

# How to determine the likelihood of confusion at the examination stage



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# Review of Korean Trademark Act

- (Article 34) Trademarks Ineligible for Trademark Registration
- (Paragraph 1) Notwithstanding Article 33, none of the following trademarks shall be registered
  - (Article 33) Requirements for Trademark Registration
- (Subparagraph 7) Any trademark used for goods identical or similar to the designated goods, which is **identical or similar** to the registered trademark of another person (excluding any registered collective mark with geographical indication) based on first to file;

# Trademark Examination Criteria

- (Main Principal) The similarity of trademarks should be determined by objectively and dispassionately observing the **appearance, sound, and meaning** of the trademarks from the perspective of ordinary consumers or traders, considering whether there **is a likelihood of confusion or misunderstanding** regarding the origin of the goods.

**(Supreme Court 2001HU3415)**

# Trademark Examination Criteria

- (Principal of Distinctive part observation) In trademarks, it is necessary to compare and judge the similarity of trademarks based on their distinctive parts that **independently perform the function of indicating the origin of goods** by impressing upon, or causing recall or association with, the trademark in the minds of ordinary consumers. This is essential to guide appropriate conclusions in the overall observation.

**(Supreme Court 2015HU1690)**

# Trademark Examination Criteria

## ① Sound

- The sound of the trademark is determined by the way it naturally sounds when read by ordinary consumers.
- The wording of a trademark written in a **foreign language** is typically determined by the natural pronunciation that the majority of traders or consumers would make without any particular difficulty upon seeing that foreign language.

# Trademark Examination Criteria

## ① Sound

- "Zeiss" vs "ZEUS" : Not Similar
  - Differentiated by '[E]+[I]' and '[e]+[u]'
  
- "Elecom" vs "Elocom" : Similar
  - Sounds similar by '[e]' and '[o]'

# Trademark Examination Criteria

## ② Meaning

- The meaning of a trademark grasped by general consumers should be something that can be intuitively realized by looking at the trademark.
- It is **not** subject to consideration to know the meaning only after careful consideration or search for a dictionary.



# Trademark Examination Criteria

## ② Meaning

- “雪花” vs “韓雪花” : Similar
  - 雪花 : Snowflake
  - 韓 + 雪花 : Korean + Snowflake

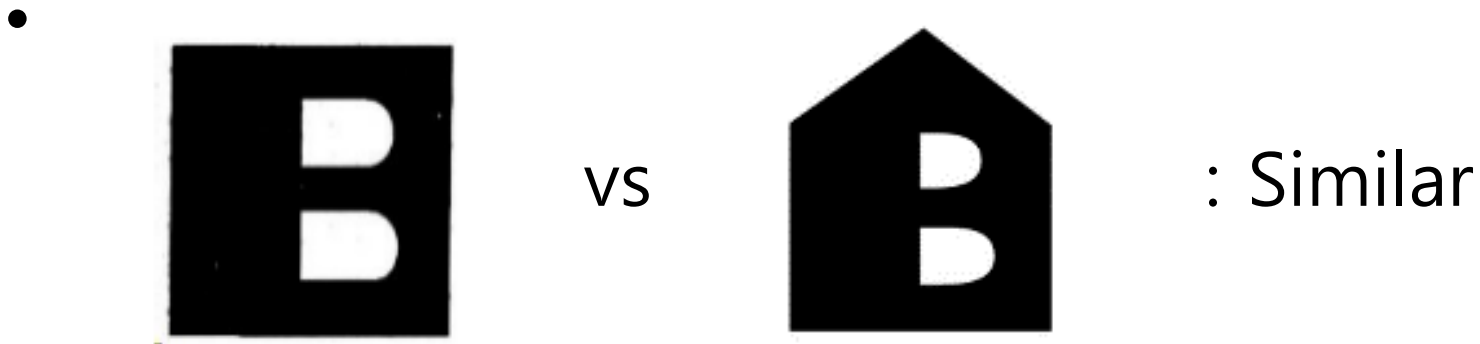
# Trademark Examination Criteria

## ③ Appearance

- “A discrete observation” : The determination of trademark similarity should not be based on directly comparing the two trademarks side by side, but rather on whether there is a likelihood of confusion among ordinary consumers as to the origin of the goods or services, considering different times and places when comparing the two trademarks.

# Trademark Examination Criteria

## ③ Appearance



→ Both trademark's designated goods is bag.

→ Similar in motif and shape.

# Precedents Regarding the likelihood of confusion

	applied trademark		a pre-registered trademark
Trademark sample	<b>PIZZA PEAK</b>	vs	<b>PIZZA PICK</b>
Designated goods	Class 43 (G0301, G0502, S120602) Restaurant Service Business, etc		Class 43 (G0301, G0502, S120602) Restaurant Service Business, etc

→ **patent trial decision : NOT Similar**

# Precedents Regarding the likelihood of confusion

- Upon overall consideration, the **appearances and meanings** of both trademarks are different. Considering that the designated goods of the application trademark, such as "pizza parlor services, operation of pizza parlors," place greater emphasis on transactions and advertising through electronic device display screens, it is deemed that the trademarks are dissimilar and can coexist without causing confusion about the origin.

# Precedents Regarding the likelihood of confusion

	Trademark in this case		a pre-registered trademark
Trademark sample		VS	<b>BURN FITNESS</b>

→ **Supreme Court decision : Similar**

# Precedents Regarding the likelihood of confusion

- The "FITNESS" part serves to indicate the efficacy or purpose of the designated goods, so that **lacks distinctiveness**.
- The "BURN" part, **considered independently**, functions as an **indication of origin for the trademark**, thus constituting a dominant feature. As the appearance is similar and the designation and concept are identical between this registered trademark and Trademark in this case, they are deemed similar.

# THANK YOU



Korean Intellectual  
Property Office