The Need to Protect Well-known Trademarks in the Digital Era

Purpose: Information
Submitted by: Korean Patent Attorney Association
The need to protect well-known trademarks in the digital era

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Digital Era
Transition from analogue to digital

What is different?
- More contents
- Easier to access
- Faster to spread
- Unlimited audiences
We are all connected in digital era
Problem – Trademark Brokers

International trademark takeover

ANNUAL

CLASSIFICATION

FRANCHISE  792
FOOD  657
MAKEUP  419
CLOTHES  581
ELECTRONICS  263
MEDICINE  166
ARCHITECTURE  104
Well known names
Famous Korean YouTubers name taken by brokers
<table>
<thead>
<tr>
<th>Law</th>
<th>Protection</th>
<th>Note</th>
</tr>
</thead>
<tbody>
<tr>
<td>34.1.6</td>
<td>Well known name of another person</td>
<td>Item 2 is protecting well known name of the deceased</td>
</tr>
<tr>
<td>34.1.9</td>
<td>Well known trademark (Korea)</td>
<td>Requires similarity between Items of the known trademark and designated items of the filed trademark</td>
</tr>
<tr>
<td>34.1.11</td>
<td>Well recognized trademark (Korea)</td>
<td>Similar to item 9</td>
</tr>
<tr>
<td>34.1.13</td>
<td>Recognized trademark (Korea or overseas)</td>
<td>Requires the applicant to have unlawful purpose</td>
</tr>
</tbody>
</table>
BTS is used world widely without right licensing.
Korea - Unfair competition prevention act

• Article 2 paragraph 1
  (a) An act of causing confusion with another person's goods by using marks identical or similar to, another person's name, trademark, etc
  (b) An act of causing confusion with another person's commercial facilities or activities by using marks identical or similar to, another person's name, trade name, etc
  (c) An act of doing damage to distinctiveness or reputation attached to another person's mark by using the mark identical or similar to, another person's name, trade name, trademark, etc

* Even if BTS or the enterprise own the trademark designating sandwiches, cell phone, butter they still can be subject to legal sanctions
Well known Trademarks
## Takeover cases

<table>
<thead>
<tr>
<th>Takeovers</th>
<th>Original</th>
<th>Country</th>
</tr>
</thead>
<tbody>
<tr>
<td>WALL- MART</td>
<td>Walmart</td>
<td>KR</td>
</tr>
<tr>
<td>Von Dutch</td>
<td>Von Dutch</td>
<td>KR</td>
</tr>
<tr>
<td>BARIS BAGUETTE</td>
<td>PARIS BAGUETTE</td>
<td>CN</td>
</tr>
<tr>
<td>NATURE REPUBLIC</td>
<td>NATURE REPUBLIC</td>
<td>CN</td>
</tr>
<tr>
<td>Pulmuone</td>
<td>Pulmuone</td>
<td>CN</td>
</tr>
</tbody>
</table>
Article 34 Paragraph 1 Item 13

Any trademark identical or similar to a trademark recognized as indicating the goods of a specific person by consumers in the Republic of Korea or overseas, which is used for unlawful purposes, such as unjust enrichment or inflicting loss on the specific person;

* This article has been added in 1998 amendment
Article 4

Any natural person, legal entity or other organization intending to acquire the exclusive right to use a trademark for the goods produced, manufactured, processed, selected or marketed by it or him, shall file an application for the registration of the trademark with the Trademark Office.

* CNIPA will reject any applications for trademarks that are not intended to be used
Why do we have to protect

- Rise of the electronic medium disregards geographical boundaries
- Creation of a new phenomenon needs to be the subject of legal rules
- The digital age brings both promise and peril to the creators and consumers
- Infringement takeovers now can take place all over the world
- It is getting more difficult for IP right holders to protect it
- They need to be protected inside the law and rules
Thank You
Korea Patent Attorneys Association (KPAA)

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