



*Newsletter – Spot 2016  
Seoul, Korea*

We wish to advise you of some of the recent changes brought to trademark practice in the wake of the February 29, 2016 revisions to the Korean Trademark Act effective as of September 1, 2016.

**1. Changing the timing of making a determination as to whether a mark is one that is ineligible to be registered**

Under the Revised Article 34 of the Korean Trademark Act that regulates the registration of trademarks, a determination of whether a mark filed to register is not eligible to be registered will be made at the time of making a substantive decision of whether it is subject to registration except for those filed to register in bad faith. Under current practice, when a trademark application is rejected for registration due to an another person's previously registered mark, re-filing the trademark application for the same mark is required after having the cited mark removed because the cited mark had remained an obstacle to registration by the filing date of the trademark application. In essence, it will not be necessary to re-file for a mark if it ceases to exist before there is a decision for registration despite the presence of a previously registered mark.

**2. The requirement that a non-use cancellation action be filed only by an interested party will be abolished. (Revised Article 119-5 of the Korean Trademark Act)**

Under current practice, a non-use cancellation action can be filed only by an interested party. Once a decision is rendered in a non-use cancellation action, the trademark right at issue will cease to exist in the future not retroactively under Article 73 of the Korean Trademark Act. Under the Revised Act, a non-use cancellation action can be filed by any person, and with a decision to cancel a mark on grounds of non-use rendered by the relevant authorities, the trademark right at issue will cease to exist retroactively effective as of the date of filing the action.

The purpose and intent of the Revised Act lie in the need to resolve a delay in examinations on trademarks filed to register that arises out of an increase in the number of unused trademarks, and it results in a narrower, limited scope of marks to file to register. Limiting the availability of filing non-use cancellation actions has also resulted in fights over who is entitled for such filings. Also, even in the absence of a substance that has to be protected as a right, resorting to the registration of a trademark would be inconsistent with the sentiment of the public in a legal sense, and the Revision is to resolve such irrational outcomes.

### **3. Abolishment of Regulation of filing for a mark within 1 year from the expiration of trademark right (Article 7(1)viii of Current Trademark Act)**

Under current practice, the registration of a mark by a third party within 1 year from the expiration of the trademark right is prohibited under Article 7(1)viii of the Korean Trademark Act. The purpose of this statutory provision is to counter a likelihood of confusion as to the source of goods or services in the trade among consumers with continuing trust and confidence in them and also to provide the original right holder to restore his or her trademark right. Under the Revised Act, the provision at issue will be removed to such extent that a third party will be allowed to file for a mark even after it expires without having to wait for a period of 1 year from the expiry date. (Revised Article 34 of the Korean Trademark Act)

The purpose and intent of this Revision lie in the notion that the currently enforceable statutory provision cannot necessarily help to counter a likelihood of confusion as to the source of goods or services since the assignment of registered trademark rights is still permissible under current practice and since licensing over two persons to use a registered

trademark is also freely possible. Also, there would be no need to grant further opportunities to restore his or her trademark right for his or her expired mark, provided that the expired mark has never been used. In any case that there is a mark that has expired and has in fact been used, seeking protection by means of the drafting of a license agreement would be possible, and therefore, the currently enforceable statutory provision will be abolished in that there is no actual benefit to be reaped under it.

**BARUN**  
I P & L A W

9th Fl., Saman Building, 520 Teheran-ro, Gangnam-gu, Seoul 06181, 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)