

ASEM Seminar on The Protection and Enforcement of Well-Known Marks in ASEM Countries

1. Definition of well known marks

1.1 Is there a definition or substantive criteria of well known mark in your economy's trademark law?

There is no clear definition for well-known marks in the Korean Trademark Act (KTA). However, it is mentioned that, in the Article 7(1) (ix) and (x), trademark registration may not be obtained in the following cases;

(ix) trademarks that are identical or similar to another person's trademark when that other person's trademark is well known among consumers to indicate or resemble the other person's goods or services, and when the trademarks are used on goods or services that are identical or similar to such goods;

(x) trademarks that are liable to cause confusion with goods or services of another person because consumers easily recognize the trademark as designating the goods or services of the other person;

Article 7(1)(ix) of the Trademark Act is about the well known mark which is well known within the scope of same or similar goods or services; Article 7(1)(x) is about the well known mark which is well known irrespective of goods or services.

When we comprehensively look over the Article 7(1) (ix) and (x) of the KTA, Trademark Examination Guidelines and court decisions, well-known marks are understood as following;

- trademarks that are well known to the relevant public associated with the particular goods or services the well-known marks are used
- trademarks that have so higher degree of reputation than the above trademarks that deserve a broader scope of protection against unauthorized use on non-competing goods or services

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1.2 Is there judicial interpretation of the term "Well Known Mark"? If so, please indicate the jurisprudence concerned. No.

1.3 Are there administrative guidelines on the interpretation of the term "Well-Known mark"? If so, please indicate the said administrative guidelines.

The “trademark is well known” stipulated in Article 7(1)(ix) means that a trademark is widely known among consumers to indicate a particular person’s goods or services (Trademark Examination Guideline Article 23 (2)).

The “trademarks that are liable to cause confusion with the goods or services of another person” stipulated in Article 7(1)(x) refer to the trademarks that are liable to cause confusion with goods or services connected with another person’s business. And the confusion can be caused not only in relation to the identical or similar goods, but also the dissimilar goods or services due to the famous status of the other person’s trademark (Trademark Examination Guideline Article 24 (2)).

2. Criteria for well-known mark

2.1 Please specify the present criteria for well-known mark in your economy.

The duration, method, type and amount of use and advertisement, sales volume and the like

(1) Whether a trademark is well-known or not should be evaluated objectively and comprehensively according to the duration, extent, method, type of use and advertisement of the mark, sales volume, geographical extent of the trading area and so forth. (TMEG Article 23)

- a. The duration and extent of use, and the geographical extent of the trading area shall not be determined only by a numerical standard, but various factors such as channels of trade, sales volume and monopolistic status of the goods or services, etc. should be taken into consideration.
- b. With respect to the method or type of use, it is not always required that the mark should be used directly on the goods. It is sufficient that the mark is widely known among consumers as a result of advertisement through various channels such as newspapers, magazines, radios, TV, Internet or exhibitions.
- c. To be a well-known trademark the mark should have a form and appearance, and the

owner of the mark should give proof that the form and appearance are remarkably recognized among consumers. If the mark is comprised of words only and is recognized among consumers as having a specific pronunciation and concept as a result of advertisement through radios, TV and other media, the above requirement of the form and appearance is not needed.

- d. In principle, a well-known mark refers to a mark that is well known in domestic area. However, if a mark is not used in domestic area but well known among the relevant business area in Korea (e.g., famous foreign marks or the marks used for the goods that are mainly exported to foreign countries), the mark shall be considered to be well known.

(2) In judging whether a mark is likely to cause confusion with others' goods or services as stipulated in the Subject Provision, various factors shall be comprehensively considered such as the degree of the well-known status of that other's mark (degree of advertising and publicity, yearly volume of sales or a market share), the creativity of the mark, the business scope of the company, and whether the mark is comprised of trade names (TMEG Article 24(4)).

2.2 Does your concept well known mark also cover the service mark?

Yes, the service mark are covered by the concept of well known mark

2.3 How does a mark acquire well-known status?

2.3.1) through actual sale of the goods / services bearing the mark in question in your country;

2.3.2) through advertising or promotion or some other means the mark may acquire well know status in your economy;

(i) To what extent do you consider the mark to be used? i.e. the goods / services bearing the mark must be offered on sale in the territory or any mere appearance of the mark in any media without any actual sale occurred.

The mark may acquire well-known status with appearance in media without any actual sale occurred.

It is not always required the actual sales of the goods or services bearing the mark in

question to acquire the well-known status. It is considered to be sufficient that the mark is widely known among consumers through advertising or promotion or some other means.

2.3.3) through actual knowledge of the mark by the public;

(i) Does "public" mean the public in general or public who normally deal with the goods/services bearing the mark in question?

"Public" means the public who normally deals with the goods or services bearing the mark in question as well as consumer. (the relevant sector of the public - WIPO Joint Recommendation)

The "consumers" stipulated in Article 7(1)(9) of the Act include final consumers, the middlemen who purchase raw materials and intermediate goods such as machinery, parts, etc. for the purpose of manufacturing goods, and the wholesalers or retailers who are engaged in the sale of the goods (TMEG Article 23(1)).

* The Unfair Competition Prevention Act does not mention the necessary degree of recognition. This is determined in individual cases according to the kind of goods and services and the particulars of the market. When applying the concept of 'being widely known', it is not necessary that all Koreans be familiar with the goods, but only those engaged in the specific business area (although in practice this will not be examined separately), depending on whether the purchasers are retailers, middlemen or consumers.

(ii) What percentage of the public is needed to constitute the required knowledge of the mark by the public"?

There is no specific standard. This is determined in individual cases according to the kind of goods and services and the particulars of the market.

(iii) Does knowledge by the relevant sector concerned also constitute the required public knowledge? Yes.

(iv) Does knowledge have to amount to reputation in order that the mark could be considered well

In most cases for a mark to acquire a well-known status, it has to have reputation.

2.3.4) the length of time that the goods/services must be available to make the goods/services bearing the mark in question well known.

There is no specific length of time

2.3.5) the geographical extent of the trading area in which the mark is used

The geographical extent of trading area in which a well-known mark is used should be considered on a case by case basis. The area can be either the whole country or a specific region, but the determination shall be made through sufficient consideration of its designated goods (TMEG Article 23 [Reference for Interpretation](#) 4).

The geographical extent, in which the confusion with other well known-marks occurs, should be considered on a case by case basis. It can be either the whole country or a specific region (TMEG Article 24 [Reference for Interpretation](#) 3).

2.3.6) the good/bad faith of the infringer

The good or bad faith of the infringer is not required to determine the well-known status.

However, according to the Article 7(1)(xii), trademarks that are identical or similar to a trademark that consumers inside or outside the Republic of Korea easily recognize as indicating the goods of a particular person, and which are used for unfair intention (for obtaining unjust profits or inflicting harms on the particular person) may not be registered.

2.3.7) the market share of goods / services for which the mark is used

Yes, market share of goods or services is to be considered to determine well-known status.

Others

2.3.8) through advertising and publicity of the mark

As far as advertising and publicity is concerned, do you take the following factors into consideration?

a) the amount of money spent on advertising and publicity of the goods or services for which the mark is used; yes

b) the means of advertising and publicity of the mark : television, newspapers, magazines, advertising boards and computer network; yes

c) the length of time spent on advertising and publicity; yes

d) the geographical extent of the advertising area; yes

e) others

2.3.9) the need for registration. Need the mark be registered to qualify as a well known mark ?

2.3.10) the duration of registration. How long must the mark have been registered, as a criteria for well known mark?

There is no need for the mark to be registered.

3. Scope of protection

3.1 Is the protection given to specific class of goods / services bearing the mark and / or to any other classes of goods? Is it a bar against similar mark being registered for dissimilar goods / services? If a class system does not exist please briefly explain the present systems.

The protection is given to other classes of goods or services. If similar mark for dissimilar goods or services cause confusion with another person's goods or services bearing the well known mark, it cannot be registered.

3.2 Could the status of being well known create the distinctiveness of the mark although the mark is in itself descriptive of the goods or services?

Yes. If the mark obtains a secondary meaning, the status of being well known could create the distinctiveness.

3.3 Under your law, do you allow a mark to be used in dissimilar goods or services from varying sources?

If the mark is not liable to cause confusion with another person's business or goods, or it can be used in dissimilar goods or services.

3.4 Do you bar illicit use of a well known mark for business identifiers such as trade name etc.?

Yes, if such a use is liable to cause confusion.

According to the Article 2(1)(i) of the Korean Unfair Competition Prevention and Trade Secret Protection Act, the following acts are regarded as 'acts of unfair competition' and prohibited regardless of the intention.

(i) an act of causing confusion with another person's goods or services by using signs identical or similar to another person's name, trade name, trademark, container or package of goods or any other sign widely known in the Republic of Korea as an indication of goods, or by selling, distributing, importing goods or services with such things;

(ii) an act of causing confusion with another person's commercial facilities or activities by using signs identical or similar to another person's name, trade name, emblem or any other sign widely known in the Republic of Korea as an indication of commerce.

4. Remedies

4.1 What kinds of remedies are available to the holder of well know mark?

An injunction relief, monetary damages, restoration of injured good will, and criminal sanction are available.

4.2 Are there different remedies for registered and unregistered well known marks?

Yes.

Remedies for registered well known marks are an injunction relief, monetary damages, restoration of injured good will and criminal sanction (imprisonment with labor not exceeding seven years, a fine not exceeding one hundred million won) are available.

Remedies for unregistered well known marks are mainly stipulated in the Korean Unfair Competition Prevention and Trade Secret Protection Act.

- Article 4: Injunction against acts of unfair competition
- Article 5: Liability for compensation of damages from acts of unfair competition
- Article 6: Restoration of injured good will by acts of unfair competition
- Article 18 (3): Criminal sanction (imprisonment with labor not exceeding three years, a fine not exceeding thirty million won)

4.3 Could bad faith be a ground for revocation of the registered mark when the applicant knew or should have known at the time of filing an application that his mark is similar on identical to someone else's well known mark?

Yes.

According to Article 7(1) (xii), trademark registration may not be obtained in the case of trademarks that are used for unfair intention of obtaining unjust profits or inflicting harms on a particular person, etc. If the mark that causes confusion with someone else's well known mark happen to be registered with bad faith, it can be invalidated anytime by proving the bad faith of the applicant. (Article 71)

5. Administrative Decisions Rules and Regulations

5.1 When asking a jurisdiction to define well known mark, what part of the government is responsible for defining the term; what part of the government is responsible for recognizing the definition and enforcing such definition?

Korean Intellectual Property Office (KIPO) is responsible for defining the well-known mark. KIPO and the Court are responsible for recognizing the definition. The Court is responsible for enforcing the definition.

5.2 How could an already registered mark similar to a well known mark be registered?

Where the similar mark is not likely to cause any confusion, or where well known mark acquires "well known status" later after the similar mark is registered, it can be registered.

6. Status of well known mark

6.1 Are there different levels of status of well-known mark? Do you have other classifications such as "international" and "domestic" well known mark, and "famous" and "notorious" mark?

We do not clearly classify the level of status of well known mark, but the following trademarks are differently dealt with in the time limit for invalidation trial.

- trademarks that are well known to the relevant public associated with the particular goods or services the well-known marks are used
- trademarks that have so higher degree of reputation than the above trademarks that deserve a broader scope of protection against unauthorized use on non-competing goods or services

6.2 If you classify international and domestic marks, are there different criteria for each type?

6.3 Do you make any distinction between "reputation" and well known status of the mark? No.

6.4 How does the mark obtain the well known status?

By decision of the Court

6.5 What is the term of validity for the well known mark ?

There is no specific term of validity.

As long as the mark is widely known to the consumer to indicate the other person's goods or services.

6.6 Do you have a list of well known marks? If possible, please provide the list.
No.

6.7 Is your list of well known marks an exhaustive list?

7. Future intention to set up criteria for well known mark

7.1 Please describe your Economy's intention to set up criteria for well known mark e.g. whose and what criteria to be used as an example, the approximate date of setting up the criteria etc.

8. Comments:

If you have other information and / or comments, which will be helpful to understand the well known mark system in your country, please specify in the space below.