

Supreme Court Decision 2023Hu11180 Decided October 25, 2024 【Decision to
Reject (Trademark)】

【Main Issues and Holdings】


[1] Method of determining the similarity of combined trademarks consisting of a combination of two or more letters and/or figures

Where a mark is among the constituents of a trademark, the method of determining the similarity of trademarks

[2] Method of determining the probative value of the results of the survey on the perception of the similarity of trademarks on prospective consumers and elements to be considered by the judge

[3] In a case where an examiner of the Korean Intellectual Property Office made a



decision to reject the application for the trademark registration of “” filed by Incorporated Company A on the ground that it is either identical or similar to “**VITTORIA**,” which constitutes “others’ trademark previously registered,” in terms of mark and related goods and, thus, falls under Article 34(1)7 of the Trademark Act, the case holding that the above trademark applied for registration is similar to the prior registered trademark in terms of mark and has similar or identical related goods to the prior registered trademark, thereby constituting a trademark falling under Article 34(1)7 of the Trademark Act, and is ineligible for trademark registration, and that the results of the survey on the perception of the similarity of trademarks on prospective consumers submitted by Company A cannot be considered to have been designed to improve the reliability of survey results, and thus the lower judgment holding that the survey results are difficult to be adopted as evidence is tenable

【Summary of Decision】

[1] The similarity of combined trademarks consisting of a combination of two or more

letters and/or figures must be determined based on the external appearance of the whole of the constituents, name, and concept in principle (“principle of whole observation”). If the constituents of a trademark involve an element, which by itself functions as an indicator of the origin of goods by leaving an impression of the trademark on general consumers or making general consumers memorize and remind themselves of the trademark in question, i.e., a mark, it is necessary to compare and contrast the marks in question and determine the similarity of the trademarks in order to draw a pertinent conclusion of the whole observation (“compare and contrast of marks”). The determination of whether a certain part of a trademark constitutes a mark must consider whether the subject part is conspicuous, prominent, or leaves a strong impression on general consumers and whether it constitutes a dominant part of the whole of the trademark, along with the level of relative identifiability in comparison to other constituents of the trademark, whether the said part is combined with other components and, if so, to what extent, the relationship of the said part with the related goods, and the present circumstances surrounding the transaction of the related goods. If there is no element considered to be a mark, the similarity of the trademarks should be determined by comparing and contrasting the trademarks as a whole in accordance with the principle of whole observation (“compare and contrast of the whole”).

[2] The determination of the probative value of the results of the survey on the perception of the similarity, etc. of trademarks on prospective consumers falls within the ambit of a judge’s free evaluation of evidence, and the judge can decide on the probative value of the survey results by examining whether the design and conduct of the survey are in accordance with the objective procedures and standards ordinarily allowed in the field relevant to the survey in question. The judge can take into consideration the following: (a) whether the subject of investigation is reasonably selected, such as the pertinence of the selection of the parent population and the draw of the sample that can represent the parent population; (b) whether adequate measures for controlling the survey were taken to reduce the errors arising from the attitudes of respondents; (c) whether the structure of the survey questions and the manner in which topics such as trademarks are presented is appropriate; (d) whether the survey questions are biased or designed in a way that prompts respondents to choose a certain response; (e) whether the place and time where the survey takes place are relevant; and (f) whether the attitude of questioning respondents is

appropriate. Even though the results of the survey on the perception of prospective consumers are limited in that they cannot fully reflect the perception of actual consumers, insofar as the survey was designed and conducted in accordance with the objective procedures and standards, whether to refuse to recognize the reliability of the results of the survey needs to be cautiously determined.

[3] In a case where an examiner of the Korean Intellectual Property Office made a



decision to reject the application for the trademark registration of “

filed by Incorporated Company A on the ground that it is either identical or similar to

“**VITTORIA**,” which constitutes “others’ trademark previously registered,”

in terms of mark and related goods and thus falls under Article 34(1)7 of the Trademark Act, the case held that the lower judgment holding that the survey results are difficult to be admitted as evidence was tenable in light of the following grounds: (a) even though the comparison of the “VICTORIA” part of the mark of the foregoing trademark applied for registration and the prior registered trademark reveals some differences in terms of the font, color, design sophistication, and spelling arrangement, their appearances show little difference in that both are written in bold type and only the third letter of the word are different, with “C” and “T” used, respectively; (b) the part concerning “VICTORIA” is called “Biktoria,” while the prior registered trademark is called “Bitoria” or “Bittoria,” having similar names with a small difference in the first syllable out of the four syllables; (c) while the “VICTORIA” part is suggestive of the name of a female, the prior registered trademark does not seem to create a specific concept in the minds of general consumers, and thus the conceptual similarities between the trademarks cannot be compared and contrasted, but given that there still is a possibility of causing general consumers to misunderstand and confuse the origin of goods if both trademarks having similar names are jointly used for related goods that are either identical or similar, the marks of the foregoing trademark applied for registration and prior registered trademark bear resemblance; (d) furthermore, given that the related goods of the trademark applied for registration and the related goods of the prior registered trademark are identical or similar, as both are “sparkling water,

etc.,” the foregoing trademark applied for registration is a trademark falling under Article 34(1)7 of the Trademark Act, which is ineligible for trademark registration; (e) that some of the questions in the survey on consumer perception submitted by Company A presented the two trademarks at the same time and directly asked about their similarity is inappropriate to be considered as a comparison by recollection of trademark; and (f) considering that the content or order of choices that can be chosen by respondents for each question is not varied, which can guide respondents to choose a certain answer, the structure or content of the survey questions is difficult to be considered to have been designed to improve the reliability of the survey results.

[Reference Provisions] [1] Article 34(1)7 of the Trademark Act / [2] Article 202 of the Civil Procedure Act / [3] Article 34(1)7 of the Trademark Act; Article 202 of the Civil Procedure Act

Article 34 of the Trademark Act (Trademarks Ineligible for Trademark Registration)

(1) Notwithstanding Article 33, none of the following trademarks shall be registered:

<Amended on Oct. 31, 2023>

7. Any trademark used on goods identical or similar to the designated goods, which is identical or similar to a registered trademark of another person (excluding any registered collective mark with geographical indication) based on first to file: *Provided*, That where the consent of such another person has been obtained for the registration of the trademark (excluding the case where such consent has been obtained for a trademark that is the same trademark and is used on goods identical to the designated goods), trademark registration may be obtained;

Article 202 of the Civil Procedure Act (Principle of Free Evaluation of Evidence)

A court shall determine, by its free conviction, whether or not an allegation of facts is true, taking account of the whole purport of pleadings and the results of examination of evidence, on the basis of the ideology of social justice and equity in accordance with the principles of logic and experiences.

[Reference Cases] [1] Supreme Court Decision 2015Hu1690 decided Feb. 9, 2017 (Gong2017Sang, 591); Supreme Court Decision 2017Hu981 decided Aug. 30, 2018

【Plaintiff-Appellant】 ○○ Foods Company Inc.

【Defendant-Appellee】 Commissioner of the Korean Intellectual Property Office

【Judgment of the court below】 Patent Court Decision 2022Heo6471 decided August 31, 2023

【Disposition】 The appeal is dismissed. The costs of appeal are borne by the Plaintiff.


【Reasoning】 The grounds of appeal are examined (to the extent of supplement in case of supplemental appellate briefs not timely filed).



1. As regards the grounds for appeal Nos. 1 to 5

A. The similarity of combined trademarks consisting of a combination of two or more letters and/or figures must be determined based on the external appearance of the whole of the constituents, name, and concept in principle (“principle of whole observation”). If the constituents of a trademark involve an element, which by itself functions as an indicator of the origin of goods by leaving an impression of the trademark on general consumers or making general consumers memorize and remind themselves of the trademark in question, i.e., a mark, it is necessary to compare and contrast the marks in question and determine the similarity of the trademarks in order to draw a pertinent conclusion of the whole observation (“compare and contrast of marks”). The determination of whether a certain part of a trademark constitutes a mark must consider whether the subject part is conspicuous, prominent, or leaves a strong impression on general consumers and whether it constitutes a dominant part of the whole of the trademark, along with the level of relative identifiability in comparison to other constituents of the trademark, whether the said part is combined with other components and, if so, to what extent, the relationship of the said part with the related goods, and the present circumstances surrounding the transaction of the related goods. If there is no element considered to be a mark, the similarity of the trademarks should be determined by comparing and contrasting the trademarks as a whole in accordance with the principle of whole observation (“compare and contrast of the whole”) (see, e.g., Supreme Court Decisions 2015Hu1690, Feb. 9, 2017; 2017Hu981, Aug. 30, 2018).

B. Below is the examination in light of the above legal doctrine and record.



1) The mark of the instant trademark applied for registration is “” and its related good is ‘sparkling water, etc.’. The foregoing mark consists of ①

“” (hereinafter “VICTORIA part,” ② “” (hereinafter “빅토리아 part,”



and ③ “” (hereinafter “figure part”).

2) ① The VICTORIA part is written in bold white figurative letters on a blue background with darkened outer edges, which makes a strong impression on general consumers, and its share in the entire trademark is not inconsiderable. It reminds of a female name, adding to the trademark’s distinctiveness from its related goods. The VICTORIA neither lacks nor is deficient in distinctiveness, given that ‘VICTORIA’ is not a conspicuous geographical name which instantaneously reminds general consumers of ‘Victoria Falls,’ and neither a trademark involving the “VICTORIA” part is registered for a number of goods that are identical or similar to sparkling water, which is a related good for the instant trademark applied for registration, nor its application has been published. ② The figure part leaves a strong impression on general consumers, a blue background with darkened outer edges making a strong contrast to the uniquely figurative description of water currents or falls, etc., and taking up a considerable part of the entire trademark. It simply conveys an idea of water currents or falls with air bubbles or water foams and cannot be readily concluded to be intuitively conveying the use or nature of its related goods. Thus, the figure part possesses distinctiveness in connection with the related goods that the trademark involving the said figure part is for. ③ The 빅토리아 part is written in small font in light gray, which is low in

readability, and considering its insignificance in the entire trademark, the 빅토리아 part does not impart a strong impression to general consumers compared to the VICTORIA part and the figure part in its relationship with its related goods. ④ In the meantime, the VICTORIA part and the figure part perform on their own the function of indicating the origin of goods, both constituting the mark of the instant trademark applied for registration. It cannot be said that they function as a distinctive mark only when combined as a whole, nor is the distinctiveness of each part relatively superior to one another.

3) The mark of prior registered trademark 1 in the lower judgment is “**VITTORIA**,” and its related goods are ‘sparkling water, etc.’. A comparison and contrast of the VICTORIA part from the marks of the instant trademark applied for registration and prior registered trademark 1 reveal the difference between the two in terms of the font type, color, degree of figurative extension made, and spelling arrangement, but they are all written in bold-face and only the third letter from the entire letter is different, with ‘C’ and ‘T’ used, respectively, showing only a little difference in external appearances. The part concerning VICTORIA is called ‘Biktoria,’ while the prior registered trademark is called ‘Bitoria’ or ‘Bittoria,’ having similar names with a small difference in the first syllable out of the four syllables. While the VICTORIA part is suggestive of the name of a female, the prior registered trademark does not seem to form a specific concept in the minds of general consumers, and thus the conceptual similarities between the trademarks cannot be compared and contrasted. However, given that there still is a possibility of causing general consumers to misunderstand and confuse the origin of goods if both trademarks having similar names are jointly used for related goods that are either identical or similar, the marks of the foregoing trademark applied for registration and prior registered trademark bear resemblance. Furthermore, the related goods of the trademark applied for registration and those of the prior registered trademark are identical or similar, as both are ‘sparkling water, etc.’.

4) The instant trademark, which constitutes a trademark under Article 34(1)7 of the Trademark Act for having a similar mark to that of prior registered trademark 1 and identical or similar related goods therefor, is ineligible for trademark registration.

C. The lower court compared and contrasted the instant trademark applied for registration and prior registered trademarks stated in the lower judgment as a whole and concluded that there is a resemblance between the former and the latter on the

ground that they have a similar name, albeit admitting that there are considerable differences in terms of the existence of figures and colors and the font adopted and that the concept embodied in the trademarks cannot be compared and contrasted and have no resemblance to one another. Supreme Court Decision 97Hu3050 and Supreme Court Decision 2004Hu2628 invoked by the lower court pertain to the standards for determining the resemblance of text trademarks and therefore are impertinent to be invoked in the determination of the similarity of trademarks consisting of a combination of letters and figures as a whole, and there is an inappropriateness in the lower court's statement of reasoning. However, the lower court's conclusion—the instant trademark applied for registration falls under Article 34(1)7 of the Trademark Act and thus disqualifies for trademark registration—is tenable. The lower court did not err in its judgment by misapprehending the legal doctrine regarding the determination of similarity of trademarks, including combined trademarks, the distinction between a combined trademark and a text trademark, the distinctiveness of a trademark registered or applied for registration for a number of goods or services, and the determination of a conspicuous geographical name or by defying precedents, nor did it adversely affect the judgment by so doing, contrary to what is alleged in the grounds of appeal.

2. As regards the grounds of appeal No. 6

A. The determination of the probative value of the results of the survey on the perception of the similarity, etc. of trademarks on prospective consumers falls within the ambit of a judge's free evaluation of evidence, and the judge can decide on the probative value of the survey results by examining whether the design and conduct of the survey are in accordance with the objective procedures and standards ordinarily allowed in the field relevant to the survey in question. The judge can take into consideration the following: (a) whether the subject of investigation is reasonably selected, such as the pertinence of the selection of the parent population and the draw of the sample that can represent the parent population; (b) whether adequate measures for controlling the survey were taken to reduce the errors arising from the attitudes of respondents; (c) whether the structure of the survey questions and the manner in which topics such as trademarks are presented is appropriate; (d) whether the survey questions are biased or designed in a way that prompts respondents to choose a certain response; (e) whether the place and time where the survey takes

place are relevant; and (f) whether the attitude of questioning respondents is appropriate. Even though the results of the survey on the perception of prospective consumers are limited in that they cannot fully reflect the perception of actual consumers, insofar as the survey was designed and conducted in accordance with the objective procedures and standards, whether to refuse to recognize the reliability of the results of the survey needs to be cautiously determined.

B. Based on the grounds stated in its reasoning, the lower court held that the results of a survey on the perception of prospective consumers conducted in 2021 (Gab Evidence No. 31) and the results of a survey on the perception of prospective consumers conducted in 2022 (Gab Evidence No. 30) (hereinafter “instant survey”), submitted by the Plaintiff, cannot be admitted as evidence, citing possible invalidity of the selection of respondents and inappropriateness in the manner in which trademarks were presented in survey questions and how questions were organized, which led to poor reliability.

C. Below is the examination of the reasoning of the lower judgment in light of the foregoing legal doctrine and record.

Of the statement of the lower court’s reasoning, the part concerning some grounds for its conclusion that the questions in the 2022 survey in the instant case were designed to instigate the selection of a desired answer appears unreasonable. However, given that questions A2 through A5 in the 2022 survey in the instant case, which directly asked about the resemblance of two trademarks by presenting them in juxtaposition, are not aligned with the principle of observation by recollection, and that there is no difference in the content of choices that can be chosen by respondents for each question or the order in which these choices were presented, which raises the possibility of leading questions, it is difficult to consider that the structure or content of the questions in the survey was designed in a way that contributes to higher reliability of the results of the survey. In essence, the lower court’s determination on the probative value of the results of the instant survey on the perception of prospective consumers or finding of fact based thereon cannot be considered to have transcended the bounds of the principle of free evaluation of evidence against logical and empirical rules. The lower court’s conclusion is reasonable and there is no error on the part of the lower court that adversely affected the judgment, contrary to what is alleged in the grounds of appeal.

3. Conclusion

The appeal is dismissed, and the costs of appeal are borne by the losing party. It is so decided as per Disposition by the assent of all participating Justices on the bench.

Justices Shin Suk-heui (Presiding Justice)
 Rho Tae-ak (Justice in charge)
 Suh Kyeong-hwan
 Noh Gyeong-pil

*** This translation is provisional and subject to revision.**

*** The published English version of the Supreme Court Decision will be made available at the end of the year**