



Number 6 of 1996

TRADE MARKS ACT, 1996

AN ACT TO MAKE NEW PROVISION FOR REGISTERED TRADE MARKS, IMPLEMENTING COUNCIL DIRECTIVE NO. 89/104/EEC OF 21st DECEMBER, 1988, TO APPROXIMATE THE LAWS OF THE MEMBER STATES RELATING TO TRADE MARKS⁽¹⁾; TO MAKE PROVISION IN CONNECTION WITH COUNCIL REGULATION (EC) NO. 40/94 OF 20 DECEMBER, 1993, ON THE COMMUNITY TRADE MARK⁽²⁾; TO GIVE EFFECT TO THE MADRID PROTOCOL RELATING TO THE INTERNATIONAL REGISTRATION OF MARKS OF 27th JUNE, 1989, AND TO CERTAIN PROVISIONS OF THE PARIS CONVENTION FOR THE PROTECTION OF INDUSTRIAL PROPERTY OF 20th MARCH, 1883, AS REVISED AND AMENDED; TO PERMIT THE REGISTRATION OF TRADE MARKS IN RELATION TO SERVICES AND FOR CONNECTED PURPOSES. [16th March, 1996]

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, 1996.

Short title and commencement.

(2) The provisions of the Act shall come into operation on such day as the Minister may by order fix.

(3) Different days may be so fixed for different provisions and different purposes.

2.—(1) In this Act, except where the context otherwise requires— Interpretation.

“the Act of 1963” means the Trade Marks Act, 1963;

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

“business” includes a trade or profession;

(1)OJ No. L40 of 11th February, 1989

(2)OJ No. L11 of 14th February, 1994

“Community trade mark”, and “Community Trade Mark Regulation” have the meanings assigned by *section 56*;

“the Controller” means the Controller of Patents, Designs and Trade Marks;

“Convention country” has the meaning assigned by *section 60*;

“the Court” means the High Court;

“director”, in relation to a body corporate whose affairs are managed by its members, means any member of the body;

“earlier trade mark” has the meaning assigned by *section 11*;

“exclusive licence” and “exclusive licensee” have the meanings assigned by *section 33*;

“infringement proceedings”, in relation to a registered trade mark, include proceedings under *section 20*;

“the Journal” means the Patents Office Journal;

“the Minister” means the Minister for Enterprise and Employment;

“the Office” means the Patents Office;

“the Paris Convention” has the meaning assigned by *section 60*;

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

“prescribed” means, in relation to proceedings before the Court, prescribed by rules of court and, in any other case, prescribed by this Act or orders, rules or regulations made hereunder;

“publish” means make available to the public, and references to publication—

(a) in relation to an application for registration, are to publication under *section 43 (1)*, and

(b) in relation to registration, are to publication under *section 45 (4)*;

“the register”, except in *Part V*, means the Register of Trade Marks kept under this Act;

“rules”, except in relation to rules of court, mean rules made by the Minister under *section 81*;

“State emblem of Ireland” means any emblem notified as such under Article 6ter of the Paris Convention;

“trade” includes any business or profession;

“trade mark” has the meaning assigned by *section 6*.

(2) References in this Act to use (or any particular description of use) of a trade mark, or of a sign identical with, similar to, or likely to be mistaken for a trade mark, include use (or that description of use) otherwise than by means of a graphic representation.

(3) Any reference in this Act to a Community instrument includes a reference to any instrument amending or replacing that instrument. Pr.I S.2

(4) In this Act—

(a) a reference to a Part or section is to a Part or section of this Act, unless it is indicated that reference to some other enactment is intended; and

(b) a reference to a subsection or paragraph is to the subsection or paragraph of the provision in which the reference occurs, unless it is indicated that some other provision is intended.

(5) In this Act a reference to an enactment includes a reference to that enactment as amended by or under any other enactment, including this Act.

3.—(1) Where a power to make orders, regulations or rules is conferred by this Act, such orders, regulations or rules may be made either in respect of all, or in respect of any one or more, of the matters to which the power relates, and different provisions may be made by any such orders, regulations or rules in respect of matters which are of different classes or descriptions. Orders, regulations and rules.

(2) Subject to *subsection (3)*, every order, regulation or rule made under this Act shall be laid before each House of the Oireachtas as soon as may be after it is made and, if a resolution annulling the order, regulation or rule is passed by either such House within the next twenty-one days on which that House has sat after the order, regulation or rule is laid before it, the order, regulation or rule shall be annulled accordingly, but without prejudice to the validity of anything previously done thereunder.

(3) Where—

(a) a regulation is proposed to be made under *section 57* or *section 59*, or

(b) an order is proposed to be made under *section 60*,

subsection (2) shall not apply and a draft of the order or regulation shall be laid before both Houses of the Oireachtas, and the order or regulation shall not be made until a resolution approving the draft has been passed by each House.

(4) As soon as may be after any order, regulation or rule is made under this Act, notice of the making thereof and of the place where copies thereof may be obtained, shall be published in the Journal.

(5) Any power under this Act to make an order includes power to amend or revoke an order made in the exercise of that power except in the case of an order under *section 1 (2)*.

4.—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. Expenses.

5.—Subject to the provisions of *section 100*, the Act of 1963 is hereby repealed. Repeal.

PART II

REGISTERED TRADE MARKS

Introductory

Trade marks.

6.—(1) In this Act a “trade mark” means any sign capable of being represented graphically which is capable of distinguishing goods or services of one undertaking from those of other undertakings.

(2) Without prejudice to *subsection (1)*, a trade mark may, in particular, consist of words (including personal names), designs, letters, numerals or the shape of goods or of their packaging.

(3) References in this Act to a trade mark include, unless the context otherwise requires, references to a collective mark within the meaning of *section 54* or a certification mark within the meaning of *section 55*.

Registered trade marks.

7.—(1) A registered trade mark is a property right obtained by the registration of the trade mark under this Act and the proprietor of a registered trade mark shall have the rights and remedies provided by this Act.

(2) No proceedings shall lie to prevent or recover damages for the infringement of an unregistered trade mark as such; but nothing in this Act shall affect the law relating to passing off.

Grounds for Refusal of Registration

Absolute grounds for refusal of registration.

8.—(1) The following shall not be registered as trade marks:

- (a) signs which do not satisfy the requirements of *section 6 (1)*;
- (b) trade marks which are devoid of any distinctive character;
- (c) trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of services, or other characteristics of goods or services;
- (d) trade marks which consist exclusively of signs or indications which have become customary in the current language or in the *bona fide* and established practices of the trade:

Provided that, a trade mark shall not be refused registration by virtue of *paragraph (b), (c) or (d)* if, before the date of application for registration, it has in fact acquired a distinctive character as a result of the use made of it.

(2) A sign shall not be registered as a trade mark if it consists exclusively of—

- (a) the shape which results from the nature of the goods themselves; or
- (b) the shape of goods which is necessary to obtain a technical result; or

(c) the shape which gives substantial value to the goods. Pr.II S.8

(3) A trade mark shall not be registered if—

(a) it is contrary to public policy or to accepted principles of morality; or

(b) it is of such a nature as to deceive the public, for instance as to the nature, quality or geographical origin of the goods or service.

(4) A trade mark shall not be registered if or to the extent that—

(a) its use is prohibited in the State by any enactment or rule of law or by any provision of Community law; or

(b) the application for registration is made in bad faith by the applicant.

9.—(1) A trade mark which consists of or contains any State emblem of Ireland or any insignia or device so nearly resembling such emblem that it may be mistaken for such emblem shall not be registered unless the Controller is satisfied that consent for its registration has been given by the Minister. Specially protected emblems.

(2) A trade mark which consists of or contains a representation of the national flag of the State, as defined by Article 7 of the Constitution, shall not be registered if it appears to the Controller that the use of the trade mark would be misleading or grossly offensive.

(3) The Controller may refuse to register a trade mark which consists of or contains any badge, device or emblem of a public authority unless such consent as is required by rules is obtained.

10.—(1) A trade mark shall not be registered if it is identical with an earlier trade mark and the goods or services for which the trade mark is applied for are identical with the goods or services for which the earlier trade mark is protected. Relative grounds for refusal of registration.

(2) A trade mark shall not be registered if because—

(a) it is identical with an earlier trade mark and would be registered for goods or services similar to those for which the earlier trade mark is protected, or

(b) it is similar to an earlier trade mark and would be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association of the later trade mark with the earlier trade mark.

(3) A trade mark which—

(a) is identical with or similar to an earlier trade mark, and

(b) is to be registered for goods or services which are not similar to those for which the earlier trade mark is protected,

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shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the State (or, in the case of a Community trade mark, in the Community) and the use of the later trade mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or reputation of the earlier trade mark.

(4) A trade mark shall not be registered if, or to the extent that, its use in the State is liable to be prevented—

- (a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade; or
- (b) by virtue of an earlier right, other than those referred to in *subsections (1) to (3)* and *paragraph (a)*, in particular by virtue of the law of copyright, registered designs or any other law relating to a right to a name, a right of personal portrayal or an industrial property right.

(5) Where by virtue of any such rule of law or earlier right as is referred to in *subsection (4)* a person would be entitled to prevent the use of a trade mark, that person is in this Act referred to as the proprietor of an “earlier right” in relation to the trade mark.

(6) Nothing in this section shall prevent the registration of a trade mark where the proprietor of the earlier trade mark or other earlier right consents to the registration.

Meaning of “earlier trade mark”.

11.—(1) In this Act an “earlier trade mark” means—

- (a) a registered trade mark, an international trade mark or a Community trade mark which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks;
- (b) a Community trade mark which has a valid claim to seniority from an earlier registered trade mark or international trade mark, even when the latter trade mark has been surrendered or allowed to lapse; or
- (c) a trade mark which, at the date of application for registration of the trade mark in question or (where appropriate) of the priority claimed in respect of the application, was entitled to protection under the Paris Convention as a well-known trade mark.

(2) References in this Act to an earlier trade mark include references to a trade mark in respect of which an application for registration has been made and which, subject to its being registered, would be an earlier trade mark by virtue of *subsection (1) (a)* or *(b)*.

(3) Where the registration of a trade mark specified in *subsection (1) (a)* or *(b)* expires, the trade mark shall continue to be taken into account in determining the registrability of a later mark for a period of one year after the expiry unless the Controller is satisfied that there was no *bona fide* use of the trade mark during the two years immediately preceding the expiry.

12.—(1) This section applies where on an application for the registration of a trade mark it appears to the Controller—

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Raising of relative grounds in case of honest concurrent use.

(a) that there is an earlier trade mark in relation to which any of the conditions set out in *subsections (1) to (3) of section 10* obtains, or

(b) that there is an earlier right in relation to which the condition set out in *section 10(4)* is satisfied,

but the applicant shows to the satisfaction of the Controller that there has been honest concurrent use of the trade mark for which registration is sought.

(2) In a case to which this section applies, the Controller shall not refuse the application by reason of the earlier trade mark or other earlier right unless objection on that ground is raised in opposition proceedings by the proprietor of that earlier trade mark or other earlier right.

(3) For the purposes of this section “honest concurrent use” means such use in the State, by the applicant or with his consent, as would formerly have amounted to honest concurrent use for the purposes of *section 20(2)* of the Trade Marks Act, 1963.

(4) Nothing in this section affects—

(a) the refusal of registration on the grounds mentioned in *section 8*; or

(b) the making of an application for a declaration of invalidity under *section 52 (2)*.

Effects of Registered Trade Mark

13.—(1) The proprietor of a registered trade mark shall have exclusive rights in the trade mark and such rights shall be infringed by the use of that trade mark in the State without the proprietor’s consent; and the acts referred to in *section 14*, if done without that consent, shall constitute infringement of the proprietor’s rights.

Rights conferred by registered trade mark.

(2) References in this Act to the infringement of a registered trade mark are references to any infringement of the rights of the proprietor of the registered trade mark.

(3) The rights of the proprietor of a registered trade mark shall have effect from the date of registration of the trade mark (as determined under *section 45 (3)*).

(4) Notwithstanding *subsection (3)*—

(a) no infringement proceedings may be begun before the date of publication of the registration of the trade mark; and

(b) no offence shall be regarded as committed under *section 92* by anything done before that date.

14.—(1) A person shall infringe a registered trade mark if that person uses in the course of trade a sign which is identical with the trade mark in relation to goods or services which are identical with those for which it is registered.

Infringement of registered trade mark.

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(2) A person shall infringe a registered trade mark if that person uses in the course of trade a sign where because—

- (a) the sign is identical with the trade mark and is used in relation to goods or services similar to those for which the trade mark is registered, or
- (b) the sign is similar to the trade mark and is used in relation to goods or services identical with or similar to those for which the trade mark is registered,

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association of the sign with the trade mark.

(3) A person shall infringe a registered trade mark if that person uses in the course of trade a sign which—

- (a) is identical with or similar to the trade mark, and
- (b) is used in relation to goods or services which are not similar to those for which the trade mark is registered,

where the trade mark has a reputation in the State and the use of the sign, being without due cause, takes unfair advantage of, or is detrimental to, the distinctive character or the reputation of the trade mark.

(4) For the purposes of this section, use of a sign shall include, in particular—

- (a) affixing it to goods or the packaging thereof;
- (b) offering or exposing goods for sale, putting them on the market or stocking them for those purposes under the sign, or offering or supplying services under the sign;
- (c) importing or exporting goods under the sign; or
- (d) using the sign on business papers or in advertising.

(5) A person who applies a registered trade mark to material intended to be used for labelling or packaging goods, as a business paper, or for advertising goods or services shall be treated as a party to any use of the material which infringes the registered trade mark if, when that person applied the mark, that person knew or had reason to believe that the application of the mark was not duly authorised by the proprietor or a licensee of the registered trade mark.

(6) Nothing in the preceding provisions of this section shall be construed as preventing the use of a registered trade mark by any person for the purpose of identifying goods or services as those of the proprietor or licensee of the registered trade mark; but any such use, otherwise than in accordance with honest practices in industrial or commercial matters, shall be treated as infringing the registered trade mark if the use without due cause takes unfair advantage of, or is detrimental to, the distinctive character or reputation of the trade mark.

Limits on effect of registered trade mark.

15.—(1) A registered trade mark shall not be infringed by the use of another registered trade mark in relation to goods or services for which the latter is registered, but subject to *section 52 (6)*.

(2) A registered trade mark shall not be infringed by—

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- (a) the use by a person of his own name or address;
- (b) the use of indications concerning the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of the service or other characteristics of goods or services; or
- (c) the use of the trade mark where it is necessary to indicate the intended purpose of a product or service, in particular, as accessories or spare parts:

Provided that such use is in accordance with honest practices in industrial and commercial matters.

(3) A registered trade mark shall not be infringed by the use in the course of trade in a particular locality of an earlier right which applies only in that locality.

(4) For the purpose of *subsection (3)* an “earlier right” means an unregistered trade mark or other sign continuously used in relation to goods or services by, or by a predecessor in title of, a person from a date prior to whichever is the earlier of—

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

and an earlier right shall be regarded as applying in a locality if, or to the extent that, its use in that locality is protected by any rule of law, in particular the law of passing off.

16.—(1) A registered trade mark shall not be infringed by the use of the trade mark in relation to goods which have been put on the market in the European Economic Area under that trade mark by the proprietor of the trade mark or with the consent of the proprietor.

Exhaustion of rights conferred by registered trade mark.

(2) The provisions of *subsection (1)* shall not apply where there exist legitimate reasons for the proprietor of the trade mark to oppose further dealings in the goods, in particular, where the condition of the goods has been changed or impaired after they have been put on the market.

17.—(1) A person who applies for the registration of a trade mark or the proprietor of a registered trade mark may—

Registration subject to disclaimer or limitation.

- (a) disclaim any right to the exclusive use of any specified element of the trade mark, or
- (b) agree that the rights conferred by the registration shall be subject to a specified territorial or other limitation;

and where the registration of a trade mark is subject to a disclaimer or limitation, the rights conferred by *section 13* shall be restricted accordingly.

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(2) If on an application for the registration of a trade mark, it appears to the Controller that any particular element of the trade mark is not distinctive and the inclusion of the element in the trade mark could give rise to doubts as to the scope of protection of the trade mark, he may refuse to accept the application unless the applicant agrees to make a disclaimer in respect of that element under *subsection (1) (a)* within such period as the Controller may specify.

(3) Particulars of any disclaimer or limitation shall be entered in the register.

Infringement Proceedings

Action for infringement.

18.—(1) Where a registered trade mark is infringed, the infringement shall be actionable by the proprietor of the trade mark.

(2) In an action for infringement of a registered trade mark all such relief by way of damages, injunctions, accounts or otherwise shall be available to the proprietor as is available in respect of the infringement of any other property right.

Order for erasure &c. of offending sign.

19.—(1) Where a person is found to have infringed a registered trade mark, the Court may make an order requiring him—

(a) to cause the offending sign to be erased, removed or obliterated from any infringing goods, material or articles in his possession, custody or control, or

(b) if it is not reasonably practicable for the offending sign to be erased, removed or obliterated, to secure the destruction of the infringing goods, materials or articles in question.

(2) If an order under *subsection (1)* is not complied with, or it appears to the Court likely that such an order would not be complied with, the Court may order that the infringing goods, material or articles be delivered to such person as the Court may direct for erasure, removal or obliteration of the sign, or for destruction, as the case may be.

Order for delivery up of infringing goods, material or articles.

20.—(1) The proprietor of a registered trade mark may apply to the Court for an order for the delivery up to the proprietor, or such other person as the Court may direct, of any infringing goods, material or articles of which a person has possession, custody or control in the course of a business or otherwise for the purpose of dealing in any way (including offering or exposing for sale or hire).

(2) An application for the delivery up of any infringing goods, material or articles shall not be made after the end of the period specified in *section 22*; and no order shall be made unless the Court also makes, or it appears to the Court that there are grounds for making, an order under *section 23*.

(3) A person to whom any infringing goods, material or articles are delivered up in pursuance of an order under this section shall, if an order under *section 23* is not made, retain them pending the making of an order or the decision not to make an order under that section.

(4) Nothing in this section shall affect any other power of the Court.

21.—(1) In this Act the expressions “infringing goods”, “infringing material” and “infringing articles” shall be construed as defined herein.

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Meaning of
“infringing goods,
material or
articles”.

(2) Goods shall be “infringing goods”, in relation to a registered trade mark, if they or their packaging bear a sign identical or similar to that mark and either—

- (a) the application of the sign to the goods or their packaging was an infringement of the registered trade mark, or
- (b) they have been or are proposed to be imported into the State and the application of the mark in the State to the goods or their packaging would constitute an infringement of the registered trade mark, or
- (c) the sign has otherwise been used in relation to the goods in such a way as to infringe the registered trade mark.

(3) Nothing in *subsection (2) (b)* shall be construed as applying to goods which may lawfully be imported into the State by virtue of any right created or arising under or by virtue of the treaties governing the European Union.

(4) Material shall be “infringing material”, in relation to a registered trade mark, if it bears a sign identical or similar to that mark and either—

- (a) it is used for labelling or packaging goods, as a business paper, or for advertising goods or services, in such a way as to infringe the registered trade mark, or
- (b) it is intended to be so used and such use would infringe the registered trade mark.

(5) “Infringing articles”, in relation to a registered trade mark, means articles—

- (a) which are specifically designed or adapted for making copies of a sign identical or similar to that mark, and
- (b) which are in the possession, custody or control, of a person who knows or has reason to believe that they have been or are to be used to produce infringing goods or material.

22.—(1) Subject to the provisions of this section, an application for an order under *section 20* may not be made after the end of the period of six years from—

Period after which
remedy of delivery
up not available.

- (a) in the case of infringing goods, the date on which the trade mark was applied to the goods or their packaging;
- (b) in the case of infringing material, the date on which the trade mark was applied to the material; or
- (c) in the case of infringing articles, the date on which they were made.

(2) If during the whole or part of the period referred to in *subsection (1)* the proprietor of the registered trade mark—

- (a) is under a disability, or

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(b) is prevented by fraud or concealment from discovering the facts entitling the proprietor to apply for an order,

an application may be made at any time before the end of the period of six years from the date on which the proprietor ceased to be under a disability or, as the case may be, could with reasonable diligence have discovered those facts.

(3) For the purposes of *subsection (2)* a person is under a disability if he is so for the purposes of the Statute of Limitations, 1957.

Order as to disposal of infringing goods, material or articles.

23.—(1) Where infringing goods, material or articles have been delivered up in pursuance of an order under *section 20*, an application may be made to the Court—

(a) for an order that they be destroyed or forfeited to such person as the Court thinks fit, or

(b) for a decision that no such order should be made.

(2) In considering what order (if any) should be made, the Court shall consider whether other remedies available in an action for infringement of the registered trade mark would be adequate to compensate and protect the interests of the proprietor and any licensee.

(3) Provision may be made by rules of court as to the service of notice on any person having an interest in the goods, material or articles, and any such person shall be entitled—

(a) to appear in proceedings for an order under this section, whether or not he was served with notice, and

(b) to appeal against any order made, whether or not he appeared;

and, unless the Court otherwise directs, an order shall not take effect until the end of the period within which notice of an appeal may be given or, if before the end of that period notice of appeal is duly given, until the final determination or abandonment of the proceedings on the appeal.

(4) Where there is more than one person interested in the goods, material or articles, the Court shall make such order as it thinks just.

(5) If the Court decides that no order should be made under this section, the person in whose possession, custody or control the goods, material or articles were before being delivered up shall be entitled to their return.

(6) References in this section to a person having an interest in goods, material or articles include references to any person in whose favour an order could be made under *section 27* of the Copyright Act, 1963.

Remedy for groundless threats of infringement proceedings.

24.—(1) Where a person threatens another with proceedings for infringement of a registered trade mark other than in relation to—

(a) the application of the mark to goods,

(b) the importation of goods to which the mark has been applied, or

(c) the supply of services under the mark,

any person aggrieved may apply to the Court for relief under this section. Pt.II S.24

(2) The relief which may be applied for as mentioned in *subsection (1)* is any of the following:

- (a) a declaration that the threats are unjustifiable;
- (b) an injunction against the continuance of the threats;
- (c) damages in respect of any loss sustained by the threats.

(3) A plaintiff shall be entitled to such relief as is referred to in *subsection (2)* unless the defendant shows that the acts in respect of which proceedings were threatened constitute (or if done would constitute) an infringement of the registered trade mark concerned.

(4) Notwithstanding the provisions of *subsection (3)*, the plaintiff shall be entitled to such relief as is referred to in *subsection (2)* if the plaintiff shows that the registration of the trade mark is invalid or liable to be revoked in a relevant respect.

(5) Notification that a trade mark is registered or that an application for registration has been made shall not of itself constitute a threat of proceedings for the purposes of this section.

25.—(1) If the District Court is satisfied by evidence that there is reasonable ground for believing that infringing goods, material or articles are in the possession, custody or control of any person in the course of business or otherwise for the purpose of dealing in any way (including offering or exposing for sale), the District Court may by order authorise a member of the Garda Síochána to seize the goods, material or articles without warrant and to bring them before the court.

Infringing goods, material or articles: powers of seizure and search.

(2) If a Judge of the District Court is satisfied by information on oath that there is reasonable ground for suspecting that infringing goods, material or articles are on any premises in the course of business or otherwise for the purpose of dealing in any way, the Judge may grant a search warrant authorising a named member of the Garda Síochána not below the rank of inspector, accompanied by such other members of the Garda Síochána as may be necessary, to enter on the premises, if need be by force, and to seize any such goods, material or articles and bring them before the court.

(3) On proof to the District Court that any goods, material or articles brought before the court under *subsection (1)* or *(2)* are infringing goods, material or articles, the court may—

- (a) order them to be delivered up to the proprietor of the registered trade mark concerned;
- (b) order them to be destroyed or forfeited to such person as the court thinks fit; or
- (c) order them to be dealt with in such other way as the court thinks fit.

(4) The powers of the District Court under this section shall be exercisable by the Judge of the District Court for the district in which the goods, material or articles are for the time being or, as the case may be, where the premises concerned are situated.

Registered Trade Mark as Object of Property

Pt. II 26.—A registered trade mark is personal property.

Nature of registered trade mark.

Jointly owned trade marks.

27.—(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, 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.

(2) Except as provided by *subsection (1)*, nothing in this Act shall permit the registration as joint proprietors of a trade mark of two or more persons who use, or propose to use, the trade mark independently.

(3) Subject to *subsection (4)*, where, in accordance with *subsection (1)*, two or more persons are registered as joint proprietors of a trade mark, 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 were vested in a single person.

(4) The rights of any one of the persons who are registered as joint proprietors of a trade mark (in this subsection referred to as “the joint owners”) shall be deemed to be infringed by any other of the joint owners who uses the trade mark in physical or other relation to goods or services—

(a) in respect of which the trade mark is so registered; but

(b) with which both or all of the joint owners are not and have not been connected in the course of trade.

Assignment &c. of registered trade mark.

28.—(1) A registered trade mark is transmissible by assignment, testamentary disposition or operation of law in the same way as other personal property, and shall be so transmissible either in connection with the goodwill of a business or independently.

(2) An assignment or other transmission of a registered trade mark may be partial, that is, limited so as to apply—

(a) in relation to some but not all of the goods or services for which the trade mark is registered; or

(b) in relation to use of the trade mark in a particular manner or a particular locality.

(3) An assignment of a registered trade mark, or a vesting assent relating to a registered trade mark, shall not be effective unless it is in writing signed by or on behalf of the assignor or, as the case may be, a personal representative; and this requirement may be satisfied in a case where the assignor or personal representative is a body corporate by the affixing of its seal.

(4) *Subsections (1) to (3)* shall apply to assignment by way of security as in relation to any other assignment.

(5) A registered trade mark may be the subject of a charge in the same way as other personal property. Pt.II S.28

(6) Nothing in this Act shall be construed as affecting the assignment or other transmission of an unregistered trade mark as part of the goodwill of a business.

29.—(1) On application being made to the Controller in the prescribed manner by—

Registration of transactions affecting registered trade mark.

- (a) a person claiming to be entitled to an interest in or under a registered trade mark by virtue of a registrable transaction, or
- (b) any other person claiming to be affected by such a transaction,

particulars of the transaction shall be entered in the register in the prescribed manner.

(2) The following are registrable transactions for the purposes of this Act—

- (a) an assignment of a registered trade mark or any right in it;
- (b) the grant or assignment of a licence under a registered trade mark;
- (c) the granting of any security interest (whether fixed or floating) over a registered trade mark or any right in or under it;
- (d) the making by a personal representative of a vesting assent in relation to a registered trade mark or any right in or under it; and
- (e) an order of a court or other competent authority transferring a registered trade mark or any right in or under it.

(3) Until an application has been made for registration of the prescribed particulars of a registrable transaction—

- (a) the transaction shall be ineffective as against a person acquiring a conflicting interest in or under the registered trade mark in ignorance of it; and
- (b) a person claiming to be a licensee by virtue of the transaction shall not have the protection of *section 34* or *35*.

(4) Where a person becomes the proprietor or a licensee of a registered trade mark by virtue of a registrable transaction, then unless—

- (a) an application for registration of the prescribed particulars of the transaction is made before the end of the period of six months beginning with the date of the transaction, or
- (b) the Court is satisfied that it was not practicable for such an application to be made before the end of that period and that an application was made as soon as practicable thereafter,

Pr.II S.29

that person shall not be entitled to damages or an account of profits in respect of any infringement of the registered trade mark occurring after the date of the transaction and before the application for registration of the prescribed particulars is made.

(5) Provision may be made by rules with respect to the amendment or deletion of particulars of registrable transactions entered in the register by virtue of this section.

Trusts and equities.

30.—(1) No notice of any trust (express, implied or constructive) shall be entered in the register; and the Controller shall not be affected by any such notice.

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

Application for registration of trade mark as an object of property.

31.—(1) The provisions of *sections 26 to 30* shall apply, with the necessary modifications, in relation to an application for the registration of a trade mark as they apply in relation to a registered trade mark.

(2) In *section 29* as it applies in relation to a transaction affecting an application for the registration of a trade mark, the references to the entry of particulars in the register, and to the making of an application to register particulars, shall be construed as references to the giving of notice to the Controller of those particulars.

(3) The procedure subsequent to the giving of notice as mentioned in *subsection (2)* shall be such as may be prescribed by rules.

Licensing

Licensing of registered trade mark.

32.—(1) A licence to use a registered trade mark may be general or limited.

(2) A limited licence may, in particular, apply—

(a) in relation to some but not all of the goods or services for which the trade mark is registered; or

(b) in relation to use of the trade mark in a particular manner or a particular locality.

(3) A licence shall not be effective unless it is in writing signed by or on behalf of the grantor and this requirement may be satisfied in a case where the grantor is a body corporate by the affixing of its seal.

(4) Unless the licence provides otherwise, it shall be binding on a successor in title to the grantor's interest; and references in this Act to doing anything with, or without, the consent of the proprietor of a registered trade mark shall be construed accordingly.

(5) Where the licence so provides, a sub-licence may be granted by the licensee; and references in this Act to a licence or licensee include a sub-licence or sub-licensee.

Exclusive licences.

33.—(1) In this Act an "exclusive licence" means a licence (whether general or limited) authorising the licensee, to the

exclusion of all other persons, including the person granting the licence, to use a registered trade mark in the manner authorised by the licence; and the expression “exclusive licensee” shall be construed accordingly. Pt.II S.33

(2) An exclusive licensee has the same rights against a successor in title who is bound by the licence as the exclusive licensee has against the person granting the licence.

34.—(1) This section has effect with respect to the rights of a licensee in relation to infringement of a registered trade mark, except where or to the extent that, by virtue of *section 35 (2)*, the licensee has a right to bring proceedings in the licensee’s own name. General provisions as to rights of licensees in case of infringement.

(2) A licensee is entitled, unless the licence, or any licence through which the licensee’s interest is derived, provides otherwise, to call on the proprietor of the registered trade mark to take infringement proceedings in respect of any matter which affects the licensee’s interests.

(3) If the proprietor—

(a) refuses to take proceedings when called upon under *subsection (2)*, or

(b) fails to do so within two months after being so called upon,

the licensee may bring the proceedings in his own name as if he were the proprietor.

(4) Where infringement proceedings are brought by a licensee by virtue of this section, the licensee may not, without the leave of the Court, proceed with the action unless the proprietor is either joined as a plaintiff or added as a defendant; but this subsection does not affect the granting of interlocutory relief on an application by a licensee alone.

(5) A proprietor who is added as a defendant as mentioned in *subsection (4)* shall not be liable for any costs in the action unless he takes part in the proceedings.

(6) In infringement proceedings brought by the proprietor of a registered trade mark the Court shall take into account any loss suffered or likely to be suffered by licensees; and the Court may give such directions as it thinks fit as to the extent to which the plaintiff is to hold the proceeds of any pecuniary remedy on behalf of licensees.

(7) The provisions of this section shall apply in relation to an exclusive licensee if or to the extent that the licensee has, by virtue of *section 35 (1)*, the rights and remedies of an assignee as if the licensee were the proprietor of the registered trade mark.

35.—(1) An exclusive licence may provide that the licensee shall have, to such extent as may be provided by the licence, the same rights and remedies in respect of matters occurring after the grant of the licence as if the licence had been an assignment. Exclusive licensee having rights and remedies of assignee.

(2) Where or to the extent that provision is made as mentioned in *subsection (1)*, the licensee shall be entitled, subject to the provisions of the licence and to the following provisions of this section,

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to bring infringement proceedings, against any person other than the proprietor, in the licensee's own name.

(3) Any such rights and remedies of an exclusive licensee shall be concurrent with those of the proprietor of the registered trade mark; and references to the proprietor of a registered trade mark in the provisions of this Act relating to infringement shall be construed accordingly.

(4) In an action brought by an exclusive licensee by virtue of this section a defendant may avail himself of any defence which would have been available to him if the action had been brought by the proprietor of the registered trade mark.

Exercise of concurrent rights.

36.—(1) Where proceedings for infringement of a registered trade mark brought by the proprietor or an exclusive licensee relate (wholly or partly) to an infringement in respect of which they have concurrent rights of action, the proprietor or, as the case may be, the exclusive licensee may not, without the leave of the Court, proceed with the action unless the other is either joined as a plaintiff or added as a defendant; but this subsection does not affect the granting of interlocutory relief on an application by a proprietor or exclusive licensee alone.

(2) A person who is added as a defendant as mentioned in *subsection (1)* shall not be liable for any costs in the action unless he takes part in the proceedings.

(3) Where an action for infringement of a registered trade mark is brought which relates (wholly or partly) to an infringement in respect of which the proprietor and an exclusive licensee have or had concurrent rights of action—

(a) the Court shall in assessing damages take into account—

(i) the terms of the licence, and

(ii) any pecuniary remedy already awarded or available to either of them in respect of the infringement;

(b) no account of profits shall be directed if an award of damages has been made, or an account of profits has been directed, in favour of the other of them in respect of the infringement; and

(c) the Court shall, if an account of profits is directed, apportion the profits between them as the Court considers just, subject to any agreement between them.

(4) The provisions of *subsection (3)* apply whether or not the proprietor and the exclusive licensee are both parties to the action; and if they are not both parties the Court may give such directions as it thinks fit as to the extent to which the party to the proceedings is to hold the proceeds of any pecuniary remedy on behalf of the other.

(5) The proprietor of a registered trade mark shall notify any exclusive licensee who has a concurrent right of action before applying for an order under *section 20*; and the Court may on the application of the licensee make such order under that section as it thinks fit having regard to the terms of the licence.

(6) The provisions of this section shall have effect subject to any

agreement to the contrary between the exclusive licensee and the proprietor. Pr.II S.36

Application for Registered Trade Mark

37.—(1) An application for registration of a trade mark shall be made to the Controller in such manner and containing such information as may be prescribed. Application for registration.

(2) The application shall state that the trade mark is being used, by or with the consent of the applicant, in relation to the goods or services specified in the application, or that the applicant has a *bona fide* intention that it should be so used.

(3) The application shall be subject to the payment of the appropriate fee or fees.

38.—(1) The date of filing of an application for registration of a trade mark is the date on which the prescribed documents are furnished to the Controller by the applicant; and if those documents are furnished on different days, the date of filing is the last of those days. Date of filing.

(2) References in this Act to the date of application for registration are to the date of filing of the application.

39.—(1) Goods and services shall be classified for the purposes of the registration of trade marks according to a prescribed system of classification; and every trade mark shall be registered in respect of particular goods or services or in respect of classes of goods or services. Classification of goods and services.

(2) Any question arising as to the class within which any goods or services fall shall be determined by the Controller, whose decision shall be final.

Priority

40.—(1) A person who has duly filed an application for protection of a trade mark in a Convention country (in this Act referred to as a “Convention application”), or the successor in title to such a person, has a right to priority, for the purpose of registering the same trade mark under this Act for some or all of the same goods or services, for a period of six months from the date of filing of the first Convention application. Claim to priority of Convention application.

(2) If the application for registration under this Act is made within the period specified in *subsection (1)*—

(a) the relevant date for the purposes of establishing which rights take precedence shall be the date of filing of the first Convention application, and

(b) the registrability of the trade mark shall not be affected by any use of the mark in the State in the period between that date and the date of the application under this Act.

(3) Any filing which in a Convention country is equivalent to a regular national filing, under its domestic legislation or an international agreement, shall be treated as giving rise to the right of priority; and for this purpose a “regular national filing” means a

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filing which is adequate to establish the date on which the application was filed in that country, irrespective of the outcome of the application.

(4) A subsequent application concerning the same subject as the first Convention application, filed in the same Convention country, shall be considered the first Convention application (of which the filing date is the starting date of the period of priority) if, at the time of the subsequent application—

(a) the previous application has been withdrawn, abandoned or refused, without having been laid open to public inspection and without leaving any rights outstanding; and

(b) it has not yet served as a basis for claiming a right of priority;

and in such a case the previous application may not thereafter serve as a basis for claiming a right of priority.

(5) Provision may be made by rules as to the manner of claiming a right to priority on the basis of a Convention application.

(6) A right to priority arising as a result of a Convention application may be assigned or otherwise transmitted, either with the application or independently; and the reference in *subsection (1)* to the applicant's successor in title shall be construed accordingly.

Claim to priority from other relevant overseas application.

41.—(1) This section applies to any country or territory in relation to which the State has entered into a treaty, convention, arrangement or engagement for the reciprocal protection of trade marks.

(2) The Government may by order make provision for conferring on a person who has duly filed an application for protection of a trade mark in a country or territory to which this section applies a right to priority, for the purpose of registering the same trade mark under this Act for some or all of the same goods or services, for a specified period from the date of filing of that application.

(3) In relation to a country or territory to which this section applies, an order under this section may make provision corresponding to that made by *section 40* in relation to Convention countries or such other provision as appears to the Government to be appropriate.

Registration Procedure

Examination of application.

42.—(1) The Controller shall examine whether an application for registration of a trade mark satisfies the requirements of this Act (including any requirements imposed by rules); and in this section those requirements are referred to as “the requirements for registration”.

(2) If it appears to the Controller that the requirements for registration are not met, the Controller shall inform the applicant and give the applicant an opportunity, within such period as the Controller may specify, to make representations or to amend the application.

(3) If the applicant fails to satisfy the Controller that the requirements for registration have been met, or to amend the application so

as to meet them, or fails to respond before the end of the specified period, the Controller shall refuse to accept the application. Pr.II S.42

(4) If it appears to the Controller that the requirements for registration are met, the Controller shall accept the application.

43.—(1) When an application for registration has been accepted, the Controller shall cause the application to be published in the Journal. Publication, opposition proceedings and observations.

(2) Any person may, within the prescribed time from the date of the publication of the application in the Journal, give notice to the Controller of opposition to the registration; and any such notice shall be given in writing in the prescribed manner, and shall include a statement of the grounds of opposition.

(3) Where an application has been published in the Journal, any person may, at any time before the registration of the trade mark, make observations in writing to the Controller as to whether the trade mark should be registered; and the Controller shall inform the applicant of any such observations.

(4) A person who makes observations as mentioned in *subsection (3)* shall not thereby become a party to the proceedings on the application.

44.—(1) An applicant may at any time by notice in writing withdraw his application or restrict the goods or services covered by the application; and, if the application has been published in the Journal, any withdrawal or restriction of the application shall also be published in the Journal. Withdrawal, restriction or amendment of application.

(2) Any such withdrawal as is mentioned in *subsection (1)* shall be irrevocable after the expiry of three months from the date of notice of the withdrawal.

(3) In a case not falling within *subsection (1)*, an application may be amended, at the request of the applicant, so long as the amendment does not substantially affect the identity of the trade mark or extend the goods or services covered by the application and, in particular, an amendment may be made (subject to that qualification) to correct—

(a) the name or address of the applicant;

(b) errors of wording or of copying; or

(c) obvious mistakes.

(4) Provision shall be made by rules for the publication of any amendment which affects the representation of the trade mark, or the goods or services covered by the application, and for the making of objections by any person claiming to be affected by it.

45.—(1) Where an application has been accepted and— Registration.

(a) no notice of opposition has been given within the period referred to in *section 43 (2)*, or

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(b) all opposition proceedings have been withdrawn or decided in favour of the applicant,

the Controller shall register the trade mark unless it appears to him, having regard to matters coming to his notice since accepting the application, that it was accepted in error.

(2) A trade mark shall not be registered unless any fee prescribed for the registration has been paid within the prescribed period and, if the fee has not been so paid, the application shall be deemed to be withdrawn.

(3) A trade mark when registered shall be registered as of the date of filing of the application for registration; and that date shall be deemed for the purposes of this Act to be the date of registration.

(4) On the registration of a trade mark the Controller shall publish the registration in the Journal and issue to the applicant a certificate of registration.

(5) The registration procedure shall be regarded as completed on the date of publication under *subsection (4)*; and that date shall be entered in the register.

Registration:
supplementary
provisions.

46.—(1) Provision may be made by rules as to—

- (a) the division of an application for the registration of a trade mark into several applications, each having the same filing date as the original application;
- (b) the merging of separate applications or registrations; and
- (c) the registration of a series of trade marks in one registration.

(2) A “series of trade marks” means a number of trade marks which resemble each other as to their material particulars and differ only in respect of matter of a non-distinctive character which does not substantially affect the identity of the trade mark.

Duration, Renewal and Alteration of Registered Trade Mark

Duration of
registration.

47.—(1) A trade mark shall be registered for a period of ten years from the date of registration.

(2) Registration may be renewed in accordance with *section 48* for further periods of ten years.

Renewal of
registration.

48.—(1) Subject to payment of the prescribed renewal fee, the registration of a trade mark may be renewed at the request of the proprietor.

(2) Provision shall be made by rules for the Controller to inform the proprietor of a registered trade mark, before the expiry of the registration, of the date of expiry and the manner in which the registration may be renewed.

(3) Subject to *subsection (4)*, a request for renewal must be made, and the prescribed renewal fee paid, before the expiry of the registration.

(4) If *subsection (3)* is not complied with, a request for renewal may be made and the fee paid within such further period (of not less than six months) as may be prescribed; in which case the prescribed additional renewal fee must also be paid within that period. Pr.II S.48

(5) A term of renewal shall take effect from the expiry of the previous registration.

(6) If the registration is not renewed in accordance with the preceding provisions, the Controller shall remove the trade mark from the register; but provision may be made by rules for the restoration of the registration of a trade mark which has been removed from the register, subject to such conditions (if any) as may be prescribed.

(7) The renewal, removal or restoration of the registration of a trade mark shall be published in the Journal.

49.—(1) The proprietor of a registered trade mark may apply in the prescribed manner to the Controller for leave to add to or alter the trade mark in any manner which does not substantially affect its identity; and the Controller may refuse leave or grant it on such terms and subject to such limitations as the Controller thinks fit. Alteration of registered trade mark.

(2) In any case where it appears to the Controller expedient to do so, the Controller may cause an application under *subsection (1)* to be advertised in the Journal.

(3) If, within the prescribed time from the date of the advertisement of an application under *subsection (2)*, 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.

(4) Where leave is granted as mentioned in *subsection (1)* and the trade mark concerned, in its altered form, has not already been advertised in an advertisement of the application under *subsection (2)*, the trade mark, in its altered form, shall be advertised in the Journal.

Surrender, Revocation and Invalidity

50.—(1) A registered trade mark may be surrendered by the proprietor in respect of some or all of the goods or services for which it is registered. Surrender of registered trade mark.

(2) Provision may be made by rules—

(a) as to the manner and effect of a surrender; and

(b) for protecting the interests of other persons having a right in the registered trade mark.

51.—(1) The registration of a trade mark may be revoked on any of the following grounds— Revocation of registration.

(a) that, within the period of five years following the date of publication of the registration, the trade mark has not been put to genuine use in the State, by or with the consent of the proprietor, in relation to the goods or services

for which it is registered, and there are no proper reasons for non-use;

- (b) that such use has been suspended for an uninterrupted period of five years, and there are no proper reasons for non-use;
- (c) that, in consequence of acts or inactivity of the proprietor, it has become the common name in the trade for a product or service for which it is registered;
- (d) that, in consequence of the use made of it by or with the consent of the proprietor in relation to the goods or services for which it is registered, it is liable to mislead the public, particularly as to the nature, quality or geographical origin of those goods or services.

(2) For the purposes of *subsection (1)*, use of a trade mark includes use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, and use in the State includes affixing the trade mark to goods or to the packaging of goods in the State solely for export purposes.

(3) The registration of a trade mark shall not be revoked on the ground mentioned in *paragraph (a) or (b) of subsection (1)* if such use as is referred to in that paragraph is commenced or resumed after the expiry of the five year period and before the application for revocation is made; but, for this purpose, any such commencement or resumption of use occurring after the expiry of the five year period and within the period of three months before the making of the application shall be disregarded unless preparations for the commencement or resumption began before the proprietor became aware that the application might be made.

(4) An application for revocation may be made by any person, and may be made either to the Controller or to the Court, except that—

- (a) if proceedings concerning the trade mark in question are pending in the Court, the application must be made to the Court; and
- (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.

(5) Where grounds for revocation exist in respect of only some of the goods or services for which the trade mark is registered, revocation shall relate to those goods or services only.

(6) Where the registration of a trade mark is revoked to any extent, the rights of the proprietor shall be deemed to have ceased to that extent as from—

- (a) the date of the application for revocation; or
- (b) if the Controller or the Court is satisfied that the grounds for revocation existed at an earlier date, that date.

(7) Revocation of a trade mark shall be entered in the register and the Controller shall publish the revocation of a trade mark in the Journal.

52.—(1) The registration of a trade mark may be declared invalid on the ground that the trade mark was registered in breach of *section 8* or any of the provisions referred to in that section; but where a trade mark was registered in breach of *subsection (1) (b), (c) or (d)* of that section, it shall not be declared invalid if, in consequence of the use which has been made of it, it has after registration acquired a distinctive character in relation to the goods or services for which it is registered.

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Grounds for
invalidity of
registration.

(2) The registration of a trade mark may be declared invalid on the grounds—

- (a) that there is an earlier trade mark in relation to which any of the conditions set out in *subsections (1) to (3) of section 10* obtains, or
- (b) that there is an earlier right in relation to which the condition set out in *paragraph (a) or (b) of subsection (4) of that section* is satisfied,

unless the proprietor of that earlier trade mark or earlier right has consented to the registration.

(3) An application for a declaration of invalidity may be made by any person, and may be made either to the Controller or to the Court, except that—

- (a) if proceedings concerning the trade mark in question are pending in the Court, the application must be made to the Court; and
- (b) if in any other case the application is made to the Controller, the Controller may at any stage of the proceedings refer the application to the Court.

(4) In the case of bad faith in the registration of a trade mark, the Controller may apply to the Court for a declaration of the invalidity of the registration.

(5) Where the grounds of invalidity exist in respect of only some of the goods or services for which the trade mark is registered, the trade mark shall be declared invalid as regards those goods or services only.

(6) Where the registration of a trade mark is declared invalid to any extent, the registration shall to that extent be deemed never to have been made, provided that this shall not affect transactions past and closed.

53.—(1) Where the proprietor of an earlier trade mark or other earlier right has acquiesced for a continuous period of five years in the use of a registered trade mark in the State, while being aware of that use, the proprietor shall no longer be entitled, on the basis of that earlier trade mark or other right—

Effect of
acquiescence.

- (a) to apply for a declaration that the registration of the later trade mark is invalid, or
- (b) to oppose the use of the later trade mark in relation to the goods or services in connection with which it has been so used,

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unless the registration of the later trade mark was applied for in bad faith.

(2) Where *subsection (1)* applies, the proprietor of the later trade mark shall not be entitled to oppose the use of the earlier trade mark or, as the case may be, the exploitation of the earlier right, notwithstanding that the earlier trade mark or right may no longer be invoked against the proprietor's later trade mark.

Collective Marks

Collective marks.

54.—(1) A collective mark is a mark distinguishing the goods or services of members of the association which is the proprietor of the mark from those of other undertakings.

(2) The provisions of this Act apply to collective marks subject to the provisions of the *First Schedule*.

Certification Marks

Certification marks.

55.—(1) A certification mark is a mark indicating that the goods or services in connection with which it is used are certified by the proprietor of the mark in respect of origin, material, mode of manufacture of goods or performance of services, quality, accuracy or other characteristics.

(2) The provisions of this Act apply to certification marks subject to the provisions of the *Second Schedule*.

PART III

COMMUNITY TRADE MARKS AND INTERNATIONAL MATTERS

Community Trade Marks

Meaning of "Community trade mark" and "Community Trade Mark Regulation".

56.—In this Act—

(a) "Community trade mark" has the meaning given by Article 1 (1) of the Community Trade Mark Regulation; and

(b) "the Community Trade Mark Regulation" means Council Regulation (EC) No. 40/94 of 20 December, 1993 on the Community trade mark.

Power to make provision in connection with Community Trade Mark Regulation.

57.—(1) The Minister may by regulations make such provision as he considers appropriate in connection with the operation of the Community Trade Mark Regulation.

(2) Provision may, in particular, be made with respect to—

(a) the filing of applications for Community trade marks through the Patents Office;

(b) the procedures for determining *a posteriori* the invalidity, or liability to revocation, of the registration of a trade mark from which a Community trade mark claims seniority;

(c) the conversion of a Community trade mark or an application

for a Community trade mark into an application for registration under this Act; and Pr.III S.57

- (d) the designation of Courts in the State having jurisdiction over proceedings arising out of the Community Trade Mark Regulation.

(3) Without prejudice to the generality of *subsection (1)*, provision may be made by regulations under this section making in relation to the list of professional representatives maintained in pursuance of Article 89 of the Community Trade Mark Regulation, and persons on that list, provision corresponding to that made by, or capable of being made under, *sections 84 to 90* in relation to the register of trade mark agents and registered trade mark agents.

(4) *Section 24* (remedy for groundless threats of infringement proceedings) and *Part VI* (offences) shall apply in relation to a Community trade mark as they apply in relation to a registered trade mark.

The Madrid Protocol: International Registration

58.—In this Act—

The Madrid Protocol.

“the Madrid Protocol” means the Protocol relating to the Madrid Agreement concerning the International Registration of Marks, adopted at Madrid on 27th June, 1989;

“the International Bureau” has the meaning given by Article 2 (1) of that Protocol; and

“international trade mark” means a trade mark which is entitled to protection in the State under that Protocol.

59.—(1) The Minister may by regulations make such provision as he considers appropriate for giving effect in the State to the provisions of the Madrid Protocol. Power to make provision giving effect to Madrid Protocol.

(2) Provision may, in particular, be made with respect to—

- (a) the filing of applications for international registrations through the Patents Office as office of origin;
- (b) the procedures to be followed where the basic application or registration in the State fails or ceases to be in force;
- (c) the procedures to be followed where the Patents Office receives from the International Bureau a request for extension of protection to the State;
- (d) the effects of a successful request for extension of protection to the State;
- (e) the transformation of an international registration or an application for an international registration into a national application for registration;
- (f) the communication of information to the International Bureau;

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(g) the payment of fees and amounts prescribed in respect of applications for international registrations, extensions of protection and renewals.

(3) *Section 24* (remedy for groundless threats of infringement proceedings); and *Part VI* (offences) shall apply in relation to an international trade mark as they apply in relation to a registered trade mark.

The Paris Convention: Supplementary Provisions

The Paris Convention.

60.—(1) In this Act—

(a) “the Paris Convention” means the Paris Convention for the Protection of Industrial Property of March 20th, 1883, as amended or supplemented by any protocol to that Convention which is for the time being in force in the State; and

(b) a “Convention country” means a country, other than the State, which is a party to that Convention.

(2) The Minister may by order make such amendments of this Act and rules made under this Act as appear to the Minister appropriate in consequence of any revision or amendment of the Paris Convention after the passing of this Act.

Protection of well-known trade marks: Article 6bis.

61.—(1) References in this Act to a trade mark which is entitled to protection under the Paris Convention as a well-known trade mark are to a mark which is well known in the State as being the mark of—

(a) a national of a Convention country, or

(b) a person who is domiciled in, or has a real and effective industrial or commercial establishment in, a Convention country,

whether or not that person carries on business, or has any goodwill, in the State; and references to the proprietor of such a mark shall be construed accordingly.

(2) Subject to *section 53*, the proprietor of a trade mark which is entitled to protection under the Paris Convention as a well-known trade mark shall be entitled to restrain by injunction the use in the State of a trade mark which, or the essential part of which, is identical or similar to the proprietor’s mark, in relation to identical or similar goods or services, where the use is likely to cause confusion.

(3) Nothing in *subsection (2)* shall affect the continuation of any *bona fide* use of a trade mark begun before the commencement of this section.

National emblems &c. of Convention countries: Article 6ter.

62.—(1) A trade mark which consists of or contains the flag of a Convention country shall not be registered without the authorisation of the competent authorities of that country, unless it appears to the Controller that use of the flag in the manner proposed is permitted without such authorisation.

(2) A trade mark which consists of or contains the armorial bearings or any other state emblem of a Convention country which is protected under the Paris Convention shall not be registered without the authorisation of the competent authorities of that country.

(3) A trade mark which consists of or contains an official sign or hallmark adopted by a Convention country and indicating control and warranty shall not, where the sign or hallmark is protected under the Paris Convention, be registered in relation to goods or services of the same or a similar kind as those in relation to which it indicates control and warranty, without the authorisation of the competent authorities of the country concerned.

(4) The provisions of this section as to national flags and other state emblems and official signs or hallmarks apply equally to anything which, from a heraldic point of view, imitates any such flag or other emblem, sign or hallmark.

(5) Nothing in this section prevents the registration of a trade mark on the application of a national of a country who is authorised to make use of a state emblem or official sign or hallmark of that country, notwithstanding that it is similar to that of another country.

(6) Where, by virtue of this section, the authorisation of the competent authorities of a Convention country is or would be required for the registration of a trade mark, those authorities shall be entitled to restrain by injunction any use of the mark in the State without their authorisation.

63.—(1) This section applies to—

- (a) the armorial bearings, flags or other emblems, and
- (b) the abbreviations and names,

Emblems &c. of
certain international
organisations:
Article 6ter.

of international intergovernmental organisations of which one or more Convention countries are members.

(2) A trade mark which consists of or contains any such emblem, abbreviation or name which is protected under the Paris Convention shall not be registered without the authorisation of the international organisation concerned, unless it appears to the Controller that the use of the emblem, abbreviation or name in the manner proposed—

- (a) is not such as to suggest to the public that a connection exists between the organisation and the trade mark; or
- (b) is not likely to mislead the public as to the existence of a connection between the user and the organisation.

(3) The provisions of this section as to emblems of an international organisation apply equally to anything which, from a heraldic point of view, imitates any such emblem.

(4) Where, by virtue of this section, the authorisation of an international organisation is or would be required for the registration of a trade mark, that organisation shall be entitled to restrain by injunction any use of the mark in the State without its authorisation.

(5) Nothing in this section affects the right of a person whose *bona fide* use of the trade mark in question began before 9th June, 1967

(when the relevant provisions of the Paris Convention entered into force in relation to the State).

Notification under Article 6ter of the Convention.

64.—(1) For the purposes of *section 62* state emblems of a Convention country (other than the national flag) and official signs or hallmarks shall be regarded as protected under the Paris Convention only if, or to the extent that—

- (a) the country in question has notified the State in accordance with Article 6ter (3) of the Convention that it desires to protect the emblem, sign or hallmark;
- (b) the notification remains in force; and
- (c) the State has not objected to it in accordance with Article 6ter (4) or any such objection has been withdrawn.

(2) For the purposes of *section 63*, the emblems, abbreviations and names of an international organisation shall be regarded as protected under the Paris Convention only if, or to the extent that—

- (a) the organisation in question has notified the State in accordance with Article 6ter (3) of the Convention that it desires to protect that emblem, abbreviation or name;
- (b) the notification remains in force; and
- (c) the State has not objected to it in accordance with Article 6ter (4) or any such objection has been withdrawn.

(3) Notification under Article 6ter (3) of the Paris Convention shall have effect only in relation to applications for registration made more than two months after the receipt of the notification.

(4) The Controller shall keep and make available for public inspection by any person, at all reasonable hours and free of charge, a list of—

- (a) the state emblems and official signs or hallmarks, and
- (b) the emblems, abbreviations and names of international organisations,

which are for the time being protected under the Paris Convention by virtue of notification under Article 6ter (3).

Acts of agent or representative: Article 6septies.

65.—(1) The following provisions apply where an application for registration of a trade mark is made by a person who is an agent or representative of a person who is the proprietor of the mark in a Convention country and the application is made without the proprietor's authorisation.

(2) Where the proprietor opposes the application, registration shall be refused.

(3) Where the application (not being so opposed) is granted, the proprietor may—

- (a) apply for a declaration of the invalidity of the registration;
- or

(b) apply for the rectification of the register so as to substitute the proprietor's name as the proprietor of the registered trade mark. Pr.III S.65

(4) The proprietor may (notwithstanding the rights conferred by this Act in relation to a registered trade mark) apply to the Court to restrain by injunction any use of the trade mark in the State which is not authorised by the proprietor.

(5) *Subsections (2), (3) and (4)* shall not apply if, or to the extent that, the agent or representative justifies his action.

(6) An application under *subsection (3) (a) or (b)* must be made within three years of the proprietor becoming aware of the registration; and no injunction shall be granted under *subsection (4)* in respect of a use in which the proprietor has acquiesced for a continuous period of three years or more.

PART IV

ADMINISTRATIVE PROVISIONS

The Register

66.—(1) The Controller shall keep a Register of Trade Marks; and references in this Act to registration (in particular, in the expression “registered trade mark”) are, unless the context otherwise requires, to registration in the register. The register.

(2) There shall be entered in the register in accordance with this Act—

(a) registered trade marks;

(b) particulars of registrable transactions affecting a registered trade mark; and

(c) such other matters as may be prescribed.

(3) The register shall be kept in such form as may be prescribed, and provision shall in particular be made for—

(a) public inspection of the register; and

(b) the supply of certified or uncertified copies of, or extracts from, entries in the register.

67.—(1) Any person having a sufficient interest may apply for the rectification of an error or omission in the register: Rectification or correction of the register.

Provided that an application for rectification may not be made in respect of a matter affecting the validity of the registration of a trade mark.

(2) An application for rectification may be made either to the Controller or to the Court, except that—

(a) if proceedings concerning the trade mark in question are pending in the Court, the application must be made to the Court; and

Pt.IV S.67

(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.

(3) Unless the Controller or the Court otherwise directs, the effect of rectification of the register is that the error or omission in question shall be deemed never to have been made.

(4) The Controller may (of his own motion) correct any error made by him in any entry in the Register but, before doing so, he shall give notice of the proposed correction to any person who appears to him to be concerned.

(5) The Controller may, on request made in the prescribed manner by the proprietor of a registered trade mark—

(a) enter any change in the proprietor's name or address as recorded in the register;

(b) 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

(c) 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.

(6) The Controller may, on request made in the prescribed manner by the licensee of a registered trade mark, enter any change in the licensee's name or address as recorded in the register.

(7) The Controller may remove from the register matter appearing to him to have ceased to have effect.

Adaptation of entries to new classification.

68.—(1) Provision may be made by rules authorising the Controller to do such things as the Controller considers necessary to implement any amended or substituted classification of goods or services for the purposes of the registration of trade marks.

(2) Provision may, in particular, be made for the amendment of existing entries on the register so as to accord with the new classification.

(3) Any such power of amendment shall not be exercised so as to extend the rights conferred by the registration, except where it appears to the Controller that compliance with this requirement would involve undue complexity and that any extension would not be substantial and would not adversely affect the rights of any person.

(4) The rules may empower the Controller—

(a) to require the proprietor of a registered trade mark, within such time as may be prescribed, to file a proposal for amendment of the register; and

(b) to cancel or refuse to renew the registration of the trade mark in the event of the proprietor failing to do so.

(5) A proposal under *subsection (4) (a)* shall be advertised, and may be opposed, in such manner as may be prescribed.

Powers and Duties of the Controller

69.—(1) The Controller may require the use of such forms as he may direct for any purpose relating to the registration of a trade mark or any other proceedings before the Controller under this Act. Pr.IV
Power to require use of forms.

(2) The forms, and any directions of the Controller with respect to their use, shall be published in the Journal.

70.—(1) After publication of an application for registration of a trade mark, the Controller shall on request provide a person with such information as may be prescribed and permit him to inspect such documents as may be prescribed relating to the application or to any registered trade mark resulting from it. Information about applications and registered trade marks.

(2) A request for the purposes of *subsection (1)* must be made in the prescribed manner and be accompanied by the appropriate fee (if any).

(3) Before publication of an application for registration of a trade mark, documents or information constituting or relating to the application shall not be published by the Controller or communicated by the Controller to any person except—

(a) in such classes of case and to such extent as may be prescribed; or

(b) with the consent of the applicant;

but subject to the following provisions of this section.

(4) Where a person has been notified—

(a) that an application for registration of a trade mark has been made, and

(b) that the applicant will if the application is granted bring proceedings against that person in respect of acts done after publication of the application,

that person may make a request under *subsection (1)* notwithstanding that the application has not been published and that subsection shall apply accordingly.

71.—Where any discretionary power is, by or under this Act, given to the Controller, that power shall not be exercised adversely to any applicant for or proprietor of a trade mark or to any party in any proceedings before the Controller, without that applicant, proprietor or party being given an opportunity of being heard as regards the exercise of that power. Exercise of discretionary powers by Controller.

72.—(1) The Controller may, in any proceeding before him under this Act, order the payment to any party of such costs (if any) as the Controller may consider reasonable and direct how and by what party 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. Costs and security for costs.

(2) Where, under this Act, a party who neither resides nor carries

Pr.IV S.72 on business in the State or in any other state which may be prescribed is a party to any proceedings before the Controller, the Controller or, in the case of any appeal, the Court, may require that party to give security for the costs of the proceedings.

(3) If a requirement under *subsection (2)* is not complied with, the Controller or the Court, as may be appropriate, may treat the proceedings as abandoned.

Evidence before the Controller. **73.**—In subsection (1) of section 92 of the Patents Act, 1992 (which relates to evidence in proceedings before the Controller under that Act or any other enactment) after the words “before the Controller” there shall be inserted “(including proceedings under the *Trade Marks Act, 1996*)”.

Exclusion of liability in respect of official acts. **74.**—(1) The Controller shall not be taken to warrant the validity of the registration of a trade mark under this Act or under any treaty, convention, arrangement or engagement to which the State is a party.

(2) The Controller shall not have any liability by reason of, or in connection with, any examination required or authorised by this Act, or any such treaty, convention, arrangement or engagement, or any report or other proceedings consequent on such examination.

(3) No proceedings shall lie against an officer of the Controller in respect of any matter for which, by virtue of this section, the Controller is not liable.

Content of Controller's annual report. **75.**—In the report on the execution of the provisions of this Act included in the Controller's annual report, prepared in accordance with section 103 of the Patents Act, 1992, there shall be included a report on the discharge of the Controller's functions in relation to the Madrid Protocol.

Legal Proceedings and Appeals

Registration to be *prima facie* evidence of validity. **76.**—In all legal proceedings relating to a registered trade mark (including proceedings for rectification of the register) the registration of a person as proprietor of a trade mark shall be *prima facie* evidence of the validity of the original registration and of any subsequent assignment or other transmission of it.

Certificate of validity of contested registration. **77.**—(1) If, in proceedings before the Court, the validity of the registration of a trade mark is contested and it is found by the Court that the trade mark is validly registered, the Court may give a certificate to that effect.

(2) If the Court gives such a certificate and in subsequent proceedings—

(a) the validity of the registration is again questioned, and

(b) the proprietor obtains a final order or judgment in the proprietor's favour,

the proprietor shall be entitled to his costs as between solicitor and client unless the Court otherwise directs.

(3) *Subsection (2)* does not extend to the costs of an appeal in any proceedings. Pt.IV S.77

78.—(1) In any proceedings before the Court (including an appeal) which involve or relate to— Controller's appearance in court proceedings.

- (a) the revocation of the registration of a trade mark, or
- (b) a declaration of the invalidity of the registration of a trade mark, or
- (c) the rectification of the register, or
- (d) any other matter in which the relief sought would affect the register,

the Controller shall be entitled to appear and be heard, and shall appear if so directed by the Court.

(2) Unless otherwise directed by the Court, in any proceedings before the Court the Controller may instead of appearing submit to the Court a statement in writing signed by the Controller, giving particulars of—

- (a) any proceedings before the Controller in relation to the matter in issue;
- (b) the grounds of any decision given by the Controller affecting it;
- (c) the practice of the Patents Office in like cases; or
- (d) such matters relevant to the issues and within the Controller's knowledge as the Controller thinks fit;

and the statement shall be deemed to form part of the evidence in the proceedings.

79.—(1) Unless otherwise provided by rules of court, within the period of three months from the date of a decision of the Controller under this Act, an appeal shall lie from the decision to the Court. Appeals from the Controller.

(2) On an appeal under this section—

- (a) the Controller shall be entitled to appear and be heard, and shall appear if so directed by the Court: and
- (b) the Court may exercise any power which could have been exercised by the Controller in the proceedings from which the appeal is brought.

(3) 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 point of law.

80.—In any proceedings before the Courts under this Act, the Controller shall not be awarded or be ordered to pay costs. No award of costs to or against the Controller.

Rules and Fees

Pt.IV
Power of Minister
to make rules.

81.—(1) The Minister may make rules—

- (a) for the purposes of any provision of this Act authorising the making of rules with respect to any matter; and
- (b) for prescribing anything authorised or required by any provision of this Act to be prescribed,

and generally for regulating practice and procedure under this Act.

(2) Without prejudice to the generality of *subsection (1)*, provision may, in particular, be made by rules under this section—

- (a) as to the manner of filing of applications and other documents;
- (b) requiring and regulating the translation of documents and the filing and authentication of any translation;
- (c) as to the service of documents;
- (d) authorising the rectification of irregularities of procedure; and
- (e) prescribing time limits for anything required to be done in connection with any proceeding under this Act, and providing for the extension of any such limit (whether or not it has already expired).

Fees.

82.—(1) There shall be charged by the Controller and paid in respect of applications and registration and other matters 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) Provision may be made by rules to enable the payment of a single fee in respect of two or more matters.

(3) All fees charged by the Controller under this section shall be collected and accounted for in such manner as shall be determined by the Minister with the consent of the Minister for Finance.

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

PART V

TRADE MARK AGENTS

Authorised agent
may act.

83.—(1) Subject to rules made under *section 90*, whenever, under this Act, any act has to be done by or to any person in connection with the registration of a trade mark or any procedure relating to a registered trade mark, the act may be done by or to an agent—

- (a) who is authorised by that person orally or in writing; and
- (b) who is a registered trade mark agent.

(2) A person duly authorised by another person under *subsection (1)* to act as his registered trade mark 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 the other person, cease to act as registered trade mark agent for the other person. Pt.V S.83

84.—The Register which, immediately before the commencement of this section, was known as the Register of Trade Mark Agents shall continue to be known as such and to be maintained by the Controller; and in this Part— Register of Trade Mark Agents.

- (a) “the Register” means the Register of Trade Mark Agents;
- (b) “registered trade mark agent” means a person whose name is entered in the Register; and
- (c) “registration”, in relation to a person who is or has been a registered trade mark agent, means the entry of that person’s name in the Register.

85.—(1) Subject to the provisions of this section, an individual who is not a registered trade mark agent shall not— Business to be carried on only by registered trade mark agents &c.

- (a) carry on a business (otherwise than in partnership) under any name or other description which contains the words “registered trade mark agent”, or
- (b) in the course of a business otherwise describe or hold himself out, or permit himself to be described or held out, as a registered trade mark agent.

(2) A partnership shall not—

- (a) carry on a business under any name or other description which contains the words “registered trade mark agent”, or
- (b) in the course of a business otherwise describe or hold itself out or permit itself to be described or held out, as a firm of registered trade mark agents,

unless all the partners are registered trade mark agents or the partnership satisfies such conditions as may be prescribed for the purposes of this section.

(3) A body corporate shall not—

- (a) carry on a business (otherwise than in partnership) under any name or other description which contains the words “registered trade mark agent”, or
- (b) in the course of a business otherwise describe or hold itself out, or permit itself to be described or held out, as a registered trade mark agent,

unless all the directors of the body corporate and any manager who is not also a director are registered trade mark agents or the body satisfies such conditions as may be prescribed for the purposes of this section.

(4) 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, the Minister may permit any person who is not a registered trade

mark agent but who is a citizen of a state which is also a party to that international agreement, upon application made by that person, to act on behalf of others in relation to trade marks subject to any conditions that the Minister considers appropriate.

(5) The legal personal representative of a deceased registered trade mark agent may carry on the business or practice of the deceased agent for a period not exceeding three years from the agent's death, or for such further period (if any) as the Court allows if the personal representative—

- (a) is authorised by the Court to manage the business or practice; or
- (b) employs another person who is so authorised to manage the business or practice on behalf of the personal representative.

(6) Any person who contravenes any provision of this section shall be liable on summary conviction to a fine not exceeding £500 in the case of a first offence and, in the case of a second or subsequent offence, £1,000; and, notwithstanding section 10 (4) of the Petty Sessions (Ireland) Act, 1851, proceedings for an offence under this section may be commenced at any time within twelve months from the date of the offence.

(7) Nothing in this Act shall be construed as prohibiting solicitors or barristers from taking such part in proceedings under this Act as has heretofore been taken by solicitors or barristers in connection with a trade mark or any procedure relating to a trade mark or the registration thereof.

(8) A registered trade mark agent shall not be guilty of an offence under section 58 of the Solicitors Act, 1954 (which prohibits the preparation for reward of certain instruments by persons not legally qualified), by reason only of the preparation by the agent of—

- (a) a deed assigning the property in a trade mark application or trade mark; or
- (b) any document (not being a deed) for use in proceedings under this Act before the Controller or the Court.

(9) No offence is committed under any enactment restricting the use of certain expressions in reference to any person not qualified to act as a solicitor by use of the term "Community Trade Mark Attorney" in reference to a Registered Trade Mark Agent.

Entitlement to be registered as trade mark agent.

86.—(1) Any person who—

- (a) resides in the State or in such other state as may be prescribed,
- (b) has a place of business in the State,
- (c) possesses the prescribed educational and professional qualifications, and
- (d) complies with the prescribed conditions,

shall be eligible to be a registered trade mark agent and a partnership shall be so eligible if every partner is registered in accordance with

the provisions of this section; and, on application in the prescribed form and manner and on payment of the prescribed fee, a person or partnership so eligible shall be registered. Pr.V S.86

(2) Persons and partnerships whose names were entered in the Register under the Act of 1963 immediately before the commencement of this Act shall continue to be registered trade mark agents.

87.—The Controller may, upon the application of any person who is a registered trade mark agent, remove that person's name from the Register.

Removal from Register.

88.—(1) Where, in the opinion of the Controller, a person who is a registered trade mark agent ceases to be eligible to be registered or has been guilty of conduct disgraceful to that person in the capacity of a registered trade mark agent, the Controller may, after giving that person an opportunity to be heard, decide that the name of that person should be erased from the Register or that, during a period of specified duration, that person's registration should not have effect.

Suspension and erasure of registration of trade mark agent.

(2) On making a decision under *subsection (1)*, the Controller shall forthwith send by post to the person to whom the decision relates (in this section referred to as "the person in default"), at that person's address as stated in the Register, a notice in writing stating the decision, the date thereof and the reason therefor.

(3) On giving notice to the Controller in the prescribed manner, the person in default may, within the period of 21 days beginning on the date of the decision in question, apply to the Court for cancellation of the decision; and, if that person so applies, the Court, on hearing the application, may either—

(a) cancel the decision, or

(b) declare that it was proper for the Controller to make a decision under *subsection (1)* in relation to the person in default and either (as the Court may consider proper)—

(i) direct the Controller to erase the name of the person in default from the Register; or

(ii) direct that, during a specified period (beginning not earlier than 7 days after the decision of the Court), the registration of the person in default shall not have effect.

(4) If at any time the Controller satisfies the Court that the person in default has delayed unduly in proceeding with an application under *subsection (3)*, the Court shall, unless it sees good reason to the contrary, declare that it was proper for the Controller to make a decision under *subsection (1)* in relation to the person in default and either (as the Court may consider proper)—

(a) direct the Controller to erase the name of the person in default from the Register; or

(b) direct that, during a specified period (beginning not earlier than 7 days after the decision of the Court), the registration of the person in default shall not have effect.

Pr. V S.88

(5) Where the person in default does not, within the period of 21 days beginning on the date of the decision in question, 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, declare accordingly and either (as the Court may consider proper)—

(a) direct the Controller to erase the name of the person in default from the Register; or

(b) direct that, during a specified period (beginning not earlier than 7 days after the decision of the Court), the registration of the person in default shall not have effect.

(6) The decision of the Court on an application under *subsection (3)* or *subsection (5)* shall be final, save that, by leave of the Court or the Supreme Court, an appeal by the Controller or the person in default from the decision shall lie to the Supreme Court on a specified question of law.

Notice of erasure or suspension: subsequent restoration.

89.—(1) Upon the erasure of the name of a person from the Register the Controller shall forthwith send by pre-paid post to that person, at that person's address as stated in the Register, notice in writing of the erasure.

(2) Where a decision is made under *section 88* that, during a specified period, a person's registration shall not have effect, the Controller shall, before the commencement of that period, send by pre-paid post to that person, at that person's address as stated in the Register, notice in writing of the decision.

(3) The name of any person which has been erased from the Register may at any time be restored to the Register by direction of the Controller but not otherwise; and, when a person's name 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 the person for registration if that person was being registered for the first time) as the Controller thinks fit.

(4) Where a person's registration has ceased to have effect under *section 88* for a specified period, the Controller may, if he so thinks fit, on application made to him by that person, terminate the suspension.

Rules relating to trade mark agents.

90.—(1) The Minister may make rules for the management of the Register and may, by those rules, prescribe any matter or thing referred to in this section or *section 85* and, in particular, may so prescribe the educational and professional qualifications and the conditions (including conditions relating to nationality or citizenship) for eligibility for registration and the maximum fees which may be charged by any person who is registered for such services in connection with trade marks as may be specified in the rules.

(2) Rules under *subsection (1)* may authorise the Controller to refuse to recognise as agent in respect of any business under this Act any person who does not satisfy the requirements of *section 85*.

(3) Rules under this section may authorise the Controller to refuse to recognise as agent in respect of any business under this Act a

company or firm of which any director, manager or partner (as the case may be) is an individual whom the Controller could refuse to recognise as an agent. Pr.V S.90

91.—(1) This section applies to communications in respect of any matter relating to the protection of a trade mark or in respect of any matter involving passing off. Privileged communications.

(2) Any communication to which this section applies—

- (a) between a person and his registered agent, or
- (b) for the purposes of obtaining or in response to a request for information which a person is seeking for the purpose of instructing his registered agent,

is privileged from disclosure in legal proceedings in the State in the same way as a communication between a person and his solicitor or, as the case may be, a communication for the purpose of obtaining or in response to a request for information which a person seeks for the purpose of instructing his solicitor.

(3) In *subsection (2)* “registered agent” means—

- (a) a registered trade mark agent;
- (b) a partnership entitled to describe itself as a firm of registered trade mark agents; or
- (c) a body corporate entitled to describe itself as a registered trade mark agent.

PART VI

OFFENCES

92.—(1) Subject to the provisions of *subsection (3)*, it shall be an offence for any person— Fraudulent application or use of trade mark in relation to goods.

- (a) to apply a mark identical to or nearly resembling a registered trade mark to goods or to material used or intended to be used for labelling, packaging or advertising goods,
- (b) to sell, let for hire, offer or expose for sale or hire or distribute—
 - (i) goods bearing such a mark, or
 - (ii) material bearing such a mark which is used or intended to be used for labelling, packaging or advertising goods,
- (c) to use material bearing such a mark in the course of a business for labelling, packaging or advertising goods, or
- (d) to possess in the course of a business goods or material bearing such a mark with a view to doing any of the things mentioned in *paragraph (a)* to *(c)*,

when that person is not entitled to use the mark in relation to the goods in question or authorised by a person who is so entitled.

Pt. VI S.92

(2) Subject to the provisions of *subsection (3)*, it shall be an offence for any person to possess in the course of a business goods or material bearing a mark identical to or nearly resembling a registered trade mark with a view to enabling or assisting another person to do any of the things mentioned in *subsection (1) (a), (b) or (c)*, knowing or having reason to believe that the other person is not entitled to use the mark in relation to the goods in question or authorised by a person who is so entitled.

(3) Any person who contravenes the provisions of *subsection (1) or (2)* shall be guilty of an offence if, but only if that person acts with a view to gain, for himself or another, or with intent to cause a loss to another and it shall be a defence for a person charged with an offence under *subsection (1)* to show that he believed, on reasonable grounds, that he was entitled to use the trade mark in relation to the goods in question.

(4) A person who commits an offence under this section shall be liable—

- (a) on summary conviction to imprisonment for a term not exceeding six months or to a fine not exceeding £1,000, or to both;
- (b) on conviction on indictment to imprisonment for a term not exceeding five years or to a fine not exceeding £100,000, or to both.

Falsification of register, &c.

93.—(1) It shall be an offence for a person to make, or cause to be made, an entry in the register which that person knows or has reason to believe to be false.

(2) It shall be an offence for a person—

- (a) to make or cause to be made anything falsely purporting to be a copy of an entry in the register, or
- (b) to produce or tender or cause to be produced or tendered in evidence any such thing,

knowing or having reason to believe that it is false.

(3) A person who commits an offence under this section shall be liable—

- (a) on summary conviction, to imprisonment for a term not exceeding six months or to a fine not exceeding £1,000, or to both,
- (b) on conviction on indictment, to imprisonment for a term not exceeding two years or to a fine not exceeding £200,000, or to both.

Falsely representing trade mark as registered.

94.—(1) It shall be an offence for a person—

- (a) falsely to represent that a mark is a registered trade mark, or
- (b) to make a false representation as to the goods or services for which a trade mark is registered,

knowing or having reason to believe that the representation is false. Pr.VI S.94

(2) For the purposes of this section, the use in the State in relation to a trade mark—

(a) of the word “registered”, or

(b) of any other word or symbol importing a reference (express or implied) to “registration”,

shall be deemed to be a representation as to registration under this Act unless it is shown that the reference is to registration elsewhere than in the State and that the trade mark is in fact so registered for the goods or services in question.

(3) A person guilty of an offence under this section shall be liable on summary conviction to a fine not exceeding £1,000 and, in the case of a continuing offence, to a further fine not exceeding £100, for every day on which the offence continues.

95.—(1) Without prejudice to any liability of a partner under *subsection (3)*, proceedings for an offence under this Act alleged to have been committed by a partnership shall be brought against the partnership in the name of the firm and not in that of the partners. Offences committed by partnerships and bodies corporate.

(2) A fine imposed on a partnership on its conviction in proceedings brought in accordance with *subsection (1)* shall be paid out of the assets of the partnership.

(3) Where a partnership is guilty of an offence under this Act, every partner, other than a partner who is proved to have been ignorant of or to have attempted to prevent the commission of the offence, shall also be guilty of the offence and liable to be proceeded against and punished accordingly.

(4) Where an offence under this Act which is committed by a body corporate is proved to have been committed with the consent or connivance of, or to be attributable to any neglect on the part of, any person who, when the offence was committed, was a director, manager, secretary or other similar officer of the body corporate or a person who was purporting to act in any such capacity, that person (as well as the body corporate) shall be guilty of an offence and liable to be proceeded against and punished as if guilty of the offence committed by the body corporate.

PART VII

MISCELLANEOUS AND GENERAL

96.—Without prejudice to the powers conferred by this Act upon the Court, proceedings for an order under *section 20* or *section 23* may be brought in the Circuit Court in the county in which the infringing goods, material or articles are situated or in the county in which resides any person having those goods, material or articles in his possession, custody or control. Jurisdiction of the Circuit Court.

97.—(1) A person shall not, without the authority of the Minister, use in connection with any business the State emblems of Ireland notified under Article 6ter of the Paris Convention or emblems so closely resembling the State emblems as to be calculated to deceive Unauthorised use of State emblems of Ireland.

Pt.VII S.97

in such a manner as to be calculated to lead to the belief that that person is duly authorised to use the State emblems.

(2) A person who contravenes the provisions of *subsection (1)* shall be guilty of an offence and shall be liable on summary conviction to a fine not exceeding £1,000 and, in the case of a continuing offence, to a further fine not exceeding £100 for every day the offence continues.

(3) The Minister may apply to the Court for an injunction to restrain any person from contravening the provisions of *subsection (1)*.

(4) Nothing in this section shall affect any right of the proprietor of a registered trade mark containing any such emblem to use that trade mark.

(5) In any proceedings to restrain any action prohibited under *subsection (1)* or any prosecution under *subsection (2)* a certificate purporting to be signed by the Controller that the emblem is a State emblem shall be sufficient evidence of its contents unless the contrary is proved.

Misuse of trade marks indicative of Irish origin.

98.—The Minister may 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 that trade mark, mark or description is used or applied were grown, produced or manufactured in the State.

Burden of proving use of trade mark.

99.—Where, in any civil proceedings under this Act, an issue arises as to the use made by any person of any registered trade mark, the onus of proving such use shall lie with the proprietor.

Transitional provisions.

100.—The provisions of the *Third Schedule* shall have effect with respect to transitional matters, including the treatment of trade marks registered under the Act of 1963, and applications for registration and other proceedings pending under that Act, on the commencement of this Act.

Territorial waters and continental shelf.

101.—For the avoidance of doubt, it is hereby declared that this Act applies to the following waters, namely, the waters in the portion of the sea which comprises the territorial seas of the State, the waters in all areas of the sea to which the internal or inland waters of the State are extended by section 5 of the Maritime Jurisdiction Act, 1959 and the waters in any area which is for the time being a designated area within the meaning of section 1 of the Continental Shelf Act, 1968.

Amendment and adaptation of existing statutes.

102.—(1) In any enactment passed before, and in any provision made under any enactment before, the commencement of this Act, any reference to trade marks or registered trade marks, within the meaning of the Act of 1963, shall, unless the context otherwise

requires, be construed after the commencement of this Act as a reference to trade marks or registered trade marks, within the meaning of this Act. Pt.VII S.102

(2) In section 24 of the Consumer Information Act, 1978—

- (a) for the words “the Trade Marks Act, 1963”, in each place where they occur except in paragraph (c), there shall be substituted “the *Trade Marks Act, 1996*”; and
- (b) in paragraph (c) for the words “a person registered under section 36 of the Trade Marks Act, 1963 as a registered user of a trade mark” there shall be substituted “in the case of a registered trade mark, a person licensed to use it”.

FIRST SCHEDULE

Section 54.

COLLECTIVE MARKS

General

1. The provisions of this Act shall apply in relation to collective marks subject to the following provisions of this Schedule.

Signs of which a collective mark may consist

2. In relation to a collective mark, the reference in *section 6 (1)* to distinguishing goods or services of one undertaking from those of other undertakings shall be construed as a reference to distinguishing goods or services of members of the association which is the proprietor of the mark from those of other undertakings.

Indication of geographical origin

3. (1) Notwithstanding the provisions of *section 8 (1) (c)*, a collective mark may be registered which consists of signs or indications which may serve, in trade, to designate the geographical origin of the goods or service.

(2) However, the proprietor of a mark referred to in *subparagraph (1)* shall not be entitled to prohibit the use of the signs or indications in accordance with honest practices in industrial or commercial matters (in particular, in the case of a person who is entitled to use a geographical name).

Mark not to be misleading as to character or significance

4. (1) A collective mark shall not be registered if the public is liable to be misled as regards the character or significance of the mark, in particular, if it is likely to be taken to be something other than a collective mark.

(2) The Controller may, accordingly, require that a mark in respect of which an application is made for registration as a collective mark shall comprise some indication that it is a collective mark, and, notwithstanding *section 44 (3)*, an application may be amended so as to comply with any such requirement.

Regulations governing use of collective mark

SCH.1

5. (1) An applicant for registration of a collective mark shall file with the Controller regulations governing the use of the mark.

(2) The regulations shall specify the persons authorised to use the mark, the conditions of membership of the association and, where they exist, the conditions of use of the mark, including any sanctions against misuse of the mark.

(3) Provision may be made by rules for further matters in respect of which regulations are required.

Approval of regulations by Controller

6. (1) A collective mark shall not be registered unless the regulations governing the use of the mark—

(a) comply with *paragraph 5 (2)* and any further requirements imposed by rules; and

(b) are not contrary to public policy or to accepted principles of morality.

(2) Before the end of the prescribed period after the date of the application for registration of a collective mark, the applicant must file the regulations with the Controller and pay the prescribed fee; and if the applicant does not do so, the application shall be deemed to be withdrawn.

7. (1) If it appears to the Controller that the requirements (other than those specified in *paragraph 6*) for registration have been met, the Controller shall consider the matters specified in *paragraph 6 (1)* and may—

(a) accept the application;

(b) accept it subject to conditions (including amendment of the regulations or otherwise); or

(c) refuse to accept it.

(2) Where the Controller accepts an application subject to specified conditions, and those conditions are complied with within the prescribed period, the Controller shall proceed with the publication in the Journal in accordance with *section 43*.

(3) Where the Controller accepts an application subject to specified conditions and those conditions are not complied with within the prescribed period, the application shall be deemed to be withdrawn.

8. (1) The regulations governing the use of the mark shall be open to public inspection and notice of opposition may be given, and observations may be made, relating to the matters specified in *paragraph 6 (1)*.

(2) The provisions of this paragraph are in addition to any other grounds on which an application may be opposed or observations made.

Regulations to be open to inspection

9. The regulations governing the use of a registered collective mark shall, in like manner as the register, be open to public inspection. SCH.1

Amendment of regulations

10. Where the regulations governing the use of a registered collective mark are amended, the regulations, as amended, shall not be effective unless and until the amended regulations are filed with and accepted by the Controller.

Infringement proceedings: rights of authorised users

11. (1) Subject to any agreement to the contrary between an authorised user and the proprietor, the provisions of this paragraph shall have effect in relation to the infringement of a registered collective mark.

(2) An authorised user shall be entitled to call on the proprietor to take infringement proceedings in respect of any matter which affects the authorised user's interests.

(3) Where the proprietor refuses or fails to take infringement proceedings in accordance with *subparagraph (2)* within two months after being called upon to do so, the authorised user may bring the proceedings in the authorised user's name as if the authorised user were the proprietor.

(4) Where the infringement proceedings are brought by virtue of *subparagraph (3)*—

(a) the authorised user may not, without the leave of the Court, proceed with the action unless the proprietor is either joined as a plaintiff or added as a defendant; and

(b) a proprietor who is so added as a defendant shall not be liable for any costs in the action unless he takes part in the proceedings.

(5) Nothing in *subparagraph (4)* shall affect the granting of interlocutory relief on an application by an authorised user alone.

(6) In the course of infringement proceedings brought by the proprietor of a registered collective mark, any loss suffered or likely to be suffered by authorised users shall be taken into account by the Court; and the Court may give such directions as it thinks fit regarding the extent to which the plaintiff shall hold the proceeds of any pecuniary remedy on behalf of such users.

Grounds for revocation of registration

12. Apart from the grounds of revocation provided for in *section 51*, the registration of a collective mark may be revoked on the ground that—

(a) the manner in which the mark has been used by the proprietor has made it misleading to the public in the manner referred to in *paragraph 4 (1)*; or

SCH.1

- (b) the proprietor has failed to observe, or to secure the observance of the regulations governing the use of the mark; or
- (c) an amendment of the regulations has been made so that the regulations—
 - (i) no longer comply with *paragraph 5 (2)* and any further conditions imposed by rules; or
 - (ii) are contrary to public policy or to accepted principles of morality.

Grounds for invalidity of registration

13. Apart from the grounds of invalidity provided for in *section 52*, the registration of a collective mark may be declared invalid on the ground that the mark was registered contrary to the provisions of *paragraph 4 (1)* or *6 (1)*.

Section 55.

SECOND SCHEDULE

CERTIFICATION MARKS

General

1. The provisions of this Act shall apply in relation to certification marks subject to the following provisions of this Schedule.

Signs of which a certification mark may consist

2. In relation to a certification mark, the reference in *section 6 (1)* to distinguishing goods or services of one undertaking from those of other undertakings shall be construed as a reference to distinguishing goods or services which are certified from those which are not certified.

Indication of geographical origin

3. Notwithstanding the provisions of *section 8 (1) (c)*, a certification mark may be registered which consists of signs or indications which may serve, in trade, to designate the geographical origin of the goods or services:

Provided that the proprietor of such a mark shall not be entitled to restrain the use of the signs or indications in accordance with honest practices in industrial or commercial matters, in particular, by a person who is entitled to use a geographical name.

Nature of proprietor's business

4. A certification mark shall not be registered if the proprietor carries on a business involving the supply of goods or services of the kind certified.

Mark not to be misleading as to character or significance

5. (1) A certification mark shall not be registered if the public is liable to be misled as regards the character or significance of the mark, in particular, if it is likely to be taken to be something other than a certification mark. SCH.2

(2) The Controller may, accordingly, require that a mark in respect of which an application is made for registration as a certification mark shall comprise some indication that it is a certification mark; and notwithstanding *section 44 (3)*, an application may be amended so as to comply with any such requirement.

Regulations governing use of certification mark

6. (1) An applicant for registration of a certification mark shall file with the Controller regulations governing the use of the mark.

(2) The regulations shall indicate who is authorised to use the mark, the characteristics to be certified by the mark, how the certifying body is to test those characteristics and to supervise the use of the mark, the fees (if any) to be paid in connection with the operation of the mark and the procedures for resolving disputes.

(3) Provision may be made by rules for further matters in respect of which regulations are required.

Approval of regulations, &c. by Minister

7. (1) A certification mark shall not be registered unless the Minister is satisfied that—

(a) the regulations governing the use of the mark—

(i) comply with *paragraph 6 (2)* and any further requirements imposed by rules; and

(ii) are not contrary to public policy or to accepted principles of morality; and

(b) the applicant is competent to certify the goods or services for which the mark is to be registered.

(2) If it appears to the Controller that the requirements for registration other than those in *subparagraph (1)* are met, the Controller shall authorise the applicant to proceed with the application.

(3) Within the prescribed period of authorisation to proceed, the applicant must file the regulations (if this has not already been done) and pay the prescribed fee, failing which, the application shall be deemed to be withdrawn.

8. (1) The Minister shall consider the matters mentioned in *paragraph 7 (1)* and may direct that the application for registration be accepted, be accepted subject to conditions (as to amendment of the regulations or otherwise), or be not accepted.

(2) Where the Minister directs that the application be accepted, and any conditions are complied with within the prescribed period, the Controller shall proceed in accordance with *section 43*.

SCH.2

(3) Where the Minister directs that an application be accepted subject to specified conditions and those conditions are not complied with within the prescribed period, the application shall be deemed to be withdrawn.

9. The regulations shall be published and notice of opposition may be given, and observations may be made, relating to the matters mentioned in *paragraph 7 (1)*, in addition to any other grounds on which an application may be opposed or observations made.

Regulations to be open to inspection

10. The regulations governing the use of a registered certification mark shall, in like manner as the register, be open to public inspection.

Amendment of regulations

11. (1) An amendment of the regulations governing the use of a registered certification mark shall not be effective unless and until the Minister consents to the amendment and the amended regulations are filed with the Controller.

(2) The Minister may cause an application for consent under *subparagraph (1)* to be published in any case where it appears expedient to do so.

(3) Any person may, within the prescribed time from the date of the publication of the application, give notice to the Minister of opposition to the application and any such notice shall be given in writing in the prescribed manner and shall include a statement of the grounds of opposition.

(4) After the Minister has consented to such an amendment as is mentioned in *subparagraph (1)*, the Controller shall publish notice in the Journal when the amended regulations are filed with him.

Consent to assignment of registered certification mark

12. The assignment or other transmission of a registered certification mark shall not be effective without the consent of the Minister.

Infringement proceedings: rights of authorised users

13. (1) Subject to any agreement to the contrary between an authorised user and the proprietor, the provisions of this paragraph shall have effect in relation to the infringement of a registered certification mark.

(2) An authorised user shall be entitled to call on the proprietor to take infringement proceedings in respect of any matter which affects the authorised user's interests.

(3) Where the proprietor refuses or fails to take infringement proceedings in accordance with *subparagraph (2)* within two months after being called upon to do so, the authorised user may bring the proceedings in the authorised user's own name as if the authorised user were the proprietor.

(4) Where infringement proceedings are brought by virtue of *sub-paragraph (3)*— SCH.2

(a) the authorised user may not, without the leave of the Court, proceed with the action unless the proprietor is either joined as a plaintiff or added as a defendant; and

(b) a proprietor who is so added as a defendant shall not be liable for any costs in the action unless the proprietor takes part in the proceedings.

(5) Nothing in *subparagraph (4)* shall affect the granting of interlocutory relief on an application by an authorised user alone.

(6) In the course of infringement proceedings brought by the proprietor of a registered certification mark, any loss suffered or likely to be suffered by authorised users shall be taken into account by the Court; and the Court may give such directions as it thinks fit regarding the extent to which the plaintiff shall hold the proceeds of any pecuniary remedy on behalf of such users.

Grounds for revocation of registration

14. (1) Apart from the grounds of revocation provided for in *section 51*, the registration of a certification mark may be revoked on the ground that—

(a) the proprietor has begun to carry on such a business as is mentioned in *paragraph 4*; or

(b) the manner in which the mark has been used by the proprietor has made it misleading to the public in the manner referred to in *paragraph 5 (1)*; or

(c) the proprietor has failed to observe, or to secure the observance of, the regulations governing the use of the mark; or

(d) an amendment of the regulations has been made so that the regulations—

(i) no longer comply with *paragraph 6 (2)* and any further conditions imposed by rules; or

(ii) are contrary to public policy or to accepted principles of morality; or

(e) the proprietor is no longer competent to certify the goods or services for which the mark is registered.

(2) An application for revocation on the ground mentioned in *subparagraph (1) (c), (d) or (e)* shall be made to the Minister.

(3) For the purposes of this paragraph the reference in *section 51 (6)* to the Controller or the Court shall be construed as a reference to the Minister.

Grounds for invalidity of registration

15. (1) Apart from the grounds of invalidity provided for in *section 52*, the registration of a certification mark may be declared invalid on the ground that the mark was registered contrary to the provisions of *paragraph 4, 5 (1) or 7 (1)*.

SCH.2

(2) An application for a declaration of invalidity on the ground that the registration was made contrary to the provisions of *paragraph 7 (1)* shall be made to the Minister.

General provisions as to functions of Minister

16. (1) The provisions of *sections 69 to 74* shall apply in relation to the Minister and the Minister's functions under this Schedule as they apply in relation to the Controller and the Controller's functions.

(2) *Section 79* shall apply in relation to a decision of the Minister under this Schedule as they apply in relation to a decision of the Controller.

(3) The Minister may, for the purpose of discharging any of his functions under this Schedule, refer any matter to a body or person appearing to the Minister to have experience of matters of that description, and may take their report or advice into account in reaching his decision.

Section 100.

THIRD SCHEDULE

TRANSITIONAL PROVISIONS

Introductory

1. (1) In this Schedule—

“commencement” means the commencement of this Act;

“existing registered mark” means a trade mark or certification trade mark, within the meaning of the Act of 1963, registered under that Act immediately before commencement;

“the former register” means the register of trade marks kept under the Act of 1963;

“the old law” means the Act of 1963 and any other enactment or rule of law applying to existing registered marks immediately before commencement;

“the new register” means the Register of Trade Marks kept under this Act.

(2) For the purposes of this Schedule an application shall be treated as pending at commencement if it was made but not finally determined before commencement.

Existing registered marks

2. (1) Existing registered marks (whether registered in Part A or Part B of the former register) shall, on commencement, be deemed to be transferred to the new register and shall have effect, subject to the provisions of this Schedule, as if registered under this Act.

(2) *Subparagraph (1)* shall apply to all entries relating to existing registered marks as it applies to the marks themselves.

(3) Entries indicating that existing registered marks are associated with other marks shall cease to have effect on commencement.

(4) A condition entered on the former register in relation to an existing registered mark immediately before commencement shall cease to have effect on commencement; and proceedings under section 41 of the Act of 1963 (application to expunge or vary registration for breach of condition) which are pending at commencement shall be dealt with under the old law (with any necessary alteration being made in the new register).

SCH.3

(5) A disclaimer or limitation entered on the former register in relation to an existing registered mark and in force immediately before commencement shall be deemed to be transferred to the new register and have effect as if entered on the new register in pursuance of *section 17*.

Effects of registration: infringement

3. (1) *Sections 13 to 16* (effects of registration) apply in relation to an existing registered mark as from commencement and *section 18* (action for infringement) applies in relation to infringement of an existing registered mark after commencement, subject to *subparagraph (3)*.

(2) Without prejudice to the operation of the Interpretation Act, 1937, the old law shall continue to apply in relation to infringements committed before commencement.

(3) It shall not be an infringement of —

(a) an existing registered mark, or

(b) a registered trade mark of which the distinctive elements are the same or substantially the same as those of an existing registered mark and which is registered for the same goods or services,

to continue after commencement any use which did not amount to infringement of the existing registered mark under the old law.

Infringing goods, material or articles

4. *Section 20* (order for delivery up of infringing goods, material or articles) shall apply to infringing goods, material or articles made before, as well as after, commencement.

Rights and remedies of licensee or authorised user

5. (1) *Section 34* (general provisions as to rights of licensees in case of infringement) shall apply to licences granted before commencement, but only as regards infringements committed after commencement.

(2) *Paragraph 13 (6)* of the *Second Schedule* shall apply only in relation to infringements committed after commencement.

Assignment &c. of registered trade marks

6. (1) *Section 28* (assignment or other transmission of registered mark) shall apply only in relation to transactions and events occurring after commencement in relation to an existing registered mark;

and the old law shall continue to apply in relation to transactions and events occurring before commencement.

(2) An application for registration under section 33 of the Act of 1963 (registration of assignments and transmissions) which is pending at commencement shall be treated as an application for registration under *section 29* and shall proceed accordingly, except that the Controller may require the applicant to amend the application so as to conform with the requirements of this Act.

(3) An application for registration under section 33 of the Act of 1963 which has been determined by the Controller but not finally determined before commencement shall be dealt with under the old law.

(4) Where, before commencement, a person became entitled by assignment or transmission to an existing registered mark but did not make an application to register his title, any application for registration after commencement shall be made under *section 29*.

(5) Any entry falling to be made in the old register as a result of *subparagraph (3)* shall be treated for the purposes of *paragraph 2* as an entry relating to an existing registered mark.

Licensing of registered mark

7. (1) *Sections 32 and 33 (2)* (licensing of registered trade mark: rights of exclusive licensee against grantor's successor in title) shall apply only in relation to licences granted after commencement; and the old law shall continue to apply in relation to licences granted before commencement.

(2) Existing entries under section 36 of the Act of 1963 (registered users) shall be deemed to be transferred on commencement to the new register and shall have effect as if made under *section 29*.

(3) An application for registration as a registered user which is pending at commencement shall be treated as an application for registration of a licence under *section 29 (1)* and shall proceed accordingly, except that the Controller may require an applicant to amend the application so as to conform with the requirements of this Act.

(4) An application for registration as a registered user which has been determined by the Controller but not finally determined before commencement shall be dealt with under the old law, and any entry falling to be made in the old register as a result of this subparagraph shall be treated for the purposes of *paragraph 2* as an entry relating to an existing registered mark.

(5) Any proceedings pending on commencement under section 36 (7) or (9) of the Act of 1963 (variation or cancellation of registration of registered user) shall be dealt with under the old law (with any necessary alteration being made to the new register).

Pending applications for registration

8. (1) The provisions of this paragraph apply where an application for registration of a trade mark, within the meaning of the Act of 1963, is pending at commencement.

(2) Subject to *paragraph 9*, the application shall be dealt with (and the registrability of the mark shall be determined) in accordance with the old law and any mark which, on that determination, falls to be registered shall be treated for the purpose of this Schedule as an existing registered mark. SCH.3

(3) Provision may be made by rules to enable pending applications for registration to continue in accordance with the procedural provisions of this Act.

Conversion of pending application

9. (1) This paragraph applies if an application which was pending at commencement has not been advertised under section 26 of the Act of 1963.

(2) If, in case where *subparagraph (1)* applies, the applicant gives notice to the Controller requesting that the registrability of the mark be determined in accordance with the provisions of this Act, the Controller shall deal with the application accordingly.

(3) Notice under *subparagraph (2)* shall be in the prescribed form, shall be accompanied by the appropriate fee and shall be given no later than six months after commencement.

(4) Notice given under *subparagraph (2)* shall be irrevocable and the application to which the notice relates shall be treated as if it were made at commencement and as if the date of filing were the date of commencement.

Duration and renewal of registration

10. (1) *Section 47 (1)* (duration of original period of registration) applies in any case where the registrability of a trade mark is determined in accordance with the provisions of this Act; and the old law applies in any other case.

(2) *Sections 47 (2) and 48* (renewal of registration) apply when the renewal falls due at or after commencement; and the old law applies in any other case.

(3) For the purposes of this paragraph it is immaterial when the application is made or when the fee is paid.

Revocation for non-use

11. (1) An application under section 34 of the Act of 1963 (removal from register or imposition of limitation on ground of non-use) which is pending at commencement shall be dealt with under the old law (with any necessary alteration being made to the new register).

(2) Subject to *subparagraph (3)*, an application under *section 51 (4)* on the grounds specified in *section 51 (1) (a) or (b)* (revocation for non-use) may be made in relation to an existing registered mark at any time after commencement.

(3) No application for the revocation of the registration of an existing registered mark which was registered by virtue of section 35 of

the Act of 1963 (defensive registration of well-known trade marks) may be made under *section 51* until more than five years after commencement.

Application for rectification &c.

12. An application under section 40 or 42 of the Act of 1963 (rectification or correction of the register) which is pending at commencement shall be dealt with under the old law (with any necessary alteration being made to the new register).

Validity of existing registered marks

13. The old law shall continue to apply as regards the validity of the registration of an existing registered mark; and no objection to the validity of such a registration may be taken on the ground of failure to satisfy the requirements of this Act.

Certification marks

14. (1) If, at commencement, a request is pending for the amendment of the regulations governing the use of an existing certification mark, that request shall be dealt with under the old law.

(2) In *subparagraph (1)* “existing certification mark” means a certification trade mark registered under the Act of 1963 immediately before commencement.

Pre-commencement applications in respect of trade marks for services.

15. (1) If, at any time between 1st January, 1993 and commencement, an application was made to the Controller for the registration of a trade mark in respect of services, this Act shall have effect, subject to *subparagraph (2)*, as if—

- (a) the application were made at commencement; and
- (b) the date of filing were the date of commencement;

and the Controller shall deal with the application accordingly.

(2) Section 20 (3) of the Act of 1963 (separate applications for registration of identical trade marks in respect of goods, etc.) shall apply in relation to applications falling within *subparagraph (1)*—

- (a) with the substitution of a reference to services for the reference to goods or a description of goods; and
- (b) with the omission of the proviso.

ACTS REFERRED TO

Copyright Act, 1963	1963, No. 10
Consumer Information Act, 1978	1978, No. 1
Continental Shelf Act, 1968	1968, No. 14
Interpretation Act, 1937	1937, No. 38
Maritime Jurisdiction Act, 1959	1959, No. 22
Partnership Act, 1890	53 & 54 Vict., c. 39
Patents Act, 1992	1992, No. 1
Petty Sessions (Ireland) Act, 1851	14 & 15 Vict., c. 93
Public Offices Fees Act, 1879	42 & 43 Vict., c. 58
Solicitors Act, 1954	1954, No. 36
Statute of Limitations, 1957	1957, No. 6
Trade Marks Act, 1963	1963, No. 9