

TRADE MARKS ACT, 1963

Number 9 of 1963

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Number 9 of 1963

TRADE MARKS ACT, 1963

AN ACT TO MAKE NEW PROVISION IN RESPECT OF TRADE MARKS AND RELATED MATTERS, IN SUBSTITUTION FOR THE PROVISIONS OF PART IV AND (SO FAR AS IT RELATES TO TRADE MARKS) PART V OF THE INDUSTRIAL AND COMMERCIAL PROPERTY (PROTECTION) ACT, 1927, AND OTHER ENACTMENTS RELATING THERETO, AND TO PROVIDE FOR OTHER MATTERS CONNECTED WITH THE MATTERS AFORESAID. [3rd April, 1963.]

BE IT ENACTED BY THE OIREACHTAS AS FOLLOWS:—

PART I.

PRELIMINARY AND GENERAL.

1.—

- (1) This Act may be cited as the Trade Marks Act, 1963.
- (2) This Act shall come into operation on such date as the Minister may by order appoint.

2.—

- (1) In this Act, unless the context otherwise requires—

“the Act of 1927” means the Industrial and Commercial Property (Protection) Act, 1927;

“assignment” means assignment by act of the parties concerned;

“the Controller” means the Controller of Industrial and Commercial Property appointed under the Act of 1927;

“the Court” means the High Court;

“the Journal” means the Official Journal of Industrial and Commercial Property;

“limitations” means any limitations of the exclusive right to the use of a trade mark given by the registration of a person as proprietor thereof, including limitations of that right as to mode of use, as to use in relation to goods to be sold (or otherwise traded in) in any place within the State, or as to use in relation to goods to be exported to any market outside the State;

“mark” includes a device, brand, heading, label, ticket, name, signature, word, letter, numeral, or any combination thereof;

“the Minister” means the Minister for Industry and Commerce;

“the Office” means the Industrial and Commercial Property Registration Office established under the Act of 1927;

“partnership” has the meaning assigned to it by section 1 of the Partnership Act, 1890;

“permitted use” has the meaning assigned to it by *paragraph (b) of subsection (1) of section 36* of this Act;

“prescribed” means, in relation to proceedings before the Court, prescribed by rules of court, and, in other cases, prescribed by this Act or the rules;

“the register” means the register of trade marks kept under this Act;

“registered trade mark” means a trade mark that is actually on the register;

“registered user” means a person who is for the time being registered as such under *section 36* of this Act;

“the rules” means rules made by the Minister under *section 3* or *section 44* of this Act;

“trade mark” means, except in relation to a certification trade mark, a mark used or proposed to be used in relation to goods for the purpose of indicating, or so as to indicate, a connection in the course of trade between the goods and some person having the right either as proprietor or as registered user to use the mark, whether with or without any indication of the identity of that person, and means, in

relation to a certification trade mark, a mark registered or deemed to have been registered under *section 45* of this Act;

“transmission” means transmission by operation of law, devolution on the personal representative of a deceased person, and any other mode of transfer not being assignment.

(2)

- (a) In this Act references to the use of a mark shall be construed as references to the use of a printed or other visual representation of the mark, and references to the use of a mark in relation to goods shall be construed as references to the use thereof upon, or in physical or other relation to, goods.
- (b) In any other Act references to a trade mark shall be construed as references to a trade mark under this Act.

3.—

(1) The Minister may from time to time make such rules, prescribe such forms and generally do such things as he thinks expedient—

- (a) for regulating the practice under this Act, including the service of documents;
- (b) for classifying goods for the purposes of registration of trade marks;
- (c) for making or requiring duplicates of trade marks and other documents;
- (d) for securing and regulating the publishing and selling or distributing, in such manner as the Minister thinks fit, of copies of trade marks and other documents;
- (e) generally, for regulating the business of the Office in relation to trade marks and all things by this Act placed under the direction or control of the Controller or of the Minister;
- (f) for prescribing any matter referred to in this Act as prescribed or to be prescribed.

(2) Rules made under this Act shall, while in force, be of the same effect as if they were contained in this Act.

(3) Every rule made under this Act shall be advertised twice in the Journal, and shall be laid before each House of the Oireachtas as soon as may be after it is made and if a resolution annulling the rule is passed by either House within the next subsequent twenty-one days on which that House has sat after the rule is laid before it, the rule shall be annulled accordingly but without prejudice to the validity of anything previously done thereunder.

4.—

(1) There shall be paid in respect of applications, registrations, notices, notifications, statements, counter-statements, amendments, renewals, cancellations, declarations, certificates, certified copies, entries and other matters in relation to trade marks under this Act such fees as may from time to time be prescribed by the Minister with the sanction of the Minister for Finance.

(2) All fees prescribed under this section shall be collected and accounted for in such manner as the Minister with the sanction of the Minister for Finance shall direct.

(3) The Public Offices Fees Act, 1879, shall not apply in respect of any fees payable under this Act.

5.—All things required or authorised under this Act to be done by, to or before the Minister may be done by, to or before the secretary of the Department of Industry and Commerce or any person authorised in that behalf by the Minister.

6.—Whenever the last day fixed by this Act for doing anything under this Act falls on a day which is specified by the rules as an excluded day, the rules may provide that the thing may be done on the next subsequent day which is not specified by the rules as an excluded day.

7.—The expenses incurred by the Minister in the administration of this Act shall, to such extent as may be sanctioned by the Minister for Finance, be paid out of moneys provided by the Oireachtas.

8.—

(1) The following sections of the Act of 1927, namely, sections 3 and 9 (in so far as they refer to trade marks), 80 to 123, and (in so far as they refer to trade marks) 124, 125, 127 to 138, and 140 to 153, are hereby repealed.

(2) Nothing in this Act shall affect any order, rule, regulation or requirement made, table of fees or certificate issued, notice, decision, determination, direction or approval given, application made, thing done or trade mark or mark registered under the Act of 1927; and every such order, rule, regulation, requirement, table of fees, certificate, notice, decision, determination, direction, approval, application, thing, trade mark or mark, shall, if in force at the commencement of this Act, continue in force and shall, so far as it could have been made, issued, given, done or registered under this Act, have effect as if made, issued, given or done under the corresponding section of this Act.

(3) Any document referring to any enactment repealed by this Act shall be construed as referring to the corresponding section of this Act.

PART II.
PROVISIONS RELATING TO REGISTRATION.

9.—

(1) There shall continue to be kept at the Office for the purposes of this Act a book called the register of trade marks, wherein shall be entered all registered trade marks with the names, addresses and descriptions of their proprietors, notifications of assignments and transmissions, the names, addresses and descriptions of all registered users, disclaimers, conditions, limitations, and such other matters relating to registered trade marks as may be prescribed.

(2) The register shall continue to consist of two parts called respectively Part A and Part B.

(3) The register shall at all convenient times be open to the inspection of the public, subject to such regulations as may be prescribed.

(4) The register shall be kept under the control and management of the Controller.

(5) The register may, in lieu of being kept in the form of a book, be kept in such other form of record as may from time to time be approved by the Minister.

10.—No person shall be entitled to institute any proceeding to prevent, or to recover damages for, the infringement of an unregistered trade mark, but nothing in this Act shall be deemed to affect rights of action against any person for passing off goods as the goods of another person or the remedies in respect thereof.

11.—A trade mark must be registered in respect of particular goods or classes of goods, and any question arising as to the class within which any goods fall shall be decided by the Controller.

12.—

(1) Subject to this section, and to *sections 15 and 16* of this Act, the registration (whether before or after the commencement of this Act) of a person in Part A of the register as proprietor of a trade mark (other than a certification trade mark) in respect of any goods shall, if valid, give or be deemed to have given to that person the exclusive right to the use of the trade mark in relation to those goods and, without prejudice to the generality of the foregoing words, that right shall be deemed to be infringed by any person who, not being the proprietor of the trade mark or a registered user thereof using by way of the permitted use, uses a mark identical with it or so nearly resembling it as to be likely to deceive or cause confusion, in the course of trade, in relation to any goods in respect of which it is registered, and in such manner as to render the use of the mark likely to be taken either—

(a) as being use as a trade mark; or

(b) in a case in which the use is use upon the goods or in physical relation thereto or in an advertising circular or other advertisement issued to the public, as importing a reference to some person having the right either as proprietor or as registered user to use the trade mark or to goods with which such a person as aforesaid is connected in the course of trade.

(2) The right to the use of a trade mark given by registration as aforesaid shall be subject to any conditions or limitations entered on the register, and shall not be deemed to be infringed by the use of any such mark as aforesaid in any mode, in relation to goods to be sold or otherwise traded in any place, in relation to goods to be exported to any market, or in any other circumstances, to which, having regard to any such limitations, the registration does not extend.

(3) The right to the use of a trade mark given by registration as aforesaid shall not be deemed to be infringed by the use of any such mark as aforesaid by any person—

(a) in relation to goods connected in the course of trade with the proprietor or a registered user of the trade mark if, as to those goods or a bulk of which they form part, the proprietor or the registered user conforming to the permitted use has applied the trade mark and has not subsequently removed or obliterated it, or has at any time expressly or impliedly consented to the use of the trade mark; or

(b) in relation to goods adapted to form part of, or to be accessory to, other goods in relation to which the trade mark has been used without infringement of the right given as aforesaid or might for the time being be so used, if the use of the mark is reasonably necessary in order to indicate that the goods are so adapted and neither the purpose nor the effect of the use of the mark is to indicate otherwise than in accordance with the fact a connection in the course of trade between any person and the goods.

(4) The use of a registered trade mark, being one of two or more registered trade marks that are identical or nearly resemble each other, in exercise of the right to the use of that trade mark given by registration as aforesaid, shall not be deemed to be an infringement of the right so given to the use of any other of those trade marks.

13.—

(1) Except as provided by *subsection (2)* of this section, the registration (whether before or after the commencement of this Act) of a person in Part B of the register as proprietor of a trade mark in respect of any goods shall, if valid, give or be deemed to have given to that person the like right in relation to those goods as if the registration had been in Part A of the register, and the provisions of *section 12* of this Act shall have effect in like manner in relation to a trade mark registered in Part B of the register as they have effect in relation to a trade mark registered in Part A of the register.

(2) In any action for infringement of the right to the use of a trade mark given by registration as aforesaid in Part B of the register, otherwise than by an act that is deemed to be an infringement by virtue of *section 14* of this Act, no injunction or other relief shall be granted to the plaintiff if the defendant establishes to the satisfaction of the Court that the use of which the plaintiff complains is not likely to deceive or cause confusion or to be taken as indicating a connection in the course of trade between the goods and some person having the right either as proprietor or as registered user to use the trade mark.

14.—

(1) Where, by a contract in writing made with the proprietor or a registered user of a registered trade mark, a purchaser or owner of goods enters into an obligation to the effect that he will not do, in relation to the goods, an act to which this section applies, any person who, being the owner for the time being of the goods and having notice of the obligation, does that act, or authorises it to be done, in relation to the goods, in the course of trade or with a view to any dealing therewith in the course of trade, shall be deemed thereby to infringe the right to the use of the trade mark given by the registration thereof, unless that person became the owner of the goods by purchase for money or money's worth in good faith before receiving notice of the obligation or by virtue of a title derived through another who so became the owner thereof.

(2) The acts to which this section applies are—

(a) the application of the trade mark upon the goods after they have suffered alteration in any manner specified in the contract as respects their state or condition, get-up or packing;

(b) in a case in which the trade mark is upon the goods, the alteration, part removal or part obliteration thereof;

- (c) in a case in which the trade mark is upon the goods, and there is also thereon other matter, being matter indicating a connection in the course of trade between the proprietor or registered user and the goods, the removal or obliteration, whether wholly or partly, of the trade mark unless that other matter is wholly removed or obliterated;
- (d) in a case in which the trade mark is upon the goods, the application of any other trade mark to the goods;
- (e) in a case in which the trade mark is upon the goods, the addition to the goods of any other matter in writing that is likely to injure the reputation of the trade mark.

(3) In this section references in relation to any goods to the proprietor, to a registered user, and to the registration, of a trade mark shall be construed, respectively, as references to the proprietor in whose name the trade mark is registered, to a registered user who is registered, and to the registration of the trade mark, in respect of those goods, and “upon” includes in relation to any goods a reference to physical relation thereto.

15.—Nothing in this Act shall entitle the proprietor or a registered user of a registered trade mark to interfere with or restrain the use by any person of a trade mark identical with or nearly resembling it in relation to goods in relation to which that person or a predecessor in title of his has continuously used that trade mark from a date anterior—

- (a) to the use of the first-mentioned trade mark in relation to those goods by the proprietor or a predecessor in title of his; or
- (b) to the registration of the first-mentioned trade mark in respect of those goods in the name of the proprietor or a predecessor in title of his;

whichever is the earlier, or to object (on such use being proved) to that person being put on the register for that identical or nearly resembling trade mark in respect of those goods under *subsection (2) of section 20* of this Act.

16.—No registration of a trade mark shall interfere with—

- (a) any *bona fide* use by a person of his own name or of the name of his place of business, or of the name, or of the name of the place of business, of any of his predecessors in business; or
- (b) the use by any person of any *bona fide* description of the character or quality of his goods, not being a description that would be likely to be taken as importing any such reference as is mentioned in *paragraph (b) of subsection (1) of section 12*, or in *paragraph (b) of subsection (3) of section 45*, of this Act.

17.—

(1) In order for a trade mark (other than a certification trade mark) to be registrable in Part A of the register, it must contain or consist of at least one of the following essential particulars:—

- (a) the name of a company, individual, or firm, represented in a special or particular manner;
- (b) the signature of the applicant for registration or some predecessor in his business;
- (c) an invented word or invented words;
- (d) a word or words having no direct reference to the character or quality of the goods, and not being according to its ordinary signification a geographical name or a surname;
- (e) any other distinctive mark, but a name, signature, or word or words, other than such as fall within the descriptions in *paragraphs (a), (b), (c) and (d)* of this subsection, shall not be registrable under this paragraph except upon evidence of its distinctiveness.

(2) For the purposes of this section “distinctive” means adapted, in relation to the goods in respect of which a trade mark is registered or proposed to be registered, to distinguish goods with which the proprietor of the trade mark is or may be connected in the course of trade from goods in the case of which no such connection subsists, either generally or, where the trade mark is registered or proposed to be registered subject to limitations, in relation to use within the extent of the registration.

(3) In determining whether a trade mark is adapted to distinguish as aforesaid the Court or the Controller (as the case may be) may have regard to the extent to which—

- (a) the trade mark is inherently adapted to distinguish as aforesaid; and
- (b) by reason of the use of the trade mark or of any other circumstances, the trade mark is in fact adapted to distinguish as aforesaid.

18.—

(1) In order for a trade mark to be registrable in Part B of the register it must be capable, in relation to the goods in respect of which it is registered or proposed to be registered, of distinguishing goods with which the proprietor of the trade mark is or may be connected in the course of trade from goods in the case of which no such connection subsists, either generally or, where the trade mark is registered or proposed to be registered subject to limitations, in relation to use within the extent of the registration.

(2) In determining whether a trade mark is capable of distinguishing as aforesaid the Court or the Controller (as the case may be) may have regard to the extent to which—

- (a) the trade mark is inherently capable of distinguishing as aforesaid; and
- (b) by reason of the use of the trade mark or of any other circumstances, the trade mark is in fact capable of distinguishing as aforesaid.

(3) A trade mark may be registered in Part B notwithstanding any registration in Part A in the name of the same proprietor of the same trade mark or any part or parts thereof.

19.—It shall not be lawful to register as a trade mark or part of a trade mark any matter the use of which would, by reason of its being likely to deceive or cause confusion or otherwise, be disentitled to protection in a court of law, or would be contrary to law or morality, or any scandalous design.

20.—

(1) Subject to *subsection (2)* of this section, no trade mark shall be registered in respect of any goods or description of goods that is identical with a trade mark belonging to a different proprietor and already on the register in respect of the same goods or description of goods, or that so nearly resembles such a trade mark as to be likely to deceive or cause confusion.

(2) In case of honest concurrent use, or of other special circumstances which in the opinion of the Court or the Controller make it proper so to do, the Court or the Controller (as the case may be) may permit the registration of trade marks that are identical or nearly resemble each other in respect of the same goods or description of goods by more than one proprietor subject to such conditions and limitations, if any, as the Court or the Controller (as the case may be) may think it right to impose.

(3) Where separate applications are made by different persons to be registered as proprietors respectively of trade marks that are identical or nearly resemble each other, in respect of the same goods or description of goods, the Controller may refuse to register any of them until their rights have been determined by the Court, or have been settled by agreement in a manner approved by him or by the Court on an appeal, as the case may be:

Provided that where separate applications by different persons to be registered as proprietors respectively of trade marks that are identical or nearly resemble each other are made on different dates, the Controller may refuse to proceed with the second or later of those applications until the first application shall have been determined, and that the trade mark the subject of the first application shall, if that trade mark is thereupon registered, be deemed to be a trade mark already on the register under *subsection (1)* of this section in relation to the trade mark the subject of the second or later application.

21.—

(1) In all legal proceedings relating to a trade mark registered in Part A of the register (including applications under *section 40* of this Act) the original registration in Part A of the register of the trade mark shall, after the expiration of seven years from the date of that registration, be taken to be valid in all respects, unless—

- (a) that registration was obtained by fraud, or
- (b) the trade mark offends against *section 19* of this Act.

(2) Nothing in *subsection (1)* of *section 13* of this Act shall be construed as making applicable to a trade mark, as being a trade mark registered in Part B of the register, the foregoing provisions of this section relating to a trade mark registered in Part A of the register.

22.—If a trade mark—

(a) contains any part not separately registered by the proprietor as a trade mark; or
(b) contains matter common to the trade or otherwise of a non-distinctive character;
the Court or the Controller (as the case may be), in deciding whether the trade mark shall be entered or shall remain on the register, may require as a condition of its being on the register—

- (i) that the proprietor shall disclaim any right to the exclusive use of any part of the trade mark, or to the exclusive use of all or any portion of any such matter as aforesaid, to the exclusive use of which the Court or the Controller (as the case may be) holds him not to be entitled; or
- (ii) that the proprietor shall make such other disclaimer as the Court or the Controller (as the case may be) may consider necessary for the purpose of defining his rights under the registration:

Provided that no disclaimer on the register shall affect any rights of the proprietor of a trade mark except such as arise out of the registration of the trade mark in respect of which the disclaimer is made.

23.—

(1) The registration of a trade mark shall not be deemed to have become invalid by reason only of any use, after the date of the registration, of a word or words which the trade mark contains, or of which it consists, as the name or description of an article or substance:

Provided that if it is proved either—

- (a) that there is a well-known and established use of the word or words as the name or description of the article or substance by a person or persons carrying on a trade therein, not being use in relation to goods connected in the course of trade with the proprietor or a registered user of the trade mark or (in the case of a certification trade mark) goods certified by the proprietor; or
- (b) that the article or substance was formerly manufactured under a patent (being a patent in force on, or granted after, the 1st day of October, 1927), that a period of two years or more after the cesser of the patent has elapsed, and that the word or words is or are the only practicable name or description of the article or substance;

the provisions of *subsection (2)* of this section shall have effect.

(2) Where the facts mentioned in *paragraph (a)* or *(b)* of the proviso to *subsection (1)* of this section are proved with respect to any word or words, then—

- (a) if the trade mark consists solely of that word or those words, the registration of the trade mark, so far as regards registration in respect of the article or substance in question or of any goods of the same description, shall be deemed for the purposes of *section 40* of this Act to be an entry wrongly remaining on the register;
- (b) if the trade mark contains that word or those words and other matter, the Court or the Controller (as the case may be), in deciding whether the trade mark shall remain on the register, so far as regards registration in respect of the article or substance in question and of any goods of the same description, may in case of a decision in favour of its remaining on the register require as a condition thereof that the proprietor shall disclaim any right to the exclusive use in relation to that article or substance and any goods of the same description of that word or those words, so, however, that no disclaimer on the register shall affect any rights of the proprietor of a trade mark except such as arise out of the registration of the trade mark in respect of which the disclaimer is made; and
- (c) for the purposes of any other legal proceedings relating to the trade mark—
 - (i) if the trade mark consists solely of that word or those words, all rights of the proprietor, whether under the common law or by registration, to the exclusive use of the trade mark

in relation to the article or substance in question or to any goods of the same description,
or

- (ii) if the trade mark contains that word or those words and other matter, all such rights of the proprietor to the exclusive use of that word or those words in such relation as aforesaid,

shall be deemed to have ceased on the date at which the use mentioned in *paragraph (a)* of the proviso to *subsection (1)* of this section first became well known and established, or at the expiration of the period of two years mentioned in *paragraph (b)* of that proviso.

(3) No word which is the commonly used and accepted name of any single chemical element or single chemical compound, as distinguished from a mixture, shall be registered as a trade mark in respect of a chemical substance or preparation, and any such registration in force at the commencement of this Act or thereafter shall, notwithstanding *section 21* of this Act, be deemed for the purposes of *section 40* of this Act to be an entry made in the register without sufficient cause, or an entry wrongly remaining on the register, as the circumstances may require:

Provided that this subsection shall not have effect in relation to a word which is used to denote only a brand or make of the element or compound as made by the proprietor or a registered user of the trade mark, as distinguished from the element or compound as made by others and in association with a suitable name or description open to the public use.

24.—

(1) A trade mark may be limited in whole or in part to one or more specified colours, and in any such case the fact that it is so limited shall be taken into consideration by the Court or the Controller (as the case may be) when deciding on the distinctive character of the trade mark.

(2) If and so far as a trade mark is registered without limitation of colour, it shall be deemed to be registered for all colours.

25.—

(1) Any person claiming to be the proprietor of a trade mark used or proposed to be used by him who is desirous of registering it must apply in writing to the Controller in the prescribed manner for registration either in Part A or in Part B of the register.

(2) Subject to this Act, the Controller may refuse the application, or may accept it absolutely or subject to such amendments, modifications, conditions or limitations, if any, as he may think right.

(3) In the case of an application for registration of a trade mark (other than a certification trade mark) in Part A of the register, the Controller may, if the applicant is willing, instead of refusing the application, treat it as an application for registration in Part B and deal with the application accordingly.

(4) In the case of a refusal or conditional acceptance, the Controller shall, if required by the applicant within the prescribed time, state in writing the grounds of his decision and the materials used by him in arriving thereat.

(5) An applicant desiring to appeal under *section 57* of this Act against a decision of the Controller under this section shall apply to the Controller under *subsection (4)* of this section for the statement in writing therein referred to, and on the appeal the Court shall, if required, hear the applicant and the Controller, and shall make an order determining whether, and subject to what amendments, modifications, conditions or limitations, if any, the application is to be accepted.

(6) Except by leave of the Court no appeal against a decision of the Controller under this section shall be made save within a period of two months from the date of dispatch to the applicant of the statement in writing referred to in *subsection (4)* of this section or within such further period not exceeding three months as the Controller may allow (upon request received before the expiration of the said period of two months).

(7) Appeals under *section 57* of this Act against decisions of the Controller under this section shall be heard on the materials stated as aforesaid by the Controller, and no further grounds of objection to the acceptance of the application shall be allowed to be taken by the Controller, other than those so stated as aforesaid by him, except by leave of the Court.

(8) The Controller or the Court (as the case may be) may at any time, whether before or after acceptance, correct any error in or in connection with the application, or may permit the applicant to amend his application upon such terms as the Controller or the Court (as the case may be) may think fit.

26.—

(1) When an application for registration of a trade mark has been accepted, whether absolutely or subject to conditions or limitations, the Controller shall, as soon as may be after acceptance, cause the application as accepted to be advertised in the prescribed manner, and the advertisement shall set forth all conditions and limitations subject to which the application has been accepted:

Provided that the Controller may cause an application to be advertised before acceptance in any case where it appears to him that it is expedient by reason of any exceptional circumstances so to do, and where an application has been so advertised the Controller may, if he thinks fit, advertise it again when it has been accepted but shall not be bound so to do.

(2) Any person may, within the prescribed time from the date of the advertisement of an application, give notice to the Controller of opposition to the registration.

(3) The notice shall be given in writing in the prescribed manner, and shall include a statement of the grounds of opposition.

(4) The Controller shall send a copy of the notice to the applicant, and within the prescribed time after receipt thereof the applicant shall send to the Controller, in the prescribed manner, a counter-statement of the grounds on which he relies for his application, and, if he does not do so, he shall be deemed to have abandoned his application.

(5) If the applicant sends such a counter-statement as aforesaid, the Controller shall furnish a copy thereof to the persons giving notice of opposition, and shall, after hearing the parties, if so required, and considering the evidence, decide whether, and subject to what conditions or limitations, if any, registration is to be permitted and shall notify the applicant and the opponent accordingly.

(6) The applicant or the opponent may, within the prescribed time after the date of notification of the decision of the Controller, apply to the Controller for a written statement of the grounds of his decision.

(7) A person desiring to appeal under *section 57* of this Act against a decision of the Controller under this section shall apply to the Controller under *subsection (6)* of this section for the written statement therein referred to, and on the appeal the Court shall, if required, hear the parties and the Controller and shall make an order determining whether, and subject to what conditions or limitations, if any, registration is to be permitted.

(8) Except by leave of the Court, no appeal against a decision of the Controller under this section shall be made save within a period of two months from the date of dispatch to the applicant of the statement in writing referred to in *subsection (6)* of this section or within such further period not exceeding three months as the Controller may allow (upon request received before the expiration of the said period of two months).

(9) On the hearing of an appeal under *section 57* of this Act against a decision of the Controller under this section any party may, either in the manner prescribed or by special leave of the Court, bring forward further material for the consideration of the Court.

(10)

(a) On an appeal under *section 57* of this Act against a decision of the Controller under this section no further grounds of objection to the registration of a trade mark shall be allowed to be taken by the opponent or the Controller, other than those so stated as aforesaid by the opponent, except by leave of the Court.

(b) Where any further grounds of objection are taken, the applicant shall be entitled to withdraw his application without payment of the costs of the opponent on giving notice as prescribed.

(11) On an appeal under *section 57* of this Act against a decision of the Controller under this section the Court may, after hearing the Controller, permit the trade mark proposed to be registered to be modified in any manner not substantially affecting the identity thereof, but in any such case the trade mark as so modified shall be advertised in the prescribed manner before being registered.

(12) If a person giving notice of opposition or an applicant sending a counter-statement after receipt of a copy of such notice, or an appellant, neither resides nor carries on business in the State, the Court (in the case of an appeal) or the Controller (in any other case) may require him to give security for costs of the proceedings and, in default of such security being duly given, may treat the opposition or application, or the appeal, as the case may be, as abandoned.

27.—

(1) When an application for registration of a trade mark in Part A or in Part B of the register has been accepted, and either—

- (a) the application has not been opposed and the time for notice of opposition has expired, or
- (b) the application has been opposed and the opposition has been decided in favour of the applicant,

the Controller shall, unless the application has been accepted in error, register the trade mark in Part A or Part B, as the case may be, and the trade mark, when registered, shall be registered as of the date of the application for registration, and that date shall be deemed for the purposes of this Act to be the date of registration:

Provided that the foregoing provisions of this subsection, relating to the date as of which a trade mark shall be registered and to the date to be deemed to be the date of registration, shall, as respects a trade mark registered under this Act with the benefit of *section 70* of this Act, have effect subject to that section.

(2) On the registration of a trade mark the Controller shall issue to the applicant a certificate in the prescribed form of the registration thereof sealed with the official seal of the Controller.

(3) Where registration of a trade mark is not completed within twelve months from the date of the application by reason of default on the part of the applicant, the Controller may, after giving notice of the non-completion to the applicant in writing in the prescribed manner, treat the application as abandoned unless it is completed within the time specified in that behalf in the notice.

28.—

(1) The registration of a trade mark shall be for a period of seven years, but may be renewed from time to time in accordance with this section:

Provided that, in relation to a registration as of a date before the commencement of this Act, this subsection shall have effect with the substitution of a period of fourteen years for the said period of seven years.

(2) The Controller shall, on application made by the registered proprietor of a trade mark in the prescribed manner and within the prescribed period, renew the registration of the trade mark for a period of fourteen years from the date of expiration of the original registration or of the last renewal of registration, as the case may be, which date is in this section called “the expiration of the last registration”.

(3) At the prescribed time before the expiration of the last registration of a trade mark, the Controller shall send notice in the prescribed manner to the registered proprietor of the date of expiration and the conditions as to payment of fees and otherwise upon which a renewal of registration may be obtained, and, if at the expiration of the time prescribed in that behalf those conditions have not been duly complied with, the Controller may remove the trade mark from the register, subject to such conditions, if any, as to its restoration to the register as may be prescribed.

(4) Where a trade mark has been removed from the register for non-payment of the fee for renewal, it shall, nevertheless, for the purpose of any application for the registration of a trade mark during one year next after the date of the removal, be deemed to be a trade mark that is already on the register:

Provided that the foregoing provisions of this subsection shall not have effect where the Court or the Controller (as the case may be) is satisfied either—

- (a) that there has been no *bona fide* trade use of the trade mark that has been removed during the two years immediately preceding its removal; or
- (b) that no deception or confusion would be likely to arise from the use of the trade mark that is the subject of the application for registration by reason of any previous use of the trade mark that has been removed.

29.—

(1)

(a) Where the proprietor of a trade mark claims to be entitled to the exclusive use of any part thereof separately, he may apply to register the whole and any such part as separate trade marks.

(b) Each such separate trade mark must satisfy all the conditions of an independent trade mark and shall, subject to *subsection (3) of section 31* and *subsection (2) of section 38* of this Act, have all the incidents of an independent trade mark.

(2) Where a person claiming to be the proprietor of several trade marks, in respect of the same goods or description of goods, which, while resembling each other in the material particulars thereof, yet differ in respect of—

(a) statements of the goods in relation to which they are respectively used or proposed to be used; or

(b) statements of number, price, quality or names of places; or

(c) other matter of a non-distinctive character which does not substantially affect the identity of the trade mark; or

(d) colour;

seeks to register those trade marks, they may be registered as a series in one registration.

30.—

(1) Notwithstanding any rule of law or equity to the contrary, and subject to this section, a registered trade mark shall be, and shall be deemed always to have been, assignable and transmissible either in connection with the goodwill of a business or not.

(2) Subject to this section, a registered trade mark shall be, and shall be deemed always to have been, assignable and transmissible in respect either of all the goods in respect of which it is registered, or was registered, as the case may be, or of some (but not all) of those goods.

(3) *Subsections (1) and (2) of this section* shall have effect in the case of an unregistered trade mark used in relation to any goods as they have effect in the case of a registered trade mark registered in respect of any good, if at the time of the assignment or transmission of the unregistered trade mark it is or was used in the same business as a registered trade mark, and if it is or was assigned or transmitted at the same time and to the same person as that registered trade mark and in respect of goods all of which are goods in relation to which the unregistered trade mark is or was used in that business and in respect of which that registered trade mark is or was assigned or transmitted.

(4) Notwithstanding anything in *subsections (1), (2) and (3) of this section*, a trade mark shall not be, or be deemed to have been, assignable or transmissible in a case in which as a result of an assignment or transmission there would in the circumstances subsist, or have subsisted, whether under the common law or by registration, exclusive rights in more than one of the persons conceded to the use, in relation to the same goods or description of goods, of trade marks nearly resembling each other or of identical trade marks, if, having regard to the similarity of the goods and of the trade marks, the use of the trade marks in exercise of those rights would be, or have been, likely to deceive or cause confusion:

Provided that, where a trade mark is, or has been, assigned or transmitted in such a case as aforesaid, assignment or transmission shall not be deemed to be, or to have been, invalid under this subsection if the exclusive rights subsisting as a result thereof in the persons concerned respectively are, or were, having regard to limitations imposed thereon, such as not to be exercisable by two or more of those persons in relation to goods to be sold, or otherwise traded in, within the State (otherwise than for export therefrom) or in relation to goods to be exported to the same market outside the State.

(5) The proprietor of a registered trade mark who proposes to assign it in respect of any goods in respect of which it is registered may submit to the Controller in the prescribed manner a statement of case setting out the circumstances, and the Controller may issue to him a certificate stating whether, having regard to the similarity of the goods and of the trade marks referred to in the case, the proposed assignment of the first-mentioned trade mark would or would not be invalid under *subsection (4) of this section*, and a certificate so issued shall, unless it is shown that the certificate was obtained by fraud or misrepresentation,

be conclusive as to the validity or invalidity under *subsection (4)* of this section of the assignment in so far as such validity or invalidity depends upon the facts set out in the case, but, as regards a certificate in favour of validity, only if application for the registration under *section 33* of this Act of the title of the person becoming entitled is made within six months from the date on which the certificate is issued.

(6) Notwithstanding anything in *subsections (1) to (3)* of this section, a trade mark shall not, on or after the commencement of this Act, be assignable or transmissible in a case in which as a result of an assignment or transmission thereof there would in the circumstances subsist, whether under the common law or by registration, an exclusive right in one of the persons concerned to the use of the trade mark limited to use in relation to goods to be sold, or otherwise traded in, in a place or places in the State, and an exclusive right in another of those persons to the use of a trade mark nearly resembling the first-mentioned trade mark or of an identical trade mark in relation to the same goods or description of goods limited to use in relation to goods to be sold, or otherwise traded in, in another place or other places in the State:

Provided that, on application in the prescribed manner by the proprietor of a trade mark who proposes to assign it, or of a person who claims that a trade mark has been transmitted to him or to a predecessor in title of his on or after the commencement of this Act, in any such case, the Controller, if he is satisfied that in all the circumstances the use of the trade mark in exercise of the said rights would not be contrary to the public interest, may approve the assignment or transmission, and an assignment or transmission so approved shall not be deemed to be, or to have been, invalid under this subsection or under *subsection (4)* of this section, so, however, that in the case of a registered trade mark this provision shall not have effect unless application for the registration under *section 33* of this Act of the title of the person becoming entitled is made within six months from the date on which the approval is given or, in the case of a transmission, was made before that date.

(7) Where an assignment in respect of any goods of a trade mark that is at the time of the assignment used in a business in those goods is made, on or after the commencement of this Act, otherwise than in connection with the goodwill of that business, the assignment shall not take effect until, in pursuance of an application made by the assignee in the prescribed manner to the Controller within a period of six months from the date on which the assignment is made (or within such extended period, if any, as the Controller may allow) a notice of the assignment is published in the Journal.

31.—

(1) Trade marks that are registered as, or that are deemed by virtue of this Act to be, associated trade marks shall be assignable and transmissible only as a whole and not separately, but they shall for all other purposes be deemed to have been registered as separate trade marks.

(2) Where a trade mark that is registered, or is the subject of an application for registration, in respect of any goods is identical with another trade mark that is registered, or is the subject of an application for registration, in the name of the same proprietor in respect of the same goods or description of goods, or so nearly resembles it as to be likely to deceive or cause confusion if used by a person other than the proprietor, the Controller may at any time require that the trade marks shall be entered on the register as associated trade marks.

(3) Where a trade mark and any part or parts thereof are, by virtue of *subsection (1) of section 29* of this Act, registered as separate trade marks in the name of the same proprietor, they shall be deemed to be, and shall be registered as, associated trade marks.

(4) All trade marks that are, by virtue of *subsection (2) of section 29* of this Act, registered as a series in one registration shall be deemed to be, and shall be registered as, associated trade marks.

(5) On application made in the prescribed manner by the registered proprietor of two or more trade marks registered as associated trade marks, the Controller may dissolve the association as respects any of them if he is satisfied that there would be no likelihood of deception or confusion being caused if that trade mark were used by another person in relation to any of the goods in respect of which it is registered, and may amend the register accordingly.

32.—Subject to this Act, the person for the time being entered in the register as proprietor of a trade mark shall, subject to any rights appearing from the register to be vested in any other person, have power to assign the trade mark, and to give effectual receipts for any consideration for an assignment thereof.

33.—

(1) Where a person becomes entitled by assignment or transmission to a registered trade mark, he shall make application in the prescribed manner to the Controller to register his title, and the Controller shall, on receipt of the application and on proof of title to his satisfaction, register him as the proprietor of the trade mark in respect of the goods in respect of which the assignment or transmission has effect, and shall cause particulars of the assignment or transmission to be entered on the register.

(2) Except for the purposes of an appeal under *section 57* of this Act against a decision of the Controller under this section or of an application under *section 40* of this Act, a document or instrument in respect of which no entry has been made in the register in accordance with *subsection (1)* of this section shall not be admitted in evidence in any court of law in proof of the title to a trade mark unless that court otherwise directs.

34.—

(1) Subject to *section 35* of this Act, a registered trade mark may be taken off the register in respect of any of the goods in respect of which it is registered on application by any person aggrieved to the Court or, at the option of the applicant and subject to *section 59* of this Act, to the Controller, on the ground either—

- (a) that the trade mark was registered without any *bona fide* intention on the part of the applicant for registration that it should be used in relation to those goods by him, and that there has in fact been no *bona fide* use of the trade mark in relation to those goods by any proprietor thereof for the time being up to the date one month before the date of the application; or
- (b) that up to the date one month before the date of the application a continuous period of five years or longer elapsed during which the trade mark was a registered trade mark and during which there was no *bona fide* use thereof in relation to those goods by any proprietor thereof for the time being;

Provided that (except where the applicant has been permitted under *subsection (2)* of *section 20* of this Act to register an identical or nearly resembling trade mark in respect of the goods in question or where the Court or the Controller (as the case may be) is of opinion that he might properly be permitted so to register such a trade mark) the Court or the Controller (as the case may be) may refuse an application made under *paragraph (a)* or *(b)* of this subsection in relation to any goods, if it is shown that there has been, before the relevant date or during the relevant period, as the case may be, *bona fide* use of the trade mark by any proprietor thereof for the time being in relation to goods of the same description, being goods in respect of which the trade mark is registered.

(2) Where in relation to any goods in respect of which a trade mark is registered—

- (a) the matters referred to in *paragraph (b)* of *subsection (1)* of this section are shown so far as regards non-use of the trade mark in relation to goods to be sold, or otherwise traded in, in a particular place in the State (otherwise than for export from the State), or in relation to goods to be exported to a particular market outside the State; and
- (b) a person has been permitted under *subsection (2)* of *section 20* of this Act to register an identical or nearly resembling trade mark in respect of those goods under a registration extending to use in relation to goods to be sold, or otherwise traded in, in that place (otherwise than for export from the State), or in relation to goods to be exported to that market, or the Court or the Controller is of opinion that he might properly be permitted so to register such a trade mark;

on application by that person to the Court, or, at the option of the applicant and subject to *section 59* of this Act, to the Controller, the Court or the Controller (as the case may be) may impose on the registration of the first-mentioned trade mark such limitations as the Court or the Controller (as the case may be) thinks proper for securing that that registration shall cease to extend to such use as last aforesaid.

(3) An applicant shall not be entitled to rely for the purposes of *paragraph (b)* of *subsection (1)*, or for the purposes of *subsection (2)*, of this section on any non-use of a trade mark that is shown to have been due to special circumstances in the trade and not to any intention not to use or to abandon the trade mark in relation to the goods to which the application relates.

35.—

(1) Where a trade mark consisting of an invented word or invented words has become so well known as respects any goods in respect of which it is registered and in relation to which it has been used that the use thereof in relation to other goods would be likely to be taken as indicating a connection in the course of trade between those goods and a person entitled to use the trade mark in relation to the first-mentioned goods, then, notwithstanding that the proprietor registered in respect of the first-mentioned goods does not use or propose to use the trade mark in relation to those other goods and notwithstanding anything in *section 34* of this Act, the trade mark may, on the application in the prescribed manner of the proprietor registered in respect of the first-mentioned goods, be registered in his name in respect of those other goods as a defensive trade mark and, while so registered, shall not be liable to be taken off the register in respect of those goods under *section 34* of this Act.

(2) The registered proprietor of a trade mark may apply for the registration thereof in respect of any goods as a defensive trade mark notwithstanding that it is already registered in his name in respect of those goods otherwise than as a defensive trade mark, or may apply for the registration thereof in respect of any goods otherwise than as a defensive trade mark notwithstanding that it is already registered in his name in respect of those goods as a defensive trade mark, in lieu in each case of the existing registration.

(3) A trade mark registered as a defensive trade mark and that trade mark as otherwise registered in the name of the same proprietor shall, notwithstanding that the respective registrations are in respect of different goods, be deemed to be, and shall be registered as, associated trade marks.

(4) On application by any person aggrieved to the Court or, at the option of the applicant and subject to *section 59* of this Act, to the Controller, the registration of a trade mark as a defensive trade mark may be cancelled on the ground that the requirements of *subsection (1)* of this section are no longer satisfied in respect of any goods in respect of which the trade mark is registered in the name of the same proprietor otherwise than as a defensive trade mark, or may be cancelled as respects any goods in respect of which it is registered as a defensive trade mark on the ground that there is no longer any likelihood that the use of the trade mark in relation to those goods would be taken as giving the indication mentioned in *subsection (1)* of this section.

(5) The Controller may at any time cancel the registration as a defensive trade mark of a trade mark of which there is no longer any registration in the name of the same proprietor otherwise than as a defensive trade mark.

(6) Except as otherwise expressly provided in this section, this Act shall apply in respect of the registration of trade marks as defensive trade marks and of trade marks so registered as they apply in other cases.

36.—

(1)

(a) Subject to this section, a person other than the proprietor of a trade mark may be registered as a registered user thereof in respect of all or any of the goods in respect of which it is registered (otherwise than as a defensive trade mark) and either with or without conditions or restrictions, provided that there subsists a prescribed relationship between the proprietor and the proposed registered user.

(b) The use of a trade mark by a registered user thereof in relation to goods with which he is connected in the course of trade and in respect of which for the time being the trade mark remains registered and he is registered as a registered user, being use such as to comply with any conditions or restrictions to which his registration is subject, is in this Act referred to as the permitted use thereof.

(2) The permitted use of a trade mark shall be deemed to be use by the proprietor thereof, and shall be deemed not to be use by a person other than the proprietor for the purposes of *section 34* of this Act and for any other purposes for which such use is material under this Act or at common law.

(3)

(a) Subject to any agreement subsisting between the parties, a registered user of a trade mark shall be entitled to call upon the proprietor thereof to take proceedings to prevent infringement thereof, and, if the proprietor refuses or neglects to do so within two months after being so

called upon, the registered user may institute proceedings for infringement in his own name as if he were the proprietor, making the proprietor a defendant.

(b) A proprietor so added as defendant shall not be liable for any costs unless he enters an appearance and takes part in the proceedings.

(4) Where it is proposed that a person should be registered as a registered user of a trade mark, the proprietor and the proposed registered user must apply in writing to the Controller in the prescribed manner and must furnish him with such documents, information or evidence as may be required under the rules or by the Controller.

(5) When the requirements of *subsection (4)* of this section have been complied with, if the Controller, after considering the information furnished to him under that subsection, is satisfied that in all the circumstances the use of the trade mark in relation to the proposed goods or any of them by the proposed registered user subject to any conditions or restrictions which the Controller thinks proper would not be contrary to the public interest, the Controller may register the proposed registered user as a registered user in respect of the goods as to which he is so satisfied subject as aforesaid.

(6) The Controller shall refuse an application under *subsection (4)* of this section if it appears to him that the grant thereof would tend to facilitate trafficking in a trade mark.

(7) Without prejudice to *section 40* of this Act, the registration of a person as a registered user—

(a) may be varied by the Controller as regards the goods in respect of which, or any conditions or restrictions subject to which, it has effect, on the application in writing in the prescribed manner of the registered proprietor of the trade mark to which the registration relates;

(b) may be cancelled by the Controller on the application in writing in the prescribed manner of the registered proprietor or of the registered user or of any other registered user of the trade mark; or

(c) may be cancelled by the Controller on the application in writing in the prescribed manner of any person on any of the following grounds, that is to say—

(i) that the registered user has used the trade mark otherwise than by way of the permitted use, or in such a way as to cause, or to be likely to cause, deception or confusion;

(ii) that the proprietor or the registered user misrepresented, or failed to disclose, some fact material to the application for the registration, or that the circumstances have materially changed since the date of the registration;

(iii) that the registration ought not to have been effected having regard to rights vested in the applicant by virtue of a contract in the performance of which he is interested.

(8) Provision shall be made by the rules for the notification of the registration of a person as a registered user to any other registered user of the trade mark, and for the notification of an application under *subsection (7)* of this section to the registered proprietor and each registered user (not being the applicant) of the trade mark, and for giving to the applicant on such an application, and to all persons to whom such an application is notified and who intervene in the proceedings in accordance with the rules, an opportunity of being heard.

(9) The Controller may at any time cancel the registration of a person as a registered user of a trade mark in respect of any goods in respect of which the trade mark is no longer registered.

(10) Nothing in this section shall confer on a registered user of a trade mark any assignable or transmissible right to the use thereof.

(11) Any person who is registered under this Act as a registered user of a trade mark shall be deemed to have been so registered as of the date of the application for his registration as a registered user.

37.—

(1) No application for the registration of a trade mark in respect of any goods shall be refused, nor shall permission for such registration be withheld, on the ground only that it appears that the applicant does not use or propose to use the trade mark—

(a) if the Court or the Controller (as the case may be) is satisfied that a body corporate is about to be constituted, and that the applicant intends to assign the trade mark to the corporation with a view to the use thereof in relation to those goods by the corporation; or

- (b) if the application is accompanied by an application for the registration of a person as a registered user of the trade mark, and the Court or the Controller (as the case may be) is satisfied that the proprietor intends it to be used by that person in relation to those goods and the Court or the Controller (as the case may be) is also satisfied that that person will be registered as a registered user thereof immediately after the registration of the trade mark.

(2) *Section 34* of this Act shall have effect, in relation to a trade mark registered under the power conferred by *subsection (1)* of this section as if for the reference, in *paragraph (a)* of *subsection (1)* of *section 34* of this Act, to intention on the part of an applicant for registration that a trade mark should be used by him there were substituted a reference to intention on his part that it should be used by the corporation or registered user concerned.

(3) The Controller or (in the case of an appeal) the Court may, as a condition of the exercise of the power conferred by *subsection (1)* of this section in favour of an applicant who relies on intention to assign to a corporation as aforesaid, require him to give security for the costs of any proceedings before the Controller or the Court (as the case may be), and in default of such security being duly given may treat the application as abandoned.

(4) Where a trade mark is registered in respect of any goods under the power conferred by *subsection (1)* of this section in the name of an applicant who relies on intention to assign to a corporation as aforesaid, then, unless within such period as may be prescribed, or within such further period not exceeding six months as the Controller may on application being made to him in the prescribed manner allow, the corporation has been registered as the proprietor of the trade mark in respect of those goods, the registration shall cease to have effect in respect thereof at the expiration of that period, and the Controller shall amend the register accordingly.

38.—

(1) Where under this Act use of a registered trade mark is required to be proved for any purpose, the Court or the Controller (as the case may be) may accept use of an associated registered trade mark, or of the trade mark with additions or alterations not substantially affecting its identity, as an equivalent for the use required to be proved.

(2) The use of the whole of a registered trade mark shall for the purposes of this Act be deemed to be also a use of any registered trade mark, being a part thereof, registered in the name of the same proprietor by virtue of *subsection (1)* of *section 29* of this Act.

39.—The application in the State of a trade mark to goods to be exported from the State, and any other act done in the State in relation to goods to be so exported which, if done in relation to goods to be sold or otherwise traded in within the State, would constitute use of a trade mark therein, shall be deemed to constitute use of the trade mark in relation to those goods for any purpose for which such use is material under this Act or at common law.

40.—

(1) Any person aggrieved by the non-insertion in or omission from the register of any entry, or by any entry made in the register without sufficient cause, or by any entry wrongly remaining on the register, or by any error or defect in any entry in the register, may apply in the prescribed manner to the Court or, at the option of the applicant and subject to *section 59* of this Act, to the Controller, and the Court or the Controller (as the case may be) may make such order for making, expunging or varying the entry as the Court or the Controller (as the case may be) may think fit.

(2) The Court or the Controller (as the case may be) may in any proceeding under this section decide any question that it may be necessary or expedient to decide in connection with the rectification of the register.

(3) In case of fraud in the registration, assignment or transmission of a registered trade mark, or in any other case in which he considers it to be necessary in the public interest, the Controller may himself apply to the Court under this section.

(4) Any order of the Court rectifying the register shall direct that notice of the rectification shall be served in the prescribed manner on the Controller, and the Controller shall on receipt of the notice rectify the register accordingly.

(5) The power to rectify the register conferred by this section shall include power to remove a registration in Part A of the register to Part B.

41.—On application by any person aggrieved to the Court or, at the option of the applicant and subject to *section 59* of this Act, to the Controller or on application by the Controller to the Court, the Court or the Controller (as the case may be) may make such order as the Court or the Controller (as the case may be) may think fit for expunging or varying the registration of a trade mark on the ground of any contravention of, or failure to observe, a condition entered on the register in relation thereto.

42.—

- (1) The Controller may, on request made in the prescribed manner by the registered proprietor—
 - (a) correct any error in the name, address or description of the registered proprietor of a trade mark;
 - (b) enter any change in the name, address or description of the person who is registered as proprietor of a trade mark;
 - (c) cancel the entry of a trade mark on the register;
 - (d) amend the specification of the goods in respect of which a trade mark is registered, provided that the amendment does not in any way extend the rights given by the existing registration of the trade mark; or
 - (e) enter a disclaimer or memorandum relating to a trade mark which does not in any way extend the rights given by the existing registration of the trade mark.
- (2) The Controller may, on request made in the prescribed manner by a registered user of a trade mark, correct any error, or enter any change, in the name, address or description of the registered user.
- (3) The Controller may, of his own motion, after having given the prescribed notice, correct any error made by him in any entry on the register.

43.—

- (1) The registered proprietor of a trade mark may apply in the prescribed manner to the Controller for leave to add to or alter the trade mark in any manner not substantially affecting the identity thereof, and the Controller may refuse leave or may grant it on such terms and subject to such limitations as he may think fit.
- (2) The Controller may cause an application under this section to be advertised in the prescribed manner in any case where it appears to him that it is expedient so to do and, where he does so, if within the prescribed time from the date of the advertisement any person gives notice to the Controller in the prescribed manner of opposition to the application, the Controller shall, after hearing the parties if so required, decide the matter.
- (3) Where leave as aforesaid is granted, the trade mark as altered shall be advertised in the prescribed manner, unless it has already been advertised, in the form to which it has been altered, in an advertisement under *subsection (2)* of this section.

44.—

- (1) The Minister may from time to time make such rules, prescribe such forms and generally do such things as he thinks expedient, for empowering the Controller to amend the register, whether by making or expunging or varying entries therein, so far as may be requisite for the purpose of adapting the designation therein of the goods or classes of goods in respect of which trade marks are registered to any amended or substituted classification that may be prescribed.
- (2) The Controller shall not, in exercise of any power conferred on him for the purpose aforesaid, make any amendment of the register that would have the effect of adding any goods or classes of goods to those in respect of which a trade mark is registered (whether in one or more classes) immediately before the amendment is to be made, or of antedating the registration of a trade mark in respect of any goods:

Provided that this subsection shall not have effect in relation to goods as to which the Controller is satisfied that compliance with this subsection in relation thereto would involve undue complexity and that

the addition or antedating, as the case may be, would not affect any substantial quantity of goods and would not substantially prejudice the rights of any person.

(3) A proposal for the amendment of the register for the purpose aforesaid shall be notified to the registered proprietor of the trade mark affected, shall be advertised with any modifications, and may be opposed before the Controller by any person aggrieved on the ground that the proposed amendment contravenes *subsection (2)* of this section.

45.—

(1) A mark adapted in relation to any goods to distinguish in the course of trade goods certified by any person in respect of origin, material, mode of manufacture, quality, accuracy or other characteristic, from goods not so certified shall be registrable as a certification trade mark in Part A of the register in respect of those goods in the name, as proprietor thereof, of that person:

Provided that a mark shall not be so registrable in the name of a person who carries on a trade in goods of the kind certified.

(2) In determining whether a mark is adapted to distinguish as aforesaid, the Court or the Controller (as the case may be) may have regard to the extent to which—

- (a) the mark is inherently adapted to distinguish as aforesaid in relation to the goods in question; and
- (b) by reason of the use of the mark or of any other circumstances, the mark is in fact adapted to distinguish as aforesaid in relation to the goods in question.

(3) Subject to *subsections (4) to (6)* of this section, and of *sections 15 and 16* of this Act, the registration of a person as proprietor of a certification trade mark in respect of any goods shall, if valid, give to that person the exclusive right to the use of the trade mark in relation to those goods, and, without prejudice to the generality of the foregoing words, that right shall be deemed to be infringed by any person who, not being the proprietor of the trade mark or a person authorised by him under the regulations in that behalf using it in accordance therewith, uses a mark identical with it or so nearly resembling it as to be likely to deceive or cause confusion, in the course of trade, in relation to any goods in respect of which it is registered, and in such manner as to render the use of the mark likely to be taken either—

- (a) as being use as a trade mark; or
- (b) in a case in which the use is use upon the goods or in physical relation thereto or in an advertising circular or other advertisement issued to the public, as importing a reference to some person having the right either as proprietor or by his authorisation under the relevant regulations to use the trade mark or to goods certified by the proprietor.

(4) The right to the use of a certification trade mark given by registration as aforesaid shall be subject to any conditions or limitations entered on the register, and shall not be deemed to be infringed by the use of any such mark as aforesaid in any mode, in relation to goods to be sold or otherwise traded in any place, in relation to goods to be exported to any market, or in any other circumstances, to which, having regard to any such limitations, the registration does not extend.

(5) The right to the use of a certification trade mark given by registration as aforesaid shall not be deemed to be infringed by the use of any such mark as aforesaid by any person—

- (a) in relation to goods certified by the proprietor of the trade mark if, as to those goods or a bulk of which they form part, the proprietor or another in accordance with his authorisation under the relevant regulations has applied the trade mark and has not subsequently removed or obliterated it, or the proprietor has at any time expressly or impliedly consented to the use of the trade mark; or

- (b) in relation to goods adapted to form part of, or to be accessory to, other goods in relation to which the trade mark has been used without infringement of the right given as aforesaid or might for the time being be so used, if the use of the mark is reasonably necessary in order to indicate that the goods are so adapted and neither the purpose nor the effect of the use of the mark is to indicate otherwise than in accordance with the fact that the goods are certified by the proprietor:

Provided that *paragraph (a)* of this subsection shall not have effect in the case of use consisting of the application of any such mark as aforesaid to any goods, notwithstanding that they are such goods as are mentioned in that paragraph, if such application is contrary to the relevant regulations.

(6) Where a certification trade mark is one of two or more registered trade marks that are identical or nearly resemble each other, the use of any of those trade marks in exercise of the right to the use of that trade mark given by registration shall not be deemed to be an infringement of the right so given to the use of any other of those trade marks.

(7)

(a) There shall be deposited at the Office in respect of every trade mark registered under this section regulations approved by the Minister for governing the use thereof, which shall include provisions as to the cases in which the proprietor is to certify goods and to authorise the use of the trade mark, and may contain any other provisions that the Minister may require or permit to be inserted therein (including provisions conferring a right of appeal to the Controller against any refusal of the proprietor to certify goods or to authorise the use of the trade mark in accordance with the regulations).

(b) Regulations deposited under this subsection shall be open to inspection in like manner as the register.

(8) A certification trade mark shall not be assignable or transmissible otherwise than with the consent of the Minister.

(9) The provisions of the *First Schedule* to this Act shall have effect with respect to the registration of a mark under this section and to marks so registered.

46.—

(1) A Minister of State may, subject to this Act, procure the registration of a trade mark or of a certification trade mark and a Minister by whom such registration is procured shall be, and shall be registered as, the proprietor thereof for all purposes under this Act.

(2) A Minister of State may procure the registration in any register maintained in any place outside the State of a trade mark (whether registered or not registered under *subsection (1)* of this section) if and so far as and subject to such conditions as such registration is permitted by the law regulating such register and in any such case may procure himself to be entered in such register as the proprietor of such trade mark.

47.—It shall be lawful for the Minister to take in any place outside the State such lawful steps, whether by way of action or prosecution at law or otherwise, as he shall think proper to prevent, restrain, or to secure punishment for the registration, use, or application in relation to or in respect of goods not grown, produced, or manufactured in the State of any trade mark or other mark or description indicating or suggesting or likely to lead to the belief that the goods in respect of which or to which such trade mark, mark, or description is used or applied were grown, produced or manufactured in the State.

PART III. PROVISIONS RELATING TO POWERS AND DUTIES OF CONTROLLER AND TO LEGAL PROCEEDINGS.

48.—

(1) The power to give to a person who proposes to apply for the registration of a trade mark in Part A or Part B of the register advice as to whether the trade mark appears to the Controller *prima facie* to

be inherently adapted to distinguish, or capable of distinguishing, as the case may be, shall be a function of the Controller under this Act.

(2) Any such person who is desirous of obtaining such advice must make application to the Controller therefor in the prescribed manner.

(3) If on an application for the registration of a trade mark as to which the Controller has given advice as aforesaid in the affirmative, made within three months after the advice is given, the Controller, after further investigation or consideration, gives notice to the applicant of objection on the ground that the trade mark is not adapted to distinguish, or capable of distinguishing, as the case may be, the applicant shall be entitled, on giving notice of withdrawal of the application within the prescribed period, to have repaid to him any fee paid on the filing of the application.

49.—The Controller may, in any case of doubt or difficulty in the administration of this Act, apply to the Attorney General for directions in the matter.

50.—Where any discretionary or other power is given to the Controller by this Act or the rules, he shall not exercise that power adversely to the applicant for registration or the registered proprietor of the trade mark in question without (if duly required so to do within the prescribed time) giving to the applicant or registered proprietor an opportunity of being heard.

51.—In all proceedings before the Controller under this Act, the Controller shall have power to award to any party such costs as he may consider reasonable, and to direct how and by what parties they are to be paid, and any such order may, by leave of the Court, be enforced in the same manner as a judgment or order of the Court to the same effect.

52.—In all legal proceedings relating to a registered trade mark (including applications under *section 40* of this Act) the fact that a person is registered as proprietor of the trade mark shall be *prima facie* evidence of the validity of the original registration of the trade mark and of all subsequent assignments and transmissions thereof.

53.—In any legal proceeding in which the validity of the registration of a registered trade mark comes into question and is decided in favour of the proprietor of the trade mark, the Court may certify to that effect, and if it so certifies then in any subsequent legal proceeding in which the validity of the registration comes into question the proprietor of the trade mark on obtaining a final order or judgment in his favour shall have his full costs, charges and expenses as between solicitor and client, unless in the subsequent proceeding the Court certifies that he ought not to have them.

54.—In any proceedings before the Court under this Act the Controller shall be neither awarded costs nor ordered to pay the costs of any other party.

55.—In any action or proceeding relating to a trade mark or trade name, the Court or the Controller (as the case may be) shall admit evidence of the usages of the trade concerned and of any relevant trade mark or trade name or get-up legitimately used by other persons.

56.—

(1) The Controller shall be given notice in writing (by the plaintiff, appellant or applicant, as the case may be) of any legal proceeding in which the relief sought would affect the register (including an appeal from any order or decision of the Controller and an application under *section 25* or *26* of this Act to extend the time for making an appeal against a decision of the Controller under either of those sections) and of the decision of the Court respecting any such legal proceeding, and shall have the right to appear and be heard, and shall appear if so directed by the Court, in any such legal proceeding.

(2) Unless otherwise directed by the Court, the Controller in lieu of appearing and being heard may submit to the Court a statement in writing signed by him, giving particulars of the proceedings before him in relation to the matter in issue or of the grounds of any decision given by him affecting it or of the practice of the Office in like cases or of such other matters relevant to the issues, and within his knowledge as Controller, as he thinks fit, and the statement shall be deemed to form part of the evidence in the proceeding.

57.—

(1) An appeal shall lie to the Court from any order or decision of the Controller under any provision of this Act (not being a decision of the Controller under *section 11* or *subsection (7) of section 69* of this Act) or from a correction of an error in the register by the Controller under *subsection (3) of section 42* of this Act, and the Court may make such order confirming, annulling or varying the order or decision or correction of the Controller as it thinks fit.

(2) In any appeal from a decision of the Controller to the Court under this Act, the Court shall have and exercise the same discretionary powers as under this Act are conferred upon the Controller.

(3) Except by leave of the Court, no appeal (other than an appeal under *section 25* or *26* of this Act) from an order or decision of the Controller or from a correction of an error in the register by the Controller under *subsection (3) of section 42* of this Act shall be entertained of which notice to the Court is not given within one month from the date of the order, decision or correction appealed against or within such further period not exceeding three months as the Controller may allow (upon request received before the expiration of the said period of one month).

(4) Subject to *subsection (5)* of this section, a decision of the Court under this section shall be final and not appealable.

(5) By leave of the Court, an appeal from a decision of the Court under this section shall lie to the Supreme Court on a specified question of law.

58.—The Court, in dealing with any question of the rectification of the register (including all applications under *section 40* of this Act), shall have power to review any decision of the Controller relating to the entry in question or the correction sought to be made.

59.—Where under this Act an applicant has an option to make an application either to the Court or to the Controller—

- (a) if an action concerning the trade mark in question is pending, the application must be made to the Court;
- (b) if in any other case the application is made to the Controller, he may, at any stage of the proceedings, refer the application to the Court, or he may, after hearing the parties, determine the question between them, subject to appeal to the Court.

60.—

(1) In any proceeding under this Act before the Controller, the evidence shall be given by statutory declaration in the absence of directions to the contrary, but, in any case in which the Controller thinks it right so to do, the Controller may take evidence orally in lieu of or in addition to evidence by declaration.

(2) Any such statutory declaration may in the case of appeal be used before the Court in lieu of evidence by affidavit, but if so used shall have all the incidents and consequences of evidence by affidavit.

(3) In case any part of the evidence is taken orally the Controller may do all or any of the following things:—

- (a) summon witnesses to attend before him,
- (b) examine on oath (which he is hereby authorised to administer), or permit the examination on oath of, the witnesses attending before him,
- (c) require any such witness to produce to the Controller any document in such witness's power or control.

(4) A witness before the Controller shall be entitled to the same immunities and privileges as if he were a witness before the Court.

(5) A summons shall be signed by the Controller.

(6) If any person—

- (a) on being duly summoned as a witness before the Controller makes default in attending, or

- (b) being in attendance as a witness refuses to take an oath legally required by the Controller to be taken, or to produce any document in his power or control legally required by the Controller to be produced by him, or to answer any question to which the Controller may legally require an answer, or
 - (c) does any other thing which would, if the Controller were a court of law, having power to commit for contempt of court, be contempt of such court,
- the Controller may certify the offence of that person under his official seal to the Court and the Court may, after such inquiry as it thinks proper to make, punish or take steps for the punishment of that person in like manner as if he had been guilty of contempt of the Court.

61.—

(1) A copy of any entry in the register, purporting to be certified by, and sealed with the official seal of, the Controller, shall be admitted in evidence in any court of law, and in all proceedings, without further proof or production of the original.

(2) Any person requiring such a certified copy as aforesaid shall be entitled to obtain it on payment of the prescribed fee.

62.—A certificate purporting to be under the official seal of the Controller as to any entry, matter or thing that he is authorised by this Act or the rules to make or do shall be *prima facie* evidence of the entry having been made, and of the contents thereof, and of the matter or thing having been done or not done.

PART IV MISCELLANEOUS.

63.—A person who makes or causes to be made a false entry in the register, or a writing falsely purporting to be a copy of an entry in the register, or who produces or tenders or causes to be produced or tendered in evidence any such writing, knowing the entry or writing to be false, shall be guilty of an offence under this section and shall be liable on summary conviction thereof to a fine not exceeding one hundred pounds or, at the discretion of the court, to imprisonment for any term not exceeding three months or to both such fine and such imprisonment.

64.—

(1) Any person who makes a representation—

- (a) with respect to a mark not being a registered trade mark, to the effect that it is a registered trade mark; or
- (b) with respect to a part of a registered trade mark not being a part separately registered as a trade mark, to the effect that it is so registered; or
- (c) to the effect that a registered trade mark is registered in respect of any goods in respect of which it is not registered; or
- (d) to the effect that the registration of a trade mark gives an exclusive right to the use thereof in any circumstances in which, having regard to limitations entered on the register, the registration does not give that right;

shall be guilty of an offence under this section and shall be liable on summary conviction thereof to a fine not exceeding twenty pounds and, in the case of a continuing offence, a further fine not exceeding five pounds for every day on which the offence continues.

(2) For the purposes of this section, the use in the State in relation to a trade mark of the word “registered”, or of any other word referring whether expressly or impliedly to registration, or of a prescribed symbol shall be deemed to import a reference to registration in the register, except—

- (a) where that word or that symbol is used in physical association with words delineated in characters at least as large as those in which that word or that symbol is delineated and indicating that the reference is to registration as a trade mark under the law of a place outside the State, being a place under the law of which the registration referred to is in fact in force;
- (b) where that word (being a word other than the word “registered”) or that symbol is of itself such as to indicate that the reference is to such registration as last aforesaid; or
- (c) where that word or that symbol is used in relation to a mark registered as a trade mark under the law of a place outside the State and in relation to goods to be exported to that place.

65.—Any person who without lawful authority uses in connection with any business, trade, calling or profession any badge, device, emblem, or flag reserved by law for the use of, or commonly used by, the State, the Defence Forces, any officer of the State or any Department of State (or any badge, device, emblem, or flag so closely resembling the same as to be likely to deceive) in such manner as to be likely to lead to the belief that he is duly authorised to use such badge, device, emblem, or flag, shall be guilty of an offence under this section and shall be liable on summary conviction thereof to a fine not exceeding twenty pounds (and, in the case of a continuing offence, to a further fine not exceeding five pounds for every day on which the offence continues) or, at the discretion of the court, to imprisonment for any term not exceeding three months.

66.—The use of a registered trade mark in relation to goods between which and the person using it any form of connection in the course of trade subsists shall not be deemed to be likely to cause deception or confusion on the ground only that the trade mark has been, or is, used in relation to goods between which and that person or a predecessor in title of his a different form of connection in the course of trade subsisted or subsists.

67.—

(1) Where the relations between two or more persons interested in a trade mark are such that no one of them is entitled as between himself and the other or others of them to use it except—

- (a) on behalf of both or all of them, or
- (b) in relation to an article with which both or all of them are connected in the course of trade, those persons may be registered as joint proprietors of the trade mark, and this Act shall have effect in relation to any rights to the use of the trade mark vested in those persons as if those rights had been vested in a single person:

Provided that the rights of any person who is so registered, shall be deemed to be infringed by any other of the said persons who uses the trade mark in physical or other relation to goods in respect of which the trade mark is registered under this section, but with which both or all of the said persons are not and have not been connected in the course of trade.

(2) Subject to *subsection (1)* of this section, nothing in this Act shall authorise the registration of two or more persons who use a trade mark independently, or propose so to use it, as joint proprietors thereof.

68.—

(1) There shall not be entered in the register any notice of any trust express, implied or constructive, nor shall any such notice be receivable by the Controller.

(2) Subject to this Act, equities in respect of a trade mark may be enforced in like manner as in respect of any other personal property.

69.—

(1) Whenever under this Act any act has to be done by or to any person in connection with a trade mark or any procedure relating to a trade mark or the registration thereof, the act (if not excepted by the

rules) may, under and in accordance with rules made under this section or, in particular cases, with the consent of the Minister, be done by or to an agent of that person duly authorised in the prescribed manner and, if acting for gain, registered in the register kept under *subsection (2)* of this section.

(2) There shall be kept at the Office a register which shall be called the register of trade mark agents, and no person shall, either alone or in partnership with any other person, practise, describe himself, hold himself out, or permit himself to be described or held out, as a trade mark agent, unless he is registered in the register of trade mark agents, and a partnership shall not so practise, describe itself, hold itself out, or permit itself so to be described or held out, unless all the partners are so registered.

(3) Any person who—

(a) resides in the State,

(b) has a place of business in the State,

(c) is not an alien (within the meaning of section 2 of the Irish Nationality and Citizenship Act, 1956),

(d) possesses the prescribed educational and professional qualifications, and

(e) complies with the prescribed conditions,

shall be eligible to be registered in the register of trade mark agents, and a partnership shall be so eligible if every partner thereof is registered in accordance with this section, and a person or partnership so eligible shall on application in the prescribed form and manner and on payment of the prescribed fee, be so registered.

(4) Notwithstanding *subsection (3)* of this section any person who has been in continuous practice as a trade mark agent in the State for a period of five years before the commencement of this Act and makes application (in the prescribed form and manner and upon payment of the prescribed fee) for registration within twelve months from the commencement of this Act shall be eligible to be registered in the register of trade mark agents.

(5) Any person who at any time after the expiration of three months from the commencement of this Act contravenes this section shall be guilty of an offence under this section and shall be liable on summary conviction thereof to a fine not exceeding, in the case of a first offence, twenty pounds and, in the case of a second or subsequent offence, one hundred pounds.

(6) Any person registered in the register of trade mark agents who—

(a) ceases to be eligible to be so registered, or

(b) applies to be removed from the register,

may be removed by the Controller from the register of trade mark agents, but no person shall be so removed (except on his own application) without being given an opportunity of being heard.

(7)

(a) Where a person registered in the register of trade mark agents is found by the Controller, after due inquiry by the Controller (including the hearing by the Controller of representations, if any, by the person), to have been guilty of conduct disgraceful to that person in a professional respect, the Controller may, if he sees fit, decide that the name of that person should be erased from the register of trade mark agents.

(b) On making a decision under this subsection, the Controller shall forthwith send by post to the person to whom the decision relates, at his address as stated in the register of trade mark agents, a notice in writing stating the decision, the date thereof and the reason therefor.

(c) A person to whom a decision of the Controller under this subsection relates may, within the period of fourteen days beginning on the date of the decision, on giving notice to the Controller in the prescribed manner apply to the Court for cancellation of the decision, and if he so applies—

(i) the Court, on the hearing of the application, may either—

(I) cancel the decision, or

(II) confirm the decision and direct the Controller to erase the name of such person from the register of trade mark agents,

- (ii) if at any time the Controller satisfies the Court that such person has delayed unduly in proceeding with the application, the Court shall, unless it sees good reason to the contrary, confirm the decision and direct the Controller to erase the name of such person from the register,
 - (iii) the Court may, subject to *section 54* of this Act, direct how the costs of the application are to be borne.
- (d) Where a person to whom a decision of the Controller under this subsection relates does not, within the period of fourteen days beginning on the date of the decision, apply to the Court for cancellation of the decision, the Controller may apply *ex parte* to the Court for confirmation of the decision and, if the Controller so applies, the Court, on the hearing of the application, shall, unless it sees good reason to the contrary, confirm the decision and direct the Controller to erase the name of such person from the register of trade mark agents.
- (e) The decision of the Court on an application under this subsection shall be final, save that, by leave of the Court, an appeal, by the Controller or the person concerned, from the decision shall lie to the Supreme Court on a specified question of law.
- (f) On erasing the name of a person from the register of trade mark agents under this subsection, the Controller shall forthwith send by post to such person, at his address as stated in the register of trade mark agents, notice in writing of the erasure.
- (g) A person whose name has been erased from the register of trade mark agents under this subsection may at any time be restored to the register by special direction of the Controller but not otherwise, and when a person is so restored to the register, the Controller may attach to the restoration such conditions (including the payment of a fee not exceeding the fee which would be payable by such person if he was then being registered for the first time) as the Controller thinks fit.

(8) A person (in this subsection referred to as an agent) duly authorised by any person under *subsection (1)* of this section to act as his agent may (subject to any provision to the contrary in any agreement between the agent and that person), on giving notice to the Controller and that person, cease to act as agent for that person.

(9) The Minister may by order make rules under this section for the management of the register of trade mark agents, and may by such rules prescribe any matter or thing referred to in this section as prescribed, and in particular may so prescribe the educational and professional qualifications and the conditions for eligibility for registration in the register of trade mark agents, and the maximum fees which may be charged by any person registered in the register of trade mark agents for such services in connection with the registration of trade marks as may be specified in such rules.

(10)

- (a) A person who is registered in the register of trade mark agents shall not be guilty of an offence under section 58 of the Solicitors Act, 1954, by reason only of the preparation by him for use in proceedings under this Act before the Controller or the Court of any document other than a deed.
- (b) Notwithstanding *subsection (5)* of this section, it shall not be an offence under this section for the legal personal representative of a deceased trade mark agent to carry on business or practise in the name of that deceased trade mark agent for a period not exceeding three years from the death of that trade mark agent, or for such further period (if any) as the Court allows, if the legal personal representative is himself a trade mark agent or employs a trade mark agent to manage the business or practice on his behalf.

(11) Notwithstanding *subsection (3)* of this section, the Minister may, with a view to the fulfilment by the Government on behalf of the State of any international agreement to which the State is a party, by order declare that a citizen of a particular state (being a state which is also a party to that international agreement) shall, if he otherwise complies with that subsection, be eligible to be registered in the register of trade mark agents.

(12) Notwithstanding *subsection (4)* of section 10 of the Petty Sessions (Ireland) Act, 1851, summary proceedings for an offence under this section may be instituted within twelve months from the date of the offence.

70.—

(1) Where any person has applied, in a foreign state which is a party to any international agreement for the mutual protection of trade marks to which the State is a party, for protection of a trade mark of which that person is the proprietor, that person or his legal representative or assignee shall be entitled to registration under this Act of that trade mark in priority to other applicants; and the registration shall have the same date as the date of the application in that foreign state:

Provided that—

- (a) the application in the State is made within the prescribed period, and
- (b) nothing in this section shall entitle the proprietor of a trade mark to recover damages for any infringement occurring prior to the date which, but for *subsection (1) of section 27* of this Act, would have been the date of registration of that trade mark.

(2) The registration under this Act of a trade mark to which this section applies shall not be invalidated by reason only of the use of that trade mark in the State during the period prescribed under *paragraph (a) of subsection (1) of this section* as that within which the application for such registration may be made.

(3) An application for the registration under this Act of a trade mark to which this section applies shall be made in the manner specified in *section 25* of or, in the case of a certification trade mark in the manner specified in the *First Schedule* to this Act.

(4) Any person who by an application which—

- (a) in accordance with the law of any foreign state is equivalent to an application duly made in that foreign state, or
 - (b) in accordance with the terms of any international agreement subsisting between any two or more foreign states is equivalent to an application duly made in one of those foreign states,
- has applied for protection of a trade mark of which he is the proprietor shall for the purpose of this section be deemed to have so applied in that foreign state.

(5) This section shall apply only in the case of those foreign states with respect to which the Government, by order, declares it to be applicable and so long only in the case of each foreign state as the order continues in force with respect to that foreign state.

(6) In this section “foreign state” includes any territory for the foreign relations of which any state (being a state which is a party to any international agreement for the mutual protection of trade marks to which the State is a party) considers itself responsible.

71.—Where an offence under *section 63, 64, 65, or 69* of this Act—

- (a) is committed by a body corporate or a partnership or by a person purporting to act on behalf of a body corporate or a partnership, and
 - (b) is proved to have been so committed with the consent or approval of, or to have been facilitated by any default on the part of, any person being, in the case of a body corporate, a director thereof, or, in the case of a partnership, a partner thereof,
- that person shall also be guilty of the offence.

72.—The transitional provisions set out in the *Second Schedule* to this Act shall have effect with respect to the matters therein mentioned respectively.

FIRST SCHEDULE. CERTIFICATION TRADE MARKS.

1.—

(1) An application for the registration of a mark under *section 45* of this Act must be made to the Controller in writing in the prescribed manner by the person proposed to be registered as the proprietor thereof.

(2) The provisions of *subsection (2)* and of *subsections (4) to (8)* of *section 25* of this Act shall have effect in relation to an application under the said *section 45* as they have effect in relation to an application under *subsection (1)* of the said *section 25*, except that for references therein to acceptance of an application there shall be substituted references to authorisation to proceed with the application.

(3) In dealing under the said provisions with an application under the said *section 45*, the Court or the Controller (as the case may be) shall have regard to the like considerations so far as relevant, as if the application were an application under the said *section 25* of this Act and to any other considerations (not being matters within the competence of the Minister under *subparagraph (5)* of this paragraph) relevant to applications under the said *section 45*, including the desirability of securing that a certification trade mark shall comprise some indication that it is such a trade mark.

(4) An applicant for the registration of a mark under the said *section 45* shall transmit to the Controller draft regulations for governing the use thereof at such time before the decision of the Controller on the application as he may require in order to enable him to consider the draft, and the Controller shall report thereon to the Minister.

(5) When authorisation to proceed with an application has been given, the Minister shall consider the application with regard to the following matters, that is to say:—

- (a) whether the applicant is competent to certify the goods in respect of which the mark is to be registered;
- (b) whether the draft regulations are satisfactory; and
- (c) whether in all the circumstances the registration applied for would be to the public advantage; and may either—
 - (i) direct that the application shall not be accepted; or
 - (ii) direct the Controller to accept the application, and approve the regulations, either without modification and unconditionally or subject to any conditions or limitations, or to any amendments or modifications of the application or of the regulations, which he thinks requisite having regard to any of the matters aforesaid;

but, except in the case of a direction for acceptance and approval without modification and unconditionally, the Minister shall not decide the matter without giving to the applicant an opportunity of being heard:

Provided that the Minister may, at the request of the applicant made with the concurrence of the Controller, consider the application with regard to any of the matters aforesaid before authorisation to proceed with the application has been given, so however that the Minister shall be at liberty to reconsider any matter on which he has given a decision under this proviso if any amendment or modification is thereafter made in the application or in the draft regulations.

2.—

(1) When an application has been accepted, the Controller shall, as soon as may be after such acceptance, cause the application as accepted to be advertised in the prescribed manner, and the provisions of *subsections (2) to (12)* of *section 26* of this Act shall have effect in relation to the registration of the mark as if the application had been an application under *section 25* of this Act:

Provided that, in deciding under the said provisions, the Court or the Controller (as the case may be) shall have regard only to the considerations referred to in *subparagraph (3)* of *paragraph 1* of this Schedule, and a decision under the said provisions in favour of the applicant shall be conditional on the determination in his favour by the Minister under *subparagraph (2)* of this paragraph of any opposition relating to any of the matters referred to in *subparagraph (5)* of the said *paragraph 1*.

(2) When notice of opposition is given relating to any of the matters referred to in *subparagraph (5)* of *paragraph 1* of this Schedule, the Minister shall, after hearing the parties, if so required, and considering any evidence, decide whether, and subject to what conditions or limitations, or amendments or modifications of the application or of the regulations, if any, registration is, having regard to those matters, to be permitted.

3.—

(1) The regulations deposited in respect of a certification trade mark may, on the application of the registered proprietor, be altered by the Controller with the consent of the Minister.

(2) The Minister may cause an application for his consent to be advertised in any case where it appears to him that it is expedient so to do, and, where the Minister causes an application to be advertised, if within the prescribed time from the date of the advertisement any person gives notice to him of opposition to the application, he shall not decide the matter without giving the parties an opportunity of being heard.

4.—

(1) The Minister may, on the application in the prescribed manner of any person aggrieved or on the application of the Controller, make such order as he thinks fit for expunging or varying any entry in the register relating to a certification trade mark, or for varying the deposited regulations, on the ground—

- (a) that the proprietor is no longer competent, in the case of any of the goods in respect of which the trade mark is registered, to certify those goods;
- (b) that the proprietor has failed to observe a provision of the deposited regulations to be observed on his part;
- (c) that it is no longer to the public advantage that the trade mark should be registered; or
- (d) that it is requisite for the public advantage that, if the trade mark remains registered, the regulations should be varied;

and neither the Court nor the Controller shall have any jurisdiction to make an order under *section 40* of this Act on any of those grounds.

(2) The Controller shall rectify the register and the deposited regulations in such manner as may be requisite for giving effect to an order made under *subparagraph (1)* of this paragraph.

5. Notwithstanding anything in *section 51* of this Act, the Controller shall not have any jurisdiction to award costs to or against any party on an appeal to him against a refusal of the proprietor of a certification trade mark to certify goods or to authorise the use of the trade mark.

6. The following provisions of this Act shall not have effect in relation to a certification trade mark, that is to say, *section 12*, *section 14*, *section 17*, *sections 25* and *26* (except as expressly applied by this Schedule), *subsections (4) to (7)* of *section 30*, *sections 34* to *37*, *section 66*, and any provisions the operation of which is limited by the terms thereof to registration in Part B of the register.

SECOND SCHEDULE. TRANSITIONAL PROVISIONS.

Preservation for three years of rights under section 82 (2) of Act of 1927.

1. Notwithstanding *subsection (1)* of *section 17* of this Act and the repeal of *subsection (2)* of *section 82* of the Act of 1927, any special or distinctive word or words, letter, numeral, or combination of letters or numerals used as a trade mark by the applicant or his predecessors in business before the 13th day of August, 1875, which has continued to be used (either in its original form or with additions or alterations not substantially affecting the identity of the same) down to the date of the application shall, in the period ending on the day which is three years after the commencement of this Act, be registrable as a trade mark in Part A of the register under this Act.

Assignments and transmissions before the commencement of this Act giving exclusive rights in different places in the State.

2. The validity of an assignment or transmission of a trade mark effected or claimed to have been effected before the commencement of this Act, in any such case as is mentioned in *subsection (6) of section 30* of this Act, shall be determined as if the provisions contained in *subsections (1) to (5)* of that section had not been enacted:

Provided that, on application made in the prescribed manner within three years from the commencement of this Act, by a person who claims that an assignment or transmission of a registered trade mark to him or to a predecessor in title of his has been so effected, the Controller shall have the like jurisdiction as under the proviso to *subsection (6)* of the said *section 30*, and an assignment or transmission approved by him shall not be deemed to have been invalid on the ground of the subsistence of such rights as are mentioned in the said *subsection (6)* or on the ground that the assignment or transmission was effected otherwise than in connection with the goodwill of a business or was effected in respect of some (but not all) of the goods in respect of which the trade mark was registered, if application for the registration under *section 33* of this Act of the title of the person becoming entitled is made within six months from the date on which the approval is given, or was made before that date.

Saving as to retrospective provisions relating to assignments and transmissions.

3. The retrospective provisions contained in *section 30* of this Act, and in *paragraph 2* of this Schedule shall have effect without prejudice to any determination of the Controller or the Court that was made before the commencement of this Act, or to the determination of any appeal from a determination so made, or to any title acquired for valuable consideration before the commencement of this Act.

Association of trade marks assignable or transmissible as a whole.

4. Where immediately before the commencement of this Act a trade mark was registered in Part B of the register subject to a condition rendering it assignable or transmissible only as a whole with another trade mark registered in the name of the same proprietor or with two or more other trade marks so registered, and not separately, the trade marks shall be deemed to be associated trade marks, and the entries in the register relating thereto may be amended accordingly.

Previous use of a trade mark by person becoming registered user on application made within three years of appointed day.

5. Where a person is registered as a registered user of a trade mark on an application made within three years from the commencement of this Act, *subsection (2) of section 36* of this Act shall have effect in relation to any previous use (whether before or after the commencement of this Act) of the trade mark by that person, being use in relation to the goods in respect of which he is registered and, where he is registered subject to conditions or restrictions, being use such as to comply substantially therewith, as if such previous use had been permitted use.

Use of trade mark for export trade before appointed day.

6. *Section 39* of this Act shall be deemed to have had effect in relation to an act done before the commencement of this Act as it has effect in relation to an act done after the commencement of this Act, without prejudice, however, to any determination of the Controller or the Court which was made before the commencement of this Act or to the determination of any appeal from a determination so made.



Trade marks registered under section 123 of the Industrial and Commercial Property (Protection) Act, 1927 to be deemed to have been registered under section 45 of this Act.

7. Section 45 of this Act shall have effect, in relation to a trade mark that immediately before the appointed day was on the register by virtue of section 123 of the Act of 1927, as if the said *section 45* had been in force at the date of the registration of the trade mark and it had been registered under that section, subject however to the following modifications, that is to say:—

- (a) the proviso to *subsection (1)* of the said *section 45* shall not apply;
- (b) in a case in which regulations for governing the use of the trade mark are deposited at the Office at the commencement of this Act, those regulations shall be deemed to have been deposited under the said *section 45*;
- (c) in a case in which no such regulations are deposited at the commencement of this Act, the proprietor shall be at liberty, or may be required by the Minister as a condition of the continuance of the registration, to deposit at any time thereafter such regulations as the Minister may permit or require; and
- (d) in a case in which no such regulations are for the time being deposited, the said *section 45* shall have effect as if references therein, and in the *First Schedule* to this Act, to the regulations had been omitted.