Preventive measures against bad faith applications

Workshop on Countermeasures Against Bad Faith Trademark Application with TM5

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1. Cases of Bad faith applications

**Pengsoo** (ペン수) is a famous penguin character that appears on the YouTube channel Giant Peng TV, run by Educational Broadcasting System (EBS) in Korea.
1. Cases of Bad faith applications
2. Related Legal Provisions

**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.

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**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;

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**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;
2. Related Legal Provisions

**Trademark Act 34(1)13**

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**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.
2. Related Legal Provisions

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.
2. Related Legal Provisions

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;
2. Related Legal Provisions

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 applicants

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. 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.

Rejected 1,000+ applications for bad faith application in 2022
Reported 700 + cases via KIPO website (2018~)
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