

Distinctiveness of Three Dimensional Trademarks

By Min-Kyoung JEE and Jason J. LEE, Kim & Chang, South Korea

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The Korean Intellectual Property Office's ("KIPO's") amended examination guidelines regarding three dimensional trademarks have been controversial ever since they came into effect on March 5, 2012. Prior to the amendment, KIPO would simply evaluate the overall distinctiveness of three dimensional trademarks much like any other trademark. However, KIPO's amended examination guidelines have provided that the distinctiveness of a three dimensional trademark must be determined based only on the three dimensional shape itself, without considering any other elements which may be part of the mark such as symbols, letters, figures, etc. This change has been the subject of much debate, as many in the legal field have argued that the amended examination guidelines are too narrow in scope.

This issue was presented before the Patent Court, which recently reviewed an appeal of a rejection by KIPO of an application for a three dimensional trademark designating artificial hip joint balls (see below). KIPO had rejected the application on the basis that the three dimensional shape of the mark lacked distinctiveness, while refusing to consider the distinctiveness of the English characters "BIOLOX delta" in its review. However, the Patent Court rejected this methodology, holding that "BIOLOX delta" should have been considered together with the three dimensional shape when judging the distinctiveness of the mark. As a result, the Patent Court found that the three dimensional mark was distinctive overall, ignoring KIPO's examination guidelines (Patent Court Case 2014Huh2344, rendered on September 19, 2014).



The Patent Court further stated that KIPO's amended examination guidelines as to three dimensional trademarks were adopted solely for the convenience of KIPO's own internal review process (and thus impliedly illegitimate). The Patent Court ruled that the scope of protection for three dimensional trademarks is to be determined by reference to all of their elements, including shapes, symbols, letters, figures, etc., and should not be limited to the three dimensional shape alone. In other words,

when determining the distinctiveness of a three dimensional mark, one must consider the mark in its entirety, just as with any other trademark.

The Patent Court's decision, by rejecting KIPO's amended guidelines, restores a reasonable standard for determining the distinctiveness of three dimensional trademarks. KIPO has filed an appeal of the Patent Court decision to the Supreme Court, which is currently pending.

For further information, please contact:



Min Kyoung JEE
Korean Patent Attorney
mkjee@ip.kimchang.com

Min-Kyoung Jee is a trademark attorney in the firm's Trademark/Design Practice Group. Ms. Jee's practice focuses on the area of trademark and design prosecution. Ms. Jee assists in litigation, enforcement, and dispute resolution cases involving intellectual property issues as well as in domain name matters.



Jason J. LEE
US Attorney
jlee4@ip.kimchang.com

Jason Jeong Lee is a foreign attorney in the firm's Intellectual Property Group. Mr. Lee's practice focuses on trademark enforcement and prosecution, unfair competition, copyrights, designs, anti-counterfeiting, customs and domain name matters. Mr. Lee's experience includes advising multinational corporations and global brands on various intellectual property issues.