

Ho-Hyun Nahm (Mr.), Patent & Trademark Attorney
(as of October 5, 2020)

License

- Admitted to the 23rd Korean Patent Bar Examination (1986)
- Registered Member of the Korea Patent Attorneys' Association (KPAA)
- Intellectual Property Evaluation Appraiser of KPAA

Academic Background

- Graduate School of Public Administration, Seoul National University (MPA) (1982 through 1985)
- College of Law, Chung-ju University (LL.B) (1972 through 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, Business Course for Chief IP Officers (CIPO)(2013 through 2014)

Present Positions

- Lead Partner of BARUN IP & LAW (1996 through present)
- Chairman of the Intellectual Property Forum (Association Incorporated under the National Assembly of the Republic of Korea) (2019 through present)
- Vice President of the FICPI-Korea (2019 through present)
- Arbitrator/Panelist of NAF, WIPO, CAC, ADNDRC, HKIAC, and KCAB

Expertise as Arbitrator - Panelist

Having rendered **711 Decisions** on Domain Name Disputes and IP related Arbitration cases as of September 2020

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

Expertise as Intellectual Property Evaluation Appraiser

- Intellectual Property Evaluation Appraiser of KPAA
- Completion of Advanced Placement Course for IP Evaluation of KPAA (February 2013)

- Development of Design Evaluation Model (December 1991)
- Performance of Evaluation of IP such as Trademarks, Designs for Korean courts including Seoul Central District Court
- Performance of IP Evaluation for KPAA
- Performance of Brand Evaluation for entrepreneurs such as KungKang Shoe Manufacturing Company, Dayhang, etc.

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 through 2006)
- Chairman of APAA (Asian Patent Attorneys' Association)-Korean Group (2012 through 2015)
- Coordinator of National Group Presidents' Meeting of the APAA (Asian Patent Attorneys' Association) (2015 through 2018)
- Vice Chairman of APAA (Asian Patent Attorneys' Association) (2015 through 2018)
- Chairman of the Korean Trademarks Institute (1999 through 2000)

- Chairman of Korea Trademark, Design and Copyright Chapter of the Korean Patent Attorneys' Association (2009 through 2010)
- Chairman of the Trademark Committee of the Asian Patent Attorneys' Association (2003 through 2009)
- International Affairs Director of the Korean Patent Attorneys Association (2000 through 2002)
- Policy Advisor of the Ministry of Public Administration and Security (2011 through present)
- Trademark policy advisor for the Korean Intellectual Property Office (KIPO)
- Partner of Central International Law Firm (1987 through 1996)
- Legal Affairs Department of Korean Air (1982 through 1987)
- Overseas Information Service, Ministry of Culture and Information (1980 through 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 (representing Hardy Amies successfully in defense to the non-use cancellation action against its trademark registration on the basis of a piece of advertisement carried in a foreign publication)
- Group Lotus PLC v. Hyundai Motor Company; the Supreme Court of Korea 2004 Hu 2628, September 30, 2005 over the marks 'LOTS' v. 'LOTUS' (representing Hyundai Motor Company successfully in defense to the invalidation action; 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' (representing J.Choo Limited successfully to register the mark 'JIMMY CHOO' in respect of bags)
- Hyundai Motor Company and Chung, Mong Koo v. Individual; WIPO D2005-1068, December 21, 2005 over the domain names <chungmongku.com> and <chungmongku.net> (representing Hyundai Motor Company and Chung, Mong Koo successfully for the transfer of disputed domain names; recognition of Chung, Mong Koo, chairman's name of the Hyundai Motor Company group constituting common law trademark right)
- Pantone LLC v. Keon-Young PARK; the Supreme Court of Korea 2019 HU11596, January 16, 2019 (representing Pantone LLC successfully in cancellation of the registration of the mark 'PANTONE' in respect of 'clothes' on the basis of non-use notwithstanding existence of some piece of evidence of use)
- Fairmont Hotel Management L.P. v. YoungOne Outdoor Co., Ltd.; the Patent Court of Korea 2018 Huh 7712, January 24, 2019 (representing Fairmont Hotel successfully in invalidation of 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 2019 HU10036, April 5, 2019 (representing Bayer successfully in defense to the non-use cancellation action against its trademark registration on the basis of sales on Internet)
 - BASF SE; Commissioner of KIPO v. SAEHANNONGBASTA Co., Ltd., the Patent Court of Korea 2019 HEO 2585 & 2587, September 27, 2019 (representing BASF SE and assisting Commissioner of KIPO successfully in invalidation of the registrations of the marks 'BASTA' in Hangul and 'SAEHANNONGBASTA' in Hangul in respect of 'herbicides' on the basis of the notoriety of the 'BASTA')

Activities at International NGOs

- Member of international NGOs: INTA, AIPPI, FICPI, ECTA, APAA, PTMG, MARQUES 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 through 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 and Essays

- "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" (May 2015;
- ECCCK 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)

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