

## **Ho-Hyun Nahm (Mr.), Patent & Trademark Attorney**

**(as of October 10, 2023)**

**Ho-Hyun Nahm, Lead Partner of BARUN IP & LAW** (hh-nahm@barunip.com)

Ho-Hyun Nahm, as a patent and trademark attorney, has protected the trademarks, designs, and patents of some of the world's best-known entrepreneurs and international brands and designs – the British Royal Chief Designer's brand Hardy Amies, Nike, Esprit, Jimmy Choo, Elégance, Lady Gaga, global corporate leaders in a broad range of industries such as multiplayer and game producers and color companies.

Ho-Hyun Nahm has helped other corporate clients in the life science, hospitality, entertainment, automobile, insurance, shared-office, animation industries including Supercell Oy, Pantone LLC, Bayer Pharmaceutical companies, BASF SE, Hotel Fairmont and Mondrian as part of Accor Hotel family, and Hyundai Motor Company on a global scale.

Among the various types of clients, AIA, WEWORK, Pret A Manger, Colgate-Palmolive, Airbus Helicopters, Le Petit Prince of Antoine de Saint-Exupéry, and Studio Ghibli have benefited from Ho Hyun Nahm's expertise in IP services.

Ho-Hyun Nahm takes a special pride in having protected the lyrical and allusive works of the world's famous Japanese anime director Miyazaki Hayao - Studio Ghibli, My Neighbor Totoro, Princess Mononoke, CHIHIRO - SPIRITED AWAY.

His experience includes prosecution, litigation and negotiating settlement agreements for all types of intellectual property rights including license agreements and dispute resolution in domain names.

### **Expertise as Arbitrator · Panelist**

Ho-Hyun also has extensive experience in domain name disputes resolution. **He has rendered over 1,150 decisions on domain name disputes and IP related arbitration cases.** He was awarded a certificate of merit - 1,000 Achievements Award by the Commissioner the KISA (Korea Internet Security Agency) for his contributions to the development and promotion of ADR. He served as Chairman of Korea Internet Address Dispute Resolution Committee (KIDRC) , and he is currently very active as a panelist or an arbitrator of the U.S. National Arbitration Forum (NAF), WIPO, the Asian Domain Name Dispute Resolution Committee (ADNDRC), the Czech Arbitration Court (CAC), Hong Kong International Arbitration Centre (HKIAC), the Korean Commercial Arbitration Board (KCAB).

### **Expertise as Intellectual Property Evaluation Appraiser**

Ho-Hyun is an Intellectual Property Evaluation Appraiser of KPAA. He completed the Advanced Placement Course for IP Evaluation of KPAA, developed the Design Evaluation Model (December 1991), and performed various IP evaluation projects on behalf of Korean courts including the Seoul Central District Court, KPAA, and various entrepreneurs.

## **Academic Background**

Ho-Hyun has graduated from the Graduate School of Public Administration, Seoul National University (MPA); and the College of Law, Chung-ju University (LL.B). He has obtained a diploma of the KCAB Arbitration CEO Academy. He lectured at the National Police University of Korea and the Sookmyung Women's University in the capacity of visiting professor. He also lectured at the Handong International Law School and the Seoul National University, Business Course for Chief IP Officers (CIPO).

## **Present Positions**

He is currently serving as Lead Partner of BARUN IP & LAW, President of the FICPI-Korea, and Arbitrator/Panelist of NAF, WIPO, CAC, ADNDRC, HKIAC, and KCAB; and URS Examiner of NAF and ADNDRC.

## **Past Positions**

Ho-Hyun served as a member of the Presidential Advisory Council on State Science and Technology of the Republic of Korea (Chaired by then President Roh Moo Hyun; chairman of APAA (Asian Patent Attorneys' Association)-Korean Group; vice chairman of APAA (Asian Patent Attorneys' Association); chairman of the Korean Trademarks Institute; chairman of Korea Trademark, Design and Copyright Chapter of the Korean Patent Attorneys' Association; chairman of the Trademark Committee of the Asian Patent Attorneys' Association; International Affairs Director of the Korean Patent Attorneys Association; Policy Advisor of the Ministry of Public Administration and Security of the Republic of Korea; Trademark Policy Advisor for the Korean Intellectual Property Office (KIPO); and Partner of Central International Law Firm. He also served for Legal Affairs Department of Korean Air and the Overseas Information Service of the Ministry of Culture and Information of the Republic of Korea. Most recently, he chaired the Intellectual Property Forum, an association incorporated under the National Assembly of the Republic of Korea.

## **Landmark Cases**

Ho-Hyun has produced numerous landmark cases, some of which include the followings:

- 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 and (transferred; recognition of Chung, Mong Koo, chairman's name of the Hyundai Motor Company group constituting common law trademark right);
- Pantone LLC v. Park Keun-Young: the Supreme Court of Korea 2019HU11596, January 16, 2019 (successfully cancelling the prior existing trademark registration on non-use grounds on behalf of Pantone, LLC despite some legitimate use evidence presented by Park Keun-Young);
- Fairmont Hotel Management L.P. v. YoungOne Outdoor Co., Ltd.; and 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');
- Bayer Consumer Care AG v. Nature's Way Products LLC: the Supreme Court of Korea 2019HU10036, April 5, 2019 (successfully countering the non-use cancellation action filed by Nature's Way Products on behalf of Bayer Consumer Care AG on the basis of proper online use evidence);
- BASF SE & KIPO Commissioner v. SAEHANNONG CO., LTD: the Patent Court of Korea 2019HEO2585 & 2587, September 27, 2019 (affirming the decision of rejection on SAEHANNONG's "BASTA" and "SAEHANNONG BASTA" applied for in bad faith on the basis of BASF SE's fame and reputation evidence on herbicides for its "BASTA" marks through judicial intervention in litigation);
- BASF SE v. SAEHANNONG CO., LTD: the Supreme Court of Korea 2020HU11165 (successfully invalidating SAEHANNONG's "ARIBASTA" registration in bad faith on the basis of BASF SE's fame and reputation evidence on herbicides for its "BASTA" marks)
- KumKang Shoe v. YOON, TAE-SAN: the Supreme Court of Korea 2020HU10421, November 11, 2022 (successfully cancelling YOON's "KumgKang" logo mark registration in respect of 'socks' on the basis of YOON's use of the mark in a changed format from the registered mark because YOON caused confusion over KumgKang's KumgKang logo mark on 'shoes' notwithstanding the co-existence agreement between the parties. The Supreme Court affirmed Ho-Hyun's argument that the provision for the public interest (protection of consumers) should prevail over the individual interests.

### **Broadcastings**

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

### **Books**

He has written as many books on intellectual property issues as: "Challenging the 21st Century with Intellectual Property Rights" published by the Chosun Daily Newspaper and selected as a best seller

in the section of sociology and politics subsequently published in English and Japanese; "Change Your Life with Ideas"; "From Edison to iPod" (2010), an adapted version to Korean Intellectual Property Law and Practice; Internet searchable "Opposition Guideline (for Korean jurisdiction)" of International Trademark Association (INTA); Internet searchable "Enforcement: An International Litigation Guide (for Korean jurisdiction) of International Trademark Association (INTA); "Domain Name Handbook 2nd Edition (for Korean jurisdiction (in English and German))" published by Oxford University Press; "Designing Your Own Unique and Dazzling Life" published in Korean by Maeil Business News Korea (Economic daily newspaper) (2016) and published in English by AuthorHouse in London; "A Jackpot Journey" published by the Korea Economic Daily. Ho-Hyun co-authored "Rebecca's Real English Expression" published by Mj Books in 2023.

### **Essays**

He has written a dozen of articles and research thesis relating to intellectual properties as: 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)

### **Lectures and Speech**

Ho-Hyun has lectured and spoken more than 50 times at universities, law schools, entrepreneurs, international conferences such as INTA, AIPPI, APAA, FICPI, PTMG, ECKK, etc.

- "H.H.Nahm's Domain Name Dispute Resolution Overview 2023" spoken at the IDRC (Korean Internet Address Dispute Resolution Commission) in April 2023 in honor of his 1,000th decision in domain dispute resolution
- "Skill sets for Effective Decision Drafting in Usual and Unusual Circumstances" spoken at the ADNDRC Workshop 2.0 in April 2023
- "Recent PBR Developments in Korea" spoken at CIOPORA ACADEMY Workshop Hong Kong in September 2023
- "ADNDRC Business Development Interviewing" (September 16, 2021 interviewed with Kiran

Sanghera, ADNDRC Secretary General)

- "Update on Domain Name Dispute Resolutions including New gTLDs" (May 2015;
- 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)

### **Recognition**

Ho-Hyun was selected as one of ‘the World's Leading Experts in Trademark Law’ 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 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; and awarded ‘Korean IP Law Firm of the Year 2012’ by a renowned British monthly magazine, Acquisition International. In 2023, he was awarded a certificate of merit - 1,000 Achievements Award by the Commissioner the KISA (Korea Internet Security Agency) for his contributions to the development and promotion of ADR.

### **Activities at International NGOs**

Ho-Hyun is a member of international NGOs: INTA, AIPPI, FICPI, ECTA, APAA, PTMG, MARQUES and ECCK.