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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) AND (2) OF THE COMMON REGULATIONS

1. Office Making the Notification:

Korean Intellectual Property Office (KIPO)
920 Dunsan-dong, Seo-gu, Daejeon, 302-701, Republic of Korea

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

763699 (14/07/2006)

3. Name and Address of the Holder:

Société des Produits Nestlé SA
CH-1800 Vevey Switzerland

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

All the designated goods/service

※ 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.

5. 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

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

Article 6(1)(iii), Article 10(1)

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

2007. 10. 4.(2007. 12. 4.)

8. Guidance as to Future Procedure:

Where the holder receives this notification, the protection of the international registration is to be refused as a whole unless the holder submits to the KIPO, through a representative whose address is in the Republic of Korea, a written opinion (amendment) within two months from the date on which this provisional refusal was pronounced or to the International Bureau MM6 (Request for the Recording of a Limitation of the List of Goods and Service).

The holder may request the extension of time to submit a written opinion (amendment) to KIPO. The extension will be granted only once and for a period of 1 month. This request should be made within the given time limit.

If a request for Limitation is presented to the International Bureau so as to get over the ground for refusal mentioned below, we wish that it could also be informed by e-mail (kipomadrid@kipo.go.kr) at the same time for your convenience.

9. Details of the Provisional Refusal:

(Ground 1)

The examiner refuses registration **because the mark merely describes the designated goods and lacks the distinctiveness to enable consumers to recognize whose goods it indicates.** Trademark Act, Article 6(1)(iii).

A mark is merely descriptive under the above-mentioned Article 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.

The indication of 'shape' in the above provision shall be considered applicable in case it is acknowledged that the appearance, shape (including patterns) or size of the goods or packages is indicated in connection with the relevant designated goods. Korean Trademark Examination Standard, Article 8(7).

If the appearance or shape indicated in the three-dimensional shape can be recognized as the same kind of goods (including the package or container of the goods) or as the pertinent designated goods in the trading society, the three-dimensional shape shall be considered indistinctive since it constitutes a general shape for the pertinent goods. Even if a partial change has been made or an ornament has been added to the general shape, the three-dimensional shape as a whole shall be considered indistinctive if the change is recognized to display merely the function or aesthetics of the goods or package, and to come under the scope adoptable in the trading society through the characteristics of the overall shape. Korean Trademark Examination Standard, Article 8(7) – Reference for interpretation 11.

The proposed mark consists solely of a figure indicating the general appearance/shape of the designated goods (Dry cell battery) and, therefore, it is decided that it merely describes 'all' the designated goods and lacks the distinctiveness to enable consumers to recognize

whose goods it indicates.

The proposed mark indicates the common shape of container which the designated goods are put in, viewing it from a different angle.

Accordingly it is decided that the proposed mark lacks the distinctiveness to enable consumers to recognize whose goods it indicates.

(Ground 2)

The assigned examiner refuses registration, because **the identification of some designated goods (services), *which are listed below***, is not specific or is too broad a definition to **accept**. Korean Trademark Act, Article 10(1).

However, this ground for refusal could be avoided if the applicant amends (or deletes) the identification to specify the definite commercial names of the goods (services).

<Broad/Vague identification>

[Class 30] tea extracts and tea-based preparations; chocolate goods, sweet goods; pastry articles; desserts, sauces.

10. Official Seal or Signature by the Office:

KIPO Examiner HAN, Sang Kyoo



※ If the holder has any questions or needs assistance in responding to this notification,
please contact the examiner.
e-mail: kipomadrid@kipo.go.kr, telephone: (82) (42) 481 5283 or Fax: (82) (42) 472 3507

Extract from the Korean Trademark Act

Article 5 *Mutatis Mutandis* Application of the Patent Act

Articles 3 to 26 and 28 to 28^{ter} of the Patent Act apply *mutatis mutandis* to trademarks. In such cases, "Article 132^{ter}" in Articles 6, 11(1)(iv), 15(1) and 17 of the Patent Act reads "Article 70^{bis} or 70^{ter}", "patent right and patent" in the proviso of Article 28(2) of the Patent Act reads "trademark right and trademark" and "international application under Article 2(vii) of the Patent Cooperation Treaty (hereinafter referred to as 'an international application')" reads "international application under Article 2(2) of the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks (hereinafter referred to as 'an international application')." ("The Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks" is referred to as 'the Protocol').

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;

(xiv) 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.

(2) Notwithstanding a trademark falls under paragraphs (1)(vi), (ix), (ix^{bis}) and (x) of this Article, the respective provisions do not apply where the trademark does not fall under the respective sub-paragraphs at the time the applicant applies for trademark registration.

(3) Paragraph (1)(vii), (vii^{bis}), (viii) and (viii^{bis}) of this Article apply where the trademark falls under the respective sub-paragraphs at the time the applicant applies for trademark registration (or where the registered trademark of another person is invalidated under Article 71(3) of this Act). However, this provision does not apply where the owner of the trademark and the applicant for the trademark registration (hereinafter referred to as 'the applicant') has become the same person after filing the application.

(4) Paragraphs (1)(viii) and (viii^{bis}) of this Article do not apply to the following cases:

- (i) where the registered trademark has not been used for more than one year retroactively from the date on which the trademark right is extinguished;
 - (ii) where a rightful applicant applies to register the trademark after a decision on invalidation or revocation becomes final for the reason that the registered trademark violates paragraphs (1)(vi), (ix), (ix^{bis}), (x), (xii) and (xii^{bis}) of this Article or Articles 8 or 73(1)(vii) of this Act; or
 - (iii) where an applicant applies to register the trademark after the period of six months as prescribed in proviso of Article 43(2) of this Act has elapsed without applying to renew the duration term of the registered trademark.
- (5) Where a trial for cancellation of a trademark registration is requested under Article 73(1)(ii), (iii), and (v) to (xii) of this Act, and where any of the following sub-paragraphs occurs after the date on which the cancellation trial is requested, the owner of the trademark right and any person using the trademark may not obtain registration for a trademark that is identical or similar to the extinguished trademark with respect to goods that are identical or similar (restricted to 'identical' in the case of a collective mark for geographical indication) to the designated goods of the extinguished trademark, unless three years has elapsed since the date on which each of the following sub-paragraphs occurs:
- (i) where the trademark right has been extinguished because the duration term has expired;
 - (ii) where the owner of the trademark right abandons the trademark right for all or some of the designated goods; or
 - (iii) where the trial decision to cancel the trademark registration has become final.
- (6) Paragraph (1)(vii^{bis}), (viii^{bis}) and (ix^{bis}) may not be applicable between the collective marks for homonymous geographical indications.

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 (iii^{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.

Extract from the Korean Patent Act

Article 5 Patent Administrator for Nonresidents

- (1) A person who has neither a residential nor business address in the Republic of Korea (hereinafter referred to as 'a nonresident') may not, except when the nonresident (or a representative of a legal entity) is sojourning in the Republic of Korea, initiate any patent-related procedure or appeal any decision made by an administrative agency in accordance with this Act or any decree under this Act, unless the person is represented by an agent (hereinafter referred to as 'a patent administrator') who has a residential or business address in the Republic of Korea.
- (2) A patent administrator may, within the scope of powers conferred on the patent administrator, represent the principal in all procedures related to a patent and in any appeal against a decision made by an administrative agency in accordance with this Act or any decree under this Act.

Article 26 Effects of a Treaty

Where a treaty contains a patent-related provision that differs from this Act, the treaty prevails.

Article 92 Decision etc. on Registration for Extending the Term of a Patent Right

- (1) Where the examiner finds no grounds under any subparagraph of Article 91(1) to refuse an application to extend the term of a patent right, the examiner shall grant the extension.

- (2) Where a decision to extend has been made under paragraph (1), the Commissioner of the Korean Intellectual Property Office shall register the extension of the term of the patent right in the Patent Register.
- (3) Where the registration under paragraph (2) has been made, the information prescribed in the following sub-paragraphs must be published in the Patent Gazette:
- (i) the name and address of the patentee (if the patentee is a legal entity, the title and address of the business);
 - (ii) the patent number;
 - (iii) the date of registration of the extension;
 - (iv) the period of the extension; and
 - (v) the contents of the authorization and so on under Article 89.

Article 220 Transmittal of Documents to Nonresidents

- (1) Documents to be transmitted to a nonresident who has a patent administrator must be transmitted to the patent administrator.
- (2) Documents to be transmitted to a nonresident who does not have a patent administrator may be sent to the nonresident by registered airmail.
- (3) When documents have been sent by registered airmail under paragraph (2), the documents are deemed to have been served on the mailing date.

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