



Newsletter - Spot, 2019

Lead Partner Ho Hyun Nahm of Barun IP & Law has been named as the Chairman of the Intellectual Property Forum.



Patent and Trademark Attorney Ho-Hyun Nahm was named as Chairman of the Intellectual Property Forum at the general conference of the Forum convened on February 12, 2019. The Intellectual Property Forum is an association incorporated under the National Assembly of Korea. It is made up of many members including corporate leaders and IP professionals, and it does research activities, runs discussion forums, symposiums, and seminars, and also aims at the protection, creation, use of intellectual property rights, and policy making. Since founded in year 2005, the Intellectual Property Forum has played a driving role in enacting 'Intellectual Property Framework Act' and establishing the 'Presidential Council on Intellectual Property of Korea.'

Chairman Nahm left his remarks stated as "I will endeavor to pursue intellectual property as basis of the nation's engine for growth and competitiveness in the world systematically to such extent necessary for maximizing the national power of Korea abroad and will serve every member of the Intellectual Property Forum and also of the Republic of Korea to realize the purpose for which the Forum has been founded. I will make every effort to enlarge and expand the scope of communication with the executive, legislative, and judicial bodies of the Republic of Korea, with the media and press, and also with civil society all for the purposes of creating an environment in which our country can be a front runner in the IP World."

Chairman Ho Hyun Nahm's profile

License

- Admitted to the 23rd Korean Patent Bar Examination (1986)

Academic Background

- Graduate School of Public Administration, Seoul National University (MPA) (1982 ~ 1985)
- College of Law, Chung-ju University (LL.B) (1972 ~ 1976)
- Diploma of the KCAB Arbitration CEO Academy (2007)
- Visiting Professor of the National Police University of Korea (2012)
- Visiting Professor of the Sookmyung Women's University (2000)
- Lecturing at the Handong International Law School (2011)
- Lecturing at the Seoul National University (2013)

Present Positions

- Lead Partner of BARUN IP & LAW (1996~present)
- Chairman of the Intellectual Property Forum (Association Incorporated under the National Assembly of the Republic of Korea) (2019 ~ present)
- Coordinator of National Group Presidents' Meeting of the APAA (Asian Patent Attorneys' Association) (2015~present)
- Vice President of the FICPI-Korea (2019~present)
- Arbitrator/Panelist of NAF, WIPO, CAC, ADNDRC, HKIAC, and KCAB

Expertise as Arbitrator · Panelist

Having rendered over **600 Decisions** on Domain Name Disputes and IP related Arbitration cases as of February 2019

- Chairman of KIDRC (Korea Internet Address Dispute Resolution Committee; an organization instituted by a special Act) (2014~2016)
- Panelist of KIDRC (2000~2016)
- Panelist/Arbitrator of the U.S. National Arbitration Forum (NAF) (2006~present)
- Panelist of the WIPO (2008~present)
- Panelist of the Asian Domain Name Dispute Resolution Committee (ADNDRC) (2004~present)
- Panelist/Arbitrator of the Czech Arbitration Court (CAC) (2016~ present)
- Arbitrator of HKIAC - Hong Kong International Arbitration Centre (2015~present)
- Arbitrator of Korean Commercial Arbitration Board (2007~present)
- Vice President of Korean Arbitrators' Association (2014~2015)

Past Positions

- Member of the Presidential Advisory Council on State Science and Technology of the Republic of Korea (Chaired by then President Roh Moo Hyun; 2005~ 2006)
- Chairman of APAA (Asian Patent Attorneys' Association)-Korean Group (2012~ 2015)
- Vice Chairman of APAA (Asian Patent Attorneys' Association) (2015~2018)
- Chairman of the Korean Trademarks Institute (1999~2000)
- Chairman of Korea Trademark, Design and Copyright Chapter of the Korean Patent Attorneys' Association (2009~2010)
- Chairman of the Trademark Committee of the Asian Patent Attorneys' Association (2003~2009)
- International Affairs Director of the Korean Patent Attorneys Association (2000~2002)
- Policy Advisor of the Ministry of Public Administration and Security (2011~present)
- Trademark policy advisor for the Korean Intellectual Property Office (KIPO)
- Partner of Central International Law Firm (in charge of Trademark Department) (1987~1996)
- Legal Affairs Department of Korean Air (1982~1987)

- Overseas Information Service, Ministry of Culture and Information (1980~1982)

Leading or Landmark Cases Won by Mr. Nahm

- Pacific Co., Ltd. v. Vov Co., Ltd.; the Patent Court of Korea 2006 Huh (Dang) 5225, November 23, 2006 over the marks 'SNOW PERFUME' v. 'ICE SNOW' (dissimilarity in respect of cosmetics)
- Hardy Amies Ltd. v. Lee~; the Supreme Court of Korea 98 HU 1907, March 23, 1999 (recognition of an advertisement featured in a foreign publication constituting proper evidence of use in defending a non-use cancellation action in Korea)
- Group Lotus PLC v. Hyundai Motor Company; the Supreme Court of Korea 2004 Hu 2628, September 30, 2005 over the marks 'LOTS' v. 'LOTUS' (dissimilarity in respect of automobiles)
- Elegance Rolf Offergelt GmbH v. Hanyoung Industries Co., Ltd.; the Patent Court of Korea 2002 Huh 888, July 19, 2002 (recognition of secondary meaning on the word 'ELEGANCE' in respect of clothes and fashion accessories)
- J.Choo Limited v. Commissioner of KIPO; the Supreme Court of Korea 2005 Hu 2008, August 26, 2006 over the marks 'JIMMY CHOO' and 'PATTY & JIMMY with a device' (dissimilarity in respect of bags)
- Chung, Mong Koo and Hyundai Motor Company v. Individual; WIPO D2005-1068, December 21, 2005 over the domain names <chungmongku.com> and <chungmongku.net> (transferred; recognition of Chung, Mong Koo, chairman's name of the Hyundai Motor Company group constituting common law trademark right)
- Fairmont Hotel Management L.P. v. YoungOne Outdoor Co., Ltd.; the Patent Court of Korea 2018 Huh 7712, January 24, 2019 (invalidating the registration of the mark 'Fairmont' in respect of 'clothes' on the basis of the notoriety of the Fairmont Hotel outside of Korea and recognition of the economic nexus between 'hotel service' and 'clothes')

Activities at International NGOs

- Member of international NGOs: INTA, AIPPI, FICPI, ECTA, APAA, PTMG and ECCK

Recognitions of Mr. Nahm's expertise

- Selected as one of 'The World's Leading Experts in Trademark Law' in 1996 by 'Euromoney Publications PLC' based in London.
- Nominated as one of the leading, most highly-acclaimed legal experts, and highly recommended Asia-Pacific-focused lawyers in areas of Intellectual Property Rights, for nine consecutive years (2007~2015), by 'Asia Law'.
- Recognized as the 'Man of the Year in Law 2010' by American Biographical Institute for Dedication and Excellence.
- Awarded 'Winner of the 2010 New Quality Innovation Award (Service Innovation)' for the first time in the field of legal service in Korea.
- Awarded 2015 Korea Invention Education Writing Award ' by Korean Academy of Invention Education
- Awarded 'Korean IP Law Firm of the Year 2012' by a renowned British monthly magazine, Acquisition International.

Broadcastings

- Host of the weekly program- 'Ho-Hyun Nahm's Fun Anecdotes of Patents' broadcasted by Daily Economy TV (MBN)

Books

- "Challenging the 21st Century with Intellectual Property Rights"
 - published in Korean by the Chosun Daily Newspaper and selected as a best seller in the section of sociology and politics (2003)
 - published in English (2003)
 - published in Japanese (2008)

- 2nd Edition in English (2010)
- “Change Your Life with Ideas” (2010)
- “From Edison to iPod” (2010), an adapted version to Korean Intellectual Property Law and Practice.
- Author of Korean jurisdiction of “Opposition Guideline” of International Trademark Association (INTA)
- Author of Korean jurisdiction of “Enforcement: An International Litigation Guide” of International Trademark Association (INTA)
- Author of Korean jurisdiction of “Domain Name Handbook 2nd Edition” published by Oxford University Press in 2015
- "Designing Your Own Unique and Dazzling Life"
 - published in Korean by Maeil Business News Korea (Economic daily newspaper) (2016)
 - published 1st Edition in English by Maeil Business News Korea (Economic daily newspaper) (2017)
 - published 2nd Edition in English by AuthorHouse in London (2017)
- "A Jackpot Journey" published in Korean by the Korea Economic Daily (2018)

Lectures and Presentations

- "Update on Domain Name Dispute Resolutions including New gTLDs" (2015. 5. ECCK Legal Seminar, Seoul)
- “Ensuring Internet security, domain name and trademark protection” (October, 2014; ALB IP Conference, Seoul)
- "Protection of Non-traditional trademarks in Korea" (April, 2014; FICPI Kyoto Symposium, Kyoto)
- “How does UDRP affect the evolution of ccTLD dispute resolution policies - Perspectives from.Kr” (January, 2014; ADNDRC Conference, Kuala Lumpur)
- “Are Goods and Services Specifications Inflation Proof? Perspective of South Korea” (October, 2013; FICPI Open Forum, Sorrento)
- “Counterfeiting and Criminal Sanctions in Korea” (December, 2011; FICPI Korea Symposium)
- “Strategies for Efficient Protection · Maintenance of Intellectual Properties in Korea & Role of IP Lawyers” (April, 2011; Presentation at Handong International Law School)
- “New Marks - Old Laws” (September, 2010; FICPI 12th Open Forum, Munich)
- “Trademark Bullies” (October, 2010; APAA 58th Council Meeting in Jeju)
- “Recent Amendments in Korea-Design Protection Law and the Main Characteristics of Design Policy” (January, 2010; KPAA-JPAA Joint Seminar)
- “Trademark Protection of shapes & color” (December, 2009; FICPI India Symposium)
- “The Characteristics of Korean Design Protection Policy” (November, 2008; KPAA-JPAA Joint Seminar)
- “Prominent issues of Korean IP Attorneys' Profession” (October, 2008; FICPI Korea-FICPI France Joint Seminar)
- “Similarity in a Global Context” (May, 2008; International Trademark Association (INTA) the 130th Annual Meeting)
- “Boarder Seizures” (March, 2008; KPAA-AGPA(German Patent Attorneys’ Association) Joint Seminar)
- “Strategies for Efficient Protection - Maintenance of Intellectual Properties in Korea” (March, 2008); International Seminar on Intellectual Properties hosted by British Embassy in Korea)
- “Strategies for Procuring and Maintaining Intellectual Properties to Boost Competitiveness of a Firm” (March, 2005; Guest Lecturer for Korea Invention Promotion Association)
- “Adaptation of Korean Law to Prevent Cyber-squatting” (March, 2004; Internet Address Dispute Resolution Committee)
- “Effective Trade Mark Rights Enforcement in Asia” (March, 2004; Pharmaceutical Trademark Group (PTMG) General Assembly)
- “Trademark Assignment & Licensing, Trade Remedies and An Advice to Exporting Companies” (March, 2003; Guangzhou, China)
- “The Madrid Protocol and its Impact on Korean Trademark Laws” (2002; the 3rd Joint Seminar of AIPPI Japan, China and Korea)
- “Protection and Enforcement of Well-Known Trademarks and Domain Names in Korea” (2001; the Joint Seminar of AIPPI Japan, China and Korea)

Thesis and Research

- Trend of IP Education in Korea (2011, Japan, “Patent” Magazine)
- Domain name dispute white paper (2003~2012, Korea, Korea Internet & Security Agency)
- Amendments for Korea Trademark Law and Korea Design (Protection) Law (2005, AIPPI Japan)
- Annotation on Judicial Precedents in Korea on Trademarks in Letter or Figure Type: STARBUCKS vs. STARPREYA (2005, Japan, International Association for the Protection of Intellectual Property)
- Amendments for Korea Trademark Law and Korea Design (Protection) Law (2005, AIPPI Japan)
- Domain Name Dispute Resolution Policy (2005, Korea Internet Security Agency)
- The Protection of Telegraphic Design Registration in Korea (2003, Japan, Intellectual Property Information Center at Economic Industrial Investigating Committee)
- Policy on Disclosing Design Application, Registration without Examination of Some Products, and Multiple Design Registration Application in Korea (2003, Journal of AIPPI Japan)
- Use of a Mark 'As a Mark' as a Legal Requirement in Respect of Acquisition Maintenance Infringement of Rights in Korea (2002, AIPPI Year Book)
- The Madrid Protocol and its Impact on Korean Trademark Laws (2002, Journal of AIPPI Japan Group)
- Recent Trends in Judicial Precedents by the Korean Supreme Court with Regard to Domain Name Disputes and Judicial Judgments on Decision for Adjustment (2002, KRNIC International Seminar)
- Protection and Enforcement of Well-Known Trademarks, Service Marks and Domain Names in Korea (2001, Journal of the Japanese Group of AIPPI)

- The End -

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If you have any questions or comment concerning the newsletter, please feel free to contact us at office@barunip.com

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