



*News Letter - Summer 2014*  
*Seoul, Korea*

**Amendment to Korean Patent Act**

**1. Relaxing the specification requirement for the purpose acknowledging the filing date of application**

The Korean Intellectual Property Office (KIPO) has decided to relax the requirement imposed on specifications to help applicants to seek the filing dates fast. The Korean Intellectual Property Office (KIPO) has decided to acknowledge the filing date provided that the patent specification contains the so-called “explanatory materials for ideas” completed on research essays or written instruments regardless of the specification standards even when they are written in the description of invention. However, the applicant has to amend the patent application consistent with the standard specification forms within 14 months from the priority date, and the patent application will be considered as withdrawn unless an amendment is made thereto. Also, the Office will allow the specification to be written in English for the purpose of filing. However, the patent applicant is required to file the formal specification along with its Korean translation with the Office within 1 year and 2 months from the earliest filing date. The amendment will only apply to patent applications filed after January 1, 2015.

**2. Adoption of term extensions for filing Korean translations corresponding to PCT patent applications**

For the purposes of convenience provided for applicants of PCT patent applications, the KIPO has decided to grant a period of one more month to file a Korean translation of PCT patent applications, and thus, the Office has allowed the applicants to file such documents within 2 years and 8 months from the priority date. Under the current law, the documents showing intent to file the national phase application along with their Korean translations must be submitted simultaneously within 2 years and 7 months. However, under the amended law, the applicants can simply show intent to seek a term extension without the Korean translation for the purpose of filing the translation, and then the Office will recognize a period of one more month to be granted to file the Korean translation corresponding to the PCT patent application. The amendment will take effect as of January 1, 2015 on PCT patent applications filed thereon.

### **3. Easing the regulation of the restoration of patent right**

In the event of a lapse of a patentee's right arising out of failure to pay patent fees, the KIPO has decided to ease the requirement for the restoration of patent right. Under the current law, in case that the patent right lapses due to the patentee's failure to pay patent fees, the patentee is able to apply for the restoration of his or her patent right upon the payment of patent fees amount of which is tripled within 3 months from the date of expiration limited to patented inventions in execution. Under the amended law, the requirement is eased to such extent that the payment of patent fees the amount of which is only doubled within 3 months from the date of expiration allows the patentee to apply for the restoration of his or her patent right so as to lift the burden off of the patentees' shoulders. As such, the patentees no longer need to submit written instruments establishing patented inventions in execution. The subject amendment has become enforceable and took effect concerning the applications for the restoration of patent right filed since June 11, 2014.

## **Amendment to Korean Trademark Act**

(effective as of June 11, 2014)

### **1. Easing the requirement on the recognition of a trademark's secondary meaning as a result of use**

(Paragraph 2 of Article 6)

The amended Act has relaxed the requirement on the registration of trademarks based upon use, thereby making the establishment of their secondary meanings possible even if the trademarks actually lack distinctiveness, and the requirement that such trademarks be recognized “prominently” as belonging to a certain person among general consumers as a result of using trademarks will not be enforced any longer. Rather, the same requirement is in place to the extent that it merely be distinctive as belonging to a particular person as a result of using his trademarks. Before this amendment, it was difficult for non-distinctive trademarks to be recognized prominently and as being of secondary meanings as a result of use since the interpretation of the word “prominent” or “prominently” was done strictly. However, by virtue of this amendment, it is much easier for non-distinctive trademarks to be recognized as being distinctive by using the marks as concerned, and thus confidence established in a person's business operations as a result of using his or her mark for a certain period of time can be better protected.

### **2. The newly added provision for the purpose of preventing well-known trademarks from being diluted**

(Paragraph 1, item 10 of Article 7)

The provision is added into Article 7(1)x of the Korean Trademark Act to such extent that trademarks at the risk of diluting the distinctiveness or fame of other persons' marks

recognized as being prominent among general consumers cannot be registered. Actually, the provision for the purpose of preventing the dilution of well-known trademarks has long been statutorily put into text by the Unfair Competition Prevention and Trade Secret Protection Act (“UCPTSPA”), but the UCPTSPA can only regulate the “act” of diluting well-known trademarks. However, by virtue of this amendment of the Trademark Act, the prevention of the registration of trademarks that can dilute the distinctiveness or fame of other persons’ marks recognized as being well-known has now been made possible in essence immediately at the stage of filing of trademark applications.

### **3. The newly added provision for the purpose of proscribing the registration of trademarks in contravention of the principles of good faith**

(Paragraph 1, item 18 of Article 7)

Article 7(1)xviii of the Korean Trademark Act has been newly enacted and is now enforceable to the extent that trademarks filed to register on the basis of their applicants’ knowledge that they are either similar or identical to those in use or in preparation for use in business partnerships, business operations, or other business relations cannot proceed to registration.

### **4. The newly added provision of the use of the registered trademarks in contravention of the principles of good faith**

(Paragraph 2 of Article 58)

Article 58(2) of the Korean Trademark Act has been newly enacted and is now enforceable to the extent that trademark registrants, exclusive licensees, or non-exclusive licensees cannot use registered trademarks without consent of another person, if such marks are subject to review under the Paragraph 1, item ‘CHA’ of Article 2 of the UCPTSPA, thereby constituting acts of exploiting another person’s economic advantages or gains by using methods in

contravention of fair commercial trade competition practice for self economic gains and if they are thus considered as "Acts of Unfair Competition".

---

**The Appointment of  
BARUN IP & LAW's Lead Partner Ho-Hyun Nahm, Esq.  
as Chairman of the Internet Address  
Dispute Resolution Committee - Korean  
Domain Name Dispute Resolution  
Organization**



Our firm's Lead Partner Ho-Hyun Nahm, Esq. has been recently appointed as Chairman of the Internet address Dispute Resolution Committee (IDRC) by the Minister of Science, ICT, and Future Planning. IDRC was established under Article 16 of the Act on Internet Address Resources enacted on January 20, 2004 to efficiently resolve domain name disputes arising under the rising property values of Internet Address resources. IDRC is comprised of judges, public prosecutors, professors, attorneys at law, patent attorneys and researchers of good reputation with substantial experience and expertise related to issues involving Internet Address. IDRC deliberates national policies related to Internet Address Disputes and offers quick, impartial and professional resolution services over .kr domain name disputes by using an administrative arbitration system based on the Act on Internet Address Resources, a mirror version of UDRP. The total number of cases handled by IDRC and DDRC (predecessor of IDRC) at the end of 2013 is around 500.

Mr. Nahm has been extensively engaging in domain name disputes resolution activities as panelist of the World Intellectual Property Organization (WIPO), the National Arbitration Forum (NAF) in the U.S., Asian Domain Name Resolution Centre (ADNDRC) and the

Internet address Dispute Resolution Committee (IDRC) for a long period of time.

Chairman Ho-Hyun Nahm of the Internet address Dispute Resolution Committee has stated as part of his speech when taking office that the Committee is endeavoring to prevent internet addresses from being the subject of speculation or the cause of social conflicts, to help to use internet addresses more effectively and efficiently, to establish a fair, rational order of the use of internet addresses, to guarantee the legitimate rights to use internet addresses, and to protect the registrants of trade names and trademarks.

**BARUN**  
I P & L A W

9th Fl., Saman Building, 520 Teheran-ro, Gangnam-gu, Seoul 135-846, Korea  
Tel. 82-2-3479-7000 / Fax. 82-2-3479-7070 / Homepage. [www.barunip.com](http://www.barunip.com)

If you have any questions or comment concerning the newsletter, please feel free to contact us at [office@baruncip.com](mailto:office@baruncip.com)