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Newsletter June 2009

Canada

A new Practice Note has introduced some changes to the opposition procedure in Canada. The most notable change is the introduction of a cooling off period to allow the parties time to conduct negotiations with a view to an amicable settlement. Either party can request the cooling off period with the consent of the other party. An opponent can request an extension of time of up to nine months, with consent, either prior to filing its statement of opposition or prior to filing its evidence. The applicant can also request an extension of time of up to nine months, with consent, either prior to filing its counter statement or prior to filing its evidence. The end result is a potential “cooling-off” period of a maximum of 18 months.

The Practice Notice also includes a tightening of the rules for other extensions of time and if a settlement is not reached within the “cooling-off” period, parties to opposition proceedings will now have even tighter (and non-extendable) deadlines to comply with. Therefore if the opposition reaches the evidence stage, it will be important to begin compiling the necessary supporting materials as early as possible.

Iran

On 10 March 2009 a new trade mark law came into force introducing a number of changes. Firstly applicants will now have only 60 days from filing their application to complete the relevant formalities, although a 60 day extension may be granted at the discretion of the Office.

If an opposition is based on an earlier non-registered right it is now compulsory for the opponent to file a trade mark application simultaneously with the opposition, otherwise the opposition is likely to be dismissed.

It will now be possible to apply for renewal of a trade mark up to twelve months preceding the renewal date. A six month grace period has also been introduced, although additional fees will be payable.

It is now possible to apply for cancellation of a mark on the grounds of non-use if a mark has not been used for an uninterrupted period of three years or more.

Following these changes there has been a significant increase in official fees by the Trade Mark Office.

Albania

A new Regulation on the Registration of Trade and Service Marks has entered into force in Albania.

The most important change brought about by the new regulation is the possibility for opposition based on relative grounds. Previously it has only been possible to file an opposition based on absolute grounds.

There have also been various procedural changes and an increase in official fees is expected soon.

Aruba

As of 1 June 2009 it will be possible to file for an expedited trade mark application in Aruba with only a small increase in the official fee. The trade mark should be registered in 5 working days.

South Korea

Since 1 April 2009 it has been possible to request an expedited examination of a trade mark application in certain circumstances. The expedited process decreases the period between filing and examination from the usual five to seven months down to only two months. Applicants, who have filed applications for marks that are currently in use, or are ready for use, may apply for expedited examination. Likewise expedited examination can be requested by an applicant whose trademark is being used by a third party without his consent and the applicant has sent a cease and desist letter or filed for an injunction to prevent the third party's use of the mark.

If you require further advice please contact your attorney or e-mail HallMark at info@hallmark-ip.com.