

Specific Determination criteria on the Grounds for Refusal in Republic of Korea's Trademark office practice

1. Descriptive marks(Art. 6 (1) 3 of the Act)

(1) Consideration of the propagation of foreign language words (Ref 15, Art. 8 of the Guides)

Any mark consisting of foreign language words that are not widely propagated among the Korean public or whose meaning could be recognized only upon mature deliberation or by looking it up in a dictionary, in principle, is not deemed descriptive.

(2) Irrelevance of actual use or nonuse (Ref 15, Art. 8 of the Guides)

Since a trademark's perceived descriptiveness as to the nature of goods shared by general consumers and traders is sufficient evidence of descriptiveness, the actual, inevitable or likely use of the designated goods is irrelevant.

2. Famous geographical names (Art. 6 (1) 4 of the Act)

(1) Famous geographical names and their abbreviations (Art. 9 (1) of the Guides)

"Famous geographical names and their abbreviations" refer to the names of countries, Seoul, conurbations, provinces, cities, wards of Seoul, wards of conurbations, counties; and famous foreign capitals, larger cities, states, provinces or any other equivalents; and well-known domestic and foreign historic sites, tourist districts, and Main Streets.

(2) Irrelevance of the association with the designated goods(Supreme Court Decision 1983Hu90 Delivered on May 15, 1984)

A famous geographical names simply refer to a geographic or regional name, which does not mean it requires the name to be a badge of origin for specialty products in the region within an association between the name and the products. The geographical name, therefore, requires only famousness, not a perceived extraordinary association in its relation to its designated goods.

3. Simple and common marks(Art. 6 (1) 6 of the Act)

(1) Simple and common marks(Art. 11 (1) of the Guides)

"Simple and common marks" refer to any simple and common mark. It is, therefore, not the case that any trademark consisting solely of a simple or common mark is unregistrable.

(2) The meaning of "consisting solely of"(Art. 11 (6) of the Guides)

Any simple and common mark combined with any other distinctive mark is not deemed as a simple and common mark unless the part other than the simple and common mark merely forms a supplement or is incorporated into the simple and common mark and forms an integral part of the whole.

(3) Marks to be regarded as being simple and common

1) A mark consisting of one Korean character (An exploded expression by Korean alphabets for a Korean character as in "□,□,□" for "□" shall be regarded as one character) (Art. 11 (2) of the Guides)

Example) □, □

Exception) Such mark shall be regarded as being distinctive, since that consisting of one Korean character such as "□" (Chicken) or "□" (Star) readily brings to mind the concept of an object.

2) A mark consisting of one or two of English alphabets (Art. 11 (2) of the Guides)

Example) P, O, AB, dk

3) A mark consisting of any number under 99, including a mark consisting of a foreign number phonetically transliterated into Korean, or expressed in foreign letters (Art. 11 (3) of the Guides)

Example) 57, 88, two, second, □ □ □ (Korean transliteration of 'one three'), ninety-nine

4. Other non-distinctive marks (Art. 6 (1) 7 of the Act)

(1) Where it is generally difficult to recognize distinctiveness due to overall visual perception (Art. 12 (1) 2, 3 of the Guides)

1) Any mark expressed in characters that represents or is likely to be confused with a year in the Christian Era

2) Any mark consisting of a photograph, print or photocopy of a natural person, natural object or cultural asset

(2) Where distinctiveness is not recognized due to actual use by a large number of persons (Art. 12 (1) of the Guides, Ref 1, Art. 12 of the Guides)

1) Any mark expressed in generally used slogans, watchwords, greetings, personal pronouns or catchwords

2) http://, www, @

(3) Where a consumer may not identify whose business is associated with the goods (Ref 3, Art. 12 of the Guides)

Any mark used to mean a place for the concentration, sale or manufacturing of goods or the provision of services, is deemed non-distinctive as in such typical examples as: "Land," "Mart," "Club," "Plaza," "World," "Outlet," "Depot," "Village," "Yard," "Ville," "Bank," "House," "City," "Town," and "Park."

5. Trademarks containing the names or titles of famous persons(Art. 7 (1) 6 of the Act)

(1) Person(Art. 20 (1) of the Guides)

Person refers to both currently existing natural persons and juristic persons (including organizations without juridical personality) and includes both Korean and foreign nationals.

(2) Name, title, trade name, or an abbreviation thereof(Ref. 2, Art. 20 of the Guides)

This subparagraph is deemed applicable to when the name, title, trade name, portrait, signature, seal, famous pseudonym, professional name or pen name of well-known persons, or an abbreviation thereof is included as a supplement of a trademark.

6. Trademarks that are likely to deceive consumers(Art. 7 (1) 11 of the Act)

Court cases dictate that the likelihood of deceiving consumers requires the existence of a cited trademark at all times. A cited trademark has only to be perceived as a particular person's trademark by general consumers or traders. Therefore, such cited trademark is not required to be well-known or famous.

7. Application filed for illegitimate purposes(Art. 7 (1) 12 of the Act)

(1) Significance

Any trademarks that are identical or similar to a trademark that is perceived to indicate the goods of a particular person by domestic or foreign consumers and to be used to obtain unjust enrichment, cause damages to said particular person or otherwise pursue illegitimate purposes, is not registrable.

(2) Specific criteria

1) domestic or foreign consumers(Art. 26 (1) of the Guides)

It is important that this provision provides that the determination is based on domestic or foreign consumers; therefore, this may be applicable to the trademarks known only to foreign consumers, and "foreign consumers" does not necessarily refer to more than two nations' consumers.

2) A particular person(Ref 2, Art. 26 of the Guides)

An abstract source as an anonymous being is enough to qualify as a particular person in this context even if the traders or consumers of the goods in question may not specifically pinpoint who used the trademark.

3) Level of well-knownness(Art. 26 (1) of the Guides)

The amendment in January 2007 to the Act revised this subparagraph ("remarkably" was deleted), mitigating the required level of well-knownness of imitated trademarks. Therefore, although a cited trademark is not required to be well-known or famous, said trademark or its

designated goods must be known enough to be perceived as a particular person's trademark or goods among general consumers or traders.

4) Applicability to trademarks and goods(Art. 7 (1) 12 of the Act)

Although this subparagraph provides that its applicability is limited to a trademark identical or similar to those as indicating a particular person's goods among consumers, its applicability to goods is not limited at all.

5) Trademarks used for illegitimate purposes(Art. 26 (2), (3) of the Guides)

"To obtain unjust enrichment, cause damages to [a] particular person or otherwise pursue illegitimate purposes" as set forth in this subparagraph, refers to instances: where an application for the registration of a trademark identical or similar to a trademark that a legitimate trademark user has yet to have registered is filed to impede said legitimate trademark user from entering the domestic market or force said user into entering a distributorship agreement; or where an application is filed to dilute the source indication of a famous trademark even if no identical or similar trademark is likely to cause confusion with another person's goods or services (Art. 26 (2) of the Guides).

On the other hand, the test of the existence of illegitimate purposes requires the consideration of: (i) documents on the applicable trademark owner's specific plans to enter the domestic market; (ii) documents on any request by the applicant for the purchase of the trademark or a distributorship agreement; and (iii) documents substantially evidencing the likelihood of damages to the good image or attraction of the famous mark.