



Korean Intellectual
Property Office

**Workshop on Countermeasures Against Bad Faith
Trademark Application with TM5**

Preventive measures against bad faith applications

24 January 2024 | KIPO

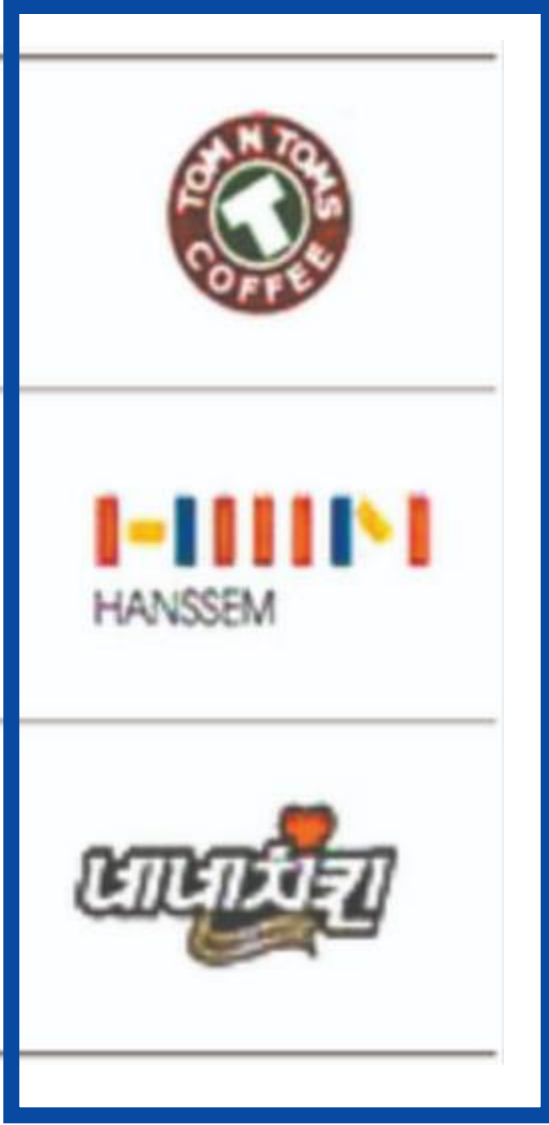
1. Cases of Bad faith applications



Pengsoo(펭수) is a famous penguin character that appears on the YouTube channel Giant Peng TV, run by Educational Broadcasting System (EBS) in Korea.

펭수	Rejected	APPLICANT: Mr. Jung APPLICATION DATE: 2029.11.13.
펭수	Rejected	APPLICANT: Mr. Park APPLICATION DATE: 2019.11.20.
펭수	Registered	APPLICANT: EBS APPLICATION DATE: 2019.11.20.
펭수	Rejected	APPLICANT: Mr. Joo APPLICATION DATE: 2019.11.23.
펭수	Rejected	APPLICANT: Mr. Oh APPLICATION DATE: 2019.12.23.

1. Cases of Bad faith applications



Trademark Act 3(1)

(1) Any person who uses or intends to use a trademark in the Republic of Korea may obtain registration of his/her trademark

Trademark Act 34(1)12

Notwithstanding Article 33, none of the following trademarks shall be registered:

12. Any trademark which is likely to mislead consumers about the quality of goods or to deceive consumers;

Trademark Act 34(1)13

13. Any trademark identical or similar to a trademark (excluding a geographical indication) recognized as indicating the goods of a specific person by consumers in the Republic of Korea or overseas, which is used for unlawful purposes, such as unjust enrichment or inflicting loss on the specific person;

Trademark Act 34(1)13

13. Any trademark identical or similar to a trademark (excluding a geographical indication) recognized as indicating the goods of a specific person by consumers in the Republic of Korea or overseas, which is used for unlawful purposes, such as unjust enrichment or inflicting loss on the specific person;

To be considered as a bad faith application

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.
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 mark.

To be considered as a bad faith application

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.



“recognized as a source identifier of a specific person” is the extent to which a trademark is known to a specific person to the minimum range of people in general transactions at home or abroad.

To be considered as a bad faith application

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 mark.



- ✓ Where a trademark owner has applied for a trademark identical or similar to a trademark that has not yet been registered for the purpose of **preventing legitimate trademark holders from entering the domestic** market or forcing them to conclude agency contracts;
- ✓ Where a trademark identical or similar to a well-known trademark under Article 34 (1) 11 of the Act is applied for the purpose of **diluting the source indication function of a well-known trademark**, even if there is no concern of confusion with another person's product or business;

To be considered as a bad faith application

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 mark.



- ✓ In the case of applying for the **same or extremely similar imitation** of another person's trademark for which creativity is recognized
- ✓ Other cases where the application is filed for the purpose of **obtaining unfair profits by taking advantage of the business credit** or customer attraction of another person's pre-used trademark

3. Countermeasures against bad faith applications

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 **intensively monitored**.

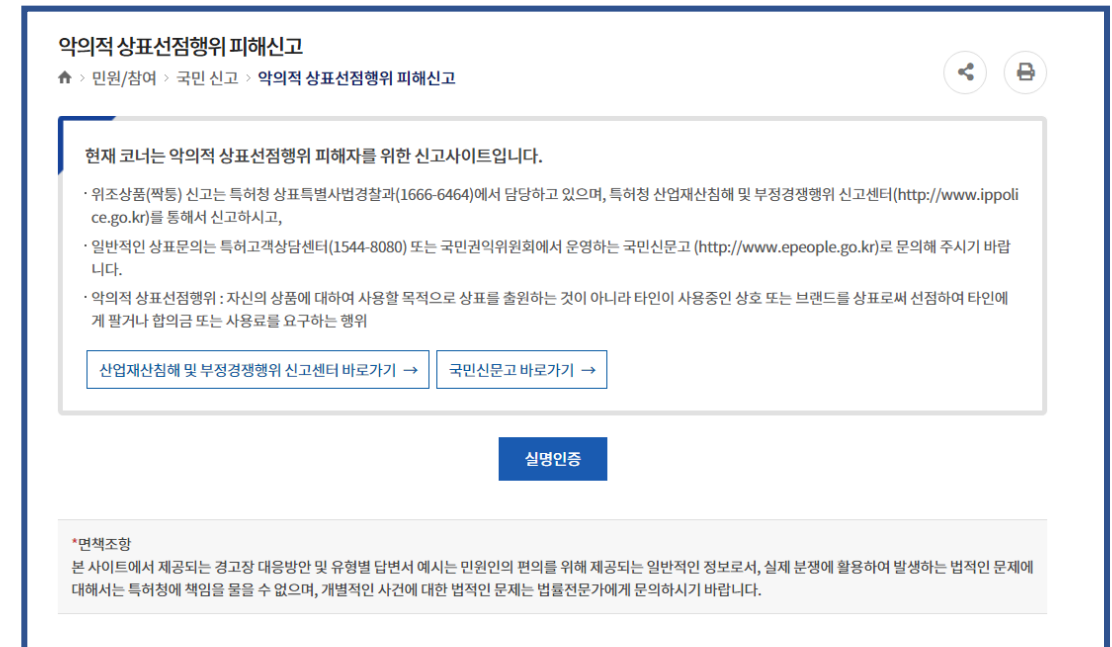
2. Check an intent-to-use and conduct rigid examination on illegal purpose of the filed mark

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.

3. Countermeasures against bad faith applications

3. Website for reporting damages

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



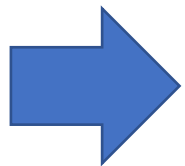
The screenshot shows a webpage titled "악의적 상표선점행위 피해신고" (Report of Damages from Bad Faith Trademark Applications). The page includes a breadcrumb trail: "민원/참여 > 국민 신고 > 악의적 상표선점행위 피해신고". It features a main content area with the following text:

현재 코너는 악의적 상표선점행위 피해자를 위한 신고사이트입니다.

- 위조상품(짝퉁) 신고는 특허청 상표특별사법경찰과(1666-6464)에서 담당하고 있으며, 특허청 산업재산침해 및 부정경쟁행위 신고센터(<http://www.ippolice.go.kr>)를 통해서 신고하시고,
- 일반적인 상표문의를 특허고객상담센터(1544-8080) 또는 국민권익위원회에서 운영하는 국민신문고 (<http://www.epeople.go.kr>)로 문의해 주시기 바랍니다.
- 악의적 상표선점행위 : 자신의 상품에 대하여 사용할 목적으로 상표를 출원하는 것이 아니라 타인이 사용중인 상호 또는 브랜드를 상표로써 선점하여 타인에게 팔거나 합의금 또는 사용료를 요구하는 행위

Below the text are two buttons: "산업재산침해 및 부정경쟁행위 신고센터 바로가기 →" and "국민신문고 바로가기 →". A blue button labeled "실명인증" (Real-name authentication) is also present.

At the bottom, there is a disclaimer section titled "*면책조항" (Disclaimer) stating that the information provided is for general reference and that the user is responsible for the accuracy of the information.



Rejected 1,000+ applications for bad faith application in 2022

Reported 700 + cases via KIPO website(2018~)



Korean Intellectual
Property Office

klein83@korea.kr