

# Bad-faith TM System of KIPO

Feb 15, 2023

Trademark Examination Policy Division,  
Korean Intellectual Property Office

### **Trademark Act 34(1)13**

A 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 RoK or overseas, which is used for unlawful purposes, such as unjust enrichment or inflicting loss on the specific person shall not be registered.

### **Trademark Act 34(1)14**

A trademark which is identical or similar to a geographical indication recognized as indicating the goods of a specific region by customers in the RoK or overseas, which is used for unlawful purposes, such as unjust enrichment or inflicting loss on any legitimate users of such geographical indication shall not be registered.

## Purpose of Act 34(1)13&14

- ▶ To maintain a sound commercial order and protect consumers from confusion over the source of goods by preventing the registration of bad-faith filings
- ▶ When a third party files a mark that is identical or similar to an unregistered mark that is already recognized as a specific person's mark in or outside of the RoK, in order to prevent the legitimate owner from using the mark in the RoK or gaining unjust profits

## **TM Examination Guidelines – Trademarks in bad faith**

### **Requirements**

- 1.1. The mark must be identical or similar to a mark recognized as a source identifier of a specific person by consumers in or outside of the Republic of Korea.
- 1.2. The applicant must have filed the mark in bad faith in order to reap unjust financial gains or inflict financial damage on the legitimate owner of the prior mark.

## TM Examination Guidelines – Trademarks in bad faith

### Considerations for determination

- 2.1. The examiner can investigate whether the filed mark falls under the **provision** by conducting internet searches and can issue a provisional refusal based on the search results.
- 2.2. The **provision** can be applied even if the designated goods of the filed mark and the goods on which the prior mark has been used are dissimilar or not commercially related.
- 2.3. If the applicant deletes designated goods that have a commercial relationship to the goods on which the prior mark was used after receiving a provisional refusal due to a bad-faith filing, the provisional refusal cannot be overcome.

## **TM Examination Guidelines – Trademarks in bad faith**

### **When to determine the registrability**

- 3.1. A third-party mark must be recognized as a source identifier of a specific person among consumers in or outside of the RoK at the time of filing.
  
- 3.2. Whether the applicant corresponds to “another person” under the Article will be determined at the time when the examiner completes the examination and renders a decision.

## **Countermeasures against Bad-faith Filings – Prevention**

### **1. intensive management of repeated bad-faith applicants**

In case an applicant repeatedly files a trademark application in bad-faith, not a one-time, in order to squat a trademark or files a host of counterfeiting trademarks in a short period of time, he or she will be put on a blacklist as a suspect and regularly monitored.

As for the classes for which counterfeiting trademarks are frequently filed, we will comprehensively review the actual use and illegal purposes of the filed mark as well as whether consumers are likely to be deceived by the filed mark, thereby deciding to put the applicant on the blacklist and the examination direction before commencing the examination.

## **Countermeasures against Bad-faith Filings – at the Examination Stage**

### **2. Check an intent-to-use and conduct rigid examination on illegal purpose of the filed mark**

If a trademark application is suspected to be filed in bad-faith, the applicant will be required to submit a statement of intent-to-use.

If an examiner determines at his or her discretion that there is an illegal purpose or any intention to deceive consumers through the investigation on the actual use of the filed mark or the provision of third party information, the registration will be refused.



## Countermeasures against Bad-faith Filings – Post remedies

### 3. Website for reporting damages ([https://www.kipo.go.kr/kpo/BoardApp/UMemBoardApp?c=1000&board\\_id=broker&catmenu=m02\\_04\\_01&ssl=Y](https://www.kipo.go.kr/kpo/BoardApp/UMemBoardApp?c=1000&board_id=broker&catmenu=m02_04_01&ssl=Y))

At the KIPO website, victims are allowed to report damages caused by trademark squatting in order to prevent counterfeiting trademarks from being registered while providing the following information

- Offer information on the right of prior use of a trade name, limited effects of the trademark right and provision of relevant materials, the appeal process against the registration and tips to respond to a warning letter
- Provide answer sample forms by type for those who receive a warning letter for trademark infringement, thereby supporting them to respond to such a letter on their own without professional help

## **Countermeasures against Bad-faith Filings - Results**

- Heightened awareness about the importance of trademark rights among users
- Rejected 1,000+ applications for counterfeiting trademarks for the illegal purpose in 2022
- Reported 700 + cases via KIPO website(2018~)

**Thank you**