

26.01

Regarding the Examination of an Application for the Registration of a Defensive Mark and the Renewal of the Duration of a Right Based on a Registered Defensive Mark

1. The examination of an application for the registration of a defensive mark will be conducted as follows:

(1) When examining an application for the registration of a defensive mark, emphasis should be placed on the prevention of unfair competition. Particularly when a trademark is widely known, the scope of the goods or services for which the registration of a defensive mark registration is being sought should be granted broadly.

(2) As a legal interpretation, the scope of confusion between Article 64 and Article 4(1)(xv) of the Trademark Act is considered identical, and thus, the scope of the goods or services for which a registration of a defensive mark will be accepted must not exceed the scope of the registered trademark in question, which is protected by Article 4(1)(xv) of the Trademark Act.

(3) The concept or procedures based on Article 4(1)(xv) of the Trademark Act must be implemented flexibly in accordance with the actual economic conditions. The same concept applies to the registration of defensive marks.

For famous trademarks that are adequately qualified for application, the scope of confusion should be interpreted as broadly as possible (with respect to the probability of confusion, the perspective of the user should be fully considered or introduced).

(4) Based on the perspective described above, the examination policy will be set as follows:

1) When examining an application for registration of a defensive mark, the degree to which the registered trademark which is the basis of the examination (hereinafter referred to as the "original registered trademark") is known and its relationship with the pertinent industrial sector must be fully considered. As for the method of examination, the current 45 classes must be reorganized and integrated into several industrial sectors (for example chemicals, machinery, general merchandise and textiles, industrial services and general services), after which the designated goods or designated services of the application must be compared with the designated goods or designated services of the original registered trademark to determine whether or not they belong to identical industrial sectors. In addition, the degree to which the trademark is known must be taken into consideration to arrive at a decision regarding the probability of confusion.

(a) When the original registered trademark is not yet widely known among the citizens of the country but is widely acknowledged among the users of the pertinent industrial sector, the goods or services which do not exceed the scope of the industrial sector to which the designated goods or designated services of the registered trademark belong may be granted the registration of a defensive mark.

(b) If the original trademark is widely known among the citizens of a country, the goods or services which exceed the scope of the industrial sector to which the designated goods or designated services of the registered trademark belong may be granted the registration of a defensive mark.

2) When goods or services that exist are mutually and closely related in a special manner, those goods and services will be deemed to belong to the same industrial sector irrespective of the provisions of the preceding paragraph.

(5) A defensive mark is registered for a trademark that is identical to the original registered trademark, with the necessary premise that the original registered trademark is widely known. In this case, there may be cases where the defensive mark, the original registered trademark and the well-known trademark are identical. However, especially with respect to the latter two, due to changing trends and other reasons, the trademark currently in use, and, as a result, widely recognized in terms of appearance by the general public, is in many cases not identical to the original registered trademark. Taking this situation into consideration, the concept regarding the relationship between these three is given below.

1) The defensive mark for which a person is seeking registration must be identical to the original registered trademark (a defensive mark which is not identical to the original registered trademark cannot be registered).

2) The determination as to whether the original registered trademark is the well-known trademark which is actually recognized by the general public shall be made as described in Part II, Article 3(2) (Discrimination by Use), Chapter 1, Item (1) of the Examination Guidelines for Trademarks as applied *mutatis mutandis* pursuant to Part XIV, Article 64 (Requirements for defensive mark registration), Chapter 3 of the Examination Guidelines for Trademarks.

2. In order to register a renewal of the duration of the right based on the defensive mark registration, as in the case of the original registered trademark related to the defensive mark registration, the registered defensive mark related to the defensive mark renewal registration application must meet the requirements of Article 64 of the Trademark Act. Thus, when examining the degree of public knowledge about a

defensive mark that is the subject of the defensive mark registration renewal application, the examination must be handled in a manner that is identical to the handling of the defensive mark registration application as mentioned above. In such case, the circumstances of use of the original registered trademark will be fully considered.

(Note) Click below to see the Examination Guidelines for Trademarks

Examination Guidelines for Trademarks:

Article 4(1)(xv) (Confusion over the source of goods and services)

Article 64 (Requirements for defensive mark registration)

Article 65-2, 3, and 4 (Duration of right based on defensive mark registration)

Article 68-9, 68-10, 68-11, 68-12, 68-13, 68-15, 68-16, 68-17, 68-18, 68-20 and 68-28 (Special provisions relating to international applications for trademark registration)