

## **TRADE MARKS RULES (1996)**

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I, Richard Bruton, Minister for Enterprise and Employment, in exercise of the powers conferred on me by section 81 of the Trade Marks Act, 1996 (No. 6 of 1996), and in exercise, with the sanction of the Minister for Finance, of the powers conferred on me by section 82 of that Act, and in exercise of the powers conferred on me by section 92(1) of the Patents Act, 1992 (No. 1 of 1992), as amended by section 73 of the Trade Marks Act, 1996, hereby make the following rules:

### **Preliminary ➡**

*Short title.*

1. These rules may be cited as the Trade Marks Rules, 1996.

*Interpretation.*

2. (1) In these Rules, unless the context otherwise requires—

"the Act" means the Trade Marks Act, 1996 (No. 6 of 1996);

"agent" means an agent duly authorised in accordance with these Rules and registered in the Register of Trade Mark Agents;

"form" means a form set out in Schedule 2;

"Schedule" means one of the Schedules to these rules;

"section" means a section of the Act;

"specification" means the statement of goods or services in respect of which a trade mark is registered or proposed to be registered.

(2) In these Rules a subsection of a section is indicated by a number enclosed in brackets immediately following the number of the section.

*Commencement.*

3. These Rules shall come into operation on the first day of July, 1996.

*Fees.*

4. (1) The fees to be paid in relation to any matter under the Act and these Rules shall be those specified in Schedule I.

(2) Fees shall be paid in the currency of the State. Save as otherwise provided in this Rule, payment of a fee or fees by any person shall be made by cheque payable to the Minister for Enterprise and Employment and crossed "& Co.", guaranteed to the satisfaction of the Controller, drawn on any bank carrying on business in the State and presented at the Office with the application or the matter to which it relates.

(3) Payment of a fee or fees by a person who, at the date of payment, is outside the State shall be made by banker's draft, or Post Office Money Order, payable to the Minister for Enterprise and Employment and crossed "& Co.", and sent by post to the Office.

(4) Any fee or fees paid at the Office not exceeding £200 may be paid in cash.

(5) (a) A request for the remission of the whole or part of any fee properly paid shall be made in writing.

(b) No appeal shall lie from any decision of the Controller in respect of such a request.

*Certificates for use in obtaining registration abroad.*

5. (a) The Controller may issue certificates for use in connection with applications for registration abroad of marks which are the subject of applications pending before the Controller or which he or she has registered in the register.

(b) A certificate shall contain such information about a pending application or a registration as may be appropriate.

*Classification of goods and services.*

6. For the purposes of the registration of trade marks, goods and services shall be classified as specified in the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks (1957), as revised at Stockholm (1967) and at Geneva (1977), and as amended.

*Signature of documents.*

7. A document purporting to be signed by, or on behalf of, a partnership or body corporate shall be signed, by any person who is duly authorised to sign the document.

*Filing of documents.*

8. (a) (i) Any application, notice or other document authorised or required under the Act or these Rules to be delivered to the Controller or any other person may be sent by post.

(ii) In proving the sending it shall be sufficient to prove that the letter was properly addressed, prepaid (when requisite) and posted.

(b) The Controller may at his or her discretion allow submission of documents by other means subject to such terms or conditions as may be specified by him or her and published in the Journal.

*Translations.*

9. (1) Where a document or part thereof which is in a foreign language is sent to the Controller in connection with any proceedings under the Act or these Rules, a translation verified to the satisfaction of the Controller shall also be furnished to the Controller.

(2) The Controller may refuse to accept any translation which is in his or her opinion inaccurate and thereupon another translation verified as aforesaid shall be furnished, together with the appropriate number of copies thereof.

*Address for service.*

10. (1) (a) Every applicant and any person concerned in any proceeding under the Act or these Rules and every trade mark proprietor shall give to the Controller an address for service in the State and that address may for all purposes under the Act and these Rules be treated as the actual address of the person who has furnished it.

(b) A letter addressed to such applicant, person or proprietor to his or her address for service shall be deemed to be properly addressed.

(2) For the purposes of this Rule, in a case where the person or proprietor concerned desires that the address for service shall consist of the address of an agent who is registered in the Register of Trade Mark Agents, the Controller may accept an address for service comprising the name of the agent so registered followed by a statement in the following terms: "at his or her address as recorded for the time being in the Register of Trade Mark Agents".

(3) Where an address for service has not been given as required under paragraph (1), the Controller shall send the person concerned notice to file an address for service within two months of the date of the notice and if that person fails to do so—

(a) in the case of an applicant under section 37, 51, 52 or 67, the application shall be treated as abandoned;

(b) in the case of a person referred to in section 43(2) or 43(3), the person shall be deemed to have withdrawn from the proceedings; and

(c) in the case of a proprietor of a registered trade mark which is the subject of an application under Rule 41, the proprietor shall not be permitted to take part in proceedings.

*Revocation of existing rules &c.*

11. (1) Subject to paragraph (2), the Rules specified in Schedule 3 are hereby revoked.

(2) The said Rules shall continue to apply to any matter to which by virtue of section 100 of, and the Third Schedule to the Act, the Act of 1963 continues to apply.

### **Application for Registration** ➡

12. (1) The following documents are hereby prescribed for the purpose of section 38:

(a) a document indicating that registration of a trade mark is sought and containing the name and address of the person requesting registration;

(b) a document containing a representation of the mark the registration of which is sought;

(c) a document in which the goods or services in respect of which the mark is to be registered are stated.

(2) (a) An application for registration of a trade mark shall be made in Form No. 1 and shall contain the information required by that Form.

(b) Where a right to priority is claimed, the information required by Form No. 1 concerning claims to priority shall be furnished in the Form.

(3) (a) A representation of a mark shall not exceed 8cm x 8cm in size unless the Controller, in the case of a specific application, agrees to a greater size.

(b) The Controller may request an applicant to submit additional representations of a mark.

(c) Where an application indicates that registration of a three-dimensional mark is sought, the representation of the mark shall consist of a photographic reproduction or a graphic representation of the mark. A number of perspectives not exceeding 6 may be submitted. The representation which most characteristically illustrates the mark shall be shown in the space indicated in Form No. 1 and the additional perspectives shall be submitted on separate sheets.

(d) The Controller may give directions either generally, or by reference to a specific application for registration, as to the furnishing and form of representation of marks for the purpose of applications for registration.

(4) If an applicant states that a mark, when used, will be in a particular colour (or colours), this fact shall be published by the Controller when the application for registration has been accepted and shall be entered in the register upon registration of the mark.

(5) If the application fee was not submitted with the application and is not received within a period of one month from the date of filing of an application for registration as determined under section 38(1), the application shall be deemed to have been abandoned at the end of that period.

#### *Claim to priority.*

13. Where a right to priority is claimed under section 40 or 41 there shall be filed, with the application or within 3 months of the date of filing thereof, a certificate by the competent national authority verifying to the Controller's satisfaction the date and country of filing, the

representation of the mark, the goods or services covered by the earlier application and its filing number.

*Application may be for more than one class.*

14. (1) A single application may be made for registration in respect of one or more classes of the Nice Agreement.

(2) Every application shall specify the class or classes to which it relates and shall specify the goods or services relating to that class in respect of which registration is sought.

(3) The Controller may require the applicant to amend an application which specifies goods or services by reference to a class in which they do not fall, and to pay any additional class fee or fees which may be required.

*Matters not registrable.*

15. The Controller may refuse to accept any application for the registration of a mark upon which any of the following appears in the representation of the mark:—

(a) the word "Patent", "Patented", "Registered", "Copyright", or any other word or any symbol with a like signification;

(b) any badge, emblem, or device referred to in section 9(3) unless the written consent of the appropriate public authority to the registration is furnished to the Controller;

(c) words or initials precluded from registration by section 31 of the Industrial Research and Standards Act, 1961 (No. 20 of 1961).

### **Procedure on Receipt of Application ➡**

*Search.*

16. (1) For the purposes of sections 10 and 11, the scope and methodology of the search of earlier trade marks shall be as determined by the Controller.

(2) The Controller may at his or her discretion cause a search to be renewed at any time before the acceptance of an application.

*Publication.*

17. An application for registration which has been accepted shall be published in the Journal in such manner as the Controller may direct and the Controller shall inform the applicant of the acceptance.

*Notice of opposition to registration.*

18. (1) Notice of opposition under section 43 shall be sent to the Controller within three months of the date of publication of the application in the Journal.

(2) The notice of opposition shall be submitted in duplicate accompanied by the prescribed fee or evidence of payment thereof, and shall include a statement of the grounds of opposition.

(3) The Controller shall on receipt of the notice of opposition send a copy to the applicant.

*Counter-statement.*

19. (1) Within three months of receipt by the applicant of a copy of the notice of opposition, the applicant shall file a counter-statement in duplicate with the Controller, accompanied by the prescribed fee or evidence of payment thereof.

(2) The Controller shall on receipt of a counter-statement forthwith send a copy thereof to the opponent and failing receipt of a counter-statement within the prescribed period the application shall be deemed to have been withdrawn.

*Evidence in support of opposition.*

20. (1) Within three months of receipt by the opponent of the copy of the counter-statement under Rule 19, the opponent shall file with the Controller such evidence by way of statutory declaration as he or she desires to adduce in support of his or her opposition and shall send to the applicant a copy thereof.

(2) Unless the Controller otherwise directs, an opponent who fails to file evidence under this Rule shall be deemed to have abandoned his or her opposition and the Controller shall proceed with the application accordingly.

*Evidence in support of application.*

21. If the person opposing the registration files evidence under Rule 20, the applicant shall, within three months of receipt of a copy of such evidence, file such evidence by way of statutory declaration as he or she desires to adduce in support of the application with the Controller and shall send a copy thereof to the opponent.

*Evidence in reply by opponent.*

22. (1) The opponent may, within two months of receipt of a copy of the evidence filed with the Controller under Rule 21, file evidence with the Controller by way of statutory declaration and shall deliver to the applicant a copy thereof.

(2) Evidence filed by the opponent under this Rule shall be confined to matters strictly in reply.

*Further evidence*

23. No further evidence may be filed unless, in any proceedings before the Controller, the Controller gives leave to either the applicant or the opponent to file evidence upon such terms as to costs or otherwise as the Controller may think fit.

*Exhibits.*

24. (1) (a) Where there are exhibits to declarations filed in an opposition, a copy or

impression of such exhibits shall be sent to the other party unless such copy or impression cannot conveniently be furnished.

(b) If such copy or impression cannot conveniently be furnished, the originals shall be left with the Controller for inspection by the party concerned, and any dispute arising as to whether a copy or impression can conveniently be furnished, shall be determined by the Controller.

(2) The original exhibits shall be produced at the hearing of an opposition unless the Controller otherwise directs.

#### *Hearing.*

25. (1) Upon completion of the evidence the Controller shall give notice to the parties of a date for a hearing, which shall be at least 21 days after the date of the notice unless the parties consent to a shorter notice.

(2) Within seven days of receipt of the notice, a party who intends to appear at the hearing shall so notify the Controller and shall pay the prescribed fee.

(3) A party who fails to notify the Controller in accordance with this Rule may be treated as not desiring to be heard, and the Controller may act accordingly,

#### *Amendment of Application.*

26. (1) Where a notice under section 44(1) restricting the goods or services covered by an application is received after publication of the application in response to a notice of opposition under Rule 18(1) or in the course of opposition proceedings the following provisions shall apply:

(i) the Controller shall, following publication of the restriction, inform the opponent of the restriction;

(ii) an opponent who has been informed by the Controller in accordance with subparagraph (i) shall, within one month of the date of the communication from the Controller inform the Controller whether he or she wishes to abandon his or her opposition, to amend the notice of opposition filed under Rule 18 or to pursue the opposition on the basis of the notice of opposition given;

(iii) an opponent who does not respond to a communication from the Controller under subparagraph (i) within the time allowed shall be deemed to have expressed a wish to proceed with the notice of opposition as given.

(iv) where an opponent decides, in response to a communication under subparagraph (i), to amend the notice of opposition he or she shall inform the Controller accordingly and shall, at the same time, furnish to the Controller an amended notice of opposition in duplicate. A copy of the amended notice shall be sent

by the Controller to the applicant. The amended notice shall be deemed to be the notice of opposition under Rule 18 and Rules 18 to 25 shall apply accordingly;

(v) where no notice of opposition had been given to the Controller under section 43(2) before the publication of the notice restricting the goods or services covered by an

application, any notice of opposition under section 43(2) shall relate to the published application as restricted by the notice under section

44(1); and the prescribed period for filing of notice of opposition shall, in such case, be deemed to commence on the date on which the notice restricting the goods or services was published by the Controller.

(2) Where a request under section 44(3) to amend an application which has been published is filed in response to a notice of opposition under Rule 18(1) or in the course of opposition proceedings, and the proposed amendment affects the representation of the mark or the goods or services covered by the application, the Controller shall publish the proposed amendment and the provisions of subparagraphs (i) to (v) of paragraph (1) shall, subject to the appropriate modifications, apply;

(3) Where a request under section 44(3) to amend an application is filed prior to the date of publication of the application and the proposed amendment affects the representation of the mark or the goods or services covered by the application, the Controller shall, if he or she accepts the application, cause the application as amended to be published under section 43(1); and the provisions of Rules 18 to 25 shall thereupon apply.

#### *Notification of Controller's decision and grounds.*

27. (1) The decision of the Controller in the exercise of any discretionary power following a hearing before him or her shall be notified to the party or parties concerned.

(2) A written statement of the grounds of a decision under paragraph (1) shall be furnished if application, accompanied by the prescribed fee, is made to the Controller by a party to the hearing within one month from the date of notification of the decision.

(3) Where, following inter partes proceedings, a written statement of grounds is furnished to one of the parties the Controller shall furnish every other party with a copy of the statement.

### **Division, Merger and Series of Marks ➡**

#### *Division of application.*

28. (1) (a) At any time before a notification of acceptance by the Controller of an application has been issued, the applicant may send to the Controller a request for a division of the application ("the original application") into two or more separate applications ("divisional applications"), indicating for each divisional application those goods or services of the original application which are to be covered by it. A request for a division of an application shall be accompanied by the prescribed fee.

(b) A divisional application shall comply with the provisions of Rule 12(2) and (3) and shall be treated as a separate application for the purposes of the Act and these Rules save that the fee prescribed for the purpose of section 37(3) shall not be payable upon the filing of a divisional application. A divisional application shall have the same date of filing and priority date (if any) as the original application.

(c) A request under subparagraph (a) shall, in relation to the original application, have the effect that the goods or services which are to be covered by any divisional application shall be excluded from the original application.



(2) Upon division of an original application in respect of which notice had been given to the Controller of particulars relating to the grant of a licence, or a security interest or any right in or under the mark, the notice and the particulars shall be deemed to apply in relation to each of the divisional applications.

(3) An applicant may, after publication of an application, submit a request for a division of the application in response to a notice of opposition under Rule 18 or in the course of opposition proceedings; and where the applicant does so, the Controller shall inform the opponent and the provisions of Rule 26 (1), (ii), (iii) and (iv) shall apply to the opposition proceedings.

*Merger of separate applications or registrations.*

29. (1) An applicant who has made separate applications for registration of the same mark may, at any time before a notification of acceptance of any of the applications has issued to the applicant, request the Controller to merge the separate applications into a single application.

(2) The Controller shall merge the applications into a single application if satisfied that they all —

(a) are in respect of the same trade mark, and

(b) bear the same date of filing and priority date (if any),

(3) Subject to the conditions in paragraph (4), a person who is the registered proprietor of two or more marks separately registered in his or her name may request the Controller to merge the separate registrations into one single registration.

(4) The conditions referred to in paragraph 3 are:

(i) each of the separate registrations shall relate to the same mark and have the same date of registration (as defined in section 45(3)) and priority date, if any, pursuant to section 40 or 41;

(ii) where a registrable transaction is recorded in the register, in respect of any of the marks to be merged, the Controller shall not merge the registrations unless the same transaction is recorded in respect of each of the other marks;

(iii) any of the marks shall not have been registered subject to any disclaimer or limitation or, if so registered, the nature of the disclaimer or limitation must be the same in respect of each mark.

(5) The Controller shall, if satisfied that the separate registrations may be merged following consideration of a request under paragraph (3), determine the entry to be made in the register in relation to the single registration.

(6) Following the entry in the register referred to in paragraph (5), the separate registrations shall be deemed to have been removed from the register as of the date of the entry; and the entry shall be deemed to be a registered trade mark for the purpose of the Act and these Rules.

(7) The provisions of paragraphs (3) to (6) shall not apply in relation to marks which are

collective or certification marks.

*Registration of a series of trade marks.*

30. (1) (a) The proprietor of a series of trade marks may apply to the Controller for their registration as a series in a single registration and there shall be included in such application a representation of each mark claimed to be in the series.

(b) The Controller may, if satisfied that the marks constitute a series, register them in a single registration.

(2) Where the proprietor of a registered series of trade marks requests the Controller to delete a mark in that series, the Controller shall record such deletion in the register.

**Collective and Certification Marks ➡**

*Application under section 54.*

31. (1) The applicant shall file regulations governing the use of the mark with the Controller within six months of the date of application for registration of a collective mark. The regulations shall be accompanied by the prescribed fee.

(2) For the purpose of paragraphs 7(2) and 7(3) of the First Schedule to the Act, a period of 3 months from the date the specified conditions referred to in these subparagraphs are notified to the applicant, is hereby prescribed.

(3) For the purpose of paragraph 8(1) of the First Schedule to the Act, the regulations governing the use of the mark shall be open to public inspection on and from the date of publication of the application in the Journal and the period during which opposition to the regulations may be given, or observations made thereon, shall be 3 months from the said date of publication.

(4) A notice of opposition under paragraph 8(1) of the First Schedule to the Act shall contain a statement of the grounds of opposition and shall be accompanied by the prescribed fee.

(5) The Controller shall send a copy of a notice of opposition to the applicant and shall, thereafter, determine the procedure to be followed before deciding the issue.

*Amendment of regulations governing use of collective marks.*

32. (1) Where regulations governing the use of a collective mark are amended, the regulations, as amended, shall be submitted to the Controller in accordance with paragraph 10 of the First Schedule to the Act.

(2) Following acceptance of amended regulations, the Controller shall publish a notice in the Journal indicating that copies of the amended regulations are available for public inspection at the Office.

*Application under section 55.*

33. (1) The applicant shall file the regulations governing the use of the mark and pay the fee

prescribed for this purpose within six months of the date of authorisation to proceed under paragraph 7(3) of the Second Schedule to the Act. At the option of the applicant the regulations, accompanied by the prescribed fee, may be filed with the Controller at an earlier date.

(2) Where the Controller authorises an application to proceed, a report shall be furnished by him or her to the Minister thereon if the applicant files the regulations referred to in paragraph (1) of this Rule. The Minister may, if necessary, hear the applicant before giving a direction under paragraph 8 of the Second Schedule to the Act.

(3) For the purposes of paragraphs 8(2) and 8(3) of the Second Schedule to the Act a period of 4 months from the date of the notification of any conditions imposed by the Minister is hereby prescribed.

(4) (a) For the purpose of paragraph 9 of the Second Schedule to the Act, the regulations governing the use of the mark shall be open to public inspection on and from the date of publication of the application in the Journal in accordance with section 43(1) and the period during which opposition may be given, or observations made, under the provisions of that Paragraph shall be 3 months from the said date of publication.

(b) A notice of opposition under paragraph 9 of the Second Schedule to the Act shall contain a statement of the grounds of opposition and shall be accompanied by the prescribed fee.

(c) A notice of opposition shall be filed with the Minister and the opponent shall, simultaneously, furnish the Controller with a copy. On receipt of a notice of opposition the Minister shall send a copy of the notice to the applicant and shall, thereafter, determine the procedure to be followed before he or she decides the issue.

*Amendment of regulations governing use of certification marks.*

34. (1) Where the proprietor of a registered certification mark requests that the regulations governing the use of the mark be amended, a draft of the regulations showing desired amendments thereon shall be submitted to the Controller.

(2) Where it appears expedient to do so, the Minister shall cause a request to amend regulations under paragraph (1) of this Rule to be published.

(3) (a) Any person may, within three months of the date of the publication under paragraph (2) of this Rule, give notice to the Minister of opposition to the amended regulations on the grounds that they do not satisfy paragraph 7(1)(a) of the Second Schedule to the Act or that the proprietor of the mark is not competent to certify the goods or services for which the mark is registered.

(b) The notice of opposition shall be accompanied by a statement setting out fully the grounds upon which the amended regulations are opposed.

(4) A copy of any notice and statement under paragraph (3) of this Rule shall be sent by the Minister to the proprietor.

(5) The Minister shall not decide the matter without giving the parties an opportunity to be heard.

(6) Following the consent of the Minister to amended regulations the Controller shall publish a notice in the Journal that copies of the amended regulations are available for public inspection at the Office.

### **Alterations and Surrender of Registered Trade Mark. ➡**

#### *Alteration of registered trade mark.*

35. (1) An application under section 49(1) shall state the reasons therefor and the Controller may require the submission by the proprietor of evidence in support of the application.

(2) Where an application under section 49(1) is advertised in the Journal by the Controller, any notice of opposition under section 49(3) shall be filed with the Controller within 3 months of the date of the advertisement of the application. A notice of opposition shall state fully the grounds upon which the application is opposed and shall be accompanied by the prescribed fee. Upon receipt of a notice, the Controller shall send a copy thereof to the proprietor and shall hear the parties, if so required, before he or she decides the matter.

#### *Surrender of registered trade mark.*

36. (1) A notification of surrender of a registered trademark shall be submitted to the Controller and shall specify the goods or services covered by the registration in respect of which the mark is being surrendered.

(2) The Controller shall not act upon a notice of surrender under paragraph (1) unless the proprietor, in that notice —

(a) certifies that he or she is not precluded by contract or other agreement or arrangement from surrendering the mark,

(b) specifies the name and address of each person entered in the register as having an interest in the mark, and

(c) certifies that each of the persons named under (b) has been notified of the proprietor's intention to surrender the mark at least 3 months prior to the date of the notice to the Controller and that none of the persons has objected to the surrender.

(3) If it appears to the Controller from the register that a person other than the proprietor has an interest in the mark and that person's name is not included in the list referred to in paragraph (2)(b), the Controller may require the proprietor to notify that person of the proposed surrender and shall not act on the notice to surrender the mark until he or she is satisfied that the person notified under this paragraph has not objected to the surrender within the period specified in paragraph (2).

(4) Where the proprietor has complied with the requirements of this Rule, the Controller shall enter the surrender of a trade mark in the register and notice of the surrender shall be published in the Journal.

(5) As from the date of publication in the Journal of the notice referred to in paragraph (4), the effects of registration shall, to the extent that the mark has been surrendered, cease to apply; but no action for infringement shall lie in respect of any act done before that date.

## **Renewal and Restoration** ➡

### *Reminder of renewal of registration.*

37. At any time not earlier than six months nor later than one month before the expiration of the registration of a trade mark or any renewal thereof, the Controller shall (except where renewal has already been effected under Rule 38) send to the registered proprietor notice that the registration may be renewed as prescribed in that Rule and of the date of expiry.

### *Renewal of registration.*

38. An application for the renewal of the registration of a trade mark shall be effected by filing a request for renewal under section 48 at any time not earlier than six months before the expiration of the registration or any renewal thereof as the case may be, accompanied by the prescribed fee or evidence of payment thereof.

### *Delayed renewal and removal of registration.*

39. (1) If, on the expiration of the registration of a trade mark or renewal thereof, the renewal fee has not been paid the Controller shall publish that fact; and if, within six months from the date of the expiration of the registration or renewal thereof, a request for renewal is filed accompanied by the renewal fee and the prescribed additional fee, the Controller shall renew the registration and shall inform the proprietor thereof.

(2) Where a request for renewal is not so filed together with the prescribed renewal and additional fees, the Controller shall, subject to Rule 40, remove the mark from the register.

(3) Where the date of issue of a certificate of registration of a mark is later than two months prior to expiry of the period of 10 years specified in section 47, the following provisions shall apply:

(i) the period within which a request for renewal of registration shall be filed under Rule 38 and the prescribed fee paid shall be the unexpired term of the 10 year period or 6 weeks from the date of issue of the certificate of registration, whichever is the later.

(ii) the Controller shall not publish a notice of non-payment under paragraph (1) until after the expiry of the appropriate period provided for in subparagraph (i).

(iii) the other provisions of this Rule shall apply subject to the modifications in subparagraphs (i) and (ii).

### *Restoration of registration.*

40. (1) Where a mark has been removed from the register for failure to renew its registration the Controller may, upon a request filed within six months of the date of publication of the removal of the mark accompanied by the appropriate renewal fee and appropriate restoration fee, restore the mark to the register and renew its registration if, having regard to the circumstances of the failure to renew, the Controller is satisfied that it is just to do so.

(2) The restoration of the registration shall be published in the Journal.

## **Revocation, Invalidation and Rectification** ➡

*Procedure on application for revocation, declaration of invalidity and rectification of the register.*

41. (1) An application to the Controller for revocation under section 51 or for a declaration of invalidity under section 52 or for the rectification of an error or omission in the register under section 67 shall contain a statement of the grounds on which the application is made and shall be accompanied by the prescribed fee.

(2) Where any application is made under paragraph (1) of this Rule by a person other than the proprietor of the registered trade mark, the Controller shall send a copy of the application and the statement to the proprietor.

(3) Within three months of receipt by the proprietor of the copy of the application and the statement the proprietor may file a notice of opposition with the Controller and the Controller shall send a copy thereof to the applicant:

Provided that where an application for revocation under section 51(4) is based on a ground of non-use specified in section 51(1)(a) or (b), the proprietor shall file with the notice of opposition evidence of the use by him or her of the mark; and upon failure to do so, the Controller may dismiss the opposition and grant the application.

(4) The Controller may require the submission to him or her of any further evidence, statement or counter-statement within such time as he or she may decide. Subject to the proviso in paragraph (3) above, the Controller shall hear the parties, if so required, before deciding upon an application.

## **The Register** ➡

*Form of register.*

42. The register required to be kept by the Controller under section 66(1) may be kept in such form as the Controller may determine.

*Entry in register of particulars of registered trade marks.*

43. Upon registration, there shall be entered in the register in respect of each trade mark the following particulars —

(a) the date of registration as determined in accordance with section 45(3) (that is to say, the date of the filing of the application for registration);

(b) the date of publication of the registration as provided for in section 45(5);

(c) the priority date (if any) claimed pursuant to section 40 or 41;

(d) the name and address of the proprietor;

(e) the address for service furnished pursuant to Rule 10 above;

- (f) any disclaimer or limitation subject to which the mark is registered;
- (g) the goods or services in respect of which the mark is registered and their class or classes;
- (h) where the mark is a collective or certification mark, that fact; and
- (i) any consent pursuant to section 10(6) by the proprietor of an earlier trade mark or other earlier right to which that section relates.

*Entry in register of particulars of registrable transactions.*

44. For the purpose of section 29 the following are the particulars to be entered in the register in relation to registrable transactions;

- (a) in the case of an assignment of a registered trade mark or any right in it —
  - (i) the name and address of the assignee,
  - (ii) the nature and date of the document upon which the interest of the assignee is based, and
  - (iii) where the assignment is in respect of any right in the mark, a description of the right assigned;
- (b) in the case of the grant or assignment of a licence under a registered trade mark —
  - (i) the name and address of the licensee,
  - (ii) whether or not the licence is an exclusive or non-exclusive licence,
  - (iii) where the licence is limited, a description of the limitation, and
  - (iv) the duration of the licence if the same is, or is ascertainable as, a definite period;
- (c) in the case of the grant of any security interest over a registered trade mark or any right in or under it —
  - (i) the name and address of the grantee,
  - (ii) the nature of the interest (whether fixed or floating), and
  - (iii) the extent of the security and the right in or under the mark secured;
- (d) in the case of the making by a personal representative of a vesting assent in relation to a registered trade mark or any right in or under it —
  - (i) the name and address of the person in whom the mark or any right in or under it vests by virtue of the assent,
  - (ii) the date of the assent; and

(iii) the nature of the vesting assent;

(e) in the case of an order of a court or other competent authority transferring a registered trade mark or any right in or under it —

(i) the name and address of the transferee,

(ii) the date and particulars of the order, and

(iii) where the transfer is in respect of a right in the mark, a description of the right transferred;

and in each case, there shall be entered the date on which the entry is made.

*Application to register transactions under section 29.*

45. (1) An application under section 29(1) shall —

(a) where the transaction is an assignment, be signed by or on behalf of the parties to the assignment;

(b) where the transaction falls into any of the other categories specified in section 29(2) (b) to (d), be signed by or on behalf of the grantor of the right.

(2) An application under section 29(1) shall be accompanied by the prescribed fee and by a certified copy of the instrument or document upon which the claim of the person whose title or interest is to be entered in the register is based.

(3) Where a transaction is effected by an instrument chargeable with duty, the applicant shall satisfy the Controller that the instrument has been duly stamped.

*Notices under section 31.*

46. (1) Notices given to the Controller in pursuance of section 31 shall comply with the requirements specified in Rule 45 in respect of applications under section 29(1).

(2) If a notice pursuant to section 31 relates to an assignment and it appears to the Controller from the notice and accompanying documents that the assignee should be recorded in the register as the proprietor of the trade mark in question, if registered, the entry to be made in the register in pursuance of Rule 43(d) shall be construed accordingly.

(3) If a notice pursuant to section 31 relates to a licence, a security interest, a vesting assent or an order of a court and it appears to the Controller in the case of any such transaction that it applies to the trade mark, if and when registered, the Controller shall, upon registration, enter the relevant particulars in the register.

*Public inspection of register.*

47. The register shall, on payment of the prescribed fee, be open to public inspection at the Office during the hours each day that the Office itself is open to the public.

*Supply of certified copies, &c.*



48. The Controller shall on request accompanied by the prescribed fee supply a certified copy or extract or uncertified copy or extract of any entry in the register.

*Request for change of name or address in register.*

49. (1) The Controller shall, on request accompanied by the prescribed fee, by the proprietor of a registered trade mark or a licensee, enter any change in the name or address of the person making the request as recorded in the register and the person concerned shall be informed when the change is made in the register.

(2) The Controller may at any time, on request by any person who has furnished an address for service under Rule 10, if the address is recorded in the register, change it and the person concerned shall be informed when the change is made in the register.

*Change of classification.*

50. (1) Where, in pursuance of section 68(1), the Controller proposes to amend existing entries in the register, the Controller shall give the proprietor of the mark written notice of his or her proposals and shall publish the proposals in the Journal.

(2) Notice of opposition to the proposals may be filed within three months of the date of publication of the proposals. A notice shall state the grounds of opposition and shall include in particular, any grounds based on matters to which section 68(3) relates.

(3) The Controller may require or admit any evidence which he or she considers relevant to the questions at issue and, if so requested by any opponent, give that opponent an opportunity to be heard thereon before deciding the matter.

(4) If no notice of opposition under paragraph (2) of this Rule is filed within the time specified, the Controller shall amend the register in accordance with the proposals published under paragraph (1).

### **Registered Trade Mark Agents** ➔

*Application for registration.*

51. (1) An application under section 86 for registration in the Register of Trade Mark Agents shall be made in writing to the Controller, shall be accompanied by the prescribed fee and shall contain:—

(a) in case the applicant is an individual, the first names, surname, date of birth, nationality and private address of the individual, the name or style under which he or she carries on or proposes to carry on business as a registered trade mark agent (if other than his or her full name), and a statement of his or her educational and professional qualifications,

(b) in case the applicant is a partnership, the first names, surname, date of birth and nationality of each of the partners, the name or style under which the partnership carries on or proposes to carry on business as a registered trade mark agent, and a statement that all the partners are registered in the Register of Trade Mark Agents,

(c) the address at which the applicant carries on or proposes to carry on business as a registered trade mark agent,

(d) in case the applicant is an individual who proposes to become a member of a partnership, the full name or style under which and the address at which the partnership carries on, or proposes to carry on, business as a registered trade mark agent.

(2) Applications for registration in the Register of Trade Mark Agents shall be considered by a Board consisting of the Controller and other persons nominated for the purpose by the Minister.

(3) For the purposes of section 86 a person shall possess such educational and professional qualifications and be of such personal character as to satisfy the Board, after such inquiries, including such oral or written examination in the law and practice of trade marks, as the Board deems necessary, that such person is fit to practise as a registered trade mark agent.

*Proof of authorisation of agent may be required*

52. The Controller may by notice in writing sent to an agent require the agent to produce evidence of the agent's authority.

*Entry in the Register of Trade Mark Agents.*

53. (a) Subject to the provisions of section 86 and these Rules, an applicant shall, upon payment of the prescribed fee, be registered by the Controller in the Register of Trade Mark Agents.

(b) The entry in that register shall include the date of registration and, in case the applicant is a partnership, the business name and address thereof and the full name and private address and particulars of the qualifications for entry of each of the partners or, in any other case, the full name, business name (if any), private and business address of the applicant together with particulars of the applicant's qualifications for entry, and such other particulars as the Controller considers desirable.

(c) Where the address of an applicant who has been entered in the register changes, the Controller shall record the new address on receipt of a written request from the person concerned.

*Publication of entries in Register of Trade Mark Agents.*

54. The Controller shall publish in the Journal particulars of entries in the Register of Trade Mark Agents, and shall so publish before the end of March in each year a list in alphabetical order of the names entered in that register.

*Payment of annual registration fee.*

55. The prescribed annual fee in respect of each registration shall be payable before the 1st day of December in each year in respect of the following year, and in case it is not paid within one month from that date the Controller shall send to the registered trade mark agent at such agent's registered business address a notice in writing requiring such agent to pay the fee on or before a date to be mentioned in the notice, and in the case of failure to pay the fee within the time specified in the notice the Controller may cause the name of such agent to be erased from the Register of Trade Mark Agents.

*Request for removal from Register of Trade Mark Agents.*

56. Any person registered in the Register of Trade Mark Agents desiring to be removed therefrom shall make a request to that effect in writing to the Controller, who shall thereupon amend that Register accordingly.

*Notice to Controller of application to the Court under subsection (3) of section 88.*

57. Where a person applies to the Court under section 88(3) for cancellation of a decision by the Controller, the notice to the Controller of such application shall be in writing and shall be given at the time when the person so applies to the Court. The notice shall be accompanied by a copy of the application.

*Application for restoration to Register of Trade Marks Agents.*

58. (1) A person desiring to be restored to the Register of Trade Mark Agents under section 89(3) shall make an application to that effect in writing to the Controller.

(2) An application under section 89(4) shall be in writing.

*Controller may refuse to deal with certain agents.*

59. The Controller may refuse to recognise in respect of any business under the Act —

(a) an individual whose name has been erased from and not restored to, or who is suspended from, the Register of Trade Mark Agents;

(b) a person who is found by the Minister to have been guilty of such conduct as would, in the case of an individual registered in that register, render such person liable to have his or her name erased from it on the ground of misconduct;

(c) a partnership or body corporate of which one of the partners or directors is a person whom the Controller could refuse to recognise under paragraph (a) or (b) of this Rule;

(d) any solicitor whose name has been struck off the role of solicitors maintained under the Solicitors Acts, 1954 to 1994, and has not since been restored.

### **Powers and Duties of Controller, Evidence and Costs ➡**

*Provision of information and inspection of documents.*

60. (1) In addition to any other information or documents which the Controller is under the Act or these Rules authorised or obliged to provide or to make available for inspection, the following provisions of this Rule shall apply in relation to information or documents relating to applications for registration of trademarks and registered trademarks.

(2) Following the filing of applications for registration, the Controller shall permit the inspection of copies of the applications as made in accordance with Rule 12(2) and of certificates filed under Rule 13.

(3) For the purpose of section 70(1), the following documents and information are hereby prescribed —

- (a) the documents in paragraph (2);
  - (b) any written statements of the grounds of decisions of the Controller which have been prepared in respect of inter partes proceedings;
  - (c) notices of opposition submitted under Rule 18;
  - (d) applications under Rule 35(1);
  - (e) notifications of surrender under Rule 36(1);
  - (f) applications under Rule 41(1);
  - (g) in relation to an application for registration, information as to whether, prior to its publication, a notice was given or a request made under section 44 and the outcome of any such notice or request;
  - (h) any instrument or document submitted to the Controller under Rule 45(2) which is retained in the Office and which the person who submitted it agrees may be inspected;
- (4) A request under section 70(1) shall be in writing. If the request is for the provision of information, it shall be accompanied by the prescribed fee.
- (5) Where a request is for the inspection of documents, the Controller shall inform the person making it of the time, or times, at which the documents specified in the request may be inspected at the Office. The prescribed fee for inspection of documents at the Office shall be paid at the time the inspection takes place.

#### *Hearing*

61. (1) For the purposes of section 71 the Controller shall give the applicant, proprietor or party concerned notice that he or she may be heard.
- (2) Save as otherwise provided by these Rules, an application for a hearing shall be made within ten days from the date of notice by the Controller under paragraph (1) and shall be accompanied by the prescribed fee.
- (3) Upon receiving an application for a hearing the Controller shall notify any other party to the proceedings and if such a party desires to attend and be heard he or she shall inform the Controller accordingly within 10 days of notification and pay the prescribed fee. The Controller shall give the party or parties concerned not less than ten days' notice of the time of the hearing unless the parties consent to shorter notice.
- (4) A party who fails to attend a hearing appointed in accordance with this Rule may be treated as not desiring to be heard and the Controller may act accordingly.
- (5) If in inter partes proceedings either party intends to refer at the hearing to any document not already mentioned in the proceedings, he or she shall give to the other party and to the Controller at least 7 days' notice of his or her intention, together with details of each document to which he or she intends to refer.

Controller's power to require documents, information or evidence.

62. The Controller may, at any stage of any proceedings before him or her, direct that such documents, information or evidence as he or she may require shall be filed within such period as he or she may specify.

*General power to enlarge time.*

63. (1) The time or periods:

(a) prescribed by these Rules, other than the times or periods prescribed by the rules mentioned in paragraph (2) below, or

(b) specified by the Controller for doing any act or taking any proceedings,

may, at the request of the person or party concerned, be extended by the Controller if he or she thinks fit, upon such notice to any other person or party affected and upon such terms as he or she may direct.

(2) The Rules excepted from paragraph (1) of this Rule are Rule 10(3) (failure to file address for service), Rule 12(5) (time limit for payment of application fee), Rule 18(1) (time for filing opposition to registration), Rule 19(1) (time for filing counter-statement), Rule 39 (delayed renewal) and Rule 40 (restoration of registration).

(3) Subject to paragraph (4) below, a request for extension under paragraph (1) above shall be made before the time or period in question has expired.

(4) If the request under paragraph (1) is made not later than two months after the expiry of the time or period in question the Controller may, at his or her discretion, extend the period or time if he or she is satisfied with the explanation for the delay in requesting the extension and it appears to him or her that any extension would not disadvantage any other person or party affected by it. A person availing of the provisions of this paragraph shall pay the prescribed fee at the time the request for extension is made.

(5) Where the period within which any party to proceedings before the Controller may file evidence under these Rules is to begin upon the expiry of any period in which any other party may file evidence and that other party notifies the Controller that he or she does not wish to file any, or any further, evidence the Controller may direct that the period within which the first mentioned party may file evidence shall begin on such date as may be specified in the direction and shall notify all parties to the dispute of that date.

(6) Where any period of time specified in the Act or these Rules for the giving, making or filing of any notice, application or other document expires on a day certified by the Controller as being one on which there is a general interruption or subsequent dislocation in the postal service of the State, the period shall be extended to the first day following the end of the period of interruption or dislocation.

*Costs.*

64. (1) In the event of an opposition to the registration of a mark being uncontested by the applicant the Controller, in deciding whether costs should be awarded to the opponent shall consider whether proceedings might have been avoided if reasonable notice had been given by the opponent to the applicant before the notice of opposition was lodged.

(2) The States prescribed for the purposes of section 72(2) are the other Member States of

the European Communities.

*Form of statutory declaration.*

65. (a) A statutory declaration required by the Act or these Rules or used in any proceedings before the Controller thereunder shall be headed in the matter to which it relates and shall be drawn up in the first person, and shall be divided into paragraphs consecutively numbered, and each paragraph shall so far as is possible be confined to one subject.

(b) Every statutory declaration shall state the description and true place of abode of the person making the declaration, and shall bear the name and address of the person leaving it and shall state on whose behalf it is left.

*Statutory declaration made outside the State.*

66. A statutory declaration required by the Act or these Rules or used in any proceedings before the Controller thereunder shall, if made and subscribed outside the State, be made and subscribed before a person authorised by law to administer an oath in the country in which it is made.

*Notice of seal of officer taking declaration to prove itself.*

67. Any document purporting to have affixed, impressed, or subscribed thereto or thereon the seal or signature of any person authorised to take a declaration, in testimony that the declaration was made and subscribed before such person, may be admitted by the Controller without proof of the genuineness of the seal or signature, or of the official character of the person or such person's authority to take the declaration.

## **Applications to and Orders of Court ➡**

*Application to Court.*

68. Every application to the Court under the Act in relation to any matter which is a function of the Controller shall be notified forthwith to the Controller by the applicant.

*Order of Court.*

69. (a) Where an order has been made by the Court in any matter under the Act relating to a function of the Controller, the person in whose favour the order has been made, or such one of them if there is more than one, as the Controller may direct, shall forthwith leave at the Office an attested copy thereof.

(b) The register shall, if necessary, thereupon be rectified or altered by the Controller.

## **Miscellaneous ➡**

*Excluded days.*

70. Whenever the last day fixed by the Act, or by these Rules, for doing any act or thing at

the Office falls on any of the days on which the Office is not open (which days shall be excluded days for the purposes of the Act and these Rules), it shall be lawful to do any such act or thing on the first day which is not an excluded day next following such excluded day, or days, if two or more of them occur consecutively.

#### *Searches.*

71. On application, accompanied by payment of the prescribed fee, the Controller may cause a search to be made in respect of specified goods or services to ascertain whether or not at the date of the search any mark is on record which resembles a trade mark of which duplicate representations accompany the application, and shall cause the person making such request to be notified of the result of the search.

#### *Pending applications for registration.*

72. (1) Where an application which was pending at the commencement of the Act is to be dealt with in accordance with the old law, the provisions of Rule 73 as regards the issue by the Controller of a request for payment of the fee for registration and the time within which such fee shall be paid shall apply to such application if the fee for registration had not been paid at commencement.

(2) (i) Where, in relation to an application to which paragraph (1) applies, the date of issue of the certificate of registration of the mark concerned is later than 2 months prior to the expiry of a period of seven years from the date of filing of that application, the period within which an application shall be made for renewal of the registration of the mark shall be the unexpired term of the seven year period or six weeks from the date of issue of the certificate of registration, whichever is the later.

(ii) In relation to an application to which subparagraph (i) applies, a notice of non-payment of a registration renewal fee shall be published by the Controller upon expiry of the appropriate period provided for in that subparagraph if the fee remains unpaid at the expiry of that period.

(iii) Subject to paragraph (ii), paragraphs (1) and (2) of Rule 39 shall apply.

#### *Time limit for payment of fees required for registration.*

73. The prescribed period for the purposes of section 45(2) shall be two months from the date of issue by the Controller of a request for payment of the fee prescribed for registration.

#### *Power to dispense with evidence, signature, &c.*

74. Where, under these Rules, any person is required to do any act or to sign any document, or to make any declaration on behalf of himself or of any body corporate, or any document or evidence is required to be produced to or left with the Controller or at the Office, and it is shown to the satisfaction of the Controller that from any reasonable cause such person is unable to do such act or thing or to sign such document or to make such declaration or that such document or evidence cannot be produced or left as aforesaid, it shall be lawful for the Controller, upon the production of such evidence and subject to such terms as he or she thinks fit, to dispense with any such act or thing, signature, declaration, document or evidence.



*General power of amendment.*

75. Any document for the amending of which no special provision is made by the Act or these Rules may be amended, and any irregularity in procedure which in the opinion of the Controller may be obviated without detriment to the interests of any person may be corrected, if and on such terms and in such manner as the Controller thinks fit; provided that, without prejudice to the Controller's power to extend any time or periods under Rule 63 and except where such irregularity is attributable wholly or in part to an error, default or omission on the part of the Office, the Controller shall not direct that any period of time specified in the Act or Rules shall be altered.

*Partial assignments.*

76. (1) Where an assignment of a registered trade mark is limited so that it applies in relation to some only of the goods or services for which the mark is registered, Rule 45 shall apply in respect of an application to the Controller under section 29.

(2) The Controller shall enter in the register the relevant particulars in relation to the assignment.

(3) At the same time as the entry referred to in paragraph (2) is made, the Controller shall register the mark in the name of the assignee as proprietor in respect of the goods or services to which the assignment relates; and such registration shall, for the purposes of the Act and these Rules, be deemed to be an independent registration.

(4) Where an assignment of a registered trade mark is limited so that it applies in relation to use of the mark in a particular manner or in a particular locality, the provisions of paragraphs (1) to (3) shall, with the necessary modifications, apply in respect of any application under section 29; and, in addition, the following provisions shall apply:

(i) in the case of an assignment which is limited so that it applies in relation to use of a trade mark in a particular manner, the registration pursuant to paragraph (3) shall include the representation of the mark in the particular manner in which it is to be used;

(ii) in the case of an assignment which is limited so that it applies in relation to use of the mark in a particular locality, the registration pursuant to paragraph (3) shall have effect as if it resulted from an application for registration in respect of which the applicant had agreed to a territorial limitation to the same effect under the provisions of section 17.

*Non-exclusive licence.*

77. (1) The Controller may, on application therefor to him or her in writing by a person and on payment of the prescribed fee, grant or refuse to grant to the person a licence (referred to in this rule as a non-exclusive licence) authorising the use by that person of part or all of the computerised trade mark data base open to public inspection.

(2) A non-exclusive licence shall be subject to such conditions and restrictions (if any) as the Controller may impose, at the time of the grant of the licence or subsequently, and specify in the licence or in another document given or sent to the holder of the licence.

(3) The Controller may, if he or she is satisfied that there has been a contravention of a condition or restriction of a non-exclusive licence, revoke the licence.



(4) A non-exclusive licence shall, unless previously revoked remain in force until such period as may be determined by the Controller.

Form for conversion of pending application.

78. A notice to the Controller under paragraph 9(3) of the Third Schedule to the Act, claiming to have the registrability of a mark determined in accordance with the provisions of this Act, shall be in Form No. 2.

Forms.

79. The forms mentioned in these Rules are those set out in Schedule 2.