

PATENT COURT OF KOREA

FOURTH DIVISION

DECISION

Case No. 2015Heo8417 Rejection (Trademark)
Plaintiff A
United States of America
Counsel for Plaintiff Attorney Heegyeong JO
Defendant Commissioner of the Korean Intellectual Property
Office (KIPO)
Counsel for defendant Seokjo JEONG
Date of Closing Argument March 11, 2016
Decision Date April 8, 2016

ORDER

1. The Plaintiff's claim is dismissed.
2. The cost arising from this litigation shall be borne by the Plaintiff.

PLAINTIFF'S DEMAND

The IPTAB Decision 2014Won6452, October 23, 2015 shall be revoked.

OPINION

1. Background

A. Claimed Trademark or Service Mark

- 1) Composition: **That's Good Science**
- 2) International registration date (date of application for trademark registration)/

international registration number: March 14, 2013/ No. 1161872

3) Designated goods/ services

a) **Class 1 under Classification of Goods:** Reagents for scientific or medical research use, namely, enzymes, nucleic acids, nucleotides, proteins, antibodies, buffer solutions, biological reagents, or biochemicals and conjugates used in molecular biological laboratories; and kits comprised of reagents for scientific or medical research use, namely, buffer solutions, biological reagents, or biochemicals and conjugates used in molecular biological laboratories; and chemical reagents (other than for medical or veterinary purposes); unprocessed resins¹⁾

b) **Class 42 under Classification of Services:** Laboratory research services in the field of molecular biology

4) Holder of international registration: Plaintiff

B. IPTAB Decision

1) As the Plaintiff filed an international application for **That's Good Science**, which is the Claimed Trademark/Service Mark, with the United States Patent and Trademark Office under the Protocol of the Madrid Agreement Concerning the International Registration of Marks (hereinafter the "Protocol"), the Claimed Trademark/Service Mark was internationally registered by the International Secretariat of the World Intellectual Property Organization (WIPO) on March 14, 2013. The Korean Intellectual Property Office, which was one of designated countries in the international application (Plaintiff's Exhibit 2), then proceeded with examination of the application for trademark registration.²⁾

1) The international application originally stated the underlined as "reagents used in biological or biochemical laboratory procedures, namely, chromatographic separation and purification" but was finally corrected as stated by the Plaintiff's written opinion and amendment on April 10, 2014, as shown below.

2) On February 12, 2014, the examiner of the Korean Intellectual Property Office notified, through the International Secretariat, the Plaintiff of a provisional refusal *ex officio* (Plaintiff's Exhibit 3) to the effect that "the Claimed Trademark or Service Mark only indicates the quality and effect of goods and is perceived as a slogan or catch phrase, and thus has no distinctiveness to consumers. Also, a portion of the designated goods is not specified or too extensive in terms of definition. Thus, the Claimed Trademark or Service Mark violates Article 6(1)(iii), Article 6(1)(vii), and Article 10(1) of the Trademark Act."

3) On April 10, 2014, the Plaintiff submitted a written opinion and amendment. However, on September 18, 2014, the examiner of KIPO rendered a decision to reject (Plaintiff's Exhibit 4) on the ground that "the amendment resolved the ground for rejection under Article 10(1) of the Trademark Act in relation to the designated goods. However, the Claimed Trademark or Service Mark directly indicates the properties (quality, effect, etc.) of the goods and therefore has no distinctiveness, and is also a non-distinctive mark as being perceived as a slogan or catch phrase. Thus, the Claimed Trademark or Service Mark cannot be registered under Article 6(1)(iii) and (vii) of the Trademark Act."

4) Then, the Plaintiff filed a petition for an administrative appeal against the rejection decision to the IPTAB. The IPTAB heard the petition as Case No. 2014Won6452 and, on October 23, 2015, rendered the IPTAB Decision

2) Under Article 86-14(1) of the Trademark Act, an international application that has been registered internationally in accordance with the Madrid Protocol, and which has indicated the Republic of Korea as a designated country, shall be deemed an application for trademark registration under this Act. Under paragraph (2), the date of international registration under Article 3(4) of the Madrid Protocol shall be deemed the filing date of an application for trademark registration under this Act. Thus, the filing date of the application for trademark registration of the Claimed Trademark or Service Mark shall be March 14, 2013.

(Plaintiff's Exhibit 1) to dismiss the Plaintiff's petition for trial on the ground that "since the Claimed Trademark or Service Mark indicates a slogan or a catch phrase for the designated goods or services, a source of the designated goods or services could not be identified. Also, since everyone wants to use these kinds of marks, it would be against the public interest to grant an exclusive right therein to a specific person. Thus, the Claimed Trademark or Service Mark falls under Article 6(1)(vii) of the Trademark Act and thus cannot be registered even without examining other grounds."

2. Whether IPTAB Erred

A. Summary of Plaintiff's Arguments

The registration of the Claimed Trademark or Service Mark shall not be rejected on the following grounds; however, the IPTAB decided that it was reasonable to render a decision for rejection of the Claimed Trademark or Service Mark, and thus the IPTAB Decision shall not be upheld.

1) **That's Good Science**, which is the Claimed Trademark or Service Mark, is not a slogan or a motto used by everyone. Rather, only the Plaintiff uses the Claimed Trademark or Service Mark. Thus, it shall be deemed, in light of the course of trade, that the Claimed Trademark or Service Mark is distinctive in relation to the designated goods and services. Therefore, the Claimed Trademark or Service Mark is not a mark without distinctiveness under Article 6(1)(vii) of the Trademark Act.

2) Also, "Science" in the Claimed Trademark or Service Mark is a word widely used in various fields, such as the natural sciences, humanities, social science, etc. However, it is difficult to deem that if the Claimed Trademark or Service Mark is used in reagents, etc. among the designated goods, general

consumers would instinctively perceive its meaning. Therefore, the Claimed Trademark or Service Mark is not even a descriptive mark under Article 6(1)(iii) of the Trademark Act.

3) Even if it is assumed that the Claimed Trademark or Service Mark is not distinctive in itself, the Claimed Trademark or Service Mark came to be perceived among domestic consumers and traders as indicating a source of the Plaintiff's goods as the Plaintiff continued to use the Claimed Trademark or Service Mark in its goods, pamphlets, leaflets, homepage, etc. Therefore, the Claimed Trademark or Service Mark would be able to be registered in accordance with the provisions for acquired distinctiveness based on use under Article 6(2) of the Trademark Act.

B. Applicability of Article 6(1)(vii) of Trademark Act

1) Standard of judgment

Article 6(1)(vii) of the Trademark Act stipulates that a trademark which is unrecognizable for consumers to identify which goods related to whose business it indicates, i.e. a trademark without special significance, cannot be registered. Here, whether the Claimed Trademark or Service Mark falls under Article 6(1)(vii) of the Trademark Act would be determined depending on whether general consumers could perceive the source of its designated goods or services.

Where a trademark or a service mark for which an application is filed does not indicate a source of its designated goods or services but is recognized as a slogan or a catch phrase commonly used in a marketplace, thus making it unreasonable to grant an exclusive right therefor to a specific person, its registration shall be rejected under Article 6(1)(vii) of the Trademark Act.

Meanwhile, even if it seems that a certain mark is not especially significant

in light of its own meaning or relationship with designated goods or services, etc. without considering its state of usage, the mark would not correspond to a mark without special prominence under Article 6(1)(vii) of the Trademark Act, unless there are special circumstances, provided that, as an applicant uses the mark, consumers or traders come to prominently perceive that the mark indicates goods related to someone else's business.³⁾ Also, in this case, whether a mark is perceived as prominent shall be determined, in principle, at the time of registration or rejection. Where the registration of a mark is determined by administrative appeal against the rejection decision, whether the mark is perceived as prominent shall be determined when the decision from the appeal is rendered.

2) Objective distinctiveness

It shall be deemed that the Claimed Trademark or Service Mark corresponds to a mark for which, in relation to the designated goods and services, consumers could not identify which goods it indicates and to whose business they are related, and that it would be against the public interest to grant an exclusive right therein to a specific person in light of the following circumstances:

a) **That's Good Science** is a word mark composed of four English words. In light of levels of diffusion and education of the English language as of March 14, 2013, which is the filing date of the application for

3) In this case, the Plaintiff argues that Article 6(2) of the Trademark Act should apply. However, Article 6(2) of the Trademark Act only applies to Article 6(1)(iii) through (vi), and excludes Article 6(1)(vii) from the scope of its application. This is because where a mark without special prominence stipulated by Article 6(1)(vii) of the Trademark Act acquires distinctiveness based on use, it shall be deemed that the mark would no longer correspond to a mark without distinctiveness and thus could be registered. Thus, the Plaintiff's argument for having distinctiveness under Article 6(2) of the Trademark Act shall be understood and construed to argue that as the Claimed Trademark or Service Mark acquires its own distinctiveness based on use, it would no longer fall under Article 6(1)(vii) of the Trademark Act.

trademark registration, it seems that even middle school students could understand that the Claimed Trademark or Service Mark means “that is good (useful) science.”

b) The designated goods and services of the Claimed Trademark and Service Mark are “reagents for scientific or medical research use, namely, enzymes, nucleic acids, nucleotides, proteins, antibodies, buffer solutions, biological reagents, or biochemicals and conjugates used in molecular biological laboratories; and kits comprised of reagents for scientific or medical research use, namely, buffer solutions, biological reagents, or biochemicals and conjugates used in molecular biological laboratories; and chemical reagents (other than for medical or veterinary purposes); unprocessed synthetic resins” and “laboratory research services in the field of molecular biology.” That is, the designated goods and services of the Claimed Trademark and Service Mark are all closely related to experiments and research activities in scientific or medical fields. Also, the Claimed Trademark or Service Mark contains no distinctive composition not related to the quality or effect of the designated goods or services of the Claimed Trademark or Service Mark.

c) Thus, in relation to the designated goods or services of the Claimed Trademark or Service Mark, it is highly likely that general consumers or traders who encounter the Claimed Trademark or Service Mark would perceive it only as a slogan or a catch phrase to mean that “that is good (useful) science.” Also, since everyone in the relevant industry surely wants to use this slogan or catch phrase in advertising goods or services, etc., it would not be desirable in terms of the public interest to grant an exclusive right therefor to a specific person.

d) On the other hand, according to statements in Plaintiff’s Exhibit 5, if a

search is performed via “Google (<http://www.google.co.kr>)” with “That’s Good Science” as a keyword, which is the Claimed Trademark or Service Mark, the Plaintiff’s homepage or a number of materials related to the Plaintiff would be presented as search results. However, it cannot be decided, only with these circumstances, that only the Plaintiff uses the expression “That’s Good Science,” as the Plaintiff argues. That is, according to the results of a search performed via Google, content that seems not to be related to the Plaintiff also appears. Also, according to statements or images in Defendant’s Exhibits 5 through 7, the expression “Good Science” has been commonly used in a variety of contexts in relation to properties, etc. of science.

3) Acquired distinctiveness

Furthermore, it is difficult to deem that the Claimed Trademark or Service Mark came to be perceived as the indication of a source of goods or services on the following grounds:

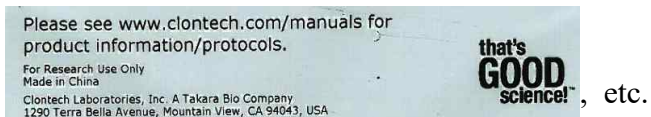
a) First, according to statements or images in Plaintiff’s Exhibits 8 through 12 (omitting hyphenated numbers; hereinafter the same shall apply), it is admitted that the reagents, chemicals, etc. that the Plaintiff manufactured have been sold in Korea through Takara Korea Biomedical Inc. (hereinafter, “Takara Korea”) and the phrase “That’s Good Science!” has been indicated on wrappers, leaflets, shopping bags, calendars, etc.

b) Meanwhile, according to statements in Plaintiff’s Exhibit 9, product


names, such as **Terra™ qPCR Direct SYBR® Premix**, **SMARTer® Ultra™ Low Input RNA Kit for Sequencing-v3 Components**, etc.,

and marks indicating the Plaintiff’s company name, such as ,

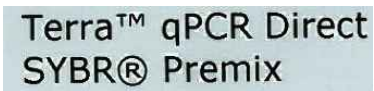
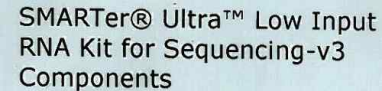
etc., are displayed at the top of product wrappers that the Plaintiff sold in Korea, and phrases like the Claimed Trademark or Service Mark have been displayed next to the Plaintiff's homepage address, such as




c) Where a mark indicating a source of products, such as an indication of a product name and manufacturer is specified separately at the top of product wrapper as shown above, if a phrase that seems not particularly distinctive, such


as , is displayed together at the bottom corner, it is likely that


consumers or traders would perceive  as a product name, such as

 ,  , etc., or a source of

goods, such as  , rather than as a separate source. This is even so in light of the fact the consumers or traders of the Plaintiff's goods are mostly persons who are engaged in experiments and research in the fields of science or medicine.

d) In addition, according to statements and images in Plaintiff's Exhibits 10-1 through 8, the Plaintiff added phrases of the Claimed Trademark and

Service Mark, such as  , at one corner of most of leaflets and flyers with product names, such as "Mupid-One", "LONZA Agarose", "TaKaRa Ex Taq", "VECTOR", "TaKaRa PCR Thermal Cycler Dice", "SMART-Seq", "Cellartis",

TakaRa  Clontech, etc., on most of leaflets and flyers. However, the figures are mixed with other advertisements, such as product names, explanations about the quality or superiority of products, etc. The general consumers who encounter the leaflets or flyers would perceive the figures not as an indication of a source of goods but as an indication of advertisement of goods.

e) In particular, the “Introduction” on the homepage of Takara Korea

Biomedical Inc. specifies the fact that the Claimed Trademark or Service Mark



is the “slogan” of the Plaintiff, i.e.

. Also, the Plaintiff’s

homepage (Plaintiff’s Exhibit 6-3) also explains the concrete meaning of “Good Science”: “Good science may be understated. It might not be flashy. But it makes a difference. It opens up new possibilities. It informs. It inspires. It creates ... We strive every day to be good partners, because good science needs great support.” That is, it seems that the Plaintiff uses the Claimed Trademark or Service Mark as a slogan or a catch phrase to inform consumers or traders of its company image to support the “Good Science” and specifically stress the same.

f) Even though some general consumers or traders may accept the phrase “That’s Good Science” not as a slogan or a catch phrase of the Plaintiff but as an indication of a source of goods or services, the Plaintiff failed, in this case, to submit materials with which the following could be confirmed objectively: the period, number of times, and continuity of use of the Claimed Trademark or Service Mark; turnover and market share using the Claimed Trademark or Service Mark; and the number of times, contents, period, amount, etc. of advertisement and publicity. Thus, it may not be deemed that the Claimed Trademark or Service Mark was prominently perceived as being distinctive as a source of its designated goods or services by the general consumers or traders in

Korea as of the IPTAB Decision or the date on which the Claimed Trademark or Service Mark was rejected.

3. Conclusion

Therefore, the Claimed Trademark or Service Mark falls under Article 6(1)(vii) of the Trademark Act and could not be registered, even without examining the remaining facts further. Thus, the IPTAB Decision is consistent with the above analysis and shall be upheld. Therefore, the Plaintiff's claim to revoke the IPTAB Decision is without merit.

Presiding Judge	Chungsuk LEE
Judge	Hosan LEE
Judge	Kisu KIM