

Session I.

韓国の商標共存同意制度

Letter of Consent System in Korea for Trademark Co-Existence

2024.11.07.

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I . 商標共存同意制度とは？

What is Letter of Consent System for Trademark Co-existence?

定義

商標共存同意制度

先登録/先出願権利者から商標登録に対する同意書を得て提出すればそれと同一・類似の後出願の商標登録を認める制度

◆ 韓国は **[完全型]共存同意制度** 導入

- ▶ 同意書のみ提出すれば出所の誤認混同の可能性に対する審査なしに先願との類似性に関連する拒絶理由は克服されたとみなす

Definition

Letter of Consent System for Trademark Co-existence (“Letter of Consent System”)

System that allows granting of registration of a mark identical or similar to prior marks, when the applicant submits a letter of consent regarding trademark registration from the owner of a previously-registered mark or an earlier-filed mark.

- ◆ In Korea, **[Complete type] of Letter of Consent System** was adopted.
 - ▶ Just by submitting a consent letter, it would be deemed that grounds of rejection relating to similarity with prior rights are overcome without further examining the possibility of misleading/confusing consumers as to the source of goods.

共存同意制度の類型

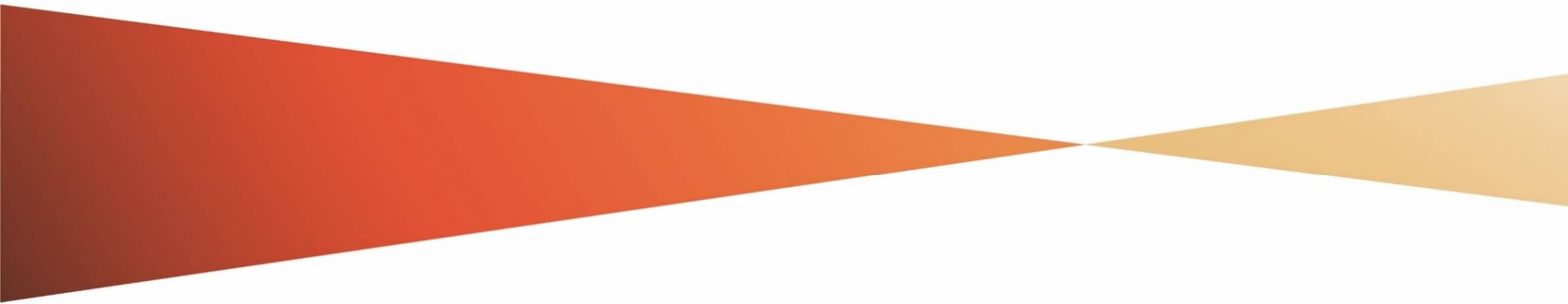
類型	区分	特徴	主要国
完全型	同意書提出時 拒絶不可型	審査官が先行商標との類似性により拒絶した場合、先行商標権者の同意書が提出されればその先行商標を根拠としては拒絶不可	韓国、ニュージーランド
	同意書提出が 不要な拒絶不可型	審査官が先行商標権者に異議申立機会を付与し、異議申立がなければ同意書提出も必要なく拒絶不可	EU、ドイツ、 フランス、デンマークなど
留保型	拒絶可能型	先行商標に基づいた拒絶通知後、同意書が提出されれば参考にして審査するが審査官の裁量により拒絶可能	日本、アメリカ、 台湾、シンガポール

Type of Letter of Consent System

Type	Classification	Key Features	Major Jurisdictions
Complete-type	Non-rejection-type upon submitting a consent letter	Even if the Examiner rejects a trademark application based on similarity to a prior registered or earlier-filed mark, the later-filed application cannot be rejected based solely on the similarity to such prior marks if a consent letter signed by the prior owner is submitted .	<u>Korea</u> , New Zealand
	Non-rejection-type even without a consent letter	The Examiner grants the owner of the prior mark an opportunity to file an opposition; if no opposition is filed, the trademark application cannot be rejected (and the consent letter does not need to be submitted).	EU, Germany, France, Denmark, etc.
Reserved-type	Rejection possible type	After issuing a rejection based on similarity to a prior mark, the Examiner may take letters of consent into consideration during examination, but may still reject the application at discretion.	<u>Japan, U.S.</u> , Taiwan, Singapore

II. 導入背景

Background to Implementation



導入背景

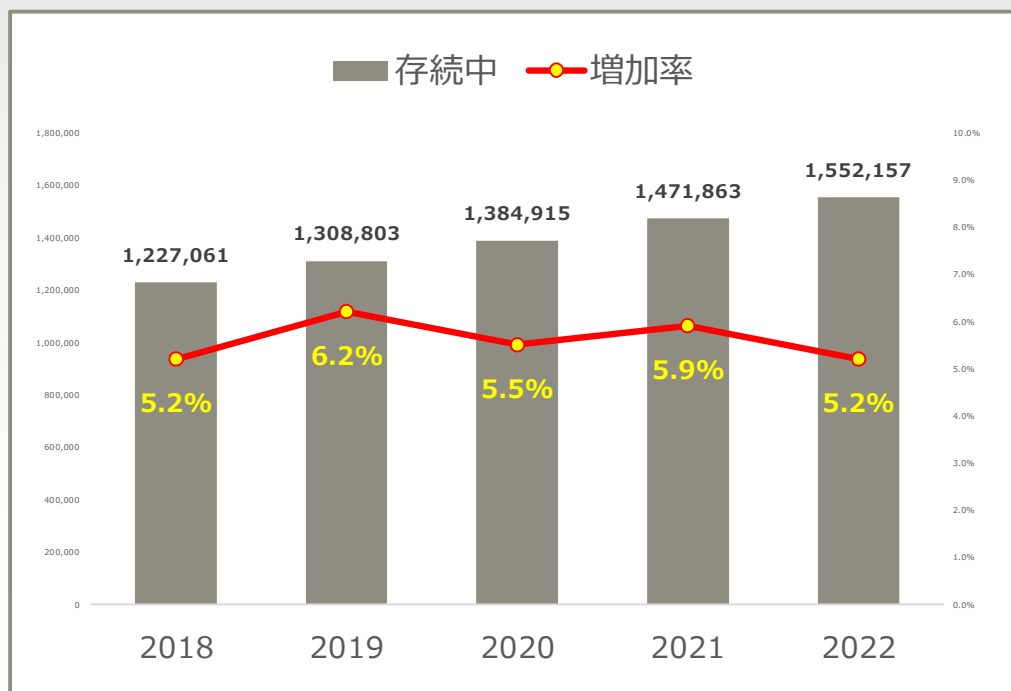
- 登録後再譲渡(Assign Back)、分割移転など迂迴的方法を使わなければならない不便を解消
- グローバル共存契約にもかかわらず、韓国では別途の手順を踏まなければならない不都合
 - ▶ 国際的傾向との調和
- 存続中の商標権の増加による商標選択権の限界(*)
- 系列社間、中小企業および小商工人などの商標登録の可能性向上

Background to Implementation

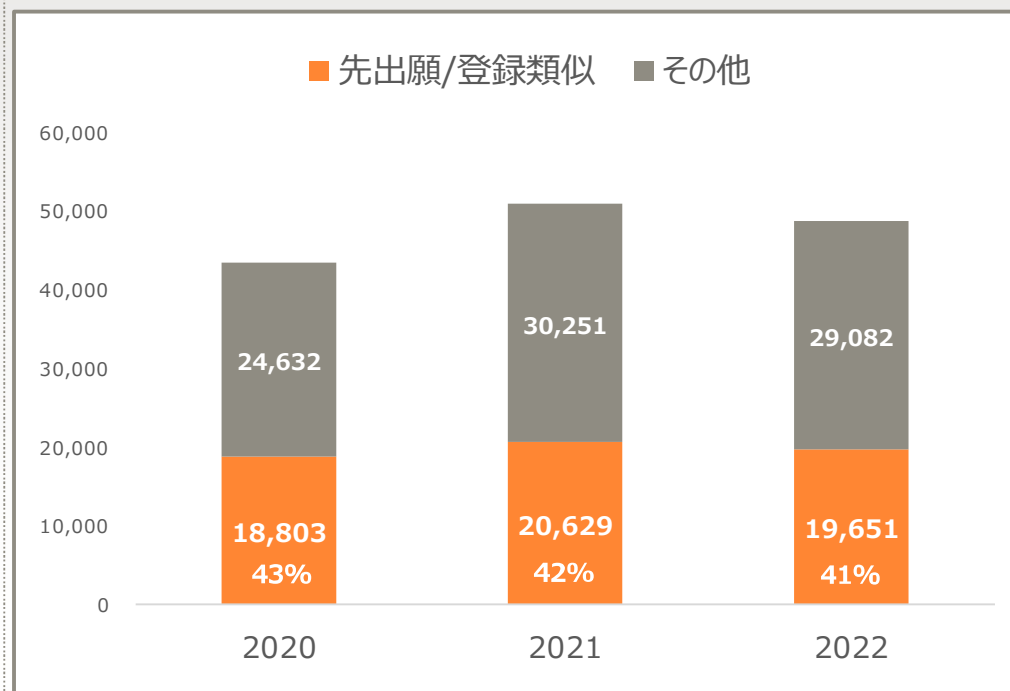
- Resolved the inconvenience of having to undergo circumventive methods (e.g., assignment/re-assignment (“assign-back”) procedure, partial assignment of trademark ownership after grant of registration, etc.)
- Inconvenience of having to pursue a separate process in Korea despite the existence of global co-existence agreement
 - ▶ Enhanced consistency with the globally accepted practices
- Limitation in the scope of selectable trademarks in line with an increase in the number of existing trademarks (*)
- Increase possibility of obtaining trademark registration by the affiliates, small- and medium-sized enterprises (“SME(s)”) and small businesses

■ 存続中の商標権の増加による商標選択範囲の限界(*)

年度別存続中商標



最近3年間の拒絶理由の詳細



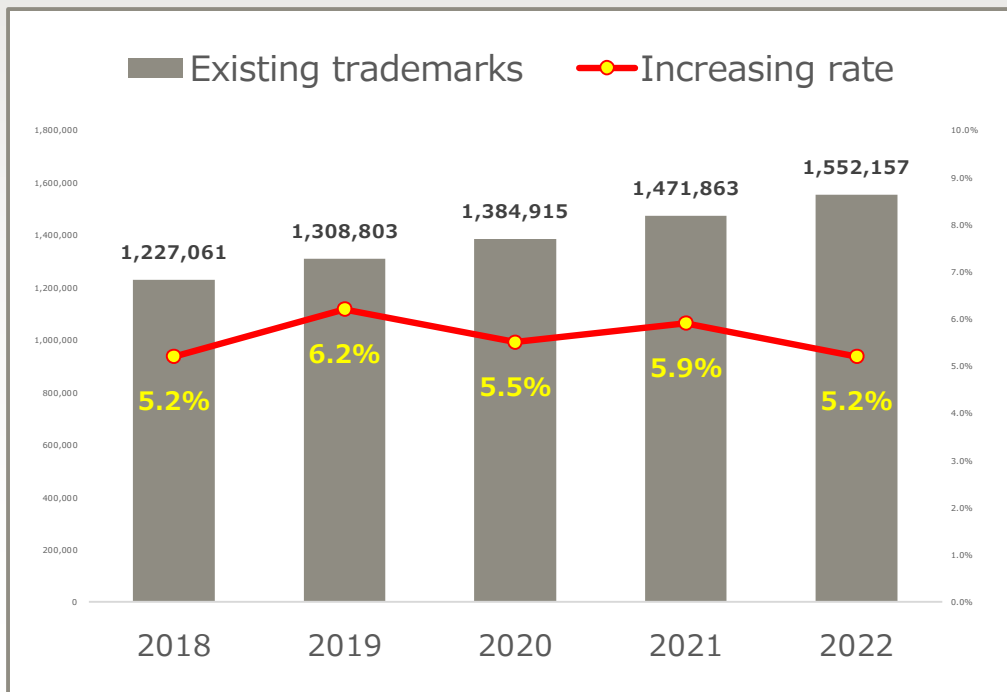
- 商標権は年間7~8万件(5~6%)ずつ増加
- 2017年に比べ5年間で389,126件(25%)増加

- 拒絶理由の40%以上が先願との類似性
- そのうち82%が個人、小商工人、中小企業による出願

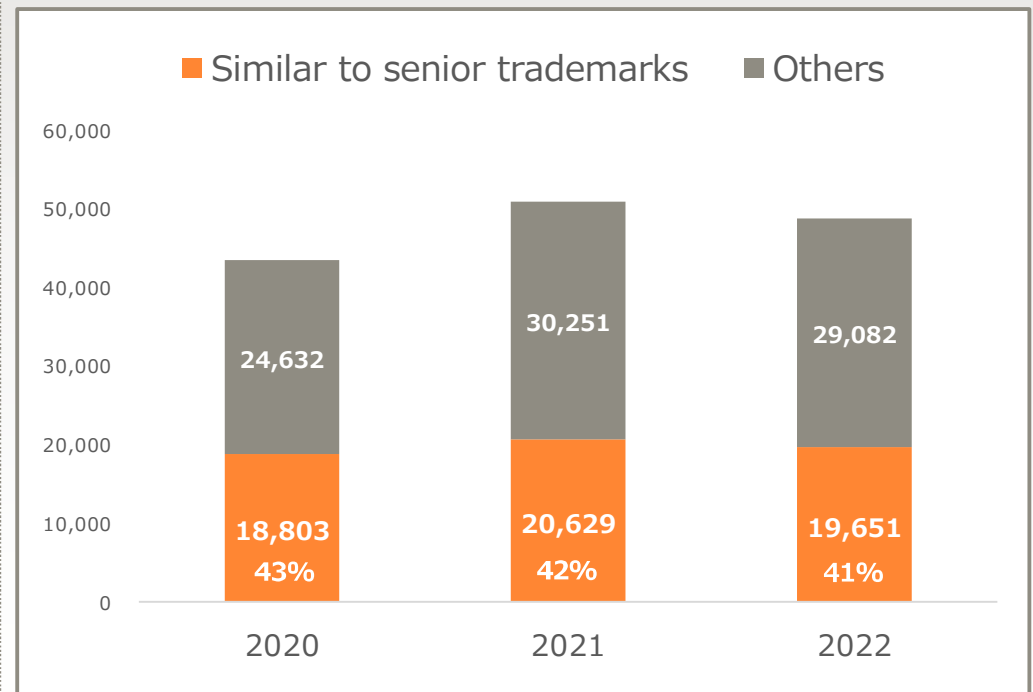
Background to Implementation

- Limitation in the scope of selectable trademarks in line with an increase in the number of existing trademarks (*)

Number of Existing Trademarks by Year



Detailed Grounds for Rejection in the Past 3 Years

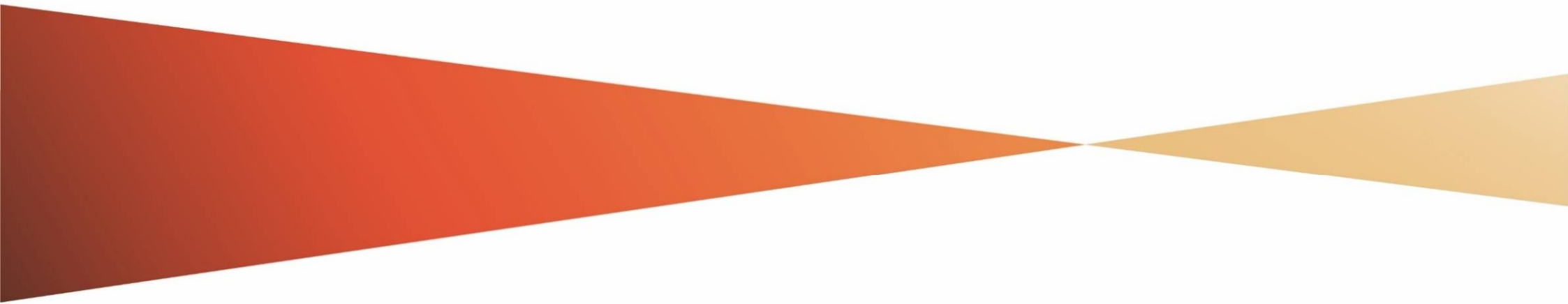


- Trademark rights are increasing by approx. 70,000-80,000 cases (5~6%) per year.
- Compared to 2017, 389,126 cases (25%) increased over 5 years.

- 40% or more of the cases were rejected due to similarity with existing trademarks.
- Among them, 82% of the applications were filed by the individuals, small businesses, or SMEs.

Ⅲ. 導入經過

Progress of Implementation



導入経過



Progress of Implementation

2014

- The bill was included in the total amendment of the Trademark Act, but was excluded during the NA's deliberative process.

2023

- The bill was selected as the major policy objectives of Korean Intellectual Property Office ("KIPO").

March 20, 2023

- Partial amendments to the Trademark Act were proposed to adopt the Letter of Consent System.

October 6, 2023

- The amendments passed the NA.

October 31, 2023

- The amendments were promulgated.

May 1, 2024

- The amendments entered into force.

IV. 関連法令

Relevant Laws



関連法令

先登録権者/先出願人の同意による商標登録許容

商標法34条1項7号ただし書

先の出願による他人の登録商標と同一・類似の商標であってその指定商品と同一・類似の商品に使用する商標。ただし、その他人から商標登録に対する同意を得た場合(同一の商標であってその指定商品と同一の商品に使用する商標に対し同意を得た場合は除く)には商標登録を受けることができる。

同法35条6項

先に出願した者又は協議・抽選により定められ若しくは決定された出願人から商標登録に対する同意を得た場合(同一の商標であってその指定商品と同一の商品に使用する商標に対し同意を得た場合は除く)には、後に出願した者又は協議・抽選により定められ若しくは決定された出願人でない出願人も、商標登録を受けることができる。

Relevant Laws

Granting of trademark registration based on consent by the owner of prior-registered/filed trademarks

Proviso of Article 34(1)7 of the Trademark Act

Any trademark used on goods identical or similar to the designated goods, which is identical or similar to a registered trademark of another person based on first to file: **Provided, That where the consent of such another person has been obtained for the registration of the trademark (excluding the case where such consent has been obtained for a trademark that is the same trademark and is used on goods identical to the designated goods), trademark registration may be obtained.**

Article 35(6) of the Trademark Act

Where the consent of the first person filing an application or of an applicant determined by agreement or by a lot drawn has been obtained for the registration of the trademark (excluding the case where such consent has been obtained for a trademark that is the same trademark and is used on goods identical to the designated goods), a person who files an application later or who is not an applicant determined by agreement or by a lot drawn may obtain registration of the trademark.

関連法令

登録後の需要者保護規定

119条1項5の2号(不正使用取消審判新設)

第34条第1項第7号ただし書又は第35条第6項により登録された商標の権利者又はその商標登録に対する同意をした者のうち1人が自己の登録商標の指定商品と同一・類似の商品に不正競争を目的として自己の登録商標を使用することにより需要者に商品の品質を誤認させ又は他人の業務に関連する商品と混同を生じさせた場合

(*不正競争目的の例示:どちらか一方の商標が著名になった場合で、他方の商標がこれにフリーライドしたとき)

122条2項(除斥期間)

第119条第1項第1号・第2号・第5号・第5号の2、第7号から第9号まで及び第120条第1項に該当することを事由とする商標登録の取消審判及び専用使用权又は通常使用权登録の取消審判は、取消事由に該当する事実がなくなった日から3年を過ぎた後は、請求することができない。

34条3項(3年間再出願制限のペナルティ)

商標権者又はその商標権者の商標を使用する者は、第119条第1項第1号から第3号まで、第5号、第5号の2及び第6号から第9号までの規定に該当するという理由で商標登録の取消審判が請求され、その請求日以後に次の各号のいずれか(商標登録取消審決が確定した場合など)に該当するに至った場合、その商標と同一・類似の商標(同一・類似の商品を指定商品として再び登録を受けようとする場合に限る)については、その請求日から次の各号のいずれかに該当するに至った日から3年が過ぎる前に出願すれば商標登録を受けることができない。

Relevant Laws

Provisions relating to the protection of consumers post-registration

Article 119(1)5-2 (Newly Inserted Provision re Cancellation Action on the Grounds of Using the Trademark for Unlawful Purposes)

Where one person among the right holder of a trademark that is registered under the proviso of Article 34(1)7 or Article 35(6) and the persons who have consented to the registration of the trademark causes the misunderstanding of the quality of goods or confusion with goods related to another person's business among consumers by using his or her registered trademark for the purpose of unfair competition on goods identical or similar to the designated goods of his or her registered trademark.

*(*example of the "purpose of unfair competition": where certain trademark becomes well-known and the other trademark free-rides on the reputation of such trademark)*

Article 122(2) (Statute of Limitations)

No trial to revoke trademark registration or registration of an exclusive license or non-exclusive license on the grounds that the trademark falls under Articles 119(1) 1, 2, 5, 5-2, 7 through 9 and 120(1) shall be requested after three (3) years elapse from the date the fact that constitutes grounds for revocation ceases to exist.

Article 34(3) (Penalty for Restriction on Refiling for 3 Years)

Where a trial to revoke trademark registration is requested because a trademark right holder or a person who uses a trademark of such trademark right holder falls under Article 119(1)1 through 3, 5, 5-2, 6 through 9, and he or she falls under any of the following on or after the date the revocation is requested, he or she may obtain trademark registration if he or she applies for registration of a trademark identical or similar to such trademark [limited to where he or she intends to obtain trademark registration again by designating identical or similar goods as the designated goods] before three (3) years elapse from the date he or she falls under any of the following on or after the date the revocation is requested.

関連法令

施行日関連経過規定

附則第2条

第34条1項7号ただし書および第35条6項の改正規定は、**本法施行前に出願された商標登録出願、変更出願、分割出願および指定商品追加登録出願であって本法施行以後に商標登録の可否が決定される場合にも適用される。**

Relevant Laws

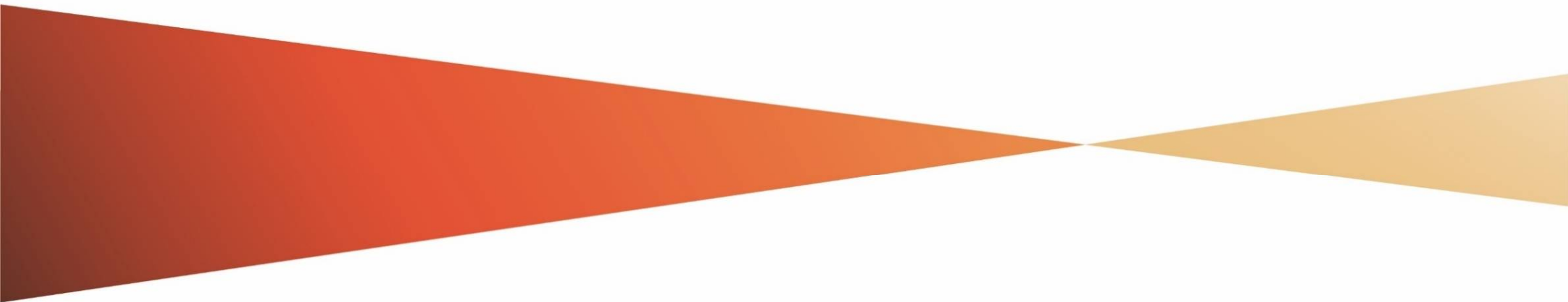
Transitional provision relating to the effective date

Article 2 of Addenda

The amended provisions of the proviso of Article 34(1)7 and of Article 35(6) shall **also apply where a decision on whether to grant trademark registration is made after this Act enters into force for an application for trademark registration, a modified application, a divisional application, or an application for registration of additional designated goods filed before this Act enters into force.**

V. 共存同意制実務ガイドライン

Working Guidelines on Letter of Consent System



1. 同意書提出要件

イ. 時期的要件

- 出願書とともに提出しOAを未然に防止可能
- 拒絶時、意見書、補正書に添付して提出可能
- (異議申立がある場合)異議答弁書に添付して提出可能
- 拒絶決定不服審判段階でも提出可能(審決後2審—特許法院—では提出しても克服不可)

1. Requirements for Submitting Consent Letter

(a) Temporal requirement

- Office Actions (“OA”) may be prevented in advance by submitting a consent letter along with the application.
- If refused, the consent letter may be submitted by attaching it to the response or amendment.
- (Where there is an opposition) The consent letter may be submitted by attaching it to the opposition response.
- Consent letter can also be submitted at the stage of appealing against a rejection decision (rejection cannot be overcome even if a consent letter is submitted at 2nd instance (i.e., Patent Court) after the IPTAB decision is rendered).

1. 同意書提出要件

□. 実体的要件

- [同意書必須記載事項]

- 1) 氏名(法人名)
- 2) 先登録(出願)権利者および出願人の署名または捺印
- 3) 特許顧客番号(ない場合は理由を記載)
Ex) 国際登録のため特許顧客番号がない等
- 4) 登録(出願)番号
- 5) 登録に同意する指定商品の範囲
- 6) 登録原簿反映事項確認
- 7) 同意日など

1. Requirements for Submitting Consent Letter

(b) Substantive requirement

- **[Mandatory items to be included in the consent letter]**
 - 1) Name (corporate name)
 - 2) Signature or seal of the owner of the earlier-registered (filed) trademark & applicant
 - 3) Applicant Identification Code (if there is no applicant identification code, the reason should be specified.) (e.g., there is no applicant identification code because it is an internationally registered patent right)
 - 4) Registration (Application) No.
 - 5) Scope of designated goods for which registration is being consented
 - 6) Confirmation of matters reflected in the respective trademark registers
 - 7) Date of consent, etc.

共存同意書様式

- 共存契約書自体ではない簡略な同意書様式で提出可能
- 多数の登録/出願番号を記載することができ、各件別に指定商品の範囲を異にして記載可能
- 原本ではなくカラースキャン本でも提出可能
- 公証または大使館認証は不要

Form of Letter of Consent to Co-existence of Trademarks

- **A brief consent form in lieu of the actual co-existence agreement can be submitted.**
- **Multiple registration/application numbers may be indicated and different scope of designated goods may be stated for each case.**
- **A color scanned copy instead of the original copy may be submitted**
- **Notarization or legalization is not required.**

特許庁の共存同意書様式

Form of Letter of Consent Provided by KIPO

日本語 Japanese

商標共存同意書		
出願人	氏名(法人名)	(署名または印)
	特許顧客番号	(特許顧客番号がないときは理由記載)
	出願番号 (国際登録番号)	(出願番号がないときは商標見本および商品区分記載)
以下の先登録商標権者は上記出願人の商標出願・登録・使用に同意します。		
○ 共存同意を受ける出願商標の指定商品		
-		
(例：該当商品区分の指定商品全部に対し共存同意する場合)		
- 25 類、35 類：全部		
(例：該当商品区分の指定商品一部に対し共存同意する場合)		
- 25 類：帽子、履物		
- 35 類：帽子小売業、履物卸売業		
<div style="border: 1px solid black; padding: 5px;"> 「先登録(出願)商標」および「先登録(出願)商標権者の同意によって登録される出願商標」は、いずれも登録原簿に共存同意と関連した登録商標であることが表記され、当事者はこれを確認する。 </div>		
年 月 日		
先登録(出願)商標権者	氏名(法人名)	(署名または印)
	特許顧客番号	
	登録(出願)番号	

英語 English

Consent to Coexistence of Trademarks		
Applicant	Name	_____ [Signature: _____] [Typed Name: _____]
	Applicant Identification Code	
	Application No.	
The owner of the below indicated prior-filed trademark consents to the filing, registration and use of the applicant's above indicated mark.		
* Designated goods of the applicant's trademark for which co-existence consent is obtained. - All designated goods in Class 18		
The parties acknowledge that the respective trademark registers of the prior-filed trademark and the applicant's trademark will reflect that the applicant's trademark was registered with the consent of the owner of the prior-filed trademark.		
Dated this _____ day of _____, 2024		
Senior Applicant	Name	_____ [Signature: _____] [Typed Name: _____]
	Applicant Identification Code	
	Registration No.	

2. 不認定となる共存同意書の類型

イ. 条件付き同意

- 期限、地域制限、法律効果の一部排除などの条件付き同意は不可
- ただし、一部指定商品に対する限定同意は可能
- 特許庁では当事者間の契約内容にまでは関与しないため、別途契約書に条件を記載して制限することは可能

ロ. 包括的同意

- 「今後出願される出願商標一切」 or 「主要部Aを含む出願商標一切」のような包括的同意は認められない

2. Types of Letter of Consent That Cannot Be Accepted

(a) Conditional Consent

- Conditional consent cannot be accepted by limiting parties to use the trademark during certain time or geographic area, or by allowing partial exclusions of legal effect.
- However, a limited consent with respect to certain designated goods will be allowed.
- As KIPO does not intervene in relation to the contractual terms between the parties, it is possible to set certain limitations by specifying conditions in a separate agreement.

(b) Comprehensive Consent

- Comprehensive consent cannot be granted to “any and all trademarks applied for in the future” or “any and all trademarks applied for that include essential part A.”

3. 適用の例外

イ. 標章および指定商品がすべて同じ場合

- 標章および商品が同一か否かは<1商標1出願主義>に違反するかを基準に判断
ex) 商標が同一でも商品が衣類 vs. ジーンズで異なれば同意書で克服可能

ロ. (地理的表示)団体標章、(地理的表示)証明標章、業務標章

- 譲渡および使用権設定などが厳格に制限されている特性を考慮

ハ. 他の拒絶理由が共に出された場合

- 周知著名商標との混同可能性、冒認出願など(34条1項9号、10号、11号、13号など)
他の拒絶理由が共に出された場合、同意書だけでは克服不可

3. Exceptions to Application

(a) Where both the marks and designated goods are identical

- Whether the marks and designated goods are identical should be determined based on whether they are in violation of the <1-mark-1-application principle>.
e.g.) Even if the trademarks are identical, if the goods are different (e.g., apparel vs. jeans), the rejection may be overcome by submitting a letter of consent.

(b) Collective mark (with geographical indication), certification mark (with geographical indication) or business emblem

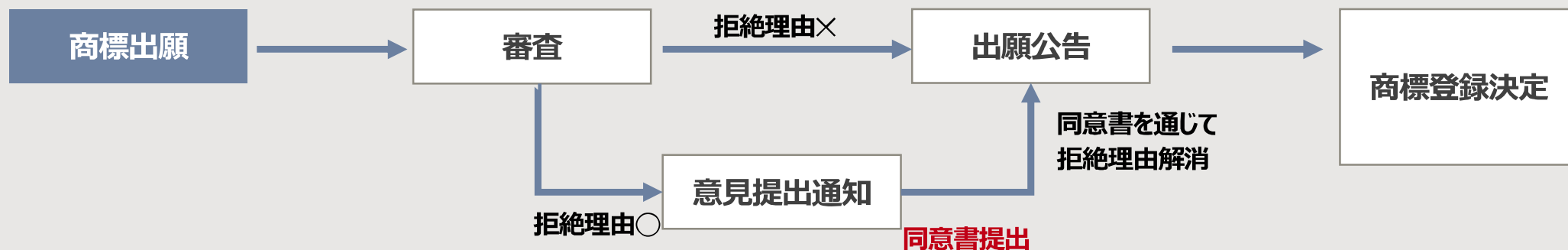
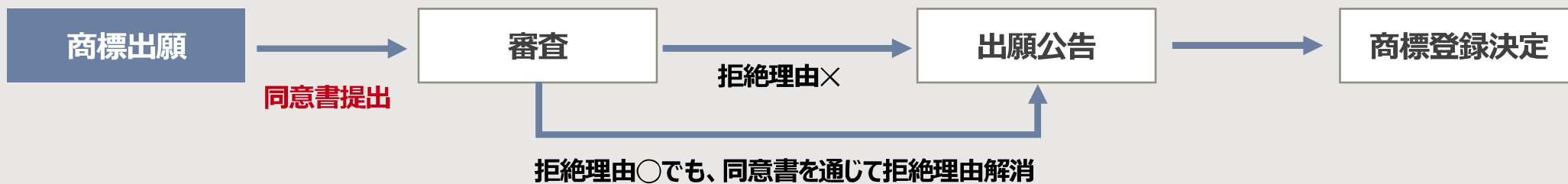
- The nature of trademarks is taken into account, i.e., where transfer or granting license, etc. is strictly restricted

(c) Where other grounds for rejection exist

- Where other grounds for rejection also exist (e.g., possibility of confusion with well-known trademarks, copycat mark with bad faith, etc. (see Article 34(1)9, 10, 11 and 13, etc.), the rejection cannot be overcome solely by submitting a letter of consent.

4. 共存同意書の審査

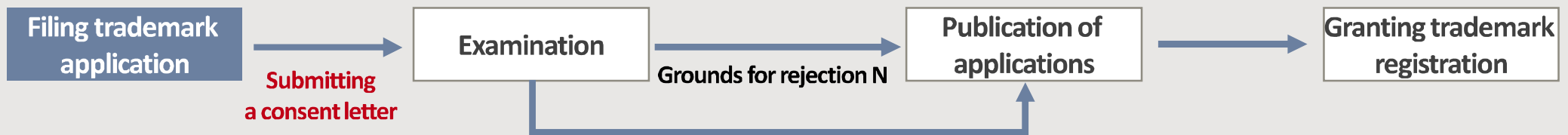
商標共存同意制施行後の審査手続きフロー



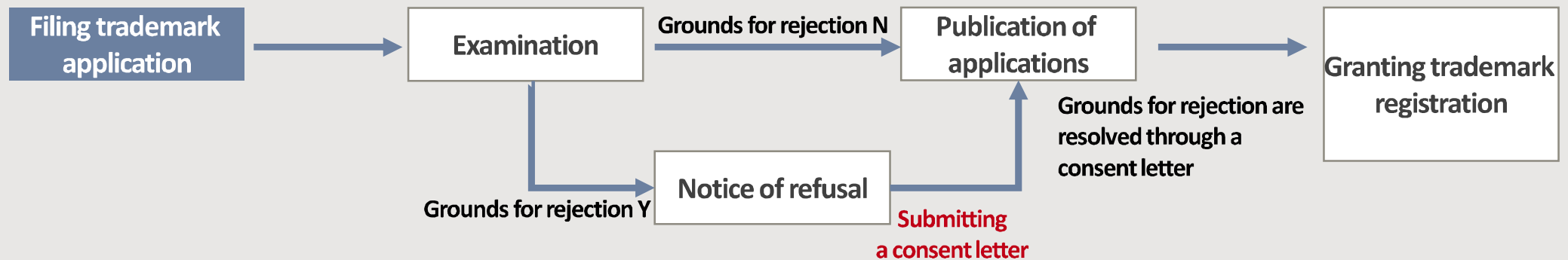
ただし、§ 34①7, §35①以外の拒絶理由がない場合に限る

4. Examination of Letter of Consent

Examination process after the implementation of the Letter of Consent System



Even if there are grounds for rejection, the grounds are resolved through a consent letter



However, this applies only when there are no grounds for rejection other than those specified in Articles 34(1)7 and 35(1).

5. 共存同意書の効力

イ. 同意により登録された商標権

：一般的な登録商標と同じ効力を有する

ロ. 同意により登録された商標権の更新

：更新時に共存同意書を再提出する必要なし

八. 共存同意事実の公示

1) 商標登録原簿への公示

- ▶ 後出願商標と先登録商標の登録原簿のどちらにも共存同意事実および関連商標登録番号が記載される。
- ▶ 一部商品に対する共存同意の場合、具体的な指定商品範囲までは表示されない

2) 登録後KIPRIS商標詳細画面上への公示

5. Effect of Letter of Consent

(a) Trademark registered through consent

: The trademark has the same effect as other registered trademarks.

(b) Renewal of trademarks registered through consent

: In case of renewal, the letter of consent does not need to be submitted again.

(c) Disclosure of the relevant facts (i.e., consent to co-existence)

1) Disclosure in the trademark registers

- ▶ The fact that the consent was obtained is specified along with the relevant trademark registration numbers, in both the registers of the later-filed mark and prior-registered mark.
- ▶ In case of consent to co-existence in relation to certain goods only, the specific scope of designated goods is not specified.

2) Upon registration of the trademark, the relevant facts are publicly disclosed in the detail screen of trademarks on KIPRIS

商標登録原簿への公示

◆ 後出願登録商標の登録原簿

設定登録又は変動登録当時の共存商標権登録番号	41-016	-00-00.	40-09	-00-00.
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◆ 先登録商標の登録原簿

	設定登録又は変動登録当時の共存商標権登録番号	165
1番 付記1	(商標権の共存同意登録) 受付年月日：2024年07月17日 登録原因：商標権共存同意 登録内容：商標権共存同意により共存商標権 [
] を登録事項に登録する 2024年07月17日 登録	
	접수번호 : 2024-00187	

Disclosure in the Trademark Registry

Registry of later-filed trademarks

Reg. No. of co-existing trademark as of the date of registration of establishment or change	41-016 -00-00. 40-09 -00-00.
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Registry of the prior-registered trademarks

	Reg. No. of co-existing trademark as of the date of registration of establishment or change	16 [redacted]
Addendum No. 1	<p>(Registration of consent to co-existence of trademark rights)</p> <p>Date of Receipt: July 17, 2024 Receipt No.: 2024-0018 [redacted]</p> <p>Grounds for Registration: Consent to co-existence of trademark rights</p> <p>Details of Registration: By consent to the co-existence of trademark rights, the registration of pending trademark shall be granted under International Registration No. 16 [redacted].</p>	

KIPRIS商標詳細画面上への公示

◆ 後出願詳細

商品分類 : 35
 出願(国際登録)番号 : 165
 登録番号 :
 出願公告番号 : 4020
 図形コード :
 最終権利者 : KABUSHIKI KAISHA

出願人 : 가부시카가이샤 KABUSHIKI KAISHA
 出願(国際登録)日 : 2022.01.
 登録日 : 2024.
 出願公告日 : 2024.05.10
 代理人 : 양영준 고이화

共存商標 公報

◆ 先登録詳細

商品分類 : 35
 出願(国際登録)番号 : 41200
 登録番号 : 41016
 出願公告番号 : 41200
 図形コード :
 最終権利者 : 가부시카가이샤

出願人 : 가부시카가이샤
 出願(国際登録)日 : 2007.
 登録日 : 2008.
 出願公告日 :
 代理人 : 양영준 고이화

共存商標 公報

共存商標クリック時

상세정보 | 출원공고 | 등록사항 | 통합행정정보

서지정보 | 인영정보 | 도형분류(비엔나)코드 | 행정처리 | 상표설명/지정상품 | 마드리드 출원정보 | **共存同意商標**

▶ 共存同意商標

番号	共存同意登録番号	入力日
1	165	20240718
2	165	20240805

Disclosure on Detail Page of Trademarks on KIPRIS

◆ Details of later-filed trademarks

Class: 35
 Appln. (International Reg. No.): 165 [redacted]
 Reg. No.: 41016
 Appln. Publication No.: 4020 [redacted]
 Device Code:
 Ultimate Right Holder: Kabushiki kaisha [redacted]

Applicant: Kabushiki kaisha [redacted]
 Date of Appln. (International Reg.): Jan. [redacted], 2022
 Date of Reg.: [redacted], 2024
 Date of Publication: May 10, 2024
 Representative: Yeong-Jun Yang, I-Hwa Go

◆ Details of prior-registered trademarks

Class: 35
 Appln. (International Reg. No.): 41200 [redacted]
 Reg. No.: 41016 [redacted]
 Appln. Publication No.: 41200 [redacted]
 Device Code:
 Ultimate Right Holder: Kabushiki kaisha [redacted]

Applicant: Kabushiki kaisha [redacted]
 Date of Appln. (International Reg.): [redacted], 2007
 Date of Reg.: [redacted], 2008
 Date of Publication: [redacted]
 Representative: Yeong-Jun Yang, I-Hwa Go

Click on the marks that are allowed to co-exist

상세정보 | 출원공고 | 등록사항 | 통합행정정보

서지정보 | 인영정보 | 도형분류(비엔나)코드 | 행정처리 | 상표설명/지정상품 | 마드리드 출원정보 | **Marks that are allowed to co-exist**

Marks that are allowed to co-exist

No.	Reg. No. of the marks allowed to co-exist	Entry Date
1	1[redacted]	20240718
2	1[redacted]	20240805

6. 共存同意の撤回、契約無効(取消し)等

—◆ (共存同意は両当事者間の協議による事項であるため)両当事者間の協議による撤回および契約無効(取消し)等は認められるが、一方による撤回および契約無効(取消し)等は認めない

イ. 出願商標の登録可否決定前

: 意見書、補正書、情報提供書等を通して共存同意の撤回、契約無効(取消し)等の資料を提出することができ、審査官はこれを参考にして審査可能

ロ. 出願商標の登録可否決定後

: 審判手続きに従う

6. Withdrawal of Consent to Co-existence, Invalidation (Cancellation) of Agreements, etc.

◆ (Since the consent to co-existence of trademarks is a matter agreed between the parties) Withdrawal or invalidation (cancellation) of an agreement through consultation between the parties is recognized; however, withdrawal or invalidation (cancellation) by either party is not recognized.

(a) Before it is decided whether the applied-for mark is to be registered

: Withdrawal of consent, invalidation of contract (cancellation), etc. may be submitted through a written opinion, amendment, statement of information, etc. The Examiner can proceed with the examination with these materials in consideration

(b) After it is decided whether the applied-for mark is to be registered

: To be proceeded in accordance with the trial procedure

7. 登録後の需要者保護措置

イ. 不正使用取消審判新設

- 1) **要件**：登録後に不正競争の目的で使用し商品の品質を誤認させ、または他人の業務と関連した商品と混同を生じさせた場合
- 2) **取消し対象**：共存同意により登録された後出願商標権だけでなく、共存同意した先登録(出願)商標権にも請求可能
- 3) **除斥期間**：該当理由がなくなった日から3年が経過した場合は取消し請求不可
- 4) **ペナルティ**：取消し確定後3年間は同一・類似商標を同一・類似商品に再出願禁止

ロ. 混同防止表示請求は未導入

7. Consumer Protection Measures Post-Registration

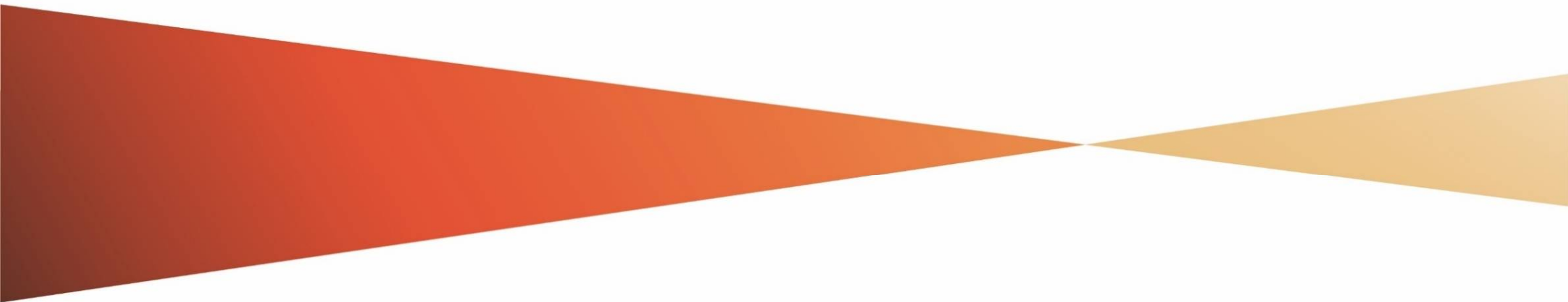
(a) Newly inserted provision re cancellation action based on uses for unlawful purposes

- 1) **Requirement:** Cases where the relevant parties cause misunderstanding of the quality of goods or confusion with goods related to another person's business, by using the registered trademark for the purpose of unfair competition
- 2) **Subject to revocation:** Trial may be requested not only with respect to the later-registered mark but also for the prior mark which provided the consent to co-exist
- 3) **Statute of limitations:** Revocation trial cannot be filed if 3 years lapse from the date on which the relevant cause ceased to exist
- 4) **Penalty:** Once the revocation becomes final and conclusive, you may not file an application for the same/similar mark for 3 years.

(b) Provision which allows you to request the other party to make an indication necessary to prevent the confusion has not been introduced.

VI. 韓国における共存同意制の活用価値

Value of Utilizing Letter of Consent System in Korea











韓国における審査は分離観察の傾向が強い

後願	先願	要旨
Gen.G esports	GENZIE	(特許法院2020ホ3324) 後願商標は「Gen.G」部分のみに分離することができるため、両商標の称呼が「ジェンジ」で類似し両商標は類似であると判断
K9AURUM	AURUM	(特許法院2019ホ1834) 後願商標が「AURUM」部分のみに略称される場合は両商標の称呼と観念が類似するため、両商標は類似であると判断
	CLTI 학습유형진단	(特許法院2018ホ7590, 大法院審理不続行棄却) 後願商標の「CLT」、先願商標の「CLTI」文字部分に分離観察され称呼が類似するため、両商標は類似であると判断
BLUEICE SPM	 SEOUL PRECISION MACHINE CO.,LTD	(特許法院2016ホ786判決) 両商標を「SPM」に分離観察し類似であると判断
The Bridge	 NINE BRIDGES	(特許法院2011ホ1968, 大法院審理不続行棄却) 両商標は「ブリッジ」に分離観察され類似
SOLARTEX	 SOLARON	(大法院2010フ3527) 両商標は「SOLAR」のみに簡略に認識されて呼称・観念されるため類似
BANGGOLF	BANG BANG	(大法院2010フ2148) 両商標は要部である「BANG」の称呼が類似

※ 分離観察傾向が依然として強い韓国商標審査において完全型同意書制度はその活用が非常に期待される

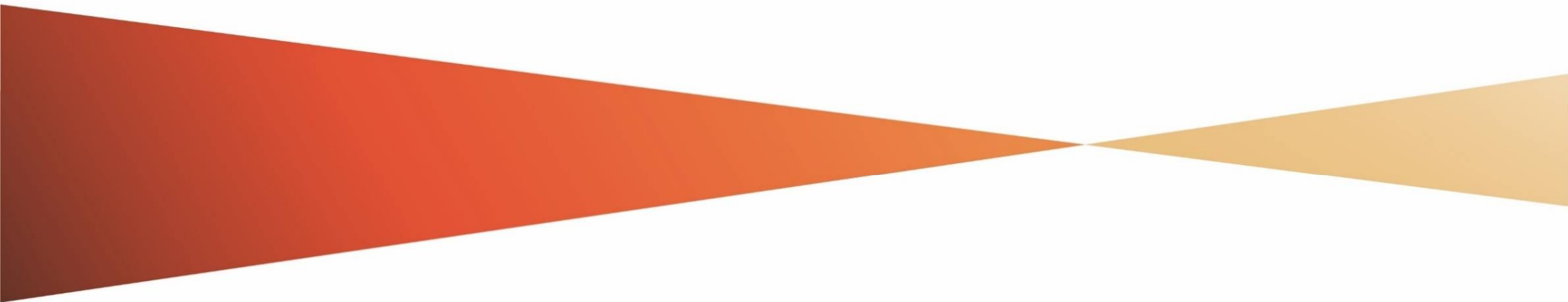
Examination in Korea tends to involve separation of elements

Later-filed Trademark	Cited Prior Trademark	Gist of Decision
Gen.G esports		<p>(Patent Court Decision No. 2020Heo3324) Since the pending mark can be separated by the “Gen.G” portion only, two marks bear resemblance in terms of their pronunciation. Accordingly, the two marks are deemed similar.</p>
K9AURUM		<p>(Patent Court Decision No. 2019Heo1834) If the pending mark is abbreviated as “AURUM” portion only, the two marks would bear resemblance in terms of their pronunciation and concept. Accordingly, the two marks deemed similar.</p>
		<p>(Patent Court Decision No. 2018Heo7590; Supreme Court’s dismissal without further deliberation) The two marks have similarity in terms of the pronunciation, when the word portion of the pending mark and the cited mark “CLT” and “CLTI,” are separately observed.</p>
		<p>(Patent Court Decision No. 2016Heo786) The two marks are similar when they are separately observed as “SPM.”</p>
The Bridge		<p>(Patent Court Decision No. 2011Heo1968; Supreme Court’s dismissal without further deliberation) Both marks are similar in that the “bridge” portion is separately observed.</p>
SOLARTEX		<p>(Supreme Court Decision No. 2010Hu3527) Both marks are similar in that they are briefly recognized and pronounced, conceptualized as the “SOLAR” portion.</p>
BANGGOLF	BANG BANG	<p>(Supreme Court Decision No. 2010Hu2148) The “Bang” part in both marks, which is the essential portion, are similar in terms of the pronunciation.</p>

※ The Letter of Consent System may be effectively utilized during examination of trademarks in Korea, which still tend to observe trademarks separately.

Ⅶ. 共存同意制の利用現況

Current Status of Utilizing Letter of Consent System



共存同意制の利用現況

(’24.8.31. 基準)

①権利者の区分 (先登録(出願)人 /後出願人)	出願件数	②審査状態	出願件数
企業/企業	321件 (72%)	審査待機 (意見書提出, 未着手, 保留等)	217件 (49%)
個人/企業	70件 (16%)	出願公告	185件 (41%)
企業/個人	36件 (8%)	登録決定	34件 (8%)
個人/個人	20件 (4%)	審判段階 *	6件 (1%)
-	-	その他 (取下げ, 再審査等)	5件 (1%)
合計	447件 (100%)	合計	447件 (100%)

* 6件は拒絶決定不服審判段階で共存同意書提出

- **2024年5月1日の施行後4ヶ月間で447件受付**
- **企業&企業間で最も活発に活用(72%)**
- **審査～審判段階まで多様な段階で活用**
- **制度が軌道に乗りつつあると評価できる**

(出処 : 2024年9月18日 特許庁報道資料)

Current Status of Utilizing Letter of Consent System

(As of August 31, 2024)

(1) Type of Right Holder (First Party to File Trademark Registration (Application)/Party who Later Filed an Application)	Number of Applications	(2) Status of Examination	Number of Applications
Enterprise/Enterprise	321 cases (72%)	Pending (response received, examination yet to be commenced, withholding, etc.)	217 cases (49%)
Individual/Enterprise	70 cases (16%)	Published	185 cases (41%)
Enterprise/Individual	36 cases (8%)	Granting registration	34 cases (8%)
Individual/Individual	20 cases (4%)	Stage of trial proceeding	6 cases (1%)
-	-	Others (Withdrawal, re-examination, etc.)	5 cases (1%)
Total	447 cases (100%)	Total	447 cases (100%)

* 6 cases pertain cases where the parties submitted a consent letter at the stage of appealing against final rejection.

- **447 cases were received throughout 4 months after adopting Letter of Consent System on May 1, 2024**
- **Most actively utilized between companies (72%)**
- **Utilized in various stages from review to trial stages**
- **Evaluated as running successfully**

(Source: KIPO's Press Release dated September 18, 2024)

Ⅷ. 共存同意交渉時のチェックリスト

Checklist for Negotiating Co-existence Agreements



同意書を要請する側のチェックリスト



イ. 同意書交渉が必ず必要な事案かどうか (他の代案の有無)

- 1) **重要商品**× : 削除補正or部分拒絶制度の下では無対応でも残りの商品は公告される
- 2) **標章/商品の非類似主張の可能性および勝算**
- 3) **取消審判請求の可能性** : 使用調査進行

ロ. **所要費用** : 相当な対価支払いを要求される可能性+代理人費用

ハ. **交渉決裂の可能性**

ニ. **交渉前の取消審判請求の要否**

Checklist for the Party Requesting for a Letter of Consent



- (a) Whether a negotiation for consent letter is really necessary** (whether there is an alternative)
- 1) **If the goods concerned are not important:** Can simply submit an amendment deleting the conflicting goods, or the application for the remaining goods can still be published even if you do not respond under the partial rejection system.
 - 2) **Possibility of arguing dissimilarity between the mark/goods and the chance of prevailing**
 - 3) **Possibility of initiating a cancellation action:** Use investigation to be conducted
-
- (b) Expenses to be incurred :** Possibility of being demanded a considerable amount of compensation (including costs incurred by legal representatives)
-
- (c) Possibility of breakdown of negotiation**
-
- (d) Whether to initiate a cancellation action prior to negotiation**

同意書提案を受けた先権利者側のチェックリスト



イ. 提案拒否時の不使用取消審判被請求のリスク、およびその場合の勝算

ロ. 同意書提供時の対価提案および/または代理人費用を相手方に負担させるか

ハ. 別途の共存契約書締結の要否：裏契約を通じて各種義務/権利関係を明確にしておき、紛争の素地をなくしておく必要あり

ニ. 類似商標を後続出願時、相手方に都度同意書を要請しなければならない煩わしさ
：先登録(A+B)が後出願(A+C)に同意書を提供して登録された場合、先権利者が(A+D)を出願時にも同意書を得なければならない

ホ. 独占権の弱化/識別力の希薄化の可能性

ヘ. 登録後の不正使用モニタリングの負担

Checklist for the Owner of Senior Mark Who Has Been Offered Signing a Letter of Consent



(a) If turning down the offer, consider the risk of being attacked with a non-use cancellation action and if so, likely chances of prevailing

(b) Whether to charge the other party for the compensation in return for signing a letter of consent & cost incurred for retaining a legal representative

(c) Whether to enter into a separate co-existence agreement: A separate agreement may be executed to clarify various obligations/rights to prevent dispute.

(d) Inconvenience of having to request for the other party's consent letter every time you file new applications for similar marks in the future

: If the owner of a previously-registered trademark (A+B) signs a consent letter and provide it to the owner of a later-filed trademark (A+C), another consent letter must be received when the owner of the senior mark files an application for the trademark (A+D).

(e) Possible weakening of exclusive rights & dilution of senior trademarks


(f) Burden of having to monitor whether there are any unlawful purposes of the mark after registration

IX. 日韓同意書制度の比較



Comparison of Letter of Consent System in Korea and Japan



日韓同意書制度の比較

No.	区分	 日本	 韓国
1	従来の実務	原則上同意書認定 × アサインバック活用 2017年4月から支配関係にある親/子会社間は 「取引実情説明書」で例外認定(審査基準改訂)	同意書認定 × アサインバック活用
2	導入時期	2024年4月1日	2024年5月1日
3	適用対象	施行日以降の出願から適用	施行後に登録可否が決定される 出願にも適用
4	コンセント制度タイプ ^o	留保型(拒絶可能型)	完全型(拒絶不可型)
5	混同憂慮の審査	○	×
6	不正使用取消審判	○	○
7	混同防止表示請求	○	×
8	適用の例外	同一標章および同一商品	同一標章および同一商品

Comparison of Letter of Consent System in Japan and Korea

No.	Classification	 Japan	 Korea
1	Previous practice	<ul style="list-style-type: none"> In principle, the consent letters were not accepted Resorted to an assign-back procedure Since April 2017, exceptions have been allowed by receiving a “statement of circumstances of trade” between a parent company/subsidiary which are in a control relationship 	<ul style="list-style-type: none"> Consent letters were not accepted Resorted to an assign-back procedure
2	Date of introduction	April 1, 2024	May 1, 2024
3	Subjects	Only applicable to those filed after the introduction	Applicable to trademark applications whose registration would be determined after the introduction of the system
4	Type	Reserved type (Rejection possible type)	Complete type (Non-rejection-type)
5	Examination on the likelihood of confusion	O	X
6	Cancellation actions based on uses for unlawful purposes	O	O
7	Request for making indication necessary to prevent confusion	O	X
8	Exceptions to application	Identical marks/goods	Identical marks/goods

ご清聴ありがとうございました。

Thank you

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