

New Marks - Old Laws



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Ho-Hyun Nahm
Barun IP & Law



12th Open Forum



Acknowledgement of Contribution



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Intro

New Elements as a Trademark

Outline

Protection for New Marks

Interesting approaches nearby Korea

The distinctive word appear on the mark

Outline

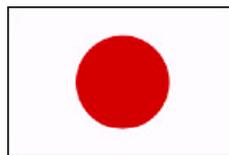
Formal requirements for registration

Adjustment of protection
of trademark and design patent

Protection for the motion mark

Protection for New marks

What is available protection for new marks



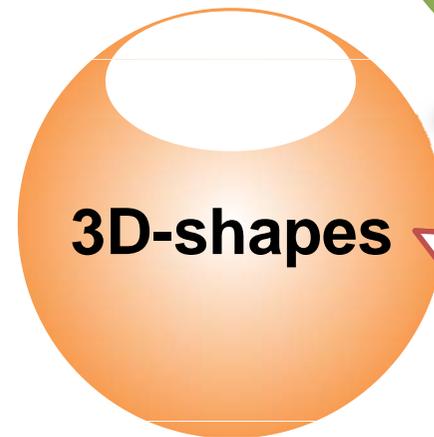
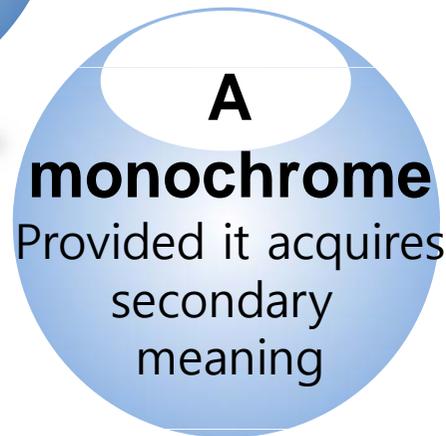
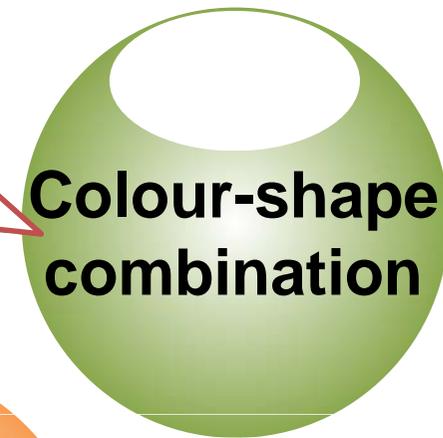
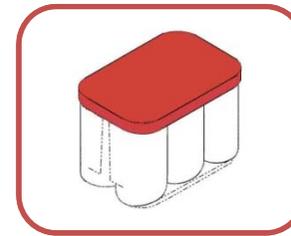
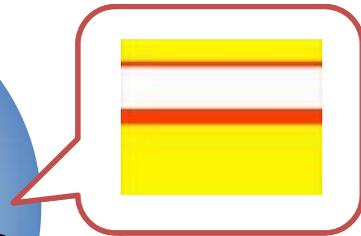
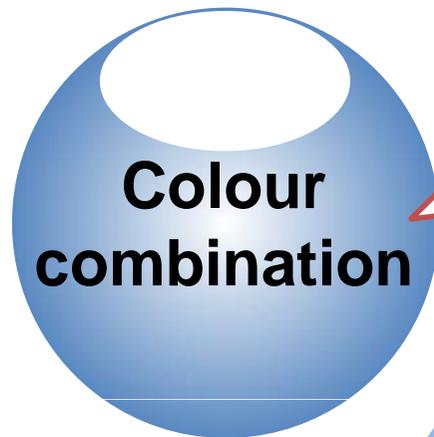
► Definition of Trademark

Any visual sign including **3D-shapes, colours** and **any combination** of the above elements

Protection for New marks

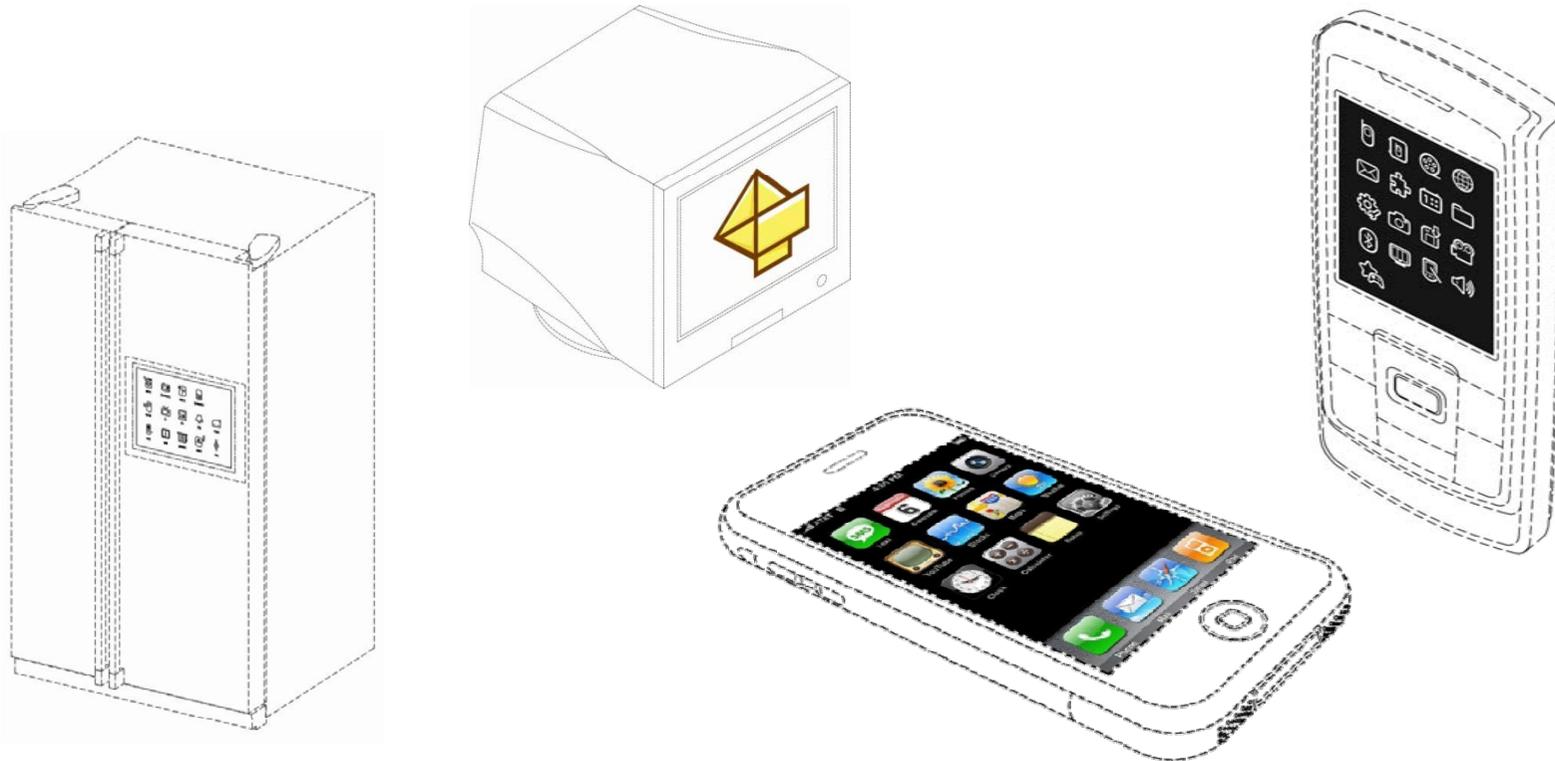


► Protectable Type of Trademark



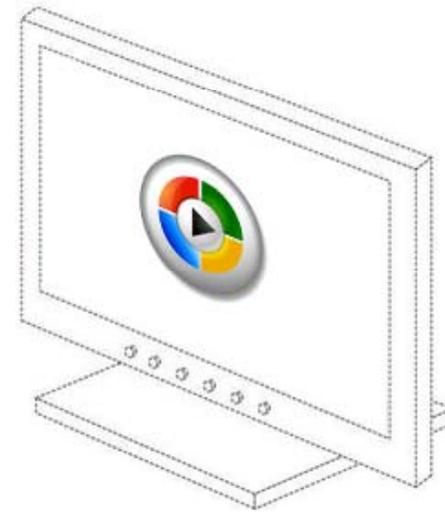
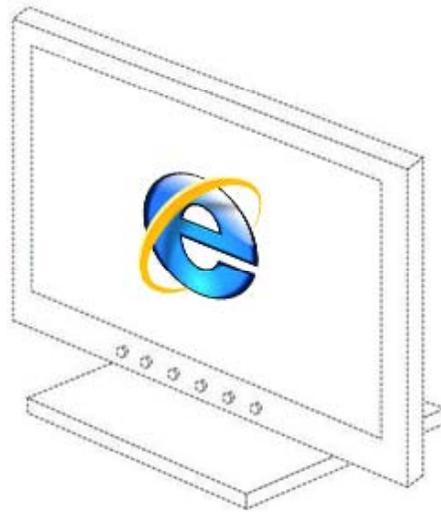
Protection for New marks

How does the protection available to fit with new elements



Protection for New marks

How does the protection available to fit with new elements



Protection for New marks



▶ Requirement

- ▶ **Distinctiveness (not descriptive)**
- ▶ **Not to secure necessary function of pertinent products or packages**
- ▶ **Recognition of secondary meaning**



Protection for New marks

► Available protection for the mark with a distinctive word

	Korea	Japan	China
Colour-combination	○	○	○
3D-shape	○	○	○
Colour-shape combination	○	○	○
Moving shape	○	X	X

Protection for New marks

► Available protection for the mark without distinctive word

	Korea	Japan	China
Colour-combination	△	△	△
3D-shape	△	X	△
Colour-shape combination	○	△	△
Moving shape	○	X	X

Protection for New marks



- ▷ **Combination colour mark:** adopted as of January 1, 1996
- ▷ **Colour mark:** adopted as of July 1, 2007
- ▷ **3D-shape mark:** adopted as of March 1, 1998
- ▷ **Moving mark:** adopted as of July 1, 2007

Protection for New marks



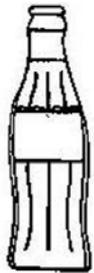
► Applications for colour and 3D-shape marks

	2005	2006	2007	2008	2009
Colour mark	12,326	14,692	15,854	12,809	13,172
3D-shape mark	58	52	81	79	108
Colour-3D-shape combination	214	251	193	130	115
Total	12,958	14,995	16,128	13,018	13,395

Protection for New marks



▶ 2D-device without logo



Registered as a 2D-device mark as of November 1954
Reg. No. 40-00543

▶ 3D-shape without logo



Registered as a 3D-device mark as of October 30, 2009
Reg. No. 40-804966

Protection for New marks



► Recent cases

Shape and packages of Ferrero Rocher's chocolate



October 24, 2009

Korean Intellectual Property Tribunal (KIPT)

Case No. 2007Won11001

No. 2007Won11002

recognized the distinctiveness

Reg. No. 40-774571, 40-774572

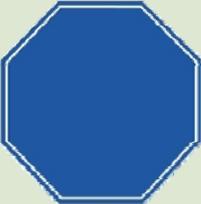
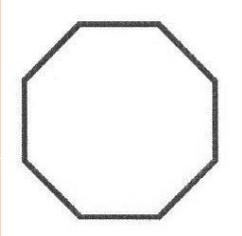
Protection for New marks

► Protection for the marks associates with consumer



electronics

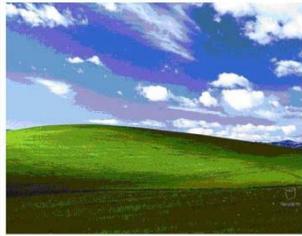
► Colour combination

	Accepted example	Rejected example
Trademark		
Reg. No. (App. No.)	40-759149	(Intl' 883260)
Reg. Date (App. Date)	August 29, 2008	(April 4, 2006)
Class & Goods	9: electronic theft Prevention apparatus	9: electron tubes

Protection for New marks



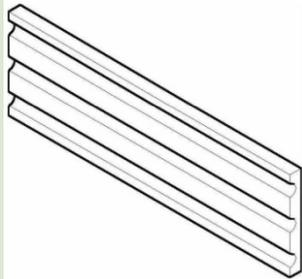
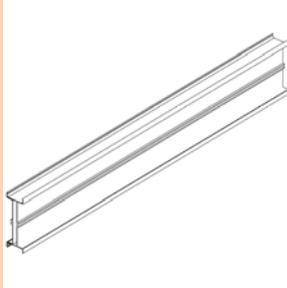
► Colour combination

	Accepted examples		
Trademark			
Reg. No.	40-623300	45-19616	40-727716
Reg. Date	July 1, 2005	April 10, 2007	November 7, 2007
Class & Goods	9: Operating system software	9: Computer software, operating system programs, etc.	9: Operating system software

Protection for New marks



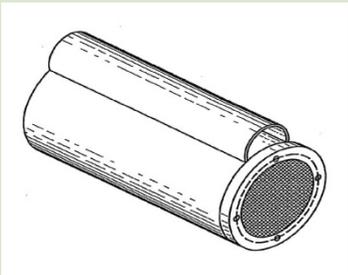
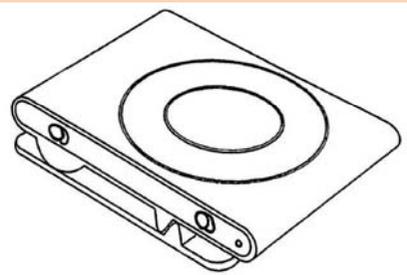
► 3D-shapes

	Accepted example	Rejected example
Trademark		
Reg. No. (App. No.)	40-610399	(40-2009-3309)
Reg. Date (App. Date)	March 3, 2005	(July 13, 2009) → Refused as of April 14, 2010 because of descriptiveness
Class & Goods	9: connection boxes	9: duct for telecommunication cable

Protection for New marks



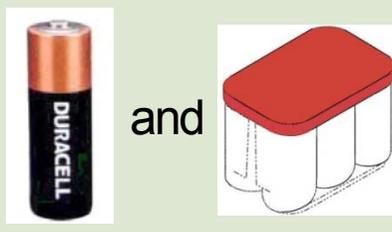
► 3D-shapes

	Accepted example	Rejected example	Pending example
Trademark			
Reg. No. (App. No.)	40-802930	Intl' 982659	(40-2010-30922)
Reg. Date (App. Date)	January 8, 2009	August 5, 2008	(June 11, 2010)
Class & Goods	9: audio speakers for high-fidelity music reproduction	9: portable and handheld digital devices for playing, ...	9: portable and handheld digital devices for recording, ...

Protection for New marks



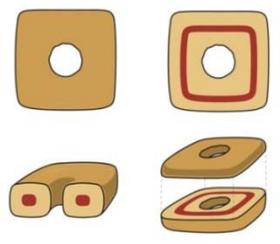
► Colour-3D shape combination

	Accepted examples	Rejected example
Trademark		
Reg. No. (App. No.)	45-23497	(Intl' 832003)
Reg. Date (App. Date)	June 9, 2008	(May 6, 2004)
Class & Goods	9: Computer software for downloading and installing other software on a personal computer, ...	9: batteries

Protection for New marks



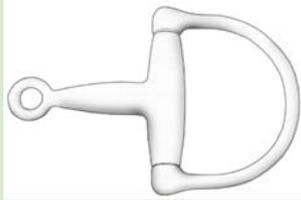
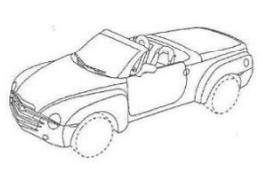
► Accepted examples for various products - 3D shape

	Accepted examples		
Trademark			
Case & Reg. No.	<p>Guylian chocolate 40-590519 40-590518</p>	<p>Hiyoko 40-642827</p>	<p>Doughnut plant 45-023575</p>
Reg. Date	August 18, 2004	December 12, 2005	June 17, 2008
Class & Goods	30; chocolates	30; Japanese pastries	30; doughnut

Protection for New marks



► Accepted examples for various products - 3D shape

and/or colour	Accepted examples			
Trademark				
Case & Reg. No.	Louis Vuitton 40-540154	Gucci IR 869616	World Cup 40-488949	GM 40-618705
Reg. Date	January 24, 2003	April 5, 2007	March 5, 2001	May 20, 2005
Class & Goods	18; handbags	9; eyeglasses 18; handbags, 25; shoes	14; commemorative cups made of metal	12; cars

Protection for New marks



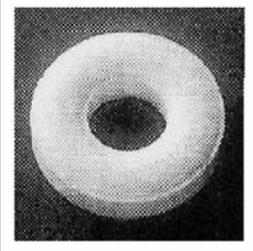
▶ Accepted examples for various products - 3D shape

	Accepted examples	
Trademark		
Case & Reg. No.	Uniform 41-188813	Delivery vehicle 41-073314
Reg. Date	August 12, 2009	February 1, 2002
Class & Goods	39; Air transport	39; delivery of personal property by vehicle

Protection for New marks



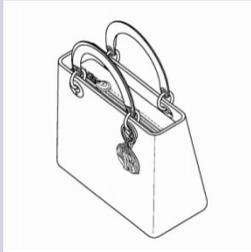
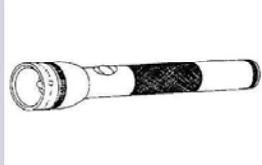
▶ Rejected examples for various products - 3D shape

and/or colour	Rejected examples		
Trademark			
Case & App. No.	Polo candy 40-2004-39260	Guylian chocolate 40-2003-04021	Monochrome mark 45-2007-04236
App. Date	August 26, 2004	January 28, 2003	September 28, 2007
Class & Goods	30; candies	30; chocolates	30; candies

Protection for New marks

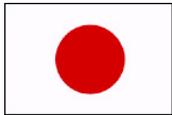


▶ Rejected examples for various products - 3D shape

and/or colour	Rejected examples			
Trademark				
Case & App. No.	Christian Dior 40-2001-04484	Maglite 40-1998-23084	Interlema Holding 40-2000-06692	GM Matiz 2 40-2004-25905
App. Date	February 8, 2001	September 7, 1998	February 17, 2000	June 8, 2004
Class & Goods	18; handbags	11; flash light	9; electric connectors	12; cars

Interesting approaches nearby Korea

Do any of the jurisdictions/countries nearby take an interesting and different approach?



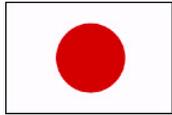
► Recent Court Precedents

Shape of the bottle of Coca-Cola



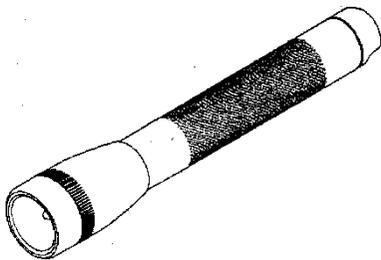
- May 29, 2008
- Japanese IP High Court 2007 Gyo-Ke 10215
- Recognized the secondary meaning
- Reg. No. 522519
- Class 32: Cola beverage

Interesting approaches nearby Korea



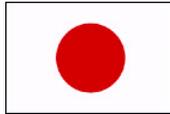
► Recent Court Precedents

Shape of Mini Maglite® Product



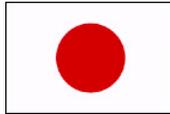
- June 27, 2007
- Japanese IP High Court 2006 Gyo-Ke 10555
- Recognized the secondary meaning
- Reg. No. 509407
- Class 11: Flashlight

Interesting approaches nearby Korea



	Accepted examples		
Trademark			
Case & Reg. No.	Recognized as combined with logo 5172274	4156317	4210761
Class & Goods	5; medicines	14; key holder	28; toy

Interesting approaches nearby Korea



	Rejected examples		
Case	Hiyoko	Gold Ingot	Goldkenn's Goldbar [Case No. H13 Gyo-Ke 418]
Trademark			
Status	Registered But cancelled later	Rejected by IP High Court July 18, 2006	Rejected by Tokyo High Court in 2002

Interesting approaches nearby Korea



▶ Recent Court Precedent

Shape and packages of Ferrero Roches' chocolate

▷ Accepted



- In August, 2009
- Beijing No. 1 Intermediate Court
- Case No. YIZHONGXING CHUZI No.815
- recognized the distinctiveness
- IR No. 783985

Interesting approaches nearby Korea



► Recent Court Precedent

Shape and packages of Ferrero Roches' chocolate

▷ Rejected



- In August, 2009
- Beijing No. 1 Intermediate Court
- Case No. YIZHONGXING CHUZI No.817
- rejected protection in China
- IR No. 783578

Interesting approaches nearby Korea



► Protection of colour combination

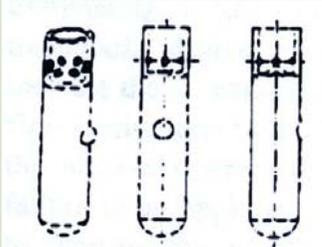
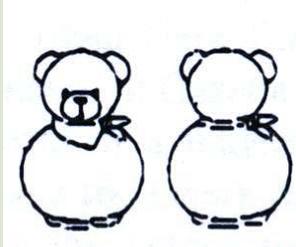
The trademark right of the colour cannot be applied to other colours

→ Identical Color will be protected

→ Other colours will not be protected

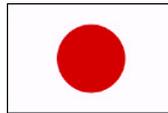
Interesting approaches nearby Korea



	Accepted examples	
Trademark		
Reg. No.	IR 776691	IR 760905
Status	approved for protection by the national procedures	approved for protection by the national procedures
Class & Goods	11; flashlight	3; cosmetics

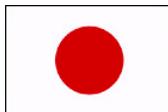
The distinctive word appear on the mark

What is the implication of having the distinctive word appear on the mark?



► In respect of registration

Containing the word being **helpful**



▷ Under the examination practice

Colour-shape combination **without the word** would **not** be possible to register

The distinctive word appear on the mark

What is the implication of having the distinctive word appear on the mark?



► In respect of enforcement

Less protectable to colour-shape combination
when registered **with the word**

The distinctive word appear on the mark

What is the implication of having the distinctive word appear on the mark?

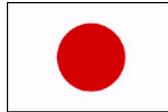


► Advice

Filing and registering the **both versions** with and without the distinctive word

Formal requirements for registration

What are the formal requirements for registration of the mark associates with consumer electronics



▷ When filing the mark

Claim each element of colour, 3D-shapes

▷ Necessary material

 One or more drawings · photographs
in one sheet

 One or more drawings · photographs
in one or more sheets

Formal requirements for registration

What are the formal requirements for registration of the mark associates with consumer electronics



▷ **Not mandatory but submittable**

Pantone color code, video tapes, CD-ROM, etc.



Formal requirements for registration

What are the prospects of stopping the use of a similar coloured shape by companies in the same line of business once patent or design protection expires



▶ Trademark registration

Less likely without the distinctive word

▷ Once registered

→ possible to stop the others' use

→ renewable

Formal requirements for registration

What are the prospects of stopping the use of a similar coloured shape by companies in the same line of business once patent or design protection expires



► Obtain a secondary meaning by intensive use

Protected by Trademark Act

Protected by Unfair Competition Prevention Act

Adjustment of protection of trademark and design patent

How does the protection available
“fit” with any available design patent /
Industrial design protection



- ▷ **Double registration:** available by the same owner
- ▷ **Co-existence:** available by different owners
- ▷ **Consent:** from the owner of earlier right required to use

Adjustment of protection of trademark and design patent



► **Protection as a design**

- Shape of goods being traditional subject of design patent or industrial design protection
- Image design, Moving design
- as a whole or partial design

▷ **Requirement:** novelty, creativeness, suitability of the industrial use

▷ **Terms of protection:** 15 years (cannot be extended)

Adjustment of protection of trademark and design patent



► Protection as a Trademark

▷ Requirement:

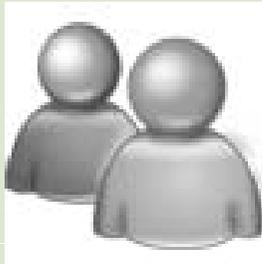
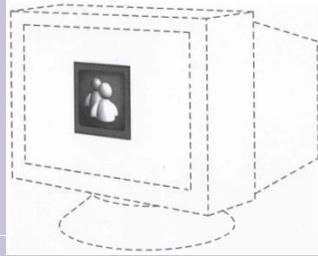
- distinctiveness
- not necessary to secure the function of pertinent products or packages
- general requirements for the normal trademark

▷ Terms of protection: 10 years (renewable)

Adjustment of protection of trademark and design patent



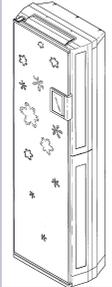
▶ Examples of seeking both trademark and design patents

	Trademark	Design patent
		
Reg. No.	45-23228	30-381531
Reg. Date	May 14, 2008	May 9, 2005
Class & Goods	9: Computer software for connecting users to web messaging services and for voice and video transmissions over the Internet and wireless networks	Computer monitor having an Icon →partial design registration

Adjustment of protection of trademark and design patent



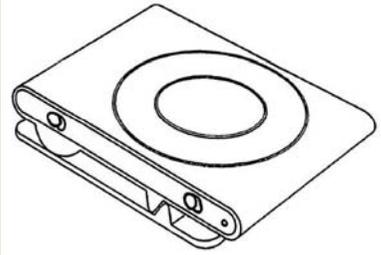
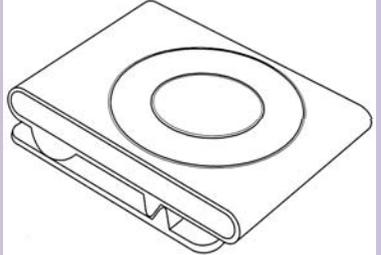
► Examples of seeking both trademark and design patents

	Trademark	Design patent
		
Reg. No. (App. No.)	Rejected (40-2007-7721)	Registered 30-463371
Reg. Date (App. Date)	(February 9, 2007)	September 17, 2007
Class & Goods	9: Air conditioners	Air conditioners

Adjustment of protection of trademark and design patent



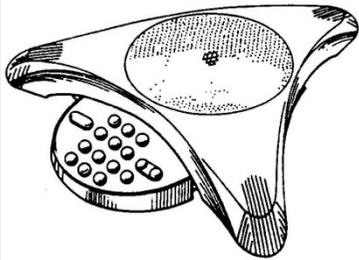
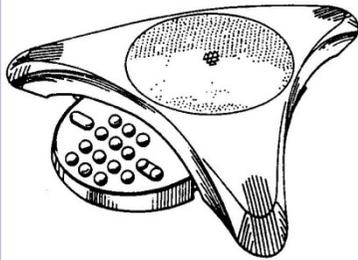
► Examples of seeking both trademark and design patents

	Trademark	Design patent
		
Reg. No. (App. No.)	Rejected (Intl' 982659) (Appeal against the refusal decision is in process)	Registered 30-457456
Reg. Date (App. Date)	(August 5, 2008)	July 23, 2007
Class & Goods	9: Portable and handheld digital electronic devices for playing, ...	Portable media players

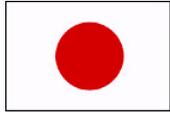
Adjustment of protection of trademark and design patent



► Examples of seeking both trademark and design patents

	Trademark	Design patent
		
Reg. No. (App. No.)	Rejected (40-2001-51655)	Registered 30-145682
Reg. Date (App. Date)	(November 22, 2001)	December 22, 1992
Class & Goods	9: Speakerphone	Speakerphone

Adjustment of protection of trademark and design patent



▷ Protection of industrial design

The colour-shape combination
may not be protected as an industrial design

∴ lack of novelty & creativity

Protection for the motion mark

Is the motion mark protectable?



- ▷ **Moving trademark:** protectable
- ▷ **Copyright:** protectable as a program copyright
- ▷ **Moving Design:** protectable

Protection for the motion mark



▶ Requirement of Moving Trademark

- ▶ **Claim** for motion of the mark when filing the mark
- ▶ **Submit** the drawings or photographs
 - 5 drawings or photographs at the maximum
- ▶ **Not mandatory but submittable**
video tapes, CD-ROM, etc.



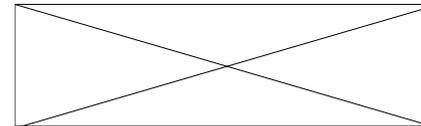
Protection for the motion mark



► Accepted examples – Moving mark

	Accepted examples
Trademark	1)  2)  3)  4)  5) 
Reg. No.	41-186674
Reg. Date	June 17, 2009
Class & Goods	42; developing game software, etc.

Protection for the motion mark



► Accepted examples

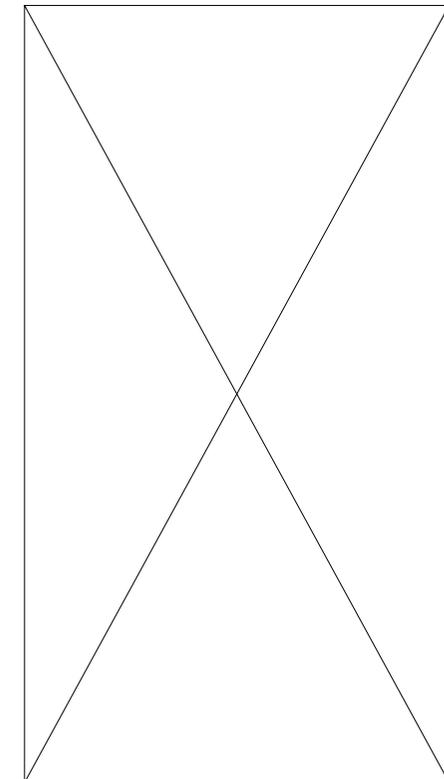
	Accepted examples
Trademark	1)  2)  3)  4)  5) 
Reg. No.	40-779284
Reg. Date	February 12, 2009
Class & Goods	5; pharmaceutical products

Protection for the motion mark



► Accepted examples - Moving design (cellphone)

	Accepted examples
Design	<p>1)  2)  3) </p> <p>4)  5) </p>
Reg. No.	30-515935
Reg. Date	December 23, 2008



Protection for the motion mark

Is the moving shape protectable?



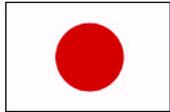
▷ **Moving trademark:** not acceptable



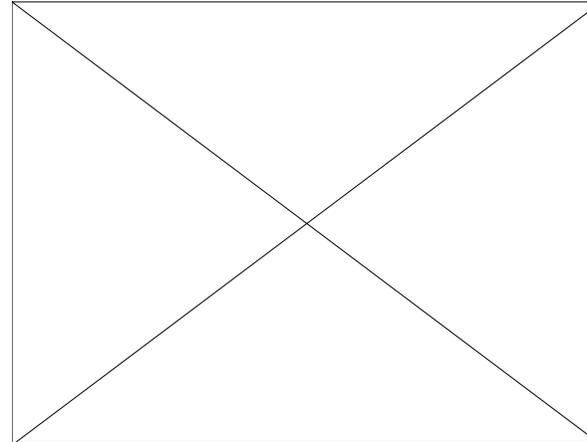
▷ **Well-known moving mark:**

protected by Unfair Competition Prevention Act

Protection for the motion mark



Signboard of moving crab (Kani Doraku Case)



- May 27, 1987
- Osaka District Court 1981wa9093
- Accepted as an indication protectable under the **Unfair Competition Prevention Act**



Thank you very much!

*Presented by **Ho-Hyun Nahm**
Barun IP & Law*

Website <http://www.barunip.com>

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