Questions

1) Analysis of current legislation and case law

1) Do your country’s laws have enactments or systems dealing specifically with GIs, e.g. a registration system for GIs? If so, what are the criteria of registrability? To which national authority must an application for protection be made? Does the applicant have the right to appeal against the refusal of the national authority to register a GI? If so, to which entity?

1) Korea has no general registration system for GIs but registration systems for GIs on agricultural products and fishery products (under the Agricultural Products Quality Control Act, the Ginseng Industry Act, and the Quality Control of Fishery Products Act). These registration systems are not to protect GIs as rights of ownership (properties) like intellectual properties such as trademark rights or copyrights but to protect GIs as a quality certification.

Since July 1, 2005, the Trademark Act has provided the protection of GIs as a collective mark. Thus, GIs can be protected as trademarks which have a kind of property (rights of ownership).

2) The Criteria of Registrability

This section will mention only registration systems for GIs of agricultural products and fishery products which are not the registration system as a collective mark under the Trademark Act. The system will be basically described regarding agricultural products because the registration systems for GIs of fishery products are similar to those of agricultural products.

i) Qualifications for Application

- Only producers’ organizations or processors–comprised organizations, limited to juridical persons, producing or processing the items subject to the registration for GIs within specific regions may apply for the registration. However, where producer or processor is only one person within the region, the person may apply the registration for GIs.

ii) Items subject to the Registration

- Items notified by the minister of the Ministry of Agriculture and Forestry through the deliberation of the Agricultural Products Quality Control Deliberative Committee

- Items notified on Sept. 10, 2002: 151 items including green tea, ginseng, liquor etc.
iii) Standards of Examination

The name of the GI, relation between quality and geographical factors, appropriateness of own quality standards, scope of the region subject to GIs, and other necessary requirements for registration.

3) National Authority
   - Agricultural products (including ginseng): (the Chairman of) the National Agricultural Products Quality Management Service
   - Fishery products: (the Minister of) the Ministry of Maritime Affairs & Fisheries

4) Appeal
   Under the Korean laws, there is no specific procedures that applicant can resist against the national authority’s rejection. Thus, it should be governed by procedures of general administrative litigation.

2) What is the status of a GI in your country? Does the registration of a GI confer a property right? Who would be the rightholder of a GI? Can GIs be the subject of dealings such as assignment, mortgage and licensing?

If a GI is registered, a registration certificate is conferred, and the right to mark a geographical indication on regional (geographical) specialties is allowed. This right can be considered as a quality certification, not a right of ownership (a possessive right). Such character of the right as a quality certification can be seen that the national authority is the National Agricultural Products Quality Management Service. Therefore, a person who obtained the registration of GI under the Agricultural Products Quality Control Act can hardly be considered as a “rightholder”, and the registered GIs may not be subjects of assignment, mortgage, or licensing. A collective mark for a geographical indication described below is protected as a property (a right of ownership), and these two systems are complementary in Korea. Where a GI is registered as a collective mark, it may be transferred by merger of entities.

3) Is the application for or registration of a GI made public in your country? Is it possible to oppose such application or registration or cancel such registration of a GI? If so, by whom and on what (absolute or relative) grounds (e.g. generic or descriptive term or prior trademark)?

The Commissioner (Minister) of the national authority to manage the GIs shall publicly notify applications for registration for GIs unless there exists any justifiable reason for the rejection of the applications.

Anyone may lodge an objection (opposition) to the Commissioner (Minister) of the national authority to manage the GIs within thirty days of the publication date of the application attaching the documents stating the reasons for objection (opposition) and supporting evidence. There is no limit to the reasons for objecting (opposing) the registration, but the person making the objection (opposition) shall indicate support evidence of the reasons in the light of foresaid standards of examination.

4) Must use requirements be satisfied in order to maintain GI protection? If so, is there any definition of what constitutes use? Are the legal rules established for appraising the maintenance of a trademark registration applicable to the appraising of the maintenance of GI protection?
1) The Commissioner (Minister) of the national authority to manage the GIs shall cancel the registration and publicly notify the cancellation when a person who obtains the registration for GIs faces difficulties to produce the regional specialties for the reasons such as change or abolishment of business.

2) Laws, which are applied to examine maintenance of trademark registration such as the obligation of use, etc., may not be applied to examine maintenance of registration for GIs. This is because the registration system for GIs is not similar to that for trademark in the aspect of the purpose and function.

5) What is the scope of protection of a GI? Is it only protected against use of the name or also against use of elements of the specification of the GI (e.g. slicing, grating) or any other practice liable to mislead the public as to the origin of the product (e.g. use of same trade dress)? Are the legal rules established for determining the scope of trademark protection applicable to determining the scope of GI protection (e.g. in relation to reputed or well-known GIs, likelihood of confusion, infringing and non-infringing acts)? May rights in a GI be enforced even where a product which allegedly infringes those rights has been made purely for export?

If a GI is registered, a certificate of registration is conferred, and the right to mark a geographical indication on regional (geographical) specialties is allowed. However, the right is not an exclusive possessive right.

False Marking as followings is prohibited.
- Act of attaching the GI or similar one on the agricultural products or proceed products thereof that are not the regional specialties; and
- Act of selling the regional specialties carrying the GI mixed with those agricultural products which are not the regional specialties, or storing exhibiting them for the purpose of selling

To such false markings, administrative measures such as disposition for mark alteration and persecution can be taken, but these are not a right of a GI registrant.

6) Can a GI be registered as individual trademark? If so, under what conditions?

A GI cannot be registered as an individual trademark, but it can be registered as a collective mark. When a GI is applied as an individual trademark, the followings are the reasons why it cannot be registered.

First, a sign indicating “a conspicuous geographical name” cannot be registered as a trademark because of lack of distinctiveness. (Article 6(1)(iv) of the Trademark Act)

Second, a sign indicating the origin of the goods cannot be registered as a trademark because of lack of distinctiveness. (Article 6(1)(iii) of the Trademark Act)

Third, trademarks that are liable to misleads or deceive consumers on the quality of the goods may not obtain trademark registration. (Article 7(1)(xi) of the Trademark Act)

Fourth, trademarks that consist of a geographical indication or include a geographical indication of the origin of wines or sprits in a member State of the World Trade Organization, and which are used for wines or spirits or other similar goods may not obtain the trademark registration. (Article 7(1)(xiv) of the Trademark Act)

If GIs which lack distinctiveness in Article 6(1) of the Trademark Act are combined with a trademark which has distinctiveness, trademark registration may be obtained. In this case, a trademark right is not effective on the GIs which lack distinctiveness. (construction of Article 51 of the Trademark Act)
7) Do your country’s laws provide for collective or certification marks? If so, under what conditions can a GI be registered as a collective mark or a certification mark?

In Korea, the system of a collective mark for a geographical indication has been effective since July 1, 2005. However, a system for certification marks is not introduced in Korea. Requirements for the registration are as follows.

1) Substantive Requirements for Collective Mark for A Geographical Indication

Definition of Geographical Indication (Art. 2(1)(iiibis) of the Trademark Act): “geographical indication” means an indication that identifies a good as originating in a certain region where a given quality, reputation or other characteristic of the good is essentially attributable to that reign.

- Object of Protection for GI: Goods
  - Kinds of goods are not limited. Thus, agricultural products, fishery products, processed products thereof, and a piece of handcraft are included.
  - Services are not included.

- Region subjected to GI: a geographical place of origin of goods
  - It means the name of a region where a goods is produced, manufactured, and processed. This name is not limited to the name in administrative districts.
  - Producing, manufacturing, and processing is not necessarily made (originated) in a same region, but there exist a case of that the characteristics of certain goods are created by one of producing, manufacturing, and processing in a certain (specific) region or a case of that producing, manufacturing, and processing should be made (originated) in the same region together.

- Existence of A Given Quality, Reputation, or Other Characteristic of The Goods
  - A Goods produced, manufactured, and/or processed in a certain region shall have a quality, reputation, or other characteristic which is distinguishable from the goods produced, manufactured, and/or processed in other regions.

- Existence of Substantial Connection between Characteristic of The Goods and Geographical Environment
  - As a quality, reputation, or other characteristic of the goods must be substantially connected with the geographical place of origin, A GI may not be recognized with the mere fact that a good is produced, manufactured, or proceed in the region. The characteristic of the goods must be essentially based on geographical environment including natural environment such as temperature, soil, and other geographical features or human factors such as a unique technique.

2) Persons Entitled to Register a Collective Mark for A GI

A person seeking to register a collective mark shall chose or establish organization which will file an application to register GIs, decide qualification of members, scope of members, and requirements for members, and provide the articles of association that govern the use of the collective mark.

Legal entities composed solely of persons who conduct business activities such as producing, manufacturing, processing or certifying goods may apply for registration of a collective mark for GIs. Individuals, companies under the Commercial Act, or entities which are not a judicial person may not obtain the registration.
In regard to deciding and executing qualifications of or requirements for members in the entities, a person who seeking to be a member of the entity shall not be barred or limited to be a member of the entity.

3) Procedures of Application to Register a Collective Mark for a GI

A judicial person, who qualified an application for registration, such as producers’ organization, submits the application along with documentary evidence to the Korean Intellectual Property Office. After submitting the application, the person pays registration fees if a decision whether the registration would be obtained through an examiner’s examination procedure is made.

4) Examination of Application for Registration of Collective Mark

Like applications for registration of common collective marks, examiners in the Korean Intellectual Property Office examine whether the application is suitable to obtain the registration for a GI. All procedures of examination are same as the procedures to examine applications for ordinary trademarks and service marks.

8) Does inclusion of a protected GI as part of a trademark qualify as legal bar to the registration of such trademark?

Most of the protected GIs are conspicuous geographical indications, and these may not obtain registration for trademarks based on lack of distinctiveness. However, if the GIs, which lack distinctiveness, are combined with a trademark which has the distinctiveness, the trademark registration may be obtained. If it is a GI that is liable to misleads or deceive consumers on the quality of the goods, or if it is a GI of the origin of wines or spirits, the trademark registration may not be obtained even though the GI is a part of a trademark.

9) Do your country’s laws, e.g. trade or merchandise legislation, require the application of correct designations of origin/source on agricultural products and food-stuffs?

Korea has laws regarding indication of origin as follow.

**Customs Duties Act**

Goods which are falsely marked origin or are not marked origin may be withheld of the customs clearance.

**Foreign Trade Act**

Any trader or seller of exported and imported goods required to have marks of origin shall mark the origin of those goods. The followings are prohibited:

1) Act of giving any false or misleading indication of origin,
2) Act of damaging or modifying the indication of origin, and
3) Act of not indicating the origin on the goods requiring such indication.

In case any person violating the indication method of origin above, a penalty surcharge, such as criminal penalty and seizure, may be imposed, and it may also be ordered to take corrective measures.

**Act on the Investigation of Unfair International Trade Practices and Remedy Against Injury to Industry**

The following goods are defined as “Unfair International Trade Practices.”

1) Goods, etc., whose marks of origin are false or misleading;
2) Goods, etc., whose marks of origin are damaged or modified; or
3) Goods requiring a mark of origin that are not marked.
Where the Trade Commission determines that unfair international trade practices have occurred, the Trade Commission may recommend that the Ministry of Commerce, Industry and Energy impose a penalty upon the offender.

**Agricultural Products Quality Control Act**

The Minister of Agriculture and Forestry shall, if proscribed by the Presidential Decree as necessary for the establishment of sound distribution order, etc., have those who sell or process any agricultural products or processed goods thereof mark the place of origin. The following acts are prohibited.

1) An act of falsely marking the place of origin or the place of origin for the purpose of leading to misunderstanding;

2) An act of impairing or changing the mark of the place of origin for the purpose of leading to misunderstanding; and

3) An act of selling any agricultural products or processed goods thereof while disguising their places of origin, or selling any agricultural products or their processed goods carrying the mark of their place of origin mixed with other agricultural products or their processed goods, or storing or exhibiting them for the purpose of selling.

**Quality Control of Fishery Products Act**

Any person who produces, processes, ships, sells the fishery products, and processed fishery products, or keeps and displays them for the purpose of selling, shall indicate the place of origin of raw materials the fishery products and processed fishery products. The following acts are prohibited.

1) An act of falsely indicating the place of origin or of making an indication which may lead to a confusion of their identity;

2) An act of damaging or altering the indications of place of origin for the purpose of leading to their confusions; and

3) An act of mixing the fishery products or processed fishery products carrying the indication of place of origin with other fishery products or processed fishery products.

**Unfair Competition Prevention and Trade Secret Protection Act**

The followings are “unfair competition acts.”

- An act of misleading the public to understand the place of origin of any goods either by falsely marking that place on any commercial document or communication, in said goods or any advertisement thereof or in any manner of misleading the general public, or by selling, distributing, importing or exporting goods bearing such false mark; and

- An act of making a mark misleading people to understand as if any goods were produced or processed in an area other than that where said goods are produced, manufactured or processed, on any commercial document or communication, in said goods or any advertisement thereof, or in any manner of misleading the general public, or an act of selling, distributing, importing or exporting goods bearing such mark.

Any person whose business profit is or might be infringed by any unfair competitive act, may file a claim before a court for the prohibition or prevention of such unfair competitive act, compensation of damages, or restoration of business credit against a person committing or attempting to do such act. A person, who commits an unfair competitive act, shall be punished by imprisonment for not more than three years or by a fine not exceeding thirty million won.
10) How are conflicts between trademarks and GIs resolved under your country’s laws? Do they co-exist or does either the trademark or GI prevail? Is there a rule for determining whether the trademark or GI should prevail, and what are the criteria to take into account (e.g. the “first in time, first in right”-rule, the reputation of the geographic region or the reputation of the trademark, the length of time that the name has been used to indicate the geographic region and the extent of such usage, the length of time that the trademark has been used and the extent of such usage)?

An example or case regarding conflict between trademarks and GIs has never been reported yet. This resulted from that the registration for GIs and a collective mark for GIs have different purpose and function and is complementary in that the registration for GIs is a kind of quality certification while a collective mark for a GI is protected as an exclusive right under the Trademark Act.

II) Proposals for adoption of uniform rules

The Groups are invited to put forward any proposals for adoption of uniform rules regarding the relationship between trademarks and GIs. More specifically, the Groups are invited to respond to the following questions:

11) Should countries provide for registration systems dealing specifically with GIs? If so, what should the key features of such system be? Should a multilateral system of registration of GIs be established? If so, what should the key features of such multilateral system be? Specifically, which international body should be tasked with establishing such system? How should the application for or registration of a GI be notified/made public (either in your country or at a multilateral level) in order to avoid that a trademark may conflict with a GI previously unknown to the trademark owner?

Korea has never had a strong opinion that registration for GIs is required, and registration systems for GIs regarding agricultural and fishery products as quality certifications have been effective. Further, collective marks for GIs can be registered and protected by the amendment of the Trade Act on July 1, 2005. Therefore, there are currently not big considerations to protect a GI as a separate system from the system for GIs under the Trademark Act.

Our opinion however, is that Korea should harmonize its laws in accordance with the international trend which seeks lengthening protection for GIs.

12) Do you have any suggestions as to the acquisition, maintenance, scope and enforcement of GI protection? What should the scope of protection of a GI be? Should the legal rules established for appraising the acquisition, maintenance, scope and enforcement of trademark protection apply to the appraising of the acquisition, maintenance, scope and enforcement of GI protection?

No specific opinion.

13) Should a protection of GIs by individual and/or collective or certification marks be possible?

It should be possible, but adjusted in order to do not conflict.

14) How should conflicts between trademarks and GIs be resolved? Please propose a specific rule for determining whether trademark or GI should prevail, which is likely to be broadly accepted. If co-existence is contemplated, should such co-existence be limited to the country of origin or relate to the relevant markets?

Our group hopes to be introduced a system which specially protect GIs which are necessary to be protected with basis of protection as a system for trademark. A treaty and establishment or amendment of law of each member States in accordance with the treaty may be a way to resolve the conflict.
Summary

Korea has no general registration system for GIs, except for the registration system for GIs on agricultural and fishery products. Such registration system for GIs is not to protect GIs as a concept of a property (a possessive right) but to certificate the quality of the products. By protecting a collective mark for GIs under the Trademark Act since July 1, 2005, the registration system became complementary and GIs may be protected as a trademark which is a kind of property. These two systems are complementary in the purpose and functional aspects, and there is no report of problem by confliction between protection of GIs and trademarks.

Korean laws have provisions to force indicating origin and restrict if the origin is falsely marked or it is not indicated. Korea has never had a strong opinion that registration for GI is required, and protection of GIs as more than a quality certification became possible after the system to protect GIs as collective marks became effective. However, Korea should harmonize its laws in accordance with the international trend which seeks lengthening protection for GIs.

Résumé

La Corée n'a aucun système d'enregistrement général pour des Indications de Provenance Géographique (IPG). L'IPG sur les produits agricoles et de la pêche constitue la seule exception. Un tel système d'enregistrement pour l'IPG ne doit pas protéger l'IPG en tant que propriété mais délivrer un certificat la qualité des produits. En protégeant une marque collective pour des IPG par la “loi sur la marque fabrique” coréenne du 1er juillet 2005, le système d’enregistrement est devenu complémentaire et l'IPG peut être protégé comme marque déposée qui est un genre de propriété. Ces deux systèmes sont l'un pour l'autre complémentaires dans le but et les aspects fonctionnels. Et il n'y a aucun problème de conflit entre la protection des IPG et les marques déposées.

La loi coréenne prescrit impérativement l’indication de provenance de produit. La Corée n’a jamais eu une opinion forte que l’enregistrement des IPG est exigé. Et la protection des IPG est devenue plus qu’une question de certification de qualité. Puisque les nouvelles dispositions de la “loi sur la marque fabrique” protègent l’ IPG en tant que marques collectives. Cependant, la Corée devrait modifier les lois en vue de l’harmonisation avec la tendance internationale qui cherche à accorder une grande protection.

Zusammenfassung


Das Koranische Gesetz schreibt die Angabe der Produktkernheit zwingend vor und versucht, die falsche Herkunftsangabe und gar die Nichtangabe der Herkunft zu beschränken. Korea vertrat bisher nie stark die Meinung, dass die Eintragung der GH erforderlich sein soll. Der Schutz der GH wurde nun mehr als eine Frage der Qualitätsbeschneinigung, weil die neuen Vorschriften des Markengesetzes GH als kollektive Marke schützen. Korea sollte die Gesetze und Regelungen zum Zwecke der Harmonisierung mit der internationalen Tendenz ändern, die einen weitergehenden Schutz zu gewähren sucht.