

IP HIGH COURT OF KOREA

SECOND DIVISION

DECISION

Case No. 2023Heo10361 Rejection (Trademark)

Plaintiff A

Counsel for Plaintiff Intellectual Property Law Firm ERUUM & LEEON

Patent Attorney in Charge Hyeokseong KWON and Seongjun PARK

Defendant Commissioner of the Korean Intellectual Property Office

Counsel for Defendant Yulgeon SHIN

Date of Closing Argument September 20, 2023

Decision Date October 27, 2023

ORDER

1. The plaintiff's claims are dismissed.
2. The cost arising from this litigation shall be borne by the plaintiff.

PLAINTIFF'S DEMAND

The IPTAB Decision 2021Won2107 dated December 28, 2022 shall be revoked.

OPINION

1. Background

A. Claimed Trademark at Issue

1) Filing date of application / Application number: September 3, 2021 / No. 40-2021-0024052



2) Mark:

3) Designated goods:

- Classification 16: Stationery, office supplies (excluding furniture), school supplies, paper advertisement boards for wall decoration, calendars, printed photographs, developed photographs, stickers, double-sided stickers, memo pads, albums, printed materials (excluding books and periodicals), books, publications, posters, periodicals, ballpoint pens, printed pictures, comic-printed materials, comic books, serialized comics, file folders

- Classification 35: Online marketplace services, promotion/advertising services, online advertising and marketing services, promotion and marketing services related to products and services accessible online, marketing services via the Internet, product and service promotional agency services via the Internet, wholesale of clothing, retail of clothing, wholesale of cosmetics, retail of cosmetics, organizing and conducting commercial exhibitions and shows, promotion through issuing prize coupons, advertising/marketing and promotional services, advertising in the tourism and travel sector, magazine advertising services, advertising related to cultural projects, advertising related to the entertainment business, promotion and marketing related to cultural projects, promotion and marketing related to the entertainment business, convenience store operations, supermarket operations, wholesale of fresh vegetables, wholesale of processed grains, retail of fresh vegetables, retail of processed grains, wholesale

of stationery, retail of stationery, Internet advertising services, commercial information services via the Internet, wholesale of bedding (excluding linen), wholesale of mattress covers (bedding), retail of bedding (excluding linen), retail of mattress covers (bedding), wholesale of hats, retail of hats

B. Procedural History

1) The plaintiff applied for the registration of the trademark at issue on February 3, 2021, but the examiner of the Korean Intellectual Property Office (hereinafter, the “KIPO”) issued a notice of grounds for rejection on April 21, 2021, stating, “The claimed trademark falls under Articles 33(1)7 and 38(1) of the Trademark Act.

2) In response, the plaintiff submitted written argument on May 10, 2021. On July 15, 2021, the KIPO examiner issued a decision to reject the application stating, “While the grounds for rejection based on Article 38(1) were resolved, the trademark still falls under Article 33(1)7.”

3) Regarding the rejection, the plaintiff filed an administrative appeal on August 13, 2021 with the Intellectual Property Trial and Appeal Board (hereinafter, the “IPTAB”) as Case No. 2021Won2107. The IPTAB issued an administrative decision to dismiss the plaintiff’s appeal on December 28, 2022, concluding that “the claimed trademark falls under Article 33(1)7.”

[Factual Basis] Undisputed facts, the descriptions and images on Plaintiff's Exhibits 1 through 5, the purport of the overall arguments

2. Summary of Parties' Arguments

A. Plaintiff

The claimed trademark does not fall under Article 33(1)7 due to the following

reasons. Therefore, the administrative decision ruling otherwise is erroneous and should be revoked.

1) Since the plaintiff is a well-known and famous public figure, recognized as a politician, lecturer, broadcaster, and celebrity, the claimed trademark--a portrait--is widely recognizable among the general public in Korea. The portrait possesses inherent distinctiveness due to its association with the plaintiff. Furthermore, the plaintiff’s consistent use of the depicted hairstyle and red tie over an extended period reinforces the portrait as a well-established representation of the plaintiff. Unlike a typical identification photograph, this portrait demonstrates a high degree of distinctiveness.

2) The portrait in question qualifies for protection as a trademark since the design and the trademark are not mutually exclusive; even the portrait of a prominent individual may be registered as a trademark, provided the individual depicted consents, as stipulated under Article 34(1)6 of the Trademark Act; and the publicity rights of celebrities are safeguarded under Article 2(1)(l) of the Unfair Competition Prevention and Trade Secret Protection Act.

3) Also, considering the numerous instances in which pictures are utilized as trademarks in the marketplace, the claimed trademark functions as a distinctive indicator through which consumers associate the product with the individual whose work the trademark represents. Therefore, it does not fall within the scope of Article 33(1)7 of the Trademark Act.

4) Even if the claimed trademark is not inherently distinctive, it has been used for various products and has acquired distinctiveness through such use.

B. Defendant

The claimed mark depicts only the upper body of a middle-aged man dressed

in a black suit and red tie. In connection with products and services such as stationery, online marketplace services, wholesale and retail of cosmetics, convenience store operations, printed photographs, wholesale and retail of clothing, office supplies, school supplies, calendars, developed photographs, books, publications, posters, and promotional/advertising services, ordinary consumers are unlikely to recognize the image as a portrait of a specific individual. Consequently, the mark does not fall under Article 33(1)7 of the Trademark Act, as it fails to function as a distinctive indicator to differentiate the applicant's products or services from those of others. The acquired distinctiveness of the claimed trademark concerning the designated products listed above is not established either. Therefore, the IPTAB decision to uphold the rejection of the claimed trademark is justified.

3. Whether the Claimed Trademark Falls under Article 33(1)7 of the Trademark Act

A. Relevant Law

1) Article 33(1)7 of the Trademark Act stipulates that a trademark cannot be registered if, "other than the trademarks falling under Articles 33(1)1 to 33(1)6, consumers cannot identify whose work the product with the mark is associated with." This provision indicates that even if a trademark does not fall under the specific prohibitions outlined in Articles 33(1)1 to 33(1)6, it is not eligible for registration when it fails to function as an indicator to differentiate the applicant's goods or services from those of others. Whether a trademark lacks distinctiveness must be determined objectively, considering the mark's concept, its relationship with the designated goods, and its use in the course of trade. A trademark is deemed non-distinctive if, under social norms, it is found that the

mark does not distinguish the applicant's products from those of others or if granting exclusive rights to a specific individual would be deemed inappropriate for the public interest (See Supreme Court Decisions 91Hu455, dated December 24, 1991, 2012Hu2951, dated December 27, 2012, etc.).

2) If the claimed mark fails to meet the registration requirements for certain designated goods, the application shall be rejected in its entirety with respect to all designated goods (See Supreme Court Decision 93Hu1360, dated December 21, 1993, etc.).

3) The determination of whether the claimed mark falls under each paragraph of Article 33(1) of the Trademark Act is, in principle, made at the time of determining its registration and of the administrative decision in cases where an administrative trial against rejection is conducted (See Supreme Court Decision 2011Hu1142, dated April 13, 2012, etc.).

B. Established Facts

Based on the descriptions and videos provided in Plaintiff's Exhibits 6 through 10, 12, 16, 18, 20, and 21, as well as the overall purport of the argument, the following facts are acknowledged.

1) The plaintiff first participated in an election in 1991, running in a local election. By December 2022, shortly before the administrative decision at issue, he had run in three presidential elections, two local elections, two National Assembly elections, and one Seoul mayoral by-election. In the Seoul mayoral by-election, he ranked third with 1.07% of the vote, and in the most recent 20th presidential election, he received 289,000 votes, accounting for 0.83% of the total.

2) The plaintiff also operates several YouTube channels, including "A

Lecture,” “A Short Lecture,” “A TV,” and “Mr. A Studio.”

3) In 2009, a music album released by the plaintiff ranked first among background music on website B. Additionally, from at least February 9, 2022, or August 26, 2022, a picture resembling the claimed trademark has been used as the official profile picture in the "Figures" section on search engines such as NAVER, DAUM, and Nate.

C. Whether the Claimed Trademark is Distinctive

1) Legal principle

A) It is understood that the provisions of the Trademark Act (Article 2(1)2 and the proviso of Article 34(1)6) imply that a portrait can be utilized as a trademark. Therefore, the mere fact that the mark is a portrait photograph does not render it ineligible for trademark registration (eligibility for registration). However, the Act also specifies that a trademark cannot be registered if it lacks the "distinctiveness necessary to differentiate its products from those of others" (Article 33(1)). Thus, the distinctiveness of a portrait photograph must be evaluated comprehensively, considering not only its appearance, name, and concept but also its relationship with the designated goods, the course of trade, and the perception of ordinary consumers and traders, similar to the evaluation of other types of marks.

B) The reason Article 33(1)7 requires distinctiveness as a condition for registration is that a trademark must enable the recipient of specific goods or services to distinguish them, without confusion, from goods or services of the same source and quality, which is a fundamental function of a trademark. However, because human faces share similar basic composition and shape, a portrait photograph cannot be presumed to have distinctiveness for all designated goods uniformly. The distinctiveness of a portrait photograph, when used in

connection with specific designated goods, must be assessed on a case-by-case basis.

C) If a portrait photograph of a specific individual is inherently very unique, or if the individual is a well-known and famous figure in certain fields and the primary consumers or customers are people related to those fields, then the photograph can possess distinctiveness as a trademark. However, even in such cases, if the photograph does not reasonably indicate the source of the specific designated goods, it cannot be considered to possess distinctiveness with respect to those goods. In other words, if ordinary consumers require education or additional explanations to recognize that the mark indicates a specific source (a particular person), the mark cannot be considered inherently distinctive.

D) Article 33(1)7 of the Trademark Act serves as a supplementary provision to prevent the registration of marks that, in light of the purposes of Articles 33(1)1 through 33(1)6, are deemed unsuitable for registration (See Supreme Court Decision 93Hu1018, dated December 28, 1993). The reason Article 33(1) prohibits the registration of marks lacking distinctiveness is to serve the public interest by protecting consumers and preventing market confusion that could arise from the registration of such marks. Additionally, under the Korean legal system, a trademark may be registered for all the designated goods specified by the applicant, regardless of whether the mark has been used or the form in which it is used for specific designated goods, unless the registration is based on distinctiveness acquired through use. In summary, even if a mark is recognized as an indicator of source to consumers in certain specific modalities of use, it should not be registered for the corresponding designated goods if it lacks distinctiveness in general modalities of use.

2) Discussion

Considering the following circumstances derived from the facts above, in light of the legal principles and evaluation criteria outlined, it can be concluded that the claimed trademark lacks distinctiveness in distinguishing the applicant's products from those of others concerning its relationship with "some of the designated products" under social norms at the time of the administrative decision in question.

A) First, the claimed trademark is a portrait photograph, specifically an ID picture, and therefore lacks any distinctive features. In other words, the mark in question does not have any unique features that distinguish it from other ID pictures, whether in terms of the person's appearance, posture, clothing, or the photograph's appearance, such as composition or background. Therefore, ordinary consumers who are unfamiliar with the plaintiff or unable to recognize the subject of the photograph as the plaintiff would perceive or think the trademark simply as "a photograph of the upper body of a middle-aged man wearing a black suit and red tie."

B) Moreover, as detailed below, the evidence submitted by the plaintiff does not establish that the claimed trademark has exclusive distinctiveness with respect to all the designated goods.

(1) In the case of stationery, school supplies, and retail of stationery, while adults may not be entirely excluded as ultimate consumers who frequent such places or purchase products, minors constitute the primary consumer group for these goods.¹⁾ Based on the acknowledged facts, it is evident that the plaintiff has gained public recognition and attention by running elections many times, with the primary audience for the plaintiff's YouTube channels appearing to consist predominantly of his political supporters.²⁾ However, the evidence

1) The claimed trademark also includes "official supplies" as additional designated goods, in addition to the goods and services mentioned above.

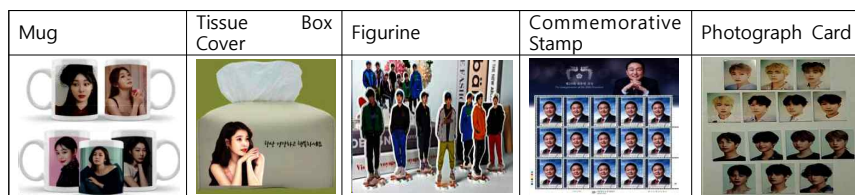
submitted by the plaintiff alone is insufficient to establish that the audience for his YouTube lectures includes people of all age groups, and there is no additional evidence to support this claim. Therefore, it cannot be concluded that the plaintiff is well-known not only among voters but also among students who are minors. Since the consumers of the designated goods mentioned above perceive the claimed mark merely as "a photograph of the upper body of a middle-aged man wearing a black suit and red tie," its use on those goods cannot be regarded as having distinctiveness sufficient to differentiate the applicant's products from those of others, particularly in relation to trademarks featuring images of other middle-aged men.

(2) For the remaining designated goods, even if the plaintiff is widely recognized by their consumers and customers, and those consumers and customers can easily distinguish the plaintiff's picture from those of others, when the claimed trademark is applied to items such as books, publications, posters, periodicals, printed photographs, developed photographs, and albums, a portrait photograph like the claimed trademark cannot reasonably be expected to function as an "indicator of source." In this case, ordinary consumers are highly likely to perceive the photograph as that of a person who authored something related to the goods or as an image intended to explain, promote, or represent the goods. In connection with the designated goods mentioned above, even if the claimed trademark does not lead consumers to instinctively think of the uses of the designated goods prescribed in Article 33(1)3 of the Trademark Act, it incorporates content that is highly related to the designated goods. As a result, consumers are generally unable to associate the goods represented by the mark

2) The plaintiff further argues that his lecture encompasses the fields of science, politics, history, economics, humanities, society, philosophy, and religion, and that through these lectures, he conveys his political views, address social issues, and share insights on humanities, religion, and philosophy. He asserts that his primary audience consists of unspecified individuals, including his supporters and fans (see preparatory document dated August 17, 2023).

with any specific source (See the legal basis of Supreme Court Decision 2000Hu1696, dated December 12, 2000). Accordingly, the claimed trademark cannot be considered to possess distinctiveness in relation to the designated goods above.

(3) The same conclusion applies when considering the course of trade for “printed photographs” and “developed photographs” among the designated goods of the claimed mark. These types of designated goods are commonly traded as “merch” featuring the actual image of a person or celebrity printed on them (Plaintiff’s Exhibits 23 and 24). In such cases, ordinary consumers are likely to perceive the image as merely a promotional element, etc. rather than as a distinctive indicator to differentiate the goods from those of others. This is because, in general, the picture on such goods does not serve to indicate the “source” of the goods and consumers who purchase “merch” featuring a particular celebrity typically do not view the picture as an indicator of source but rather as a decorative element reflecting their personal preference.



3) Discussion on the plaintiff's argument



A) Citing the “Trademark Perception Survey” (Plaintiff’s Exhibit 49) submitted as evidence, the plaintiff argues that when portraits are used on items such as photographs, posters, etc., general consumers perceive the portrait as both the image of an advertisement model and an indicator of the source of the goods. The plaintiff further contends that design elements and trademarks are not

mutually exclusive. Therefore, even a shape or form typically considered a design can function as a trademark if it performs the essential function of a trademark. Based on this reasoning, the plaintiff asserts that the claimed mark should be considered distinctive, regardless of its designated goods.


According to Plaintiff’s Exhibit 49, it is acknowledged that C Corp. conducted a survey of 500 adult men and women, aged 20 to 59, from across the country between June 12 and June 18, 2023. However, it is difficult to accept the survey results for the reasons outlined below. Furthermore, even if some of the results are deemed reliable and it is assumed that ordinary consumers perceive the portrait not only as an image of an advertisement model but also as an indicator of source, the claimed trademark cannot be regarded as an indicator of source concerning certain designated products, as seen above. Therefore, this part of the plaintiff’s argument is unfounded.

(1) The plaintiff contends that consumers perceive a portrait (or portrait photograph) as an indicator of source, citing survey results where 62.6% of respondents selected option ② (portrait trademark part) in Q2, and 55.4% selected option ③ (portrait trademark part) in Q3. However, as the two questions state, “Please assume that you have purchased other products produced or sold by the producer or seller of the product listed below,” respondents were required to speculate arbitrarily, as they lacked information about the appearance or characteristics of the “other products” and the commonalities they might share with the product, among the options provided in the questions.



Q2. Please assume that you have purchased other products produced or sold by the producer or seller of the product listed below. What aspects of the product listed below led you to	Q3. Please assume that you have purchased other products produced or made by the producer or maker of the product listed below. What aspects of the product listed below led you to
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<p>believe that the product(s) you previously purchased were produced or sold by the same entity responsible for the product listed below? Please select all that apply. [Choose all that apply]</p>	<p>believe that the product(s) you previously purchased were produced or sold by the same entity responsible for the product listed below? Please select all that apply. [Choose all that apply]</p>
	
<p>1) ① 2) ② 3) ③ 4) ④</p>	<p>1) ① 2) ② 3) ③ 4) ④</p>

(2) The plaintiff further asserts that, as 80.2% of the respondents identified one or both of the two images in Q6 as an indicator of source, portrait photographs should be considered trademarks. However, in this case, the issue is whether the claimed trademark demonstrates distinctiveness. Option ② of the survey referenced above presents a portrait photograph accompanied by the “TM” symbol as supplementary characters on the side, signifying its intended function as a trademark. Therefore, unless it can be established that the respondents perceived portrait photographs as trademarks solely based on the photographs themselves, as with the claimed trademark, the survey questions are

inadequate, and the results are unreliable. Option ① “ ” of Q7 also includes the terms “Book Publisher” and “TM” written on the side, emphasizing the unreliability of the survey results.

Q6. The following are two mugs featuring celebrity A's picture. Which of the two appears to function as a trademark, indicating the product's source? [Choose one]

<p>①</p> 	<p>②</p> 
<p>1) ① 2) ②</p>	<p>3) 둘 다 출처표시로 보임 4) 둘 다 출처표시로 보이지 않음</p>

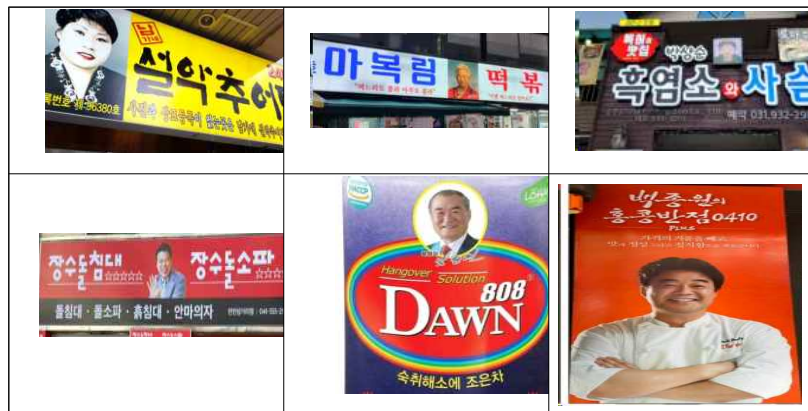
(3) The plaintiff argues that, since 87.2% of the respondents answered “yes” to the question “Do you think portrait photographs can also serve as an indicator of source?” in Q8, portrait photographs are perceived as trademarks by ordinary consumers. However, this response appears to have been influenced by the preceding questions, Q6 and Q7, which displayed portrait photographs with “TM” written on the side, leading respondents to perceive the photographs as being used as trademarks.

B) The plaintiff contends that numerous portrait photograph trademarks exist in other countries for designated goods such as stationery, photographs, and posters, serving as evidence to demonstrate that portrait photographs possess inherent distinctiveness.

Based on the descriptions of Plaintiff's Exhibits 30, 45, and 46, it is acknowledged that portrait photographs have indeed been registered as trademarks in jurisdictions such as the United States, the European Union (EU), and Japan for designated goods or services, including photographs, printed materials, stationery, and promotional/advertising services. However, while practical

examples from other countries can serve as references, the decision to approve the registration of a claimed trademark must be made independently based on the Korean trademark law and should not be bound by examples from other jurisdictions. Therefore, the plaintiff's argument above is denied.

C) The plaintiff argues that portrait photographs are frequently used as identifiers on signage, packaging, advertisements, and similar contexts, as illustrated in the photographs provided in Plaintiff's Exhibit 31. Therefore, the plaintiff asserts that the claimed trademark also possesses distinctiveness. However, the images below consist of portrait photographs accompanied by registration numbers or characters indicating the name of the person in the picture, and they were not used independently as the claimed trademark is. Thus, these examples cannot serve as evidence to demonstrate that the claimed trademark possesses distinctiveness across all the designated goods. Therefore, the plaintiff's argument above is denied.



4) The plaintiff contends that while trademarks primarily function as indicators of association for consumers, this is merely one aspect of their broader functions, such as "advertisement and promotion." Consequently, the plaintiff asserts that portrait photographs possess inherent distinctiveness, and the claimed mark should therefore be recognized as distinctive. In cases where portrait photographs are recognized as distinctive and registered as trademarks, such trademarks can serve an advertising and promotional function for the designated goods as one of their functions. However, the reverse does not hold true—that is, the ability of a portrait photograph to function in advertising and promotion does not guarantee that it possesses distinctiveness for all designated goods or meets the requirements for registration. Thus, as discussed above, the distinctiveness of a trademark must be assessed on a case-by-case basis for each designated good. Therefore, the plaintiff's argument above is denied.

D. Whether the Claimed Trademark Has Acquired Distinctiveness Through Use

1) The plaintiff argues that the claimed trademark has been used across various categories of goods, thereby acquiring distinctiveness through such use.

2) Article 33(1)7 of the Trademark Act simply stipulates that even if a mark does not fall under Articles 33(1)1 to 6, it cannot be registered if it fails to distinguish the applicant's products from those of others. Thus, even if certain trademarks may initially appear to lack distinctiveness based on their concepts or

their relationship with the designated goods when evaluated objectively without considering their usage, if, through the applicant's use of the mark, consumers or traders can identify whose work the goods are associated with, the mark would not be considered non-distinctive under Article 33(1)7 for the goods it is used with, unless special circumstances exist. Consequently, there would be no obstacle to the mark being registered. This interpretation is not altered merely because Article 33(2) does not explicitly reference Article 33(1)7 (See Supreme Court Decisions 2001Hu2863, dated July 11, 2003, and 2005Hu339, dated May 12, 2006). However, trademarks can only acquire distinctiveness for goods that are substantially identical to those on which the mark is used. Therefore, the mark cannot be registered for other goods or similar goods within the same classification.

3) In this case, based on the descriptions and images provided in Plaintiff's Exhibits 25 and 50, it is acknowledged that the claimed trademark has been used on vacuum flasks, key holders, and similar items, but the timing of such use remains unclear. Furthermore, after reviewing all the evidence submitted by the plaintiff, including the aforementioned exhibits, it is insufficient to establish that the plaintiff used the mark for all the designated goods that were previously deemed non-distinctive and that consumers have come to recognize the mark as an indicator of source. Additionally, no other evidence has been provided to support such a claim. Therefore, the plaintiff's argument above is groundless with no need to further examine it.

E. Summary of discussion

The claimed trademark lacks distinctiveness for certain designated goods and, therefore, falls under Article 33(1)7 of the Trademark Act. As a result, it cannot be registered for all designated goods, and acquired distinctiveness through use

cannot be recognized.

4. Conclusion

Therefore, the IPTAB's decision, which aligns with this conclusion, is legitimate. The plaintiff's petition seeking the revocation of the decision is without merit, and accordingly, the decision is rendered as ordered.

Presiding Judge	Jaheun KU
Judge	Hyejin LEE
Judge	Young Gi KIM