



STATUTORY INSTRUMENTS.

S.I. No. 562 of 2018



TRADE MARKS (AMENDMENT) RULES 2018

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I, HEATHER HUMPHREYS, Minister for Business, Enterprise and Innovation, in exercise of the powers conferred on me by section 81 of the Trade Marks Act 1996 (No. 6 of 1996), as adapted by the Jobs, Enterprise and Innovation (Alteration of Name of Department and Title of Minister) Order 2017 (S.I. No. 364 of 2017), hereby make the following rules:

Citation and commencement.

1. These Rules may be cited as the Trade Marks (Amendment) Rules 2018 and shall come into operation on 14 January 2019.

Definition.

2. In these Rules, “Principal Rules” means the Trade Marks Rules 1996 (S.I. No. 199 of 1996), and (except where the context otherwise requires) a reference to a Rule is a reference to a Rule of those Rules.

Amendment of Rule 4.

3. Rule 4 of the Principal Rules is amended—

(a) by substituting the following paragraphs for paragraphs (2) and (3):

“(2) Fees shall be paid in the currency of the State.

(3) Payment of a fee or fees may be made by any method acceptable to the Controller.”, and

(b) by deleting paragraph (4).

Amendment of Rule 6.

4. Rule 6 of the Principal Rules is amended by the substitution of “Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957” for “Nice Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks (1957), as revised at Stockholm (1967) and at Geneva (1977), and as amended”.

Representation of trade mark.

5. The Principal Rules are amended by inserting the following Rule after Rule 12:

“12A. (1) For the purposes of section 37 of the Act, an application for registration of a trade mark shall be made in accordance with paragraph (2)(a) to (k), as appropriate and—

Notice of the making of this Statutory Instrument was published in “Iris Oifigiúil” of 28th December, 2018.

- (a) shall include a representation of the mark in respect of which registration is being sought, and
- (b) may include a description of the representation concerned and, where such a description is included, shall accord with the representation and shall not extend the scope of that representation.

(2) Where the application for the registration of a trade mark concerns any of the trade mark types listed in subparagraphs (a) to (k), the type of the trade mark and its representation shall accord with each other as follows:

- (a) in the case of a trade mark consisting exclusively of words or letters, numerals, other standard typographic characters or a combination thereof (in these Rules referred to as a “word mark”), the representation of the mark shall consist of a reproduction of the mark in standard script and layout, without any graphic feature or colour;
- (b) in the case of a trade mark where non-standard characters, stylisation or layout, or a graphic feature or a colour are used and consist exclusively of figurative elements (in these Rules referred to as a “figurative mark”), the representation of the mark shall consist of a reproduction of the mark showing all its figurative elements and, where applicable, its colours;
- (c) in the case of a trade mark consisting of a combination of elements of a word mark as referred to in subparagraph (a) and elements of a figurative mark as referred to in subparagraph (b), then the representation of the mark shall consist of a reproduction of the mark showing both the word and figurative elements and, where applicable, the colours (in these Rules referred to as a “combined mark”);
- (d) in the case of a trade mark consisting of, or extending to, a three-dimensional shape, including the product itself, packaging, containers or their appearance (in these Rules referred to as a “three-dimensional shape mark”), the following applies:
 - (i) the representation of the mark shall consist of either a graphic reproduction of the shape, including computer-generated imaging, or a photographic reproduction;
 - (ii) the graphic or photographic reproduction may contain different views;
 - (iii) where the representation is not provided electronically, it may contain up to six different views;

- (iv) the representation which most characteristically illustrates the mark shall be shown in the space indicated in Form No. 1 and the additional perspectives shall be submitted on different sheets;
- (e) in the case of a trade mark consisting of the specific way in which the mark is placed or affixed on the product (in these Rules referred to as a “position mark”), the following applies:
 - (i) the representation of the mark shall consist of a reproduction which appropriately identifies the position of the mark and its size or proportion with respect to the relevant goods;
 - (ii) the elements which do not form part of the subject-matter of the registration shall be visually disclaimed preferably by broken or dotted lines;
 - (iii) the representation may be accompanied by a description detailing how the sign is affixed on the goods;
- (f) in the case of a trade mark consisting exclusively of a set of elements which are repeated regularly (in these Rules referred to as a “pattern mark”), the representation of the mark shall consist of a reproduction showing the pattern of repetition. The representation may be accompanied by a description detailing how its elements are repeated regularly;
- (g) in the case of a trade mark referred to in clause (i) or (ii) (in these Rules referred to as a “colour mark”), where the trade mark consists exclusively of—
 - (i) a single colour without contours, the representation of the mark shall consist of a reproduction of the colour and an indication of that colour by reference to a generally recognised colour code, or
 - (ii) a combination of colours without contours, the representation of the mark shall consist of a reproduction that shows the systematic arrangement of the colour combination in a uniform and predetermined manner and an indication of those colours by reference to a generally recognised colour code and may include a description detailing the systematic arrangement of the colours;
- (h) in the case of a trade mark consisting exclusively of a sound or combination of sounds (in these Rules referred to as “a sound mark”)—

- (i) the representation of the mark shall consist of an audio file reproducing the sound or by an accurate transcription of the sound in musical notation, and
 - (ii) where the representation of the mark consists exclusively of an audio file, the entire application shall be submitted in electronic format;
- (i) in the case of a trade mark consisting of, or extending to, a movement or a change in the position of the elements of the mark (in these Rules referred to as “a motion mark”)—
- (i) the representation of the mark shall consist of a video file or by a series of sequential still images showing the movement or change of position,
 - (ii) where still images are used, the images may be numbered or accompanied by a description explaining the sequence, and
 - (iii) where the representation of the mark consists exclusively of a video file, the entire application shall be submitted in electronic format;
- (j) in the case of a trade mark consisting of, or extending to, the combination of image and sound (in these Rules referred to as “a multimedia mark”)—
- (i) the representation of the mark shall consist of an audio-visual file containing the combination of the image and the sound, and
 - (ii) where the representation of the mark consists exclusively of an audio-video file, the entire application shall be submitted in electronic format;
- (k) in the case of a trade mark consisting of elements with holographic characteristics (in these Rules referred to as “a hologram mark”)—
- (i) the representation of the mark shall consist of a video file or a graphic of photographic reproduction containing the views which are necessary to sufficiently identify the holographic effect in its entirety, and
 - (ii) where the representation of the mark consists exclusively of a video file, the entire application shall be submitted in electronic format.

(3) Where the representation of the trade mark is required to be provided electronically, the Controller shall determine the format and size of the electronic file as well as any other technical specifications.

(4) Where the representation of the trade mark is not required to be provided electronically, that representation shall be provided in accordance with Rule 12(3)(a).”.

Amendment of Rule 13.

6. Rule 13 of the Principal Rules is amended by inserting “or such documentary evidence as the Controller may require” after “a certificate by the competent national authority”.

General powers of Controller in relation to opposition proceedings.

7. The Principal Rules are amended by inserting the following Rule after Rule 18:

“18A. (1) Save as otherwise provided by these Rules or the Act, the Controller may give such directions as to the management of any opposition proceedings as he or she thinks fit, and may in particular do any of the following:

- (a) require a document, information or evidence to be filed within such period as the Controller may specify;
- (b) require a translation of any document;
- (c) elect to hold a hearing by video conference or any other method of direct oral communication;
- (d) consolidate proceedings;
- (e) direct that part of any proceedings be dealt with as separate proceedings;
- (f) subject to Rules 20, 21, 22 and 23, exclude any evidence which the Controller considers to be inadmissible.”.

Amendment of Rule 21.

8. Rule 21 of the Principal Rules is amended—

- (a) by designating Rule 21 as paragraph (1),
- (b) by substituting, in that designated paragraph (1), “the applicant may” for “the applicant shall”, and
- (c) by inserting, after that designated paragraph (1), the following paragraph:

“(2) If the applicant chooses not to file evidence under this Rule, the evidence filing stage shall be deemed to be completed and proceedings shall progress in accordance with the provisions of Rule 25.”.

Amendment of Rule 25.

9. Rule 25 of the Principal Rules is amended—

(a) by inserting the following paragraph after paragraph (2):

“(2A) Subject to paragraph (6), a party who does not elect a preference pursuant to paragraph (1) shall be deemed to have concluded their presentation of evidence and arguments.”,

(b) by inserting the following paragraph after paragraph (3):

“(3A) (a) If both parties elect to file written submissions, the Controller shall forward to each party a copy of the written submissions of the other party.

(b) Within one month of the receipt of the written submissions of the other party under paragraph (3), each party may file with the Controller written submissions which shall be confined to matters strictly in reply to the other party’s submissions, and, shall send a copy of any submissions so filed to the other party.”,

(c) in paragraph (7), by deleting “and pay the prescribed fee”, and

(d) in paragraph (8), by deleting “and pay the prescribed fee”.

Division of registration.

10. The Principal Rules are amended by inserting the following Rule after Rule 28:

“28A. (1) (a) At any time after the registration by the Controller of an application, the proprietor may send to the Controller a request for a division of the registration (“the original registration”) into 2 or more separate registrations (“divisional registrations”), indicating for each divisional registration those goods or services of the original registration which are to be covered by it.

(b) A request for a division of a registration shall be accompanied by the prescribed fee.

(2) A divisional registration shall be treated as a separate registration for the purposes of the Act and these Rules. A divisional registration shall have the same date of filing and priority date (if any) as the original registration.

(3) A request under paragraph (1)(a) shall, in relation to the original registration, have the effect that the goods or services which are to be covered by any divisional registration shall be excluded from the original registration.

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

Amendment of Rule 32.

11. Rule 32 of the Principal Rules is amended by substituting the following paragraph for paragraph (2):

“(2) Following acceptance of amended regulations, the Controller shall publish notice in the register and in the Journal to that effect and any such notice shall state the date of acceptance and that copies of the amended regulations are available for public inspection at the Office.”.

Amendment of Rule 37.

12. Rule 37 is amended—

- (a) by substituting “not later than six months” for “not earlier than six months nor later than one month”, and
- (b) by substituting “expiry however, the Controller shall not be held liable if he or she fails to give such information” for “expiry”.

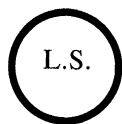
Amendment of Rule 41.

13. Rule 41(3) of the Principal Rules is amended—

- (a) in subparagraph (a), by substituting “shall send a copy thereof to the applicant” for “the Controller shall send a copy thereof to the applicant”, and
- (b) by inserting the following subparagraph after subparagraph (b):
 - “(ba) where the proprietor has filed the notice of opposition, accompanied by evidence of use, the proprietor shall send a copy thereof to the applicant.”.

Amendment of Rule 61.

14. Rule 61 of the Principal Rules is amended, in paragraph (3), by deleting “and pay the prescribed fee”.



GIVEN under my Official Seal,
18 December 2018.

HEATHER HUMPHREYS,
Minister for Business, Enterprise and Innovation.

EXPLANATORY NOTE

(This note is not part of these Rules and does not purport to be a legal interpretation.)

The amendments to Rules 32 and 37 and the inclusion of new Rules 12A and 28A of the Trade Marks Rules 1996 are necessary to give effect to Directive (EU) 2015/2436 of the European Parliament and of the Council of 16 December 2015 amending Directive 2008/95/EC relating to trade marks. Rule 12A lays down specific rules and requirements for the representation of certain types of trade mark, in accordance with the trade mark's specific nature and attributes; Rule 32(2) is amended to provide that amendments to regulations governing Collective Marks, should be recorded in the register; the amendment to Rule 37 changes the timeframe within which the Controller shall send the registered proprietor a notice that the registration may be renewed, in line with Article 49 of the Directive; and new Rule 28A provides for the division of a registration in line with Article 41 of the Directive.

The amendment to Rule 4 is for the purpose of updating practice and procedure relating to fee payments.

The amendment to Rule 6 corrects a typographical error.

The amendment to Rule 13 provides for a more up-to-date and flexible approach relating to the submission of priority documents.

The inclusion of new Rule 18A and the amendments to Rules 21 and 25 are for the purposes of setting out general powers of the Controller relating to opposition proceedings and further clarifying certain procedural steps regarding the filing of evidence, exchanges of written submissions and hearings in opposition proceedings. In particular, amendments to Rule 25 and 61 remove references to the payment of a prescribed fee by applicants for hearings as a fee is no longer prescribed.

The amendment to Rule 41 is for the purpose of clarifying certain procedural steps around oppositions to the filing of an application for revocation or invalidity.

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