

# Bad-Faith TM filings under Korean Trademark Act

- March 1, 2016



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# 1. Korean Trademark Act

Source : <http://www.law.go.kr>

# Korean TM Act Article 7 (1)

## Article 7 (Unregistrable Trademark)

(1) Notwithstanding Article 6, no trademark falling under any of the following subparagraphs shall be registered:

10. Any trademark which is likely to cause confusion with goods or services of other persons because the trademark is remarkably recognized among consumers to indicate the goods or services of other persons, tarnish its distinctiveness or reputation;

# TM Examination Guideline - 7 (1) 10

- **Burring distinctiveness** refers to the undermining the mark's function of the identification of source caused by the unauthorized use of a well-known mark on dissimilar goods even in the absence of likelihood of confusion
- It also includes the “weakening” of distinctiveness.

## < Examples >

- O “KODAK” for pianos
- O “POSCO” for securities firms.

# TM Examination Guideline - 7 (1) 10

- **Tarnishment of reputation** occurs when good images or values of a famous mark are undermined because it is used for products that have negative images.

## <Examples >

- O “CHANEL” was filed in relation to pornographic films
- O “AmorePacific” for cleaning businesses

# Korean TM Act Article 7 (1)

## Article 7 (Unregistrable Trademark)

(1) Notwithstanding Article 6, no trademark falling under any of the following subparagraphs shall be registered:

12. Any trademark which is identical or similar to a trademark (excluding any geographical indication) recognized as indicating the goods of a particular person by consumers inside or outside of the Republic of Korea, and which is used for unjustifiable purpose, such as obtaining unfair profits or inflicting harms on the particular person;

# Korean TM Act Article 7 (1)

## Article 7 (Unregistrable Trademark)

(1) Notwithstanding Article 6, no trademark falling under any of the following subparagraphs shall be registered:

18. Any trademark which is identical or similar to a trademark indicating the goods of identical or similar goods, which is applied knowing that someone else is using or preparing to use, through partnership, employment or contractual relationship, including a business relationship or transaction and other related relationship



# TM Examination Guideline - 7 (1) 18

- A person with contractual or business relationship,

## <Example>

In case where a person who filed an identical or similar trademark to another person's trademark has a contractual relationship or business relationship, such as a partnership or employment or dealership and thus knows the use of a trademark, or the preparation for a trademark use by other person, the trademark will be rejected.

# TM Examination Guideline - 7 (1) 18

## - A person with a good-faith relationship,

In case where a person who filed an identical or similar trademark to another person's trademark has a good faith relationship

### <Example>

In case a judge of a trademark contest files an identical or similar trademark to one of the marks submitted for the contest

## 2. Opposition Cases of Bad-Faith TM fillings

# Opposition Case 1

## A. Applied Mark :



- Goods : Winter clothes, Arctic clothes, Waterproof jacket

## B. Mark of Prior Use :



- Goods : Clothing

## C. Examiner's Decision

- Decision of registration
- Article 7 (1) 10, 12 : x

# Opposition Case 1

## D. Reference Case : Starbucks TM Case



### Juridical decision [ 2004하7043 ]

- The marks is made of two concentric circles, which contains the character or graphics between the concentric circles is widely used in many cafes.

## Opposition Case 2

### A. Applied Mark : 朱老六 ZHULAOLIU

- Goods : fermented bean curd, fermented preserved bean curd, vegetables preserved, salted vegetables

### B. Mark of Prior Use : 朱老六

- Goods : pickled vegetables, fermented bean curd

### C. Examiner's Decision

- Decision of refusal
- Article 7 (1) 12 : O

# Opposition Case 3

## A. Applied Mark :



- Goods : Computer game software, Computer program

## B. Mark of Prior Use :



- Goods : Animation, Comic book

## C. Examiner's Decision

- Decision of registration
- Article 7 (1) 12 : x

## Opposition Case 3

### D. Etc.

- The applicant had filed several applications of trademark on the same date

TIME SELLER MOON



- Sailor Suit : (Source: [www.naver.com](http://www.naver.com))





# Opposition Case 4

## A. Applied Mark : TOKACHI

- Goods : Milk, Milk products

## B. Mark of Prior Use : TOKACHI

- Goods : Milk products

## C. Examiner's Decision

- Decision of refusal
- Article 7 (1) 12-2 : O



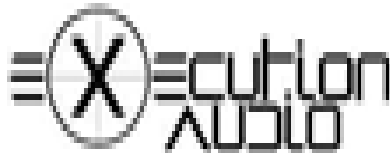
## Opposition Case 5

### A. Applied Mark :



- Goods : Sound transmission apparatus, Sound reproducing apparatus

### B. Mark of Prior Use :



- Goods : Sound transmission apparatus

### C. Examiner's Decision

- Decision of refusal
- Article 7 (1) 18 : O

# 3. A Few Things to Consider

## **A. Decision Time of TM's Reputation**

- at the time when a trademark application is filed

## **B. Location that trademark is known**

- TM Act Article 7 (1) 10 : inside of the Republic of Korea
- TM Act Article 7 (1) 12 : inside or outside of the Republic of Korea

## **C. Things to be noted for those who file an Opposition**

- When any application is published, any person may raise an opposition within two months from the date on which such application is published.
- A person who has filed an opposition to trademark registration may amend the reasons and evidence mentioned in a written request within 30 days after the period of the opposition to trademark registration expires.

## D. Evidence to be submitted to prove the reasons for opposition

- Evidence should be submitted in the form of papers
- Documents written in a foreign language should be translated into Korean
- In case web contents submitted, the information should include creation date, author, internet address etc.

## 4. KIPO's Policy against TM trolls and Counterfeits

## A. KIPO's measures to crack down on trademark trolls

1. **Trademark trolls**(Patent troll) : any person or entity who attempts to register without intending to use it and who then threatens to use others who use that mark.
2. **Current status:** according to various sources, including applications statistics, examinations process, complaints, media coverages, there are roughly 40 trademark trolls as of late September 2015. On average, 533 trademark applications are filed per trademark troll

Frequently filed trademarks include titles of popular TV shows, celebrity names, domestic and foreign popular brand names, buzz words, trademarks in prior use, or others easily accessible to general public.

### **3. The main contents of KIPO's measures**

- Established measures to crack down on trademark trolls (May 2013) and the examination guideline (June 2013)
- Incorporated trademark troll measures into trademark examination guideline (January 2014)
- Added a link of a website to report trademark trolls to KIPO's website
- Trademark Law revision (June 1, 2014) : Bad faith trademarks are denied registration
- Designated quality assurance managers to stay current on the trend in applications by trademark trolls



#### **4. Trends in trademark applications by trademark trolls after the trackdown measures were taken**

- In September 2015, trademark applications by trademark trolls fell sharply to the average 30 per month from 523 in 2014, a 17 fold decrease.
- KIPO is closely monitoring trademark trolls, and identified 38 of them as of late August 2015. KIPO conducts a survey on trend in trademark trolls and closely watches new trademark trolls. In the first half of 2015, 24 trademark trolls filed trademark applications.

#### **B. Anti-counterfeiting activities and supporting measures**

1. Established **Korea Intellectual Property Protection Association (KIPRA)**  
(January 2009)
  - Formed a offline counterfeit investigation team consisting of 10

2. Established an **online monitoring system in KIPRA** with 7 online monitoring staff (December 2009)
  - improved **automatic recognition of counterfeits** (2013)
  - developed **functions to collect evidence of counterfeit sales** (2014)
3. Established **Special Judicial Police Force for Trademarks (SJPF)** (September 2010)
  - Arrested 1,522 offenders by July 2015 since its establishment (seized 3.3 million items)
4. Reorganized SJPF as Intellectual Property Investigation Division (September 2013)
  - 25 staff members: 12 in Dajeon branch and headquarters, 8 in Seoul branch, and 5 in Busan branch
5. Established applicable provisions for offering rewards to people who report counterfeits through the revision of Unfair Competition Prevention and Trade Secret Protection Act

# Thank you!

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