

# Non-Traditional Mark Cases

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**Korean Intellectual Property Office**

## 1 Types of NTMs

- 3D, Color, Hologram, Motion and Position Marks - visible
- Sound and Smell Marks - invisible

## 2 Definition –Article 2 of Enforcement Decree of the Trademark Act

- The term “Trademark” means any of the following items...
  - (a) A sign, word, numeral, figure, design, **three-dimensional form**, combination thereof or each of these elements with color added
  - (b) Visually perceivable marks, such as a **single color**, combination of **colors, hologram or continuous movements**, etc.
  - (c) Not visually perceivable marks, such as **as sound or smell**.

# ✓ The Basic Framework of NTM Examination

**Identify trademark type and look into its specimen (Article 2 of the Trademark Act)**

- \* Does the trademark type indicated in the application form match its specimen?

**Judge Distinctiveness (Article 33 of the Trademark Act)**

- \* Can this mark be the source identifier of products or services?

**Judge Similarity (Article 34 and 35 of the Trademark Act)**

- \* Is this mark similar to or identical with other marks?

- **A position mark is a mark which is composed of a certain shape formed by a symbol, a letter or a figure, or combination thereof, and is positioned on a specific location of a designated product, thereby serving as a source identifier of the product.**
- **Previously, this mark was recognized as one of invisible marks under Article 2(1) of the Trademark Act but it has been more specified by a judicial ruling.**
  - Although a certain shape or appearance per se is non-distinctive, if it is recognized as a source identifier of products by most traders and consumers, it can be registered as it is deemed have acquired distinctiveness. (2010hu2339)

- **An applicant must check ‘other item that can be visually recognized’ and state his/her intention to obtain the registration of a position mark.**
- **While the entire object should be depicted in broken or dotted lines, a certain sign or a figure (claimed to be the position mark) should be depicted on the specific position of the object in solid lines.**
- **When a position mark is filed with KIPO, two to five drawings or pictures of the mark should be submitted along with the application.**
- **Applicants must describe the mark.**

- A position mark is inherently non-distinctive but can be considered distinctive if it has acquired distinctiveness by use.

- Introduced on July 1, 2007, more specified by the Supreme Court on December 20, 2012.

- Ruling by the Supreme Court (2010Hu2339)



Although a certain shape or appearance per se is non-distinctive, if it is recognized as a source identifier of products by most traders and consumers, it can be registered as the mark is deemed to have acquired distinctiveness.

- **As an exclusive right shall be granted to a mark which occupies a certain location of a product, applicants must provide evidence that the mark positioned on a certain location of the product serves as a trademark and consumers recognize it as a source identifier regardless of its distinctive character. If not, the application will be refused under #33-1.**
- **In case a mark which occupies a certain location of a product is functional, even if it is proved that the mark has acquired distinctiveness in accordance with Article 33, the application will be refused under Article 34(1).15.**

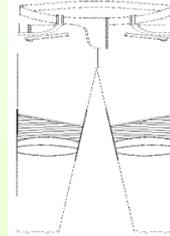
- **The similarity of position marks is examined between position marks.**
- **When determining the similarity of position marks, their position, appearance and angle will be examined, rather than the entire shape. If these factors are likely to cause confusion, those marks shall be determined to be similar.**

# 1. Position Mark

## Example 40-2014-45639

➤ Applicant : PIERRE BALMAIN S.A.S

➤ Class 25 : jeans etc.



➤ Trademark description: As for this position mark, the upward bulging curve in the upper part of the knee and the downward bulging curve in the lower part of the knee of the pants are described in the solid line while the entire shape of the pants is indicated in the dotted line.

➤ Examination results

- Ground for the initial refusal: While it was filed as “position mark”, there was no clear trademark description to fully describe the characters of the position mark. Furthermore, it was determined that consumers were likely to perceive it as a design rather than a mark and were unlikely to identify whose business the trademark indicates [Article 2(1), 33(1)7]
- Final Judgment: As the applicant corrected the trademark description and provided evidence that the position mark was widely known at home and abroad, it was determined to serve as a trademark.

### Things to consider for examination

- Whether a mark is widely known as a source identifier in the trading community (incl. consumers)
  - Previously, in order for distinctiveness of a mark to be recognized, the mark was required to be profoundly recognized under Article 7①9 (well-known marks), but currently, such requirement has been eased by taking into account laws of other countries that a mark is required to be only recognized as a source identifier.
- Whether distinctiveness has been acquired by use for a long period of time
- Whether a mark has been used before an application is filed and distinctiveness has been acquired at the time of deciding the registration
  - Distinctiveness will be determined based on the period of using the mark (e.g. more than 5~10 years) and the extent to which the mark is recognized as a source identifier in the trading community (incl. consumers)
- Whether the mark is used by another person as a trademark
  - Excluding the case where another person's use of the mark is restricted to a limited area

### Provide the evidence to comply with Article 33(2) of the Trademark Act (examples)

- A trademark that has been in use and products to which the trademark has been applied; the fact that the trademark has been used for a long period of time and in a certain area or nationwide; the product's production, manufacturing, processing, certification, sales volume, revenue, market share, marketing and advertising (content, period, cost); the way of using the mark, how many times and how long the mark has been used, objective survey results about consumer awareness; and evidence to show the product's quality or reputation in relation to the mark

## Provide a written opinion and evidence

- This mark is a position mark that has been used for denim products such as jeans and has a unique design created by the applicant. The pants had gained awareness in Korea as many Korean celebrities such as So Jiseoup, G-dragon and Cha Seungwon often wore them before the application was filed.
- After the application was filed, the pants were known to be worn by other local celebrities including Kim Heesun. As such, this mark had been widely known by local fashion consumers before and after the application was filed.
- This mark was advertised through daily newspapers and magazines in countries around the world such as Korea, the UK, China, France, Spain, the US, India, Australia and Italy.
- Looking at the revenues in relation to this mark, the products raised KRW 23,134,000,000 (EUR 17,393,839) from 2011 to 2015 in 37 countries around the world, namely, Belgium, Bulgaria, Canada, Switzerland, China, Cyprus, Germany, Denmark, Estonia, Spain, France, United Kingdom, Greece, Hong Kong, Israel, Italy, Japan, Luxembourg, Latvia, Monaco, Montenegro, Netherlands, Norway, Poland, Russia, Sweden, Singapore, Thailand, Turkey, Taiwan, Ukraine, US and Uzbekistan.

## Judgment

- It is determined that a French jean brand “Pierre Balmain” had been profoundly recognized as a source identifier as Korean celebrities had often worn the pants before an application was filed.
- The claimed position mark -- the upward bulging curve in the upper part of the knees and the downward bulging curve in the lower part of the knees of the pants – is determined to serve as a source identifier.

\* Introduced on March 15, 2012

- **An applicants must check ‘sound mark’ and state his/her intention to obtain the registration of a sound mark in the application form.**
- **Graphical representation of a sound mark**
  - **The protection scope of a sound mark shall be subject to the graphical representation of the mark**
  - **Graphical representation : the sound of the mark shall be graphically represented by using a sign, letter or a figure as realistic and specific as possible to help general users recognize it as trademark.**

- **(Trademark Definition) Applicants shall submit one electronic file that matches the graphical representation of a sound mark**
  - **File format: mp3(mpeg audio layer-3), wav / Size: less than 3MB**
- **Applicants may submit music notation if necessary**
- **(Graphical representation of a sound) Applicants must provide a graphical representation of the sound in the application to help examiners visually understand and specifically identify the mark.**

- **Non-distinctive sounds such as animal roars are not usually recognized by consumers as a source identifier of products or services. Thus, such non-distinctive sounds fall under Article 33(1)7: Provided, That when a sound mark has acquired distinctiveness in accordance with Article 33(2), it can be registered**

Non-distinctive	Distinctive
Animal roars, music without lyrics	When music is combined with pronunciation of a word such as "prince"

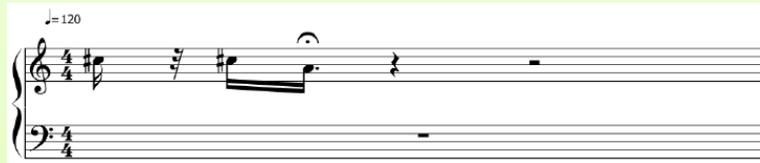
- **In principle, the similarity of sound marks shall be examined based on their graphical representations.**
- **In case a sound mark containing certain pronunciations, the similarity of the pronunciations should be examined by comparing with other types of marks**
- **When determining similarity of sound marks, conceptual aspects of the marks should be examined as well as their audible aspects presumed from graphical representation. If there is any likelihood of confusion as to the source, the marks concerned will be considered similar.**

## 2. Sound Mark

### Example 2. 40-2015-86044

- Applicant : Smart Study Co. LTD.
- Class 09 : Downloadable computer program, an application for smartphone
- Graphical representation: This sound mark consists of “ping”, “keu” and “pong” in C#, C# and A respectively in D major in four-four time. “Ping”(C#) is played in sixteenth note and thirty-second rest is followed; and “keu”(C#)”and “pong(A)” are played in sixteenth note respectively and then fourth rest and second rest are followed. .

- Musical note :



- Examination results

- Ground for initial refusal: the denomination of “ping keu pon” is similar to a prior mark “ping pong” [Article 34(1)7]

\* Prior mark :



- Final Judgment: the applicant responded to the initial refusal arguing that the denomination of his mark is different from that of the prior mark in terms of graphical representation and examiners accepted the applicant’s argument and the trademark was registered.

# Thank you

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