

Amendments to the Korean Trademark Act

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The Korean National Assembly adopted a bill introduced by the Korean Intellectual Property Office ("KIPO"), which will amend the Korean Trademark Act ("TMA"). The amended provisions of the TMA, detailed below, will be effective from October 6, 2013.

Non-use cancellation actions

Under the current TMA, non-use cancellation actions have no retroactive effect. In other words, an application filed before a senior conflicting mark is successfully canceled through a non-use cancellation action will remain blocked by this senior mark. Successful petitioners of non-use cancellation actions are instead granted an exclusive six-month period to file an application for a mark identical or similar to the canceled marks.

Non-use cancellation actions will have some limited retroactive effect under the amended bill. An application, which is blocked by a senior conflicting mark, will be able to overcome this citation if the senior mark is successfully cancelled by a non-use cancellation action.

However, the amended TMA will delete the exclusive six-month period provision. Therefore, once the amendments enter into force, petitioners will have to file an application for their mark as early as possible, even before introducing a non-use cancellation action, to avoid any risk of a third party filing an application for an identical or similar mark while the action is pending.

Prior use of names/trade names

Under the amended TMA, a party that, without bad faith intent, uses as a trademark its name, trade name, or any other personal identifiers, in accordance with customary practices, will be able to continue such use without risking trademark infringement claims from the owner of an identical or similar registered mark, as long as such use started before the application date of the identical/similar registered mark.

One of KIPO's goals with this reform of the TMA is to give greater protection to the owners of small businesses in Korea. Previous interpretations of the law had reduced the possibility for these owners to protect themselves against attacks by new trademark owners and had forced many of them to modify their trade names as a consequence. KIPO is hoping with this amendment that small businesses owners in Korea will be able to continue their prior fair use of their trade name without interference from owners of new identical or similar trademarks.

Relief measure in case of failure to comply with the deadline for filing a response to an office action

The amendments include relief measure for applicants who failed to file a response to an office action within the two month deadline. Such applicants will be granted an additional two month period from the deadline to file a request to reopen the examination of their applications. The response to the office action will have to be filed in combination with the request to reopen the examination.

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