

Supreme Court reverses its position on dual-language trademarks

By Alexandra BÉLEC and Su Yeon Chun, Kim & Chang, South Korea



Source: Kim & Chang www.ip.kimchang.com

Reversing a long-held position, the Supreme Court of Korea *en banc* recently ruled that the use of only the English portion (or equally, only the Korean transliteration portion) of a registered English/Korean transliteration combination mark constituted use of the mark as registered (Case No. 2012Hu2463, rendered on September 26, 2013).

Prior Strict Standard

Until now, Korean courts cancelled English/Korean combination mark for non-use, if the registrant was only able to prove use of only one of the two portions of the mark.

The below are two examples of past Supreme Court's decisions (Case No. 2003Hu1437, August 20, 2004 and Case No. 92Hu698, December 22, 1992) in which the marks as used were not recognized as constituting valid use of the marks as registered and the registered marks were ultimately cancelled.

Mark as registered	Mark as used
<p style="text-align: center;">HEALTH MATE 헬스 메이트</p> <p><i>(HEALTH MATE with its Korean transliteration)</i></p>	
 <p><i>(TIFFANY with its Korean transliteration)</i></p>	<p style="text-align: center;">티파니</p> <p><i>(TIFFANY in Korean transliteration)</i></p>

New position of the Supreme Court (September 2013)

Reversing its previous firm stance, the Supreme Court ruled that, although the attacked registration for

the   mark (*CONTINENTAL with its Korean transliteration*), covering rubber V-belts,

had not been used in its bilingual registered form, the use of the CONTINENTAL portion only on the designated goods, as shown below, was sufficient to save the registration from cancellation.



The Supreme Court justified its decision on the basis that Korean consumers are nowadays more accustomed to English words and can easily understand that the Korean portion of such combination marks are in fact a mere transliteration of the English portion, having the same meaning and pronunciation.

Thus, as long as the two portions of a registered combination mark have the same meaning and pronunciation, cancelling a registration simply because only one portion was used, ultimately would be a disservice to consumers who understand that the mark as used or as registered refers to the same source.

For more information, please contact:



Alexandra Bélec

Foreign Legal Counsel

Kim & Chang

abelec@ip.kimchang.com

www.ip.kimchang.com

Alexandra Bélec is a foreign attorney in the firm's Trademark/Design Practice Group. Ms. Bélec has previously practiced in Canada, in France and in Italy in matters pertaining mainly to trademarks, copyrights, domain names, licensing, computer and new technologies law.



Su Yeon Chun

Korean Patent Attorney

Kim & Chang

sychun@ip.kimchang.com

www.ip.kimchang.com

Su-Yeon Chun is a trademark attorney in the firm's Trademark/Design Practice Group. Ms. Chun's practice focuses on trademark and design prosecution matters.