

STATUTORY INSTRUMENTS.

S.I. No. 229 of 2000.

TRADE MARKS ACT, 1996 (COMMUNITY TRADE MARK) REGULATIONS, 2000.

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I, TOM KITT, Minister of State at the Department of Enterprise, Trade and Employment, in exercise of the powers conferred on me by sections 57, 66, 81 and 82 of the Trade Marks Act, 1996 (No. 6 of 1996) (as adapted by the Enterprise and Employment (Alteration of Name of Department and Title of Minister) Order, 1997 (S.I. No. 305 of 1997), and the Enterprise, Trade and Employment (Delegation of Ministerial Functions) (No. 2) Order, 1997 (S.I. No. 330 of 1997)), and, in so far as the following regulations are made under the said section 82, with the sanction of the Minister for Finance, and a resolution approving a draft of these regulations having been passed by both Houses of the Oireachtas in accordance with section 3(3) of the said Act, hereby make the following regulations:

Citation and Commencement.

1. (1) These Regulations may be cited as the Trade Marks Act, 1996 (Community Trade Mark) Regulations, 2000.

(2) These Regulations shall come into operation on the 20th day of July 2000.

Interpretation.

2. (1) In these Regulations—

“Act of 1996” means the Trade Marks Act, 1996 (No. 6 of 1996) , and a reference to a section is a reference to a section of that Act, unless it is indicated that reference to some other enactment is intended;

“Community Trade Mark Regulation” means Council Regulation (EC) No. 40/94 of 20 December 1993 on the Community trade mark⁽¹⁾ ;

“Community Trade Mark Rules” means Commission Regulation (EC) No. 2868/95 of 13 December 1995 implementing Council Regulation (EC) No. 40/94 on the Community trade mark⁽²⁾ .

“Rules” means the Trade Marks Rules, 1996 (S.I. No. 199 of 1996), and a reference to a rule shall be construed as a reference to a rule of those Rules unless the context otherwise requires.

(2) A word or expression that is used in these Regulations and is also used in the Rules has, unless the contrary intention appears, the same meaning in these Regulations as it has in the Rules.

(3) In these Regulations a reference to a Regulation, paragraph or subparagraph is a reference to a Regulation, paragraph or subparagraph of the provision in which the reference occurs unless it is indicated that reference to some other provision is intended.

Notification to the Controller of seniority.

3. Where the Controller receives a notification under Rule 28(3) of the Community Trade Mark Rules pursuant to Article 34 or 35 of the Community Trade Mark Regulation of a seniority claim based on an earlier registered trade mark, the Controller shall note the said seniority claim and such claim is hereby prescribed as a matter to be entered in the register.

Determination *a posteriori* of invalidity and liability to revocation.

4. (1) Where the proprietor of a Community trade mark claims the seniority of a registered trade mark which has been removed from the register under section 48 or has been surrendered under section 50 after registration of the Community trade mark, application may be made to the Controller or to the Court by any person for a declaration that, if the registered trade mark had not been so removed or surrendered, it would have been liable to be revoked pursuant to section 51 or deemed invalid pursuant to section 52, and the Controller or the Court may grant such a declaration accordingly.

(2) Where a declaration is made pursuant to paragraph (1) the registered trade mark shall be deemed to have been revoked pursuant to section 51 or invalidated pursuant to section 52, as the case may be, and the Controller shall notify the Office for Harmonisation in the Internal Market of any such declaration made.

(3) Where a registered trade mark has been surrendered only in respect of some of the goods and services for which it is registered, paragraph (1) shall apply only in relation to such goods and services.

(4) The provisions of section 51 or, as the case may be, section 52, and sections 76, 78 and 79 shall apply, with necessary modifications, in relation to an application to which paragraph (1) applies.

Privilege for communication with professional representatives.

5. A professional representative, within the meaning of Article 89 of the Community Trade Mark Regulation, whose name appears on the list maintained pursuant to that

Article shall be deemed, for the purpose of a conversion application, to be a registered agent for the purposes of section 91.

Power of seizure and search concerning infringements of Community trade mark.

6. For the purposes of section 25—

- (a) the reference in that section to a registered trade mark shall be construed as including a reference to a Community trade mark, and
- (b) section 21(2) (definition of infringing goods) shall apply as if references to a registered trade mark in that section included a reference to a Community trade mark.

Designation of Community trade mark courts.

7. For the purposes of the Community Trade Mark Regulation—

- (a) the High Court is hereby designated as a Community trade mark court of first instance, and
- (b) the Supreme Court is hereby designated as a Community trade mark court of second instance.

Conversion applications.

8. (1) Where the Controller decides that a request for conversion of a Community trade mark application or of a Community trade mark into a national trade mark application pursuant to Article 108 is admissible (in this Regulation referred to as a “preliminary decision”), the request shall, subject to Article 110 of the Community Trade Mark Regulation, be treated as an application for registration of a trade mark under the Act of 1996.

(2) The fees prescribed by the Rules in respect of an application under the Act of 1996 shall be payable in respect of a request to which paragraph (1) applies where the preliminary decision is to the effect that the request is admissible.

(3) Where the Controller has made a preliminary decision that the request is admissible he or she shall notify the applicant or holder in writing to that effect, and such notification shall also:

- (a) request payment of the fees referred to in paragraph (2), and
- (b) request one or more of the following to be forwarded to him or her, namely—
 - (i) a translation in the English language of the request and of the documentation accompanying it;

(ii) a representation of the trade mark,

and

(iii) if not already indicated in the application, an address for service in the State.

(4) The fees referred to in paragraph (3)(a) and the matters specified in paragraph (3)(b) shall be furnished to the Controller within three months of the giving of the notification by the Controller.

(5) Where the fees referred to in paragraph 3(a) or any of the items specified in paragraph 3(b) are not furnished to the Controller within the period referred to in paragraph (4), the Controller may refuse the application.

(6) The provisions of Rule 9 of the Rules shall apply to the translation referred to in paragraph (3)(b)(i).

Pending conversion applications.

9. (1) The fees prescribed by the Rules in respect of an application under the Act of 1996 shall be payable in respect of a request to which paragraph (2) applies.

(2) Where, on the commencement of these Regulations, a request for the conversion of a Community trade mark application or of a Community trade mark into a national trade mark application pursuant to Article 108 had been received by the Patents Office, and the request was still pending at such date, the Controller shall, as soon as practicable after such commencement, decide whether the request is admissible and, where so admissible, the request shall, subject to Article 110, be treated as an application for registration of a trade mark under the Act of 1996, and the Controller shall notify the applicant or holder, in writing, of the making of these Regulations, and such notification shall also—

(a) request payment of the fees referred to in paragraph (1), and

(b) request one or more of the following to be forwarded to him or her, namely—

(i) a translation in the English language of the request and of the documentation accompanying it,

(ii) a representation of the trade mark,

and

(iii) if not already indicated in the application, an address for service in the State.

(3) The fees referred to in paragraph (2)(a) and the matters specified in paragraph (2)(b) shall be furnished to the Controller within three months of the giving of the notification by the Controller.

(4) Where the fees referred to in paragraph 2(a) or any of the items specified in paragraph 2(b) are not furnished to the Controller within the period referred to in paragraph (3), the Controller may refuse the application.

(5) The provisions of Rule 9 of the Rules shall apply to the translation referred to in paragraph (2)(b)(i).

Provision relating to certain conversion applications.

10. Where an application for a Community trade mark—

(a) is filed on 1st April 1996, or

(b) is deemed to have been filed on that day by virtue of Article 143(4) of the Community Trade Mark Regulation, or

(c) is filed within 3 months after that date, it shall, subject to Regulation 11, maintain its filing date, and shall, for the purposes of conversion of that application into a national application, be treated as having been filed on 1st April 1996 in a case to which paragraph (a) or (b) applies and shall be considered by the Patents Office on the same basis as if it were an application which had been filed in the Patents Office after the commencement of the Act of 1996.

Priority and Seniority of conversion applications.

11. A trade mark application resulting from the conversion of a Community trade mark application or Community trade mark shall maintain the date of priority of the said Community trade mark application or said Community trade mark and, where appropriate, the seniority of an earlier registered trade mark claimed under Article 34 or 35 of the Community Trade Mark Regulation.

Designation of central industrial property office in the State.

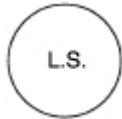
12. The Patents Office is hereby designated as the central industrial property office in the State for the purposes of Articles 109 and 110 of the Community Trade Mark Regulation.

Amendment of Trade Marks Rules, 1996.

13. The Rules are hereby amended by the substitution—

- (a) in Rule 19(1) of “Within three months of the issue by the Controller to the applicant” for “Within three months of receipt by the applicant”,
- (b) in Rule 20(1) of “Within three months of the issue by the Controller to the opponent” for “Within three months of receipt by the opponent”, and
- (c) in Rule 41(3) of “Within three months of the issue by the Controller to the proprietor” for “Within three months of receipt by the proprietor”.

The fees prescribed by these Regulations are sanctioned by the Minister for Finance.



GIVEN under my Official Seal, this 18th day of July, 2000.

CHARLIE McCREEVY,
Minister for Finance.

GIVEN under my hand, 14th July, 2000.

TOM KITT,
Minister of State at the Department of Enterprise, Trade and
Employment.

EXPLANATORY NOTE.

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

The Office for Harmonisation in the Internal Market (OHIM), based in Alicante, Spain, is primarily engaged in the registration of Community trade marks which are valid in all EU Member States. The Community trade mark system was introduced in April 1996. It co-exists with nationally registered trade marks. Having regard to the co-existence of Community trade marks and national trade marks, these Regulations introduce certain technical provisions.

Under Community trade mark law a Community trade mark may claim the seniority of an earlier trade mark that has been registered in the State. Where seniority has been claimed OHIM notifies the Patents Office. These Regulations provide that the Controller of Patents, Designs and Trade Marks shall record this seniority claim in the register.

Seniority is maintained even after the earlier registered trade mark is removed under section 48 of the Trade Marks Act, 1996 or surrendered under section 50 of the same Act by the proprietor. In order to allow any person to challenge the seniority of a Community trade mark, these Regulations provide that applications for revocation or invalidity of registered trade marks may be made *a posteriori* — i.e., after the registered marks are removed under section 48 or surrendered under section 50.

For the purpose of conversion applications the existing statutory rights of privileged communications between a person and his/her registered trade mark agent will be extended to a professional representative with respect to Community trade marks.

The Regulations extend the provisions of section 25 of the Trade Marks Act, 1996 (which deals with infringing goods, materials or articles and the power of seizure and search in relation to such goods etc) to cover a Community trade mark as well as a registered trade mark.

The Regulations designate the High Court as a Community trade mark court of first instance and the Supreme Court as a Community trade mark court of second instance.

Where the Controller decides that the conversion of a Community trade mark or Community trade mark application is admissible, it will be treated as a national trade mark application.

The Patents Office is designated as the central industrial property office in the State for the purposes of Articles 109 and 110 of the Community Trade Mark Regulations.

Certain time limits in the Trade Mark Rules (S.I. No. 199 of 1996) are amended in order to ensure that there is consistency in the methods of determining time limits.

⁽¹⁾ O.J. No. L11, 14.1.94, p.1.

⁽²⁾ O.J. No. L303, 15.12.95, p.1.
