

TRADE MARKS (AMENDMENT) RULES 2010

I, CONOR LENIHAN, Minister of State at the Department of Enterprise,

Trade and Innovation, in exercise of the powers conferred on me by section 81

of the Trade Marks Act 1996 (No. 6 of 1996), as adapted by the Enterprise,

Trade and Employment (Alteration of Name of Department and Title of

Minister) Order 2010 (S.I. No. 185 of 2010), and the Enterprise, Trade and

Innovation (Delegation of Ministerial Functions) Order 2010 (S.I. No. 332 of

2010), hereby make the following rules:

Citation and commencement.

1. These Rules may be cited as the Trade Marks (Amendment) Rules 2010

and shall come into operation on 4 October 2010.

Definition.

2. In these Rules, “Rules” means the Trade Marks Rules 1996 (S.I. No. 199

of 1996), and, except where the context otherwise requires, a reference to a

Rule is a reference to a Rule of those Rules.

Amendment of Rule 8.

3. Rule 8 is amended—

(a) in paragraph (b), by substituting “submission of applications, notices

or documents” for “submission of documents”, and

(b) by inserting the following paragraph after paragraph (b):

“(c) Where the Controller has specified that an application,

notice or document may be delivered in electronic form, any requirement in these Rules for a duplicate copy to be filed shall not apply.”.

Amendment of Rule 10.

4. Rule 10 is amended, in paragraph (1)(a) (amended by Rule 3 of the Trade

Marks (Amendment) Rules 2007 (S.I. No. 621 of 2007)), by substituting “in a

state which is a contracting party to the Agreement on the European Economic

Area signed at Oporto on 2 May 1992, as amended for the time being,” for “in

the European Community”.

Substitution of Rule 25.

5. (1) The following Rule is substituted for Rule 25:

“Hearing.

25. (1) Upon completion of the evidence the Controller shall request each of the parties to elect whether they wish to—

Notice of the making of this Statutory Instrument was published in “Iris Oifigiúil” of 27th August, 2010.

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(a) attend at a hearing, or

(b) file written submissions in lieu of attending at a hearing.

(2) Each party shall indicate their election pursuant to paragraph (1) to

the Controller and the other party within 2 months from the date of the

request. A party shall not file written submissions and attend at a hearing

unless the Controller gives leave to do so.

(3) A party who elects to file written submissions in lieu of attending at

a hearing shall file with the Controller such written submissions as he or she

desires to adduce in support of his or her case within 4 months from the

date of the request in paragraph (1) and shall send a copy of any submissions

filed to the other party.

(4) If neither party elects to attend at a hearing, each party may, within

one month of the receipt of the written submissions of the other party under

paragraph (3), file with the Controller written submissions which shall be

confined to matters strictly in reply to the other party's submissions. A party

shall send a copy of any submissions so filed to the other party.

(5) No further written submissions may be filed by either party unless the

Controller gives leave to do so upon such terms as to costs or otherwise as

the Controller thinks fit.

(6) If either party elects to attend at a hearing, the Controller shall, after

the period set out in paragraph (3) has expired, give notice to the parties of

a date of a hearing, which shall be at least 30 days after the date of the

notice unless the parties consent to a shorter notice period. A party who

fails to elect to attend at a hearing in accordance with this Rule shall not be

heard at the hearing, unless the Controller gives leave to do so.

(7) A party who intends to appear at a hearing shall notify the Controller

and pay the prescribed fee within 14 days of receipt of the notice under

paragraph (6).

(8) A party who fails to notify the Controller and pay the prescribed fee

in accordance with paragraph (7) may be treated as not desiring to be heard,

and the Controller may act accordingly.”.

(2) The amendment effected by paragraph (1) shall not apply where the Controller

has given notice of a date for a hearing before these Rules came into operation, except where—

(a) the date for the hearing was subsequently cancelled by the Controller,

or

(b) the hearing has been held, and the Controller has been unable to issue a decision or to issue written grounds for a decision, due to circumstances beyond his or her control.

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Amendment of Rule 27.

6. Rule 27 is amended by substituting the following for paragraph (1):

“(1) The decision of the Controller in the exercise of any discretionary

power following a hearing before him or her or the filing of any

written submissions under Rule 25 shall be notified to the party or

parties concerned.”.

Amendment of Rule 29.

7. Rule 29 is amended by substituting the following subparagraph for subparagraph

(ii) of paragraph (4):

“(ii) where a registrable transaction is recorded in the register in respect of any of the registrations to be merged—

(I) the Controller shall not merge the registrations unless the proprietor certifies that any person having an interest in that registration by virtue of the registrable transaction has been notified of the proposed merger at least 3 months prior to the date of the request and has not objected to it, and

(II) the Controller shall enter in the register, in relation to the merged registration, the relevant particulars of the registrable transaction, specifying the extent to which the registrable transaction affects the merged registration, including the details of the specific goods or services of the merged registration to which it relates.”.

Amendment of Rule 30.

8. Rule 30 is amended by substituting the following for paragraph (1):

“(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 provided that the series comprises no more than 6 trade marks and there shall be included in such application a representation of each mark claimed to be in the series.

(b) Where an application for the registration of a series of trade marks comprises 3 or more trade marks, the application shall

be subject to the payment of the prescribed fee for each trade mark in excess of 2 trade marks.

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

Amendment of Rule 41.

9. (1) Rule 41 is amended by substituting the following paragraphs for paragraphs

(3) and (4):

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“(3) (a) Within 3 months of the issue by the Controller to the proprietor

of the copy of the application and the statement in the case of applications to the Controller for revocation under section 51 or for the rectification of an error or omission in the register under section 67, the proprietor may file a notice of opposition with the Controller and the Controller shall send a copy thereof to the applicant.

(b) 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.

(c) In the case of applications to the Controller for a declaration of invalidity under section 52, the provisions of Rules 19 to 25 shall apply mutatis mutandis.

(d) Notwithstanding paragraph (c) the Controller shall not declare a trade mark to be invalid merely because the proprietor fails to file a counter-statement.

(4) In the case of an application to the Controller for revocation under

section 51 or for the rectification of an error or omission in the register

under section 67, 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.

(5) Subject to paragraph (3)(b), the Controller shall hear the parties, if

so required, before deciding upon an application.”.

(2) The amendment to Rule 41(3)(c) effected by paragraph (1) shall not apply

where an application for invalidity under section 52 was made before these

Rules came into operation.

Amendment of Rule 44.

10. Rule 44 is amended by inserting the following paragraph after paragraph

(e):

“(f) In the case of matters arising from the operation of law which affect

the proprietorship of a registered trade mark or any right in it—

(i) the name and address of the new proprietor,

and

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(ii) the nature and date of the document or instrument establishing

the interest, right or title of the new proprietor.”.

Amendment of Rule 45.

11. The following Rule is substituted for Rule 45:

“45. (1) An application under section 29(1) shall be in writing and 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.

(2) The Controller shall not enter particulars of a transaction in the register

unless he or she is satisfied that the instrument or document furnished

in accordance with paragraph (1) authenticates the claim of the person

whose title or interest is to be entered in the register.

(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.”.

Amendment of Rule 61.

12. Rule 61 is amended by substituting the following paragraphs for paragraphs

(2) and (3):

“(2) Save as otherwise provided by these Rules, an application for a hearing

shall be made within 21 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 21 days

of notification and pay the prescribed fee. The Controller shall give the

party or parties concerned not less than 10 days notice of the time of the

hearing unless the parties consent to shorter notice.”.

Amendment of Rule 63.

13. Rule 63 is amended—

(a) by substituting the following paragraph for paragraph (2):

“(2) The Rules excepted from paragraph (1) of the Rules 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 25(3)

(election by party to file written submissions in lieu of attending at a hearing), Rule 39 (delayed renewal) and Rule 40 (restoration of registration).”, and

(b) in paragraph (6)—

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(i) by substituting “application, payment or other document” for “application or other document”, and

(ii) by inserting “or in the service of the Patents Office” after “in the postal service of the State”.

Amendment of Rule 64.

14. Rule 64 is amended, in paragraph (2), by substituting “any state which is

a contracting party to the Agreement on the European Economic Area signed

at Oporto on 2 May 1992, as amended for the time being” for “the Member

States of the European Communities”.

Amendment of Schedule 2 to Rules.

15. Schedule 2 to the Rules is amended by substituting for Form No. 1, the

form set out in the Schedule to these Rules.

SCHEDULE

“

FORM NO. 1 Reference No. of Applicant or Legal

Representative

TRADE MARKS ACT 1996

APPLICATION FOR REGISTRATION OF A TRADE MARK

1. Applicant(s)

Name

Address

Nationality

Telephone:

Email:

2. Legal Representative (Trade Mark Agent, Solicitor or other qualified

person)

Name

Address

Telephone:

Email:

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3. Address for Service (within the EEA, to which correspondence is to be

sent)

If different to address at 1 or 2.

Address

Telephone:

Email:

Please tick box if you wish the Office to correspond with you by email
in

relation to this application

4. Representation of Mark (Illustration should not exceed 8cm x 8cm)

8cm

8cm

5. Type of Mark

Standard Trade Collective Trade Certification Trade

Mark Mark Mark

Series of Trade 3D Trade Mark Other

Marks

6. Colour

The mark in use is/will be in the colours

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7. Claim to a Right of Priority (If you have applied to register the
Trade Mark

outside the State within the last 6 months enter here the relevant
information

where a right to priority is claimed)

Country Date Number

8. Goods and/or Services

Nice Class No. List here the goods and/or services for which
registration is sought

9. Declaration

I hereby declare that the Trade Mark to which this application relates
is being

used by, or with the consent of, the Applicant named herein in relation to the

goods and/or services mentioned above or that the Applicant has a bona fide

intention that it will be so used.

Signature:

If a company, state the position within the company of the person signing

Name in BLOCK CAPITALS

Date:

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10. Fees accompanying this application

Application fee €

Class fee, for each additional class €

Total fees €

”

GIVEN under my hand,

24 August 2010.

CONOR LENIHAN,

Minister of State at the Department of Enterprise, Trade and Innovation.

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EXPLANATORY NOTE

(This note is not part of the instrument and does not purport to be a legal

interpretation.)

These Regulations make a number of amendments to the Trade Mark Rules

1996. The main changes are described in the following paragraphs.

The title, date of commencement and definitions are set out in Rules 1 and 2.

Rule 3 amends Rule 8 (Filing of documents) of the Trade Mark Rules 1996.

This Rule expands the definition of 'documents' in the original Rule 8 to include

applications and notices and facilitates delivery of an application, notice and

other documents in electronic form.

Rule 4 amends Rule 10 (Address for service) of the 1996 Trade Mark Rules

and clarifies that the requirement to provide an address for service to the Controller

is an address for service in the European Economic Area (EEA).

Rule 5 amends Rule 25 (Hearing) of the 1996 Rules. It allows for a case before

the Controller to proceed by written submissions instead of only by way of

a hearing.

Rule 6 amends Rule 27 (Notification of Controller's decision and grounds) of

the 1996 Rules. The new Rule is consequential on the introduction of the written

submission procedure and provides for notification of decisions by the Controller

whether the decision is made by way of a hearing or by way of written submissions.

Rule 7 amends Rule 29 (Merger of separate applications or registrations) of

the 1996 Rules. The new Rule amends the requirements relating to the merger

of separate registrations in circumstances where a registrable transaction is

recorded in the register in respect of any of the registrations to be merged. The

new provision prohibits the Controller from merging the registrations unless the

proprietor certifies that any person having an interest in that registration by

virtue of the registrable transaction has been notified of the proposed merger

at least 3 months prior to the date of the request and has not objected to it. The

new Rule also sets out the details to be entered in the register in relation to the

merged registration.

Rule 8 amends Rule 30 (Registration of a series of trade marks) of the 1996

Rules. It places a cap of six marks in a series and provides for the payment of

a fee for each trade mark in a series in excess of two.

Rule 9 amends Rule 41 (Revocation, Invalidation and Rectification) of the

1996 Rules and provides that the same requirements and procedures governing

oppositions to registration apply also to applications for a declaration of invalidity

except that the Controller shall not declare a trade mark to be invalid

merely because the proprietor has not filed a counter-statement.

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Rule 10 amends Rule 44 (Entry in register of particulars of registrable

transactions) of the 1996 Rules. The new Rule gives effect to Section 41 of the

Patents Amendment Act 2006, which added a further registrable transaction to

the Trade Marks Act 1996.

Rule 11 replaces Rule 45 (Application to register transactions under section

29) of the 1996 Rules. The new Rule provides for an amended procedure for

recording transactions affecting registered trade marks in the register.

Rule 12 amends Rule 61 (Hearing) of the 1996 Rules by extending the time

limits for making an application to the Controller for a hearing and notifying

the Controller of intention to attend a hearing.

Rule 13 of these Rules amends Rule 63 (General power to enlarge time) of

the 1996 Rules. The main change to the 1996 Rules provides that the Controller

is not empowered to extend the time limits applicable to the new written submissions

procedure being introduced under these Rules (i.e. Rule 5 above).

Rule 14 amends Rule 64(2) of the 1996 Rules and clarifies that the term

‘Prescribed States’, for the purpose of Section 72 of the Trade Marks Act, 1996

refers to the states which are contracting parties to the European Economic

Area.

Rule 15 amends Schedule 2 to the 1996 Trade Mark Rules by the substitution

of a new Form 1.