



Prove the Use of a Trademark

<KIPO>

Singapore, 18 May 2023

When “use” of trademarks matters in the Trademark Act

1. Application for the accelerated examination
2. Intention to use
3. Non-use cancellation trial / Trial for confirmation of the scope of rights
4. Trademark infringement



“Use” of Trademarks in Trademark Examinations and Trials

1. Application for the accelerated examination
2. Intention to use
3. **Non-use cancellation trial / Trial for confirmation of the scope of rights**
4. **Trademark infringement**



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Accelerated Examination

- When an application meets requirements for the accelerated examination (trademark disputes, **a trademark is being used or in preparation for use** or a trademark rights needed in foreign countries), its examination may be accelerated.
- When an accelerated examination is applied, whether the application is subject to the accelerated examination procedure will be determined within 10 days from the date of filing the application for the accelerated examination.
- The examination begins in two months from the filing date.
- The fee needs to be paid (KRW 160,000 per class (USD 120))

Requirement 1) Need to prove that the trademark is being used or in preparation for use


- Evidence of a trademark being used
 - ✓ Pictures of products on which the trademark is displayed
 - ✓ Advertisement leaflets and brochures
- Evidence to show that a trademark is being prepared for use
 - ✓ Documents to show that an order has been placed with an advertising company and a printing company to print the trademark to be used for the designated goods.
 - ✓ Drug approval application forms and business plans, etc.
 - ✓ The business registration certificate is NOT acceptable

1. Accelerated Examination

- Certificate of Business Registration
 - Name of Company
≠ Trademark
 - Business Item
≠ goods or services

- Certificate of Business Registration is not acceptable as evidence

(1 / 1)

발급번호 Issuance number	사업자등록증명 Certificate of Business Registration (법인사업자) (Corporate Taxpayer)		처리기간 Processing period
			즉시 Immediately
상호(법인명) Name of company	[Redacted]		
사업자등록번호 Business registration number			
성명(대표자) Name of representative			
주민(법인)등록번호 Resident(Corporation) registration number			
사업장소재지 Business Address			
개업일 Date of business commencement			
사업자등록일 Date of business registration			
업태 Business type			
종목 Business item	제조업(컴퓨터) Manufacture of Computer 프린터 부자재 Wholesale of Computers, Computer Peripheral Equipment and Software		
공동사업자 Joint business owner	성명(법인명) Name(Name of company)	주민(사업자)등록번호 Resident(Business) registration no.	
	해당사항 없습니다 (No Data)		
위와 같이 증명합니다. I certify that above information is true and correct to the best of my knowledge and belief. 위 내용은 발급일 현재 상황으로서 추후 변경될 수 있습니다. The information is true as of the issue date of this certificate and it can be subject to change.			
접수번호 Receipt No.			2018년 10월 11일 Year Month Day
담당부서 Department			 분당세무서장 Head of Bundang District Tax Office (Seal)
담당자 Staff in Charge			
연락처 Telephone No.			

Requirement 2) Being used or prepared for use for all designated goods

- Need to provide at least one designated product for each similar-group code
- If the applicant successfully proves that the trademark is being used or prepared for use for one designated product in a similar group code, it will be regarded that the trademark is being used or prepared for use on all the products of the similar group code.

Requirement 2) Being used or prepared for use for all designated goods

- Designated products : (G1201, S120907, S128302) Cosmetics for removing dead skin cells, cosmetics for anti-aging, cosmetics for manicure, makeup, cosmetics for curling hair and scalp, cosmetics for body care, cosmetics for skin care, cosmetics for children, fragrances for the body (perfume), depilatory products (cosmetics), sunscreen for makeup, makeup masks
- Filed mark: **ju:cy by nora**

<Example>



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Rejection Grounds (Article 3 of the Trademark Act)

- A trademark cannot be registered if there is no intention to use it (Article 3)
- Under the Trademark Act which came into effect on 13 Mar, 2012, the trademark without intention to use can be rejected or invalidated if registered.

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 or 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 or she is in office, except by inheritance or bequest.

- ✓ It is not necessary for the applicants to prove that the trademark is being used or their intention to use when filing an application. Only when an examiner casts a reasonable doubt about intention to use, the applicants submit a written opinion.

Rejection Grounds (Article 3 of the Trademark Act)

- Judicial precedent: It should not be hastily presumed that there is no intention to use. Only when objectively and apparently there is no intention to use, the article will be applicable.

- ✓ (Reference) 2016 Huh 2430 held by the Patent Court on Feb. 7. 2017
 - The Korean trademark law is based on the principle of “first-to-file” and elements of “first-to-use” are additionally taken into account.
 - Intention to use or evidence of the use is not required when filing an application.
 - The use of the trademark is indirectly enforced by allowing anyone to request a trial for non-use cancellation, but there is no regulation to invalidate trademark registration for non-use.
 - “Intention to use” is an applicant’s thoughts in his/her mind.

Registered Marks

히포크라
HIPPOCRA

Designated services: Attorney Service
The applicant is not an attorney

VOGUE
보 그

Designated goods: Umbrellas, Beach
umbrellas

The applicant's own prior trademark 'VOGUE'
was cancelled for non use

Examination Guidelines

- The cases in which a reasonable doubt on intention to use is raised (Examination Guidelines)
 - An individual applicant designated goods that require a large scale of finance and facilities such as artificial satellites, a ship building business, a large discount store business, etc.
 - Various kinds of goods that have no dependency on each other are designated.
 - ✓ Even if expansion of business is considered, the products, i.e. electronic products and cosmetics, which are not usually sold by the same company in the market.
 - A trademark is filed for trademark squatting or preventing someone else's trademark registration.
 - ✓ Ex) An individual files an application for a trademark containing names of celebrities or popular broadcast programs
 - ✓ Ex) If an applicant is 5 years old?

Rejected cases




Meaning: Play Date

Designated Products: A smartphone application

The applicant is 2 years old.

The examiner rejected the application determining that there was no intention to use.

Examination Guidelines

- The applicant can provide the evidence of the use or intention to use
 - Example of evidence of the use
 - ✓ Business registration certificates, newspapers, magazines, catalogues, leaflets, and other printed advertisement materials, products display pictures, order slips and other transaction documents and license contracts, etc.
 - Evidence of intention to use
 - ✓ Connection between the current business and designated goods or a detailed business plan for the future
 - No need to provide evidence of intention to use for every designated product
 - ✓ Evidence for one or more products for each similar group code
-  No need to submit them when filing an application

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Non-Use Cancellation Trial

- The registered trademark has not been used by a trademark right holder for three consecutive years in Korea before a petition for non-use cancellation is filed.
 - This is to address flaws of the “first-to-file” principle by employing the elements of the “first-to-use”.
- In the past, only the stakeholders could request a trial but now anyone can do it. (amended in 2016)
- If a petitioner claims the registered trademark has not been used, the trademark right holder needs to prove otherwise.



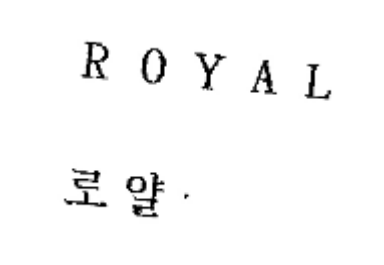

Non-Use Cancellation Trial

- The trademark in actual use should be identical with a registered mark to avoid cancellation.
 - Similar trademarks (X), Similar goods (X)
 - A trademark different only in color is considered the same (Article 225(1))
 - The trademark in actual use may be modified to the extent that the identity of the trademark as source identifier is not impaired.
 - Addition or deletion
 - Addition: Non-distinctive elements added to a trademark is considered the same
 - Deletion: In case that English and transliteration of it are combined

3. Non-Use Cancellation Trial

Identity of a Trademark

- Previous Court cases: In case where a trademark is composed of both English and Korean words, if the trademark is expressed in only one of either languages, it is deemed to be a different trademark.

Registration	Actual Use
	
	

Identity of a Trademark

- Current court case(The Court cases was changed in 2012) : In case where a trademark is composed of both English and Korean words, if the trademark is expressed in only one of either languages, the identity of the trademark is considered to be maintained. (2012Hu2463)

Registration	Actual Use
	

- Ground) No new concept other than those formed by the English word itself is created and even if the Korean word is deleted, general consumers pronounce the same. In addition, the fact that series trademarks no longer exist is taken into account.

Use of a Trademark

- “Use” of a trademark is required
 - Use for products or packages
 - A trademark
 - Products on which a trademark is displayed are only kept in a warehouse
 - Products were delivered to a wholesaler and the wholesaler stored them in boxes for a long time and no sales activities were recorded.



3. Non-Use Cancellation Trial

Legitimate Use

- Using a trademark in order to avoid registration cancellation without actual use is not acceptable
 - For instance, the company was closed but did one-off advertisement right before the non-use cancellation trial

- Using a trademark that infringes the copyright or using it on toys which have not received a safety test required by other laws are considered legitimate use of a trademark.





THANK YOU