

Recent Developments in Korean Trademark System

May 2, 2022



특허청

Korean Intellectual
Property Office

Contents

1. Amendments to the Trademark Act

(Amended on Oct 19, 2021 → Take effect on Apr. 20, 2022)

2. Amendments to the Trademark Act

(Amended on Feb. 3, 2021 → Take effect on Feb. 4, 2023)

Korean Intellectual
Property Office
Trademark & Design
Examination Bureau
Design Examination
Policy Division

Amendments to the Trademark Act dated Oct 19, 2021

[Law No. 18502, Take effect **on** Apr. 20, 2022]

- Extend the period to request **an appeal** trial against an amendment rejection **decision** or a final rejection **decision** from 30 days to three months (Article 115 and 116 of the Trademark Act)
- The new law will be applicable from the cases where the applicant receives the notice of an amendment rejection decision or of a final rejection decision after April 20, 2022. (including International Registration designating the Republic of Korea)

2. Relax Requirements to File a Petition for Restoration of Trademarks

- The requirements to file a petition for restoration of trademark rights that have been extinguished due to invalidity of trademark procedures and non-payment of registration **fees** have been relaxed from “unavoidable reasons” to “justifiable reasons”. (Article 18(2) and 77(1) of the Trademark Act)
 - ☞ “Unavoidable reasons” are applicable to the very limited situations such as natural disasters or wars.
 - ☞ “Justifiable reasons” are applicable to emergency situations where the applicant cannot **proceed with** trademark procedures due to hospitalization for Covid-19

- When dividing an application with a priority claim, the priority claim of the resulting **divisional** application will be automatically recognized. If priority documents have been submitted along with the original application, the documents are deemed to have been also submitted for the resulting **divisional** applications. (Article 45 of the Trademark Act)
- ☞ If the applicant intends to cancel the automatically recognized priority claim, the claim, entirely or partially, can be canceled within 30 days from **the filing date of the divisional application**.
- **This new law will be applicable to divisional applications filed after the amendment goes into effect and will be applicable only to domestic applications.**

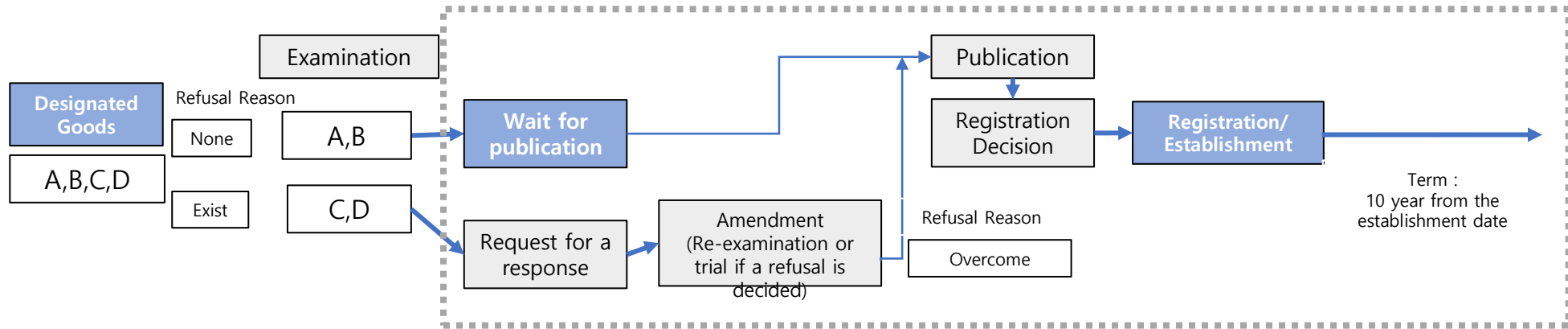
- An examiner can revoke a decision to grant registration and reopen the examination process on an application if s/he discovers a clear ground for rejection after a registration decision is made but before registration fees are paid and trademark rights are established. (Article 55 and Article 68 bis)
 - ☞ After a trademark right is established, an ex-officio re-examination is not allowed.
 - ☞ **Vague descriptions of goods** will not be considered as a clear rejection grounds for an ex-officio re-examination.
 - ☞ When an examiner intends to re-examine an application ex-officio, (s)he will notify the applicant that the registration decision of the application is due to be canceled.
 - ☞ The examiner will notify the applicant of **the refusal grounds** and provide an opportunity to respond.
- This new law will be applicable only to the domestic applications filed after April 20, 2022. (not applicable to **International Registration designating the Republic of Korea**)

Amendments to the Trademark Act dated Feb. 3, 2022

[Law No. 18817, Take effect on Feb. 4, 2023]

- As a result of trademark examination, if rejection reasons are limited only to some of the designated goods/services, the application will be **partially** granted registration for **the other** goods/services. (Article 54, 57 and 68 of the Trademark Act)
 - ☞ If only some of the goods/services have refusal reasons, **only after the refusal decision of these goods/services becomes final and conclusive.**, the application will be published and the registration will be granted for the goods/services with no refusal reasons.
 - ☞ If the rejected goods/services do not need to be registered, no further action is required for the applicant.
 - ☞ If the rest of the goods/services with **no refusal reasons** need to be registered in a fast manner, the applicant can abandon the **objected-to** goods/services or file for a divisional application.
- **This new law will be applicable** to the applications filed after Feb. 4, 2023

Outline of the Partial Refusal System



- After an applicant is notified of a final registration decision, if the rejection grounds can be easily overcome through the amendment of goods or services, (s)he can request a re-examination.
(Article 55 bis of the Trademark Act)
- ☞ If **the** rejection decision is made after an re-examination or an appeal against a **final** rejection decision, the applicant cannot request a re-examination.
- ☞ The re-examination request cannot be canceled.
- ☞ If a **final** rejection decision is made after a re-examination is **proceeded**, the applicant can request an **appeal** trial against the **final** rejection decision.
- This new law will be applicable to applications filed after Feb. 4, 2023.



특허청

Korean Intellectual
Property Office

감사합니다.

Thank you for your time and attention.