



**STANDING COMMITTEE ON GEOGRAPHICAL INDICATIONS
QUESTIONNAIRE TO NATIONAL GROUPS**

National Group: Republic of Korea
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Questions

Your Group is invited to submit a Report addressing the questions below. If your Group considers that the answer to a question has already been given in its report on Question Q191, and that nothing has changed since then, a cross-reference to the specific paragraph in your Group's report on Q191 is sufficient.

In each case please specify whether your answer differs:

(a) as between GIs and AOs; and

No. The same answer applies to GIs and AOs.

An “appellation of origin (AO)” refers to the direct geographical designation of the place of production where a given quality of the product is essentially attributable to the geographical environment of the place of production (ex: Bordeaux wines, Tequila distilled liquor). Therefore, a geographical indication (GI), which may be due to not only a natural factor(s) but also a human factor(s) and may be derived from a non-geographical appellation or indirect appellation, such as a symbol or an emblem, in addition to a geographical designation, is broader in concept than an AO (that is, GI encompasses AO).

(b) depending on whether the GI or AO is foreign or domestic.

No. The same answer applies to a foreign and a domestic GI/AO.

A registered GI, whether it be foreign or domestic, will block the registration or use of a third-party GI that is identical/confusingly similar to the registered GI for goods that fall within the scope of what is considered identical to the goods of the registered GI.

Also, under the Korean Trademark Act, regardless of registration status, a GI of the place of production for wine or spirits in a World Trade Organization member country blocks the registration of any third-party mark that includes a GI, even as an additional part for wines or spirits (so as to be compatible with WTO/TRIPs, Article 23(1) and (2), which provides for the revocation of a trademark registration that contains or consists of a GI identifying wines or spirits even when there is little likelihood of causing confusion among general consumers.) .

Additionally, under the Korean Trademark Act and the Unfair Competition Prevention and Trade Secret Protection Act, regardless of registration status, a GI protected in accordance with a free trade agreement likewise blocks registration or use of any third-party mark that includes a GI, even as an additional part for the goods that considered to fall within the scope of what is considered identical to the goods of the protected GI. This way, even an unregistered GI is afforded protection like a registered trademark.

I. Analysis of current legislation and case law

1) Are GIs and/or AOs protected under your Group's current law?

GIs are protected under several laws in Korea, mainly under the Korean Trademark Act (on which this analysis is focused), the Agricultural and Marine Products Quality Control Act and the Unfair Competition and Trade Secret Protection Act.

2) If yes, please briefly describe the following:

a) How AOs and GIs are defined and the prerequisites (in particular the type, nature and intensity of link with a territory).

○,¹ Definition of GI

GI means an indication used to identify goods produced, manufactured, or processed in a specific area in cases where a certain quality, reputation, or other characteristic of goods has essentially originated from a specific area

○,² Prerequisites

- GI is recognized not only for agricultural and marine products, but for all types of industrial products. However, GI is not recognized for services.
- 'A given quality' of goods may be derived from natural or human factors.
- 'A specific area' includes the place of production and the place of manufacture.
- 'A specific area' includes a local area and a foreign area.
- 'Indication' includes a geographical designation and a non-geographical designation, e.g., symbol, emblem, etc.

b) Whether that protection is provided by sui generis laws; solely as aspects of other laws, such as by registration as collective or certification marks; or by other (and if so, what) means.

GIs are individually protected under the Agricultural and Marine Products Quality Control Act; GIs are protected as a collective/certification mark under the Korean Trademark Act and the Unfair Competition Prevention and Trade Secret Protection Act.

- c) If GIs and/or AOs are protected by sui generis laws, whether your Group's laws provide for a system of registration. If so, what are the steps of this procedure including the content of the application and the possibility of opposition by third parties.

GIs are available for an individual registration under the Agricultural and Marine Products Quality Control Act which was enacted in 1999. Such GIs had been protected as a quality certification until the 2009 amendments to the Agricultural and Marine Products Quality Control Act under which GIs began to be protected as a possessive right. As a result, a collective /certification mark with a GI under the Korean Trademark Act and a GI under the Agricultural and Marine Products Quality Control Act have similar types of rights. (This being so, it follows that the application procedures for registration of a GI under the Agricultural and Marine Products Quality Control Act are similar to those for registration of a GI as a collective/certification mark under the Korean Trademark Act, and the opposition procedures under the two laws are also similar)

In summary, under the Agricultural and Marine Products Quality Control Act, an eligible applicant who may be either an individual or a legal entity with justifiable claims to use of a GI may file for registration of the GI by submitting required documents, such as articles of incorporation or a production plan. A filed application and accompanying documents will be reviewed by a division of examiners responsible for GIs. Unless the examiner finds a reason for rejection stipulated in Article 32(9) which are quite similar to reasons for rejection provided for under the Korean Trademark Act, the application will proceed to be published. The application will remain published for two months for a potential opposition by a third party.

- 3) If your country does not protect GIs and/or AOs, was this a deliberate decision and, if so, why?
N/A

- 4) What are the grounds of invalidity/loss of rights for GIs and/or AOs under your Group's law (e.g. becoming generic, lack of use, not paying fees) and where can such be invoked (which court, office etc.)? Please specify the applicable test, how such is proven (e.g. consumer surveys, expert advice, dictionaries, etc.) and who bears the burden of proof.

1. Grounds for invalidation/cancellation of a collective mark with GI under the Korean Trademark Act

○,¹ Grounds for invalidation (under the Korean Trademark Act)

- A trademark fails to meet the definitions of a GI or a collective mark with a GI provided for in Article 2(1).
- A person is not entitled to the registration of a collective mark.
- In cases of an application for registration of a collective mark with a GI, the articles of incorporation of an organization prohibits or does not actually permit persons to join the organization as its members.
- All or some of the matters concerning the use of a collective mark prescribed by Presidential Decree are not stated in the articles of incorporation under Article 36 (3).
- A GI that constitutes a registered collective mark is no longer protected or used in the country of origin after the collective mark with the GI is registered pursuant to Article 82.

○,² Grounds for cancellation (under the Korean Trademark Act)

- The registered trademark violates the provisions related to the transfer of a collective mark with a GI.
- Where a member of the organization allows another person to use its collective mark in violation of its articles of incorporation or causes the misunderstanding of the quality of goods, the source of a GI, or confusion with goods related to another person's business among consumers by using its collective mark in violation of its articles of incorporation. The foregoing, however, shall not apply in the case the holder of the collective mark right pays due attention to supervise its members.
- The organization is likely to cause a misunderstanding as to the quality of goods or confusion with goods related to another person's business among consumers by amending its articles of incorporation after it registers its collective mark with a GI.
- A third party causes a misunderstanding as to the quality of goods, the source of a GI, or confusion with goods related to another person's business among consumers by using its collective mark with a GI, but the holder of the collective mark right willfully fails to take appropriate measures.
- In cases of an application for registration of a collective mark with a GI, the articles of incorporation of the organization actually prevent persons from joining the organization, such as prohibiting them from joining the organization, stipulating impracticable conditions for joining the organization, or allow a person ineligible to use a GI to join the organization.

- The holder of a collective mark right with a GI or a member of the organization causes a misunderstanding as to the quality of goods or confusion on the source of the GI by using the collective mark with a GI in violation of Article 223¹.

2. Grounds for invalidation/cancellation of a certification mark with a GI under the Korean Trademark Act

○,¹ Grounds for invalidation (under the Korean Trademark Act)

- A trademark fails to meet the definitions of a GI or a certification mark with GI provided for in Article 2(1)
- A person is not entitled to registration of a certification mark.
- All or some of the matters concerning the use of a certification mark prescribed by Presidential Decree are not stated in the articles of incorporation under Article 36 (4)
- In cases of an application for registration of a certification mark, the articles of incorporation do not actually permit persons who may use such certification mark to use it, such as the prohibition of persons from using it in accordance with the articles of incorporation or the rules without justifiable grounds, or impracticable conditions of use thereof are stipulated in the articles of incorporation or the rules.
- A GI which constitutes a registered certification mark is no longer protected or used in the country of origin after the certification mark with GI is registered pursuant to Article 82.

○,² Grounds for cancellation (under the Korean Trademark Act)

- The registered trademark violates the provisions related to transfer of a certification mark with a GI.
- The holder of the certification mark with a GI right permits the use of the certification mark with a GI, in violation of the articles of incorporation or the rules submitted pursuant to Article 36 (4).
- The holder of the certification mark with a GI right uses the certification mark with a GI on his/her own goods, in violation of the provision to Article 3(3).
- A person permitted to use the certification mark with a GI allows another person to use such mark, in violation of the articles of incorporation or the

¹ Where at least two registered collective marks with a GI correspond to a mutually homonymous GI, each collective mark right holder and its members shall use a mark that prevents consumers from being confused about the geographical source along with its registered collective mark.

rules, or causes confusion concerning the quality of goods, the place of origin, methods of production, or other characteristics among consumers by using the certification mark with a GI in violation of the articles of incorporation or the rules. The foregoing, however, shall not apply where the holder of the certification mark with a GI pays due attention to supervise any person permitted to use the certification mark with a GI.

- The holder of the certification mark with a GI fails to make appropriate measures though he/she is aware that a third party who fails to obtain permission to use the certification mark with a GI causes confusion concerning the quality of goods, the place of origin, methods of production, or other characteristics among consumers by using the certification mark with a GI.
- The holder of the certification mark with a GI actually prevents a person eligible to use the certification mark with a GI from using the certification mark with a GI without justifiable grounds in accordance with the articles of incorporation or the rules, or stipulates impracticable conditions for using the certification mark with a GI in the articles of incorporation or the rules.
- The holder of a certification mark with a GI or a member of the organization causes a misunderstanding as to the quality of goods or confusion on the source of the GI by using the certification mark with a GI in violation of Article 223.

3. Decision-making authority

The invalidation/cancellation of a GI registration is determined by the Intellectual Property Tribunal (IPT) within the Korean Intellectual Property Office. The IPT decision can be challenged at the Patent Court, and the Patent Court decision can be appealed with the Supreme Court. The findings of the Supreme Court are binding and final.

4. Method and extent of proof

All measures available in a general civil proceeding are permitted to be utilized for the purpose of establishing the grounds for invalidation/cancellation proceedings. In particular, consumer surveys, accolades of awards and distinctions from recognized organizations, rankings and activities in internet portal sites, and miscellaneous media publications are relied upon to prove the well-known status of trademarks. Local and foreign precedents, academic articles, encyclopedias, and the like are relied upon to demonstrate the similarity of trademarks and goods.

5. Burden of proof

Similar to a general civil proceeding, the burden of proof is placed upon the party that is seeking to invalidate/cancel a GI registration. In a non-use cancellation

proceeding, however, the owner of the attacked GI registration is required to establish the valid use of the concerned GI for one or more of the attacked goods.

5) What is the scope of protection of GIs/AOs under your Group's current law?

Under the Korean Trademark Act

GIs are provided the same scope of protection as that provided for a general trademark. The only difference lies in that while protection provided for a general trademark extends to goods that are similar to the designated goods of the trademark, the protection provided for GIs is limited only to goods that fall within the scope of what is considered identical to the designated goods with GIs.

Under the Agricultural and Marine Products Quality Control Act

The owner of a GI registration holds the right to use the GI for the goods covered by the registration and prevent a third party from using a mark identical/confusingly similar to the registered GI on identical or similar products, packaging, or containers thereof, and in promotional materials and related documents.

6) Against what kind of conduct are GIs/AOs protected? For example, against use misleading consumers, parasitism and free riding.

1. Protection under the Korean Trademark Act

A third party without legitimate rights is prohibited from using a trademark identical/confusingly similar to a registered collective mark/certification mark with a GI on the goods that fall within the scope of what is identical to the designated goods of the registered GI.

2. Protection under the Agricultural and Marine Products Quality Control Act

A third party without legitimate rights is prohibited from using a GI identical/confusingly similar to a registered GI on identical or similar goods, packaging, or containers thereof, and in promotional materials and related documents.

3. Protection under the Korean Unfair Competition and Trade Secret Protection Act

Under the Korean Unfair Competition and Trade Secret Protection Act, the following acts are prohibited:

- An act of causing confusion about the source of origin by falsely marking the source of origin on goods or by selling, distributing, importing, or exporting goods falsely marked with the source of origin.

- An act of making a mark on goods or selling, distributing, importing, or exporting goods marked with a mark that would mislead the public into believing that the place of production, manufacture, or processing is different from the actual place of production, manufacture or processing.
- As to a GI protected under a free trade agreement that is concluded between the Republic of Korea and a foreign country or foreign countries, no unlawful holder may conduct any act described below with respect to the goods having the place of origin other than the one indicated in the geographic mark concerned (limited to goods that are identical to or recognized to be identical to the goods with the relevant GI):
 - ,¹ Using a GI separately, in addition to the authentic place of origin;
 - ,² Using a GI that is translated or transliterated
 - ,³ Using a GI with the expression of "kind", "type", "mode", "counterfeit", or other such expressions.
- Acts of transferring, delivering, exhibiting, importing or exporting goods with a GI used in the above manners.
- Acts of delivering or exhibiting goods with a GI used in such manners as described in Article 2(1)(iv) and (v)

4. Protection under the Customs Act

When any goods that are required to carry the country of origin labels in accordance with statutes fall under any of the following cases, such goods are not permitted to undergo customs clearance:

- ,¹ Where the country of origin is labeled in a manner not in compliance with standards and methods prescribed by statutes;
- ,² Where the country of origin is falsely labeled in an illegal manner;
- ,³ Where no country of origin is labeled.

5. Protection under The Foreign Trade Act

Traders or distributor of goods, etc. are prohibited from committing any of the following acts:

- ,¹ Falsely indicating an origin or labeling any misleading indication of origin;
- ,² Damaging or modifying an indication of origin;
- ,³ Omitting an indication of the origin of goods that should bear an indication of origin;
- ,⁴ Trading in the Republic of Korea goods that should bear an indication of origin, which fall under the violations in subparagraphs 1 through 3.

6. Protection under the Act on the Investigation of Unfair International Trade Practices

The following goods are not permitted to be exported or imported:

- ,¹ Goods with a mark that falsely indicate its origin or misleads consumers as to its origin
- ,² Goods with a damaged or modified indication of origin.
- ,³ Goods with an omitted origin when they are required to bear an indication of origin.

7. Protection under the Act on Origin Labeling of Agricultural and Marine Products

The following acts are prohibited:

- ,¹ False labeling of an origin or labeling that may cause confusion as to the origin of a product;
- ,² Destroying or changing labels for the purpose of confusing consumers as to a product's origin;
- ,³ Selling under a disguised origin, or selling agricultural and marine products and processed products thereof with the origin label mixed with other agricultural and marine products and the processed products thereof, or storing or displaying such products for the purpose of sale.

Anyone who sells or provides agricultural and marine products or processed products thereof after cooking it is prohibited from conducting any of the following acts:

- ,¹ False labeling of the origin or labeling that may cause confusion as to the origin.
- ,² Cooking, selling and providing agricultural and marine products or processed products thereof under a disguised origin and storing or displaying such products after destroying or changing labels for the purpose of selling or providing it after it has been cooked.
- ,³ Cooking, selling or providing origin-labeled agricultural and marine products or processed products thereof mixed with the same agricultural and marine products or processed products thereof under a different origin.

7) Who has legal standing to protect a GI/AO. For example, individual producers, consortiums and associations, public bodies.

1. Under the Korean Trademark Law

Only a corporation jointly founded by persons who produce, manufacture, process, or sell goods that are qualified to use the relevant GI

2. Under the Agricultural and Marine Products Quality Control Act

Only a corporation comprised of persons who produce, manufacture, or process agricultural and marine products or processed agricultural and marine products having geographical characteristics in a specific region are eligible to apply for registration of a GI. If only one person produces or processes a specific agricultural or marine product or processed agricultural or marine products having geographical characteristics, such person may solely apply for a registration thereof.

8) What remedies are available in the case of violation of rights in a GI/AO?

1. Under the Korean Trademark Law

- Lawsuits requesting the prohibition or prevention of infringements
- Claim for Damages
- Criminal punishment for infringement

2. Under the Agricultural and Marine Products Quality Control Act

- Lawsuits requesting the prohibition or prevention of infringements
- Claim for Damages
- * Criminal relief is not available

3. Under the Unfair Competition Prevention and Trade Secret Protection Act

- A civil injunction against acts of Unfair Competition or for prevention thereof
- Compensation of damages
- Administrative sanctions (Product investigation /examination) and recommendations for correction to the infringer, i.e., to cease an act of unfair competition and remove or destroy the mark used in the act
- Criminal punishment (Criminal relief is not available in the case of a violation of Article 3-2)

4. Remedies are also available under additional laws not listed here

9) How does your Group's law regulate the conflict between a GI/AO and a prior trademark? Does the GI/AO or the trademark prevail or do they coexist? Under what conditions?

1. Conflict between a GI and a prior trademark

The Korean Trademark Act adopts the first-to-file rule regardless of the types of trademarks. Accordingly, in the case of two identical/confusingly similar marks that are to be used for identical/similar goods, only the mark that was filed first will be allowed to be registered. (A person who has used a trademark identical or similar to a registered trademark of another person on goods identical or similar to

the designated goods will be allowed to continuously use the trademark provided that he had used the mark in Korea before the filing of the registered mark without the intention of unfair competition and through such use the mark had gained recognition as indicating goods of a certain person)

A trademark consisting solely of a GI is refused registration on the ground that it constitutes a well-known geographical designation. This way, a possibility of conflict between a collective/certification mark with a GI and a prior trademark is unlikely.

However, trademarks consisting of a GI and another distinctive element may be allowed for registration. In this case, the GI in the trademark will be deemed to be indistinctive and therefore has no power to prevent registration or use of a mark incorporating the same GI by a third party. This way, a possibility of conflict between a collective/certification mark with a GI and a prior trademark is unlikely.

On a related note, it is possible for an indistinctive GI in a trademark to be acknowledged as having acquired secondary meaning through use, though there have been no reported cases of conflict between a trademark and a GI thus far.

2. Order of priority or allowance of co-existence

Since Korea adopts the first-to-file principle, in the case of two or more identical/confusingly similar marks that are to be used for identical/similar goods, only the first-filed mark will be allowed to be registered regardless of the type of trademark.

However, the following should be noted:

- ,¹ As opposed to a GI in a general trademark, which would likely be found to be indistinctive, a GI in a collective/certification mark with a GI is deemed to be distinctive. These differences may lead to findings of disparity in the determination of the identicalness/confusing similarity of marks, and consequently result in co-existence of trademarks and collective /certification marks that incorporate the same GI. Accordingly, in the case a trademark has been filed first, a collective/certification mark with a GI may be found to be not confusingly similar to the pre-filed mark and therefore registrable. (In this case, a trademark and a collective/certification mark incorporating the same GI will be allowed to co-exist. On the other hand, in the case a collective/certification mark with a GI has been filed first, a latter-filed trademark will be found to be confusingly similar to a pre-filed collective/certification mark with the same GI and therefore will be unregistrable).
- ,² Where the determination of identicalness/similarity of goods is concerned, a general trademark that was filed first can prevent registration of a later-filed mark with respect to similar goods. On the other hand, a collective /certification mark with a GI that was filed first can prevent the registration of

a later-filed mark only with respect to goods that fall within the scope of what is considered identical to the designated goods of the collective/certification mark with the GI. Accordingly, a trademark that incorporates the same GI found in an earlier-filed collective/certification mark with a GI will be found to be registrable with respect to the goods that are deemed to be only similar and not identical to the designated goods of the collective/certification mark with the GI.

- 10) Is there any specific provision or practice concerning the inclusion of a GI/AO in a domain name?

No, there are no specific provisions or practice in this respect as of yet.

- 11) Is there anybody that administers GIs/AOs in your country and/or is responsible for the verification of compliance of goods bearing a GI/AO? Please briefly describe the relevant processes, e.g. the process by which compliance with product specifications is verified before such goods are put on the market and/or the subsequent market controls on such goods?

1. Relevant organizations

- Korean Intellectual Property Office (in compliance with the Korean Trademark Act and the Unfair Competition Prevention & Trade Secret Protection Act)
- The Ministry of Agriculture, Food and Rural Affairs and the Ministry of Oceans and Fisheries (in compliance with the Agricultural and Marine Products Quality Control Act)
- And additional organizations not listed here.

2. Relevant procedures

○,¹ before registration: Both the Korean Trademark Act and the Agricultural and Marine Products Quality Control Act strive to ensure that only qualified GIs are registered by requiring eligible applicants to submit documents required by statutes and providing reasons for refusal of a GI registration.

○,² After registration: Both the Korean Trademark Act and the Agricultural and Marine Products Quality Control Act provide for revocation of a registered GI not in compliance with registration requirements.

③ The Agricultural and Marine Products Quality Control Act additionally provides for re- inspection. The relevant officials are authorized to examine goods bearing a GI to verify that they meet the registration standards, peruse relevant books and documents, and collect and inspect samples, so as to ensure the quality maintenance of the products bearing a GI and consumer protection. If the results are

not in compliance with registration standards, which could happen if the products are determined to not satisfy the registration standards, have violated indication methods, or the production quantity of the products bearing the relevant GI have drastically decreased, corrective orders and order to cease use of the relevant GI, and revocation of a registration(s) may be called upon.

- 12) Please describe any other developments in your country in relation to GIs or AOs which you consider relevant, including any proposals for reform. For example, to the extent that your country has been involved in any negotiations or discussions regarding the protection of GIs and AOs in any fora, such as multilateral, regional or bilateral agreements, please specify whether your country is negotiating or has signed any agreement with other countries that includes provisions on AOs/GIs and whether it was necessary to amend domestic legislation as a result of such agreements.

N/A

II. Proposals for improvements and for harmonisation

- 13) Should there be harmonised definitions of AOs and GIs? If so, please propose appropriate definitions and prerequisites.

We think harmonised definitions of GIs is necessary in Korea so that the country may be in conformity with the global trend to strengthen protection for GIs. However, since every country has different interests to pursue, full prior negotiations should precede the adoption of a harmonized definition of GIs regarding prerequisites.

- 14) Should there be a registration procedure for AOs and GIs? If so, what should its key features be? For example, content of the application; examination by competent bodies; possibility of opposition by third parties.

Since GIs are protected as a collective/certification mark with GIs under the Korean Trademark Act, there is no call for an additional registration procedure for GIs.

- 15) What should the grounds of invalidity/loss of rights for GIs and/or AOs be? For example, becoming generic, lack of use, not paying fees. Please specify what the applicable test should be, how such should be proven and who should bear the burden of proof.

As discussed in Section I above, relevant Korean laws already provide for grounds of invalidation/cancellation of rights for GIs. The addition of specific provisions for who is eligible for registration or use of GIs, and confusion as to the quality or source of goods due to use of a GI, and the like, would make the relevant laws more complete.

Regarding methods or standards for the determination of suggested parameters and the question as to whom the burden of proof should be placed upon, we may look to the procedures of a general civil proceeding.

- 16) How should conflicts between GIs/AOs and prior trademark rights be regulated?
N/A
- 17) What scope of protection should GIs/AOs have and should it matter if these are domestic or foreign? Against which conduct by third parties should they be protected?
There seems to be no reason to apply a different cloak of protection to GIs from those that applied to a general trademark or to differentiate protection depending on whether such a GI is domestic or foreign.
- Since a GI indicates that the goods bearing a GI originate from a specific area, it should be ensured that GIs are protected from false indications and confusing/misleading indications by a third party.
- 18) Who should have legal standing to protect a GI/AO and which remedies are appropriate?
Organizations comprised of persons with justifiable claims to the relevant GI have the legal standing to protect the GI and appropriate remedies available in a general civil/criminal/administrative proceeding should likewise be available for the protection of a GI.
- 19) Should there be a specific provision or practice concerning the inclusion of a GI/AO in a domain name?
The prevailing opinion in Korea is that the existing provisions and practices from the Korean Trademark Act and the Unfair Competition Prevention & Trade Secret Protection Act regarding GIs have proven to be effective in this regard, and accordingly, there has been no call for additional provisions or practices specifically related to the inclusion of a GI in a domain name.

Responses to this Questionnaire

Groups are requested to submit responses to this questionnaire **by May 29, 2017**. Responses should be sent by email to StandingCommittees@aippi.org and should clearly indicate that they are responses to this questionnaire.