

PATENT COURT OF KOREA

FIFTH DIVISION

DECISION

Case No. 2016Heo8261 Rejection (Trademark)
Plaintiff A
United States of America
Counsel for Plaintiff Attorney Hoegi LEE
Defendant Commissioner of KIPO
Counsel for defendant Seokjo JEONG
Date of Closing Argument February 24, 2017
Decision Date March 17, 2017

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 2015Won3160, September 7, 2016 shall be revoked.

OPINION

1. Background

A. Plaintiff's Claimed Trademark

1) Application number/Filing date of application: No. 40-2014-29074/April 29, 2014.


2) Mark at Issue: **숲속의 콘체르토**

3) Designated goods: Air refreshers for household purposes, air fragrances for

household purposes, scented fabric refreshers for household purposes in a form of scented spray in Class 3 under Classification of Goods

B. Prior-registered Mark

1) Registration number/Filing date of application/Date of registration/Registration date of extension: No. 240388/March 28, 1991/June 9, 1992/May 15, 2012

2) Mark at Issue: The image shows the prior-registered mark, which consists of the Korean text '콘체르토' (Koncheureuto) above the English word 'CONCERTO' in a bold, sans-serif font.

3) Designated goods: Perfumes, eye shadows, skin lotions, cleansing lotions, lipsticks, foundation creams, lavender oil, joss sticks, and cosmetic creams in Class 3 under Classification of Goods

4) Registered right holder: C Co., Ltd.

C. IPTAB Decision

1) On May 7, 2015, an examiner of KIPO decided to reject registration on the ground that “since ‘콘체르토’, which is a principal part of the Claimed Trademark, and the Prior-registered Mark have similar marks and identical or similar designated goods, the Claimed Trademark falls under Article 7(1)(vii) of the old Trademark Act (prior to being generally amended by Act No. 14033, February 29, 2016; hereinafter the same shall apply).” On June 2, 2015, the Plaintiff filed a petition for administrative appeal (2015Won3160).

2) On September 7, 2016, the IPTAB rendered its decision to dismiss the Plaintiff’s petition on the ground that “where the Claimed Trademark is abbreviated to ‘Concerto’, its sound and meaning would be identical or similar to those of the Prior-registered Mark. Thus, the Claimed Trademark falls under Article 7(1)(vii) of the old Trademark Act and shall not be registered.”

[Factual basis] Undisputed facts, statements in Plaintiff’s Exhibits 1 through 4, and purport of the overall argument

2. Summary of Plaintiff’s Argument for Revocation of IPTAB Decision

A. The Claimed Trademark combines “^{^^}^^” in the former part with “^{^^}^^” in the latter part and thus forms a new meaning, such as “the sound of various forest animals creating an illusion of being in a concert.” Since the Claimed Trademark will be referred to and conceived as “^{^^}^^ ^{^^}^^” in its entirety, its sound and meaning are not similar to those of the Prior-registered Mark, and thus there is no likelihood that general ordinary consumers or traders would misconceive or confuse the source of the goods.

B. Thus, since the Claimed Trademark does not fall under Article 7(1)(vii) of the old Trademark Act in terms of its relationship with the Prior-registered Mark, the IPTAB decision, which was inconsistent with the above analysis, shall not be upheld.

3. Whether Claimed Trademark Falls Under Article 7(1)(vii) of Old Trademark Act

A. Relevant Laws

In the case of a composite trademark that is composed of two or more letters, whether such a trademark is similar shall, in principle, be determined based on sight, sound, and meaning of the mark in its entirety. However, where the trademark has a primary part that functions to indicate a source of goods independently by making general consumers remember or associate the trademark with, it is required to compare and determine similarity by comparing the primary part, to come to a proper conclusion by overall observation. A primary part in a trademark shall be subject to comparison in determining whether a trademark is similar with other trademarks due to its own distinctiveness for it be distinctively perceived by general consumers irrespective of its other components. Where a trademark contains a primary part, it can be determined whether trademarks are similar by comparing only the primary part without the need to determine whether the primary part can be viewed separately (see e.g., Supreme Court Decision 2015

Hu1690, February 9, 2017).

In the case of a composite trademark composed of a noun modified by an adjective, the noun could in principle be a primary part. However, by combining an adjective and a noun, a new word with an independent meaning or new concept could be coined, or it could function as an identifier only in its entirety by being perceived or used only in its entirety in an actual marketplace. Thus, it could not be concluded that a noun is necessarily a primary part. Thus, in this case, it shall be determined, in light of the following, which part of the components in the composite trademark is a primary part: the overall structure and shape of the composite trademark; which part among the adjective and the noun is distinctive and accounts for a high proportion in its relation to the designated goods; where both an adjective part and a noun part are distinctive, which part has a stronger distinctiveness; whether an adjective part and a noun part are indivisibly combined to a degree to be perceived as unnatural; the structure, shape, and weight of components, such as concept, sound, etc. to be perceived and used in an actual marketplace; relative difference in its distinctiveness compared with other components; state and degree of its combination with other components; its relationship with designated goods; course of trade; etc.

B. Whether Marks Are Similar

1) Primary part of Claimed Trademark

If, before determining whether the Claimed Trademark is similar with the Prior-registered Mark, it is examined whether the “^ㄱ체르토” part of the Claimed Trademark is a component that could identify the designated goods from other products, independently from the “^{^^}아” part, it would be reasonable to deem that the primary part of the Claimed Trademark is the “^ㄱ체르토” part.

① The “^{^^}아” in the former part of the Claimed Trademark is suggestive of a “natural scent or cool scent.” This word is an adjective with weak

distinctiveness in relation to air refreshers for household purposes, etc., which constitute a portion of the designated goods of the Claimed Trademark.

② In relation to designated goods, such as air refreshers, air refreshers for household purposes, etc., which are identical or similar to the designated goods of the Claimed Trademark, the following had already been registered: “^{ㅅㅅ}하_ㅅ” (Trademark Registration No. 0819102, registered February 25, 2010); “^{ㅅㅅ}의 샴” (Trademark Registration No. 0398062, registered February 24, 1998); “^{ㅅㅅ}애플” (Trademark Registration No. 0905414, registered December 20, 2011); “^{ㅅㅅ}하_ㅅ ^{ㅅㅅ}” (Trademark Registration No. 1115437, registered June 23, 2015); and “^{ㅅㅅ}의 바람” (Trademark Registration No. 0733993, registered December 17, 2007). Thus, in relation to goods identical or similar to the designated goods of the Claimed Trademark at the time of the application for the Claimed Trademark, the “^{ㅅㅅ}의” in the former part of the Claimed Trademark has weak distinctiveness in identifying the designated goods from other products.

③ The “^ㄱ첼레토” in the latter part of the Claimed Trademark is a phonetic spelling of “concerto.” This means an instrumental piece composed for orchestral instruments and a solo instrument with showy playing techniques. The “^ㄱ첼레토” part has strong distinctiveness in relation to the designated goods, such as air refreshers, etc. identical or similar to the designated goods of the Claimed Trademark.

④ In relation to the designated goods of the Claimed Trademark, “^{ㅅㅅ}의 ^ㄱ첼레토”, which is the Claimed Trademark, combines the “^{ㅅㅅ}의” part, having weak distinctiveness, with the “^ㄱ첼레토” part, having strong distinctiveness. The “^{ㅅㅅ}의” in the former part is merely an adjective that modifies the “^ㄱ첼레토” in the latter part. Thus, the Claimed Trademark means a “concerto played in the forest” and thus fails to have an independent meaning beyond the combination of the meanings of the two words or the formation of a new concept.

⑤ The Claimed Trademark is composed of seven syllables, and the “^{ㅅㅅ}의” part is separated from the “^{콘체르토}” part with a space. Thus, in relation to the designated goods, it seems that the general consumers would refer only to the “^{콘체르토}” part, which is highly distinctive, rather than “^{ㅅㅅ}의 ^{콘체르토}” in its entirety.

⑥ The Plaintiff argues that the Claimed Trademark is perceived only in its entirety at all times under the course of trade. However, Plaintiff’s Exhibit 8, which seems to support the Plaintiff’s arguments, shows only a portion of the results of a search for the keywords “^{페브리즈} ^{ㅅㅅ}의 ^{콘체르토}.” Thus, it is difficult to view that Plaintiff’s Exhibit 8 shows how the Claimed Trademark is actually used in a marketplace. Also, with only the statements in Plaintiff’s Exhibits 6 and 7, it is difficult to admit that the Claimed Trademark was perceived and used only in its entirety at all times under the course of trade. Also, there is no other evidence to admit the same.

⑦ The Plaintiff argues that since the Claimed Trademark combines “^{ㅅㅅ}의” in the former part with “^{콘체르토}” in the latter part and thus forms a new concept, such as “the sound of various forest animals creating an illusion of being in a concert,” the Claimed Trademark will be referred to and conceived as “^{ㅅㅅ}의 ^{콘체르토}” in its entirety. However, as examined above, it does not seem that the general consumers would particularly conceive, as the Plaintiff argues, the Claimed Trademark as exceeding the meaning of “a concerto played in the forest.”


⑧ The Plaintiff argues that even if the “^{ㅅㅅ}의” part in the Claimed Trademark has weak distinctiveness in relation to the designated goods, the “^{ㅅㅅ}의” part together with the “^{콘체르토}” part would have distinctiveness in its entirety, and thus would be subject to observation in its entirety. Indeed, words such as “PROJECT,” “HOUSE,” etc., which the Plaintiff uses as a partial example, are easily perceived as comprehensive and general words by the general consumers and thus can form a new concept by combining with another modifier. However,

the word “콘체르토” is not a comprehensive and general word that would be perceived as “one word” that is combined with a modifying word preceding it, and thus has a restricted meaning. In particular, as examined above, in relation to its relationship with the designated goods of the Claimed Trademark, the “콘체르토” part has particularly strong distinctiveness, while the “악” part has weak distinctiveness. Thus, the “콘체르토” part is a primary part which forms independent distinctiveness such that it is noticeably perceived by the general consumers, irrespective of other components. Thus, the Plaintiff’s arguments above are not accepted.

2) Comparison of Claimed Trademark and Prior-registered Mark

a) Comparison of sight

“숲속의 콘체르토”, which is the Claimed Trademark, is a Korean mark composed of seven syllables. On the other hand,


“CONCERTO”, which is the Prior-registered Mark, is composed of “콘체르토” and “CONCERTO” written above and below. Since both marks are different in the number of characters, composition, etc., they are not similar in terms of sight.

b) Comparison of sound and meaning

As examined above, where the Claimed Trademark is pronounced and conceived only with the “콘체르토” part, which is a primary part, its sound is identical to that of the Prior-registered Mark, and its meaning is also identical to “concerto, instrumental piece, etc.”

3) Result of Comparison

Thus, the Claimed Trademark and the Prior-registered Mark are identical in terms of sound and meaning, which play an important role in a marketplace. If

the Claimed Trademark and the Prior-registered Mark are used together in identical or similar goods, there is a likelihood that general ordinary consumers or traders would misconceive or confuse the source of the goods. Thus, the two marks are similar.

C. Whether Designated Goods Are Identical or Similar

The designated goods of the Claimed Trademark are “air refreshers for household purposes, air fragrances for household purposes, scented fabric refreshers for household purposes in a form of scented spray.” On the other hand, the designated goods of the Prior-registered Mark are “lavender oil, joss stick.” Since the designated goods of the Claimed Trademark and the Prior-registered Mark fall under “scented materials, such as natural perfumery, air refresher, etc.” in Class 3 of the Category of Goods, the goods of the two are identical or similar.

D. Summary

The Claimed Trademark is identical or similar to the Prior-registered Mark, and the designated goods thereof are identical or similar. Thus, the Claimed Trademark falls under Article 7(1)(vii) of the former Trademark Act.

4. Conclusion

The IPTAB decision is consistent with the above analysis and shall be upheld. The Plaintiff’s claim to revoke the IPTAB decision is without merit and therefore dismissed.

Presiding Judge

Youngjoon OH

Judge

Dongju KWON

Judge

Donggyu KIM