

KIPO's Policy on Bad-Faith TM filings



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1. Korean Trademark Act

Source : <http://www.law.go.kr>

Korean TM Act Article 7 (1)

Article 7 (Unregistrable Trademark)

(1) Notwithstanding Article 6, no trademark falling under any of the following subparagraphs shall be registered:

10. Any trademark which is likely to cause confusion with goods or services of other persons because the trademark is remarkably recognized among consumers to indicate the goods or services of other persons, tarnish its distinctiveness or reputation;

TM Examination Guideline - 7 (1) 10

- **Burring distinctiveness** refers to the undermining the mark's function of the identification of source caused by the unauthorized use of a well-known mark on dissimilar goods even in the absence of likelihood of confusion

- It also includes the “weakening” of distinctiveness.

< Examples >

- O “KODAK” for pianos

- O “POSCO” for securities firms.

TM Examination Guideline - 7 (1) 10

- **Tarnishment of reputation** occurs when good images or values of a famous mark are undermined because it is used for products that have negative images.

<Examples >

- O “CHANEL” was filed in relation to pornographic films
- O “AmorePacific” for cleaning businesses

Korean TM Act Article 7 (1)

Article 7 (Unregistrable Trademark)

(1) Notwithstanding Article 6, no trademark falling under any of the following subparagraphs shall be registered:

12. Any trademark which is identical or similar to a trademark (excluding any geographical indication) recognized as indicating the goods of a particular person by consumers inside or outside of the Republic of Korea, and which is used for unjustifiable purpose, such as obtaining unfair profits or inflicting harms on the particular person;

Korean TM Act Article 7 (1)

Article 7 (Unregistrable Trademark)

(1) Notwithstanding Article 6, no trademark falling under any of the following subparagraphs shall be registered:

18. Any trademark which is identical or similar to a trademark indicating the goods of identical or similar goods, which is applied knowing that someone else is using or preparing to use, through partnership, employment or contractual relationship, including a business relationship or transaction and other related relationship

TM Examination Guideline - 7 (1) 18

- **A person with contractual or business relationship,**

<Example>

In case where a person who filed an identical or similar trademark to another person's trademark has a contractual relationship or business relationship, such as a partnership or employment or dealership and thus knows the use of a trademark, or the preparation for a trademark use by other person, the trademark will be rejected.

TM Examination Guideline - 7 (1) 18

- A person with a good-faith relationship,

In case where a person who filed an identical or similar trademark to another person's trademark has a good faith relationship

<Example>

In case a judge of a trademark contest files an identical or similar trademark to one of the marks submitted for the contest

2. Opposition Cases of Bad-Faith TM fillings

Opposition Case 1

A. Applied Mark :



- Goods : Winter clothes, Arctic clothes, Waterproof jacket

B. Mark of Prior Use :



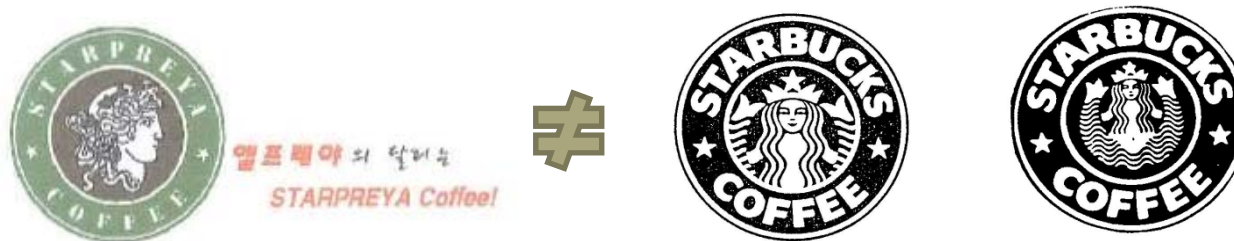
- Goods : Clothing

C. Examiner's Decision

- Decision of registration
- Article 7 (1) 10, 12 : x

Opposition Case 1

D. Reference Case : Starbucks TM Case



Juridical decision [2004하7043]

- The marks is made of two concentric circles, which contains the character or graphics between the concentric circles is widely used in many cafes.

Opposition Case 2

A. Applied Mark : 朱老六 ZHULAOLIU

- Goods : fermented bean curd, fermented preserved bean curd, vegetables preserved, salted vegetables

B. Mark of Prior Use : 朱老六

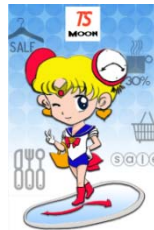
- Goods : pickled vegetables, fermented bean curd

C. Examiner's Decision

- Decision of refusal
- Article 7 (1) 12 : O

Opposition Case 3

A. Applied Mark :



- Goods : Computer game software, Computer program

B. Mark of Prior Use :



- Goods : Animation, Comic book

C. Examiner's Decision

- Decision of registration
- Article 7 (1) 12 : x

Opposition Case 3

D. Etc.

- The applicant had filed several applications of trademark on the same date

TIME SELLER MOON



- Sailor Suit : (Source: www.naver.com)



Opposition Case 4

A. Applied Mark : TOKACHI

- Goods : Milk, Milk products

B. Mark of Prior Use : TOKACHI

- Goods : Milk products

C. Examiner's Decision

- Decision of refusal
- Article 7 (1) 12-2 : O



Opposition Case 5

A. Applied Mark :



- Goods : Sound transmission apparatus, Sound reproducing apparatus

B. Mark of Prior Use :



- Goods : Sound transmission apparatus

C. Examiner's Decision

- Decision of refusal
- Article 7 (1) 18 : O

3. A Few Things to Consider

A. Decision Time of TM's Reputation

- at the time when a trademark application is filed

B. Location that trademark is known

- TM Act Article 7 (1) 10 : inside of the Republic of Korea
- TM Act Article 7 (1) 12 : inside or outside of the Republic of Korea

C. Things to be noted for those who file an Opposition

- When any application is published, any person may raise an opposition within two months from the date on which such application is published.
- A person who has filed an opposition to trademark registration may amend the reasons and evidence mentioned in a written request within 30 days after the period of the opposition to trademark registration expires.

D. Evidence to be submitted to prove the reasons for opposition

- Evidence should be submitted in the form of papers
- Documents written in a foreign language should be translated into Korean
- In case web contents submitted, the information should include creation date, author, internet address etc.

Thank you!

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