT) enabled computers used to detect and prevent driving risks.

[Class 35] all the designated goods/services

[Class 36] all the designated goods/services

[Class 37] all the designated goods/services

[Class 42] all the designated goods/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), Regulations]

11. Official Seal or Signature by the Office:

KIPO Examiner KIM, Chong Gu 

<< Information >>

<p>※ If the holder has any questions or needs assistance in responding to this notification, please contact the examiner. E-mail : kipomadrid@korea.kr, Representative Telephone Number : (+82) (42) 481 5532 (International Trademark Examination Division), Fax : (+82) (42) 472 3507</p>

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/>