



STATUTORY INSTRUMENTS.

S.I. No. 561 of 2018



EUROPEAN UNION (TRADE MARKS) REGULATIONS 2018

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I, HEATHER HUMPHREYS, Minister for Business, Enterprise and Innovation, in exercise of the powers conferred on me by section 3 of the European Communities Act 1972 (No. 27 of 1972) and for the purpose of giving effect to Directive (EU) 2015/2436 of the European Parliament and of the Council of 16 December 2015¹ to approximate the laws of the Member States relating to trade marks (Recast) and Regulation (EC) 2017/1001 of the European Parliament and of the Council of 14 June 2017² on the European Union Trade Mark, hereby make the following regulations:

1. (1) These Regulations may be cited as the European Union (Trade Marks) Regulations 2018.

(2) These Regulations shall come into operation on 14 January 2019.

2. In these Regulations, “Act of 1996” means the Trade Marks Act 1996 (No. 6 of 1996).

3. Section 2 of the Act of 1996 is amended—

(a) in subsection (1)—

(i) by the insertion of the following definitions:

“ ‘Directive’ has the meaning assigned by section 56;

‘European Union trade mark’ has the meaning assigned by section 56;

‘European Union Trade Mark Regulation’ has the meaning assigned by section 56;” and

(ii) by the deletion of the definitions of “Community trade mark” and “Community Trade Mark Regulation”, and

(b) in subsection (3), by the substitution of “European Union” for “Community”.

4. Section 6 of the Act of 1996 is amended—

(a) in subsection (1), by the deletion of “capable of being represented graphically”, and

¹OJ No. L 336, 23.12.2015, p.1

²OJ No. L 154, 16.06.2017, p.1

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

(b) by the substitution of the following subsection for subsection (2):

“(2) Without prejudice to subsection (1), a trade mark may, in particular, consist of words (including personal names) or designs, letters, numerals, colours, the shape of goods or of the packaging of goods, or sounds, provided that such signs are capable of being represented on the register in a manner which enables the Controller and the public to determine the clear and precise subject matter of the protection afforded to its proprietor.”.

5. Section 8 of the Act of 1996 is amended—

(a) in subsection (2)—

- (i) in paragraph (a), by the substitution of “shape or another characteristic” for “shape”,
- (ii) in paragraph (b), by the substitution of “shape or another characteristic” for “shape”, and
- (iii) in paragraph (c), by the substitution of “shape or another characteristic” for “shape”, and

(b) by the substitution of the following subsection for subsection (4):

“(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 European Union law including those for the protection of designations of origin and geographical indications or where the State or the European Union is party to an international agreement protecting designations of origin and geographical indications; or
- (b) its use is prohibited in the State by any European Union legislation or international agreements to which the European Union is party, providing for protection of traditional terms for wine; or
- (c) its use is prohibited in the State by any European Union legislation or international agreements to which the European Union is party, providing for protection of traditional specialties guaranteed; or
- (d) it consists of, or reproduces in its essential elements, an earlier plant variety denomination registered in accordance with the law of the State or European Union legislation, or international agreements to which the European Union or the State is party, providing protection for plant variety rights, and which are in respect of plant varieties of the same or closely related species; or

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

6. Section 10 of the Act of 1996 is amended—

(a) in subsection (3), by the substitution of “(or, in the case of an EU trade mark, in the European Union)” for “(or, in the case of a Community trade mark, in the Community)”;

(b) by the insertion of the following subsection after subsection (3):

“(3A) Subsection (3) applies irrespective of whether the goods and services for which the trade mark is to be registered are identical with, similar to, or not similar to those for which the earlier trade mark is protected.”,

(c) in subsection (4)—

(i) in paragraph (a), by the substitution of “course of trade, subject to the condition that the rights to the unregistered trade mark or other sign were acquired prior to the date of application for registration of the trade mark or date of the priority claimed for that application and that unregistered trade mark or other sign confers on its proprietor the right to prohibit the use of a subsequent trade mark; or” for “course of trade; or”;

(ii) in paragraph (b), by the substitution of “property right; or” for “property right”, and

(iii) by the insertion of the following paragraph after paragraph (b):

“(c) and to the extent pursuant to European Union legislation or the law of the State providing for protections of designations of origin and geographical indications—

(i) by virtue of an earlier application for a designation of origin or a geographical indication prior to the date of application for registration of the trade mark or the date of the priority claimed for the application, subject to its subsequent registration, and

(ii) that designation of origin or geographical indication confers on the person authorised under the relevant law to exercise the rights arising therefrom the right to prohibit the use of a subsequent trade mark.”, and

(d) by the insertion of the following subsection after subsection (5):

“(5A) Where an agent or representative of the proprietor of a trade mark applies in his or her own name, without the proprietor’s consent, for the registration of the trade mark, the application is to be refused unless the agent or representative justifies that action.”.

7. The Act of 1996 is amended by the insertion of the following section after section 10:

“Grounds for refusal or invalidity relating to only some of the goods or services

10A. Where grounds for refusal of registration of a trade mark exist in respect of only some of the goods or services for which that trade mark has been applied, refusal of registration shall cover those goods or services only.”.

8. Section 11(1) of the Act of 1996 is amended by the substitution of the following paragraph for paragraph (a):

“(a) a registered trade mark, an international trade mark, a European Union trade mark or a designation of origin or a geographical indication 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;”.

9. Section 13 of the Act of 1996 is amended—

(a) in subsection (1), by the substitution of “Without prejudice to the rights of proprietors acquired before the filing date or the priority date of the registered trade mark, the proprietor of that registered trade mark” for “The proprietor of a registered trade mark”, and

(b) by the insertion of the following subsection after subsection (2):

“(2A) (a) Without prejudice to the rights of proprietors acquired before the filing date or the priority date of the registered trade mark, the proprietor of that registered trade mark shall be entitled to prevent all third parties from bringing goods, in the course of trade, into the State, without being released for free circulation there, where such goods, including the packaging thereof, come from third countries and bear without authorisation a trade mark which is identical with the trade mark registered in the State, in respect of such goods, or which cannot be distinguished in its essential aspects from that trade mark.

(b) The entitlement of the trade mark proprietor pursuant to paragraph (a) shall lapse if during the proceedings to determine whether the registered trade mark has been infringed,

initiated in accordance with the European Union (Customs enforcement of Intellectual Property Rights) Regulations 2013 (S.I. No. 562 of 2013), evidence is provided by the declarant or the holder of the goods that the proprietor of the registered trade mark is not entitled to prohibit the placing of the goods on the market in the country of final destination.”.

10. The Act of 1996 is amended by the insertion of the following section after section 13:

“Reproduction of trademarks in dictionaries

13A. If the reproduction of a trade mark in a dictionary, encyclopaedia or similar reference work, in print or electronic form, gives the impression that it constitutes the generic name of the goods or services for which the trade mark is registered, the publisher of the work shall, at the request of the proprietor of the trade mark, ensure that the reproduction of the trade mark is, without delay, and in the case of works in printed form at the latest in the next edition of the publication, accompanied by an indication that it is a registered trade mark.”.

11. Section 14 of the Act of 1996 is amended—

(a) in subsection (3), by the substitution of “a sign which is identical with, or similar to, the trade mark irrespective of whether it is used in relation to goods or services which are identical with, similar to, or not similar to, those for which the trade mark is registered where” for “a sign which is identical with or similar to the trade mark where”,

(b) in subsection (4)—

(i) in paragraph (c), by the substitution of “sign;” for “sign; or”, and

(ii) by the insertion of the following paragraphs after paragraph (d):

“(e) using the sign as a trade or company name or part of a trade or company name; or

(f) using the sign in comparative advertising in a manner that is contrary to the European Communities (Misleading and Comparative Marketing Communications) Regulations 2007 (S.I. No. 774 of 2007).”, and

(c) by the insertion of the following subsection after subsection (4):

“(4A) Where the risk exists that the packaging, labels, tags, security or authenticity features or devices, or any other means to which the trade mark is affixed, could be used in relation to goods or services and that use would constitute an infringement of the rights of the proprietor of a trade mark under section 13(1) and 14(4), the proprietor

of that trade mark shall have the right to prohibit the following acts if carried out in the course of trade:

- (a) affixing a sign identical with, or similar to, the trade mark on packaging, labels, tags, security or authenticity features or devices, or any other means to which the mark may be affixed;
- (b) offering or placing on the market, or stocking for those purposes, or importing or exporting, packaging, labels, tags, security or authenticity features or devices, or any other means to which the mark is affixed.”.

12. Section 15 of the Act of 1996 is amended, in subsection (2)—

(a) by the substitution of the following paragraph for paragraph (a):

“(a) the use of the name or address of a third party, where that third party is a natural person;”,

(b) by the substitution of the following paragraph for paragraph (b):

“(b) the use of signs or indications which are not distinctive or which concern 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;”,

(c) in paragraph (c), by the substitution of “for the purpose of identifying or referring to goods or services as those of the proprietor of that trade mark, in particular where that use” for “where it”, and

(d) by the substitution of “Provided that such use is in the course of trade” for “Provided that such use”.

13. The Act of 1996 is amended by the insertion of the following section after section 16:

“Use of trade marks

16A. (1) If, within a period of 5 years following the date of the completion of the registration procedure, the proprietor has not put the trade mark to genuine use in the State in connection with the goods or services in respect of which it is registered, or if such use has been suspended during a continuous 5 year period, the trade mark shall be subject to the provisions of sections 18A, 43A, 51(1)(a) or 52A(3) and (4), unless there are proper reasons for non-use.

(2) With regard to trade marks registered under international arrangements and having effect in the State, the 5 year period referred to in subsection (1) shall be calculated—

(a) from the date when the mark can no longer be rejected or opposed, or

(b) where an opposition has been lodged or when an objection on absolute or relative grounds has been notified, from the date when a decision terminating the opposition proceedings or a ruling on absolute or relative grounds for refusal became final or the opposition was withdrawn.

(3) The date of commencement of the 5 year period in subsection (1) shall be entered in the register.

(4) Use within the meaning of subsection (1) shall include—

(a) use of the trade mark in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, regardless of whether or not the trade mark as used is also registered in the name of the proprietor, or

(b) affixing of the trade mark to goods or to the packaging thereof in the State solely for export purposes.

(5) Use of the trade mark with the consent of the proprietor shall be deemed to constitute use by the proprietor.”.

14. The Act of 1996 is amended by the insertion of the following sections after section 18:

“Non-use as defence in action for infringement

18A. (1) The proprietor of a trade mark shall be entitled to prohibit the use of a sign only to the extent that the proprietor’s rights are not liable to be revoked pursuant to section 51 at the time the action for infringement is brought.

(2) If the defendant so requests, the proprietor of the trade mark shall furnish proof that, during the 5 year period preceding the date of bringing the action for infringement—

(a) the trade mark has been put to genuine use as provided in section 16A, in connection with the goods or services in respect of which it is registered and which are cited as justification for the action, or

(b) that there are proper reasons for non-use,

provided that the registration procedure of the trade mark has, at the date of bringing the action, been completed for not less than 5 years.

Intervening right of the proprietor of a later registered trade mark as defence in action for infringement

18B. (1) In an action for infringement, the proprietor of a trade mark shall not be entitled to prohibit the use of a later registered trade mark where that later trade mark would not be declared invalid pursuant to sections 10(4)(a), 10(4)(b), 52(2A), 53(1), or 52A (3).

(2) In an action for infringement, the proprietor of a trade mark shall not be entitled to prohibit the use of a later registered European Union trade mark where that later trade mark would not be declared invalid pursuant to Articles 60(1), (3) or (4), 61(1) or (2) or 64(2) of the European Union trade mark regulation.

(3) Where the proprietor of a trade mark is not entitled to prohibit the use of a later registered trade mark pursuant to subsection (1) or (2), the proprietor of that later registered trade mark shall not be entitled to prohibit the use of the earlier trade mark in an action for infringement, even though that earlier right may no longer be invoked against the later trade mark.”.

15. Section 28 of the Act of 1996 is amended—

(a) by the substitution of the following subsections for subsection (1):

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

(1A) A transfer of a whole business shall include the transfer of the trade mark, except where there is agreement to the contrary, or circumstances clearly dictate otherwise.

(1B) Subsection (1A) shall apply to the contractual obligation to transfer the undertaking.”,

(b) in subsection (2), by the substitution of “other transfer” for “other transmission”, and

(c) in subsection (6), by the substitution of “other transfer” for “other transmission”.

16. Section 31 of the Act of 1996 is amended, in subsection (1), by the substitution of “sections 26 to 30 and 32 to 35” for “sections 26 to 30”.

17. Section 34 of the Act of 1996 is amended—

(a) by the substitution of the following subsection for subsection (3):

“(3) Without prejudice to the provisions of the license or the licensing contract, the licensee may bring proceedings for infringement of a trade mark only if its proprietor consents thereto.”,

(b) by the substitution of the following subsection for subsection (4):

“(4) Where infringement proceedings have been brought by a licensee under subsection (3), 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.”, and

(c) by the insertion of the following subsection after subsection (4):

“(4A) A licensee shall, for the purpose of obtaining compensation for damage suffered by him, be entitled to intervene in infringement proceedings brought by the proprietor of the trade mark.”.

18. Section 35 of the Act of 1996 is amended by the insertion of the following subsection after subsection (2):

“(2A) The holder of an exclusive licence may bring infringement proceedings if the proprietor of the trade mark, after formal notice, does not himself bring infringement proceedings within an appropriate period.”.

19. The Act of 1996 is amended by the substitution of the following section for section 39:

“Designation and Classification of goods and services

39. (1) Goods and services shall be classified for the purposes of the registration of trade marks in conformity with the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957 (herein referred to as the ‘Nice Classification’).

(2) The goods and services for which protection is sought shall be identified by the applicant with sufficient clarity and precision to enable the Controller and the public, on that sole basis, to determine the extent of the protection sought.

(3) For the purposes of subsection (2), the general indications included in the class headings of the Nice Classification or other general terms may be used, provided that they comply with the requisite standards of clarity and precision referred to in this section.

(4) The Controller shall reject an application in respect of indications or terms which are unclear or imprecise, where the applicant does not suggest an acceptable wording within a period set by the Controller to that effect.

(5) The use of general terms, including the general indications of the class headings of the Nice Classification—

(a) shall be interpreted as including all the goods or services clearly covered by the literal meaning of the indication or term, and

(b) shall not be interpreted as comprising a claim to goods or services which cannot be so understood.

(6) Where the applicant requests registration for more than one class, the applicant shall—

(a) group the goods and services according to the classes of the Nice Classification,

(b) precede each group by the number of the class to which that group of goods or services belongs, and

(c) present them in the order of the classes.

(7) Goods and services shall not be regarded as—

(a) being similar to each other on the ground that they appear in the same class under the Nice Classification, or

(b) being dissimilar from each other on the ground that they appear in different classes under the Nice Classification.

(8) 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.”.

20. Section 43 of the Act of 1996 is amended—

(a) in subsection (2), by the substitution of “opposition to the registration on the grounds provided for in section 10 and” for “opposition to the registration; and ”,

(b) by the insertion of the following subsections after subsection (2):

“(2A) (a) A notice of opposition under subsection (2) may be filed on the basis of one or more earlier trade marks or other earlier rights, provided that they all belong to the same proprietor.

(b) A notice of opposition filed on the basis of one or more earlier trade marks or earlier rights, may be based on part, or the totality, of the goods or services in respect of which the earlier rights are protected or applied for, and may be directed against part or the totality of the goods or services in respect of which the contested mark is applied for.

(2B) At any stage following the commencement of opposition proceedings, the parties shall be granted, at their joint request, a stay in

the proceedings for a minimum period of 2 months from the date of the request, in order to allow for the possibility of a friendly settlement between the opposing party and the applicant.”,

(c) by the substitution of the following for subsection (3):

“(3) Where an application has been published in the Journal, any natural or legal person and any group or body representing manufacturers, producers, suppliers of services, traders or consumers may, at any time before the registration of the trade mark, make observations in writing to the Controller explaining on which grounds the trade mark should not be registered; and the Controller shall inform the applicant of any such observations.”, and

(d) by the substitution of the following for subsection (4):

“(4) Persons and groups or bodies who make observations under subsection (3) shall not be a party to the proceedings on the application.”.

21. The Act of 1996 is amended by the insertion of the following section after section 43:

“Non-use as defence in opposition proceedings

43A. (1) In opposition proceedings pursuant to section 43(2), where at the filing date or date of priority of the later trade mark, the 5 year period within which the earlier trade mark must have been put to genuine use as provided for in section 16A had expired, at the request of the applicant, the proprietor of the earlier trade mark who has given notice of opposition shall furnish proof—

(a) that the earlier trade mark has been put to genuine use during the 5 year period preceding the filing date or date of priority of the later trade mark, or

(b) that proper reasons for non-use existed.

(2) In the absence of proof referred to in subsection (1), the opposition shall be rejected.

(3) If the earlier trade mark has been used in relation to only part of the goods or services for which it is registered, it shall, for the purpose of the examination of the opposition as provided for in subsection (1), be deemed to be registered in respect of that part of the goods or services only.

(4) Subsections (1), (2) and (3) shall also apply where the earlier trade mark is an European Union trade mark and the genuine use of the European Union trade mark shall be determined in accordance with Article 18 of the European Union trade mark regulation.”.

22. Section 46(1) of the Act of 1996 is amended by the substitution of the following paragraph for paragraph (a):

“(a) the division of an application for the registration of a trade mark and for the division of a registration of a trade mark into several applications or registrations, each having the same filing date as the original application;”.

23. Section 48 of the Act of 1996 is amended by the insertion of the following subsection after subsection (1):

“(1A) Where the request is submitted or the fees paid in respect of only some of the goods or services for which the trade mark is registered, registration shall be renewed for those goods or services only.”.

24. Section 51 of the Act of 1996 is amended, in subsection (2), by the substitution of “in the form in which it was registered, regardless of whether or not the trade mark in the form as used is also registered in the name of the proprietor” for “in the form in which it was registered,”.

25. Section 52 of the Act of 1996 is amended—

(a) in subsection (1), by the substitution of “it has before the date of application for a declaration of invalidity, acquired a distinctive character” for “it has after registration acquired a distinctive character”,

(b) in subsection (2)—

(i) in paragraph (a), by the substitution of “subsections (1) to (3A) of section 10 obtains,” for “subsections (1) to (3) of section 10 obtains, or”,

(ii) in paragraph (b), by the substitution of “paragraph (a), (b) or (c) of subsection (4) ” for “paragraph (a) or (b) of subsection (4)”, and

(iii) by the insertion of the following paragraphs after paragraph (b):

“(c) that the trade mark was registered in breach of section 8(4)(a) and section 9, or

(d) that the trade mark was registered in breach of section 10(5A),” and

(c) by the insertion of the following subsections after subsection (2):

“(2A) An application for a declaration of invalidity on the basis of an earlier trade mark shall not succeed at the date of application for invalidation if it would not have been successful at the filing date or the priority date of the later trade mark for any of the following reasons:

- (a) the earlier trade mark, liable to be declared invalid pursuant to section 8(1)(b), (c) or (d), had not yet acquired a distinctive character as referred to in section 8(1);
- (b) the application for a declaration of invalidity is based on section 10(2) and the earlier trade mark had not become sufficiently distinctive to support a finding of likelihood of confusion within the meaning of section 10(2);
- (c) the application for a declaration of invalidity is based on section 10(3) and (3A) and the earlier trade mark had not yet acquired a reputation within the meaning of section 10(3) and (3A).

(2B) An application for a declaration of invalidity may be filed on the basis of one or more earlier rights, provided they all belong to the same proprietor.”.

26. The Act of 1996 is amended by the insertion of the following section after section 52:

“Non-use as defence in proceedings seeking a declaration of invalidity

52A. (1) In proceedings for a declaration of invalidity based on a registered trade mark with an earlier filing date or priority date, if the proprietor of the later trade mark so requests, the proprietor of the earlier trade mark shall furnish proof that-

- (a) during the 5 year period preceding the date of the application for a declaration of invalidity, the earlier trade mark has been put to genuine use, as provided for in section 16A, in connection with the goods or services in respect of which it is registered and which are cited as justification for the application, or
- (b) there are proper reasons for non-use,

provided that the registration process of the earlier trade mark has at the date of the application for a declaration of invalidity been completed for not less than 5 years.

(2) Where, at the filing date or date of priority of the later trade mark, the 5 year period within which the earlier trade mark was to have been put to genuine use, as provided for in section 16A, had expired, the proprietor of the earlier trade mark shall, in addition to the proof required under subsection (1), furnish proof that the earlier trade mark was put to genuine use during the 5 year period preceding the filing date or date of priority of the later trade mark, or that proper reasons for non-use existed.

(3) In the absence of the proof referred to in subsections (1) and (2), an application for a declaration of invalidity on the basis of an earlier trade mark shall be rejected.

(4) If the earlier trade mark has been used in accordance with section 16A in relation to only part of the goods or services for which it is registered, it shall, for the purpose of the examination of the application for a declaration of invalidity, be deemed to be registered in respect of that part of the goods or services only.

(5) Subsections (1) to (4) of this section shall also apply where the earlier trade mark is an European Union trade mark and genuine use of the European Union trade mark shall be determined in accordance with Article 18 of the European Union trade mark regulation.”.

27. Section 54 of the Act of 1996 is amended by the insertion of the following subsection after subsection (1):

“(1A) Associations of manufacturers, producers, suppliers of services or traders, which, under the terms of the law governing them, have the capacity in their own name to have rights and obligations, to make contracts or accomplish other legal acts, and to sue and be sued, as well as legal persons governed by public law, may apply for collective marks.”.

28. The Act of 1996 is amended by the substitution of the following section for section 56:

“Meaning of ‘European Union trade mark’, ‘European Union Trade Mark Regulation’ and ‘Directive’

56. (1) In this Act—

- (a) ‘European Union trade mark’ has the meaning given by Article 1 (1) of the European Union trade mark regulation;
- (b) ‘European Union trade mark regulation’ means regulation (EU) 2017/1001 of the European Parliament and of the Council of 14 June 2017³ on the European Union trade mark (codification);
- (c) ‘Directive’ means Directive (EU) 2015/2436 of the European Parliament and of the Council of 16 December 2015⁴ to approximate the laws of the Member States relating to trade marks (Recast).

(2) A word or expression that is used in this Act and that is also used in the EU trade mark regulation or the Directive shall have the same meaning in this Act as it has in the EU trade mark regulation or the Directive”.

29. Section 57 of the Act of 1996 is repealed.

³OJ No. L 154, 16.06.2017, p.1

⁴OJ No. L 336, 23.12.2015, p.1

30. Section 85 of the Act of 1996 is amended, in subsection (9), by the substitution of “European Union or EEA Trade Mark Attorney” for “Community Trade Mark Attorney”.

31. The First Schedule to the Act of 1996 is amended—

(a) in paragraph 5—

(i) in subparagraph (2), by the deletion of “where they exist”, and

(ii) by the insertion of the following subparagraph after subparagraph (2):

“(2A) The regulations governing the use of the mark shall authorise any person whose goods or services originate in the geographical area concerned to become a member of the association which is the proprietor of the mark, provided that the person fulfils all the other conditions of the regulations.”,

(b) in paragraph 10, by the substitution of “the Controller and the mention of the amendment of the regulations is entered in the register.” for “the Controller.”,

(c) in paragraph 11—

(i) by the substitution of the following subparagraph for subparagraph (3):

“(3) Without prejudice to the provisions of any agreement, the authorised user may bring proceedings for infringement of a trade mark only if its proprietor consents thereto.”, and

(ii) by the insertion of the following subparagraph after subparagraph (6):

“(7) An authorised user shall for the purpose of obtaining compensation for damage suffered by him or her, be entitled to intervene in infringement proceedings brought by the proprietor of a registered collective mark.”,

(d) in paragraph 12—

(i) by the substitution of “shall” for “may”,

(ii) in subparagraph (a), by the substitution of “persons authorised to use it” for “proprietor”,

(iii) by the substitution of the following subparagraph for subparagraph (b):

“(b) the proprietor has not taken reasonable steps to prevent the mark being used in a manner that is incompatible with the

conditions of use laid down in the regulations governing the use of the mark, including any amendments thereto mentioned in the register; or”, and

- (iv) by the substitution of the following subparagraph for subparagraph (c)(i):

“(c) (i) no longer comply with paragraph 5(2) and any further conditions imposed by rules unless the proprietor of the mark, by further amending the regulations governing use, complies with the requirements of the First Schedule; or ”, and

- (e) by the substitution of the following paragraph for paragraph 13:

“13. In addition to the grounds of invalidity provided for in section 52, where appropriate with the exception of section 8(1)(c), concerning signs or indications which may serve, in trade, to designate the geographical origin of the goods or services, the registration of a collective mark shall be declared invalid on the ground that the mark was registered contrary to the provisions of paragraph 4(1) or 6(1), unless the proprietor of the mark, by further amending the regulations governing use, complies with the requirements of the First Schedule.”.

32. The Second Schedule to the Act of 1996 is amended—

- (a) by the substitution of the following paragraph for paragraph 4:

“4. Any natural or legal person, including institutions, authorities and bodies governed by public law, may apply for certification marks provided that such person does not carry on a business involving the supply of goods or services of the kind certified.”, and

- (b) by the insertion of the following paragraph after paragraph 6:

“6A. The requirement of use referred to in section 16A shall be satisfied where genuine use of a certification mark is made by any person who has the authority to use it.”.

33. The Third Schedule to the Act of 1996 is amended by the insertion of the following paragraph after paragraph 17:

“18. The amendments to this Act effected by the European Union (Trade Marks) Regulations 2018 shall not apply to any application for registration of a trade mark made under this Act before the coming into operation of those Regulations.”.



GIVEN under my Official Seal,
18 December 2018.

HEATHER HUMPHREYS,
Minister for Business, Enterprise and Innovation.

EXPLANATORY NOTE

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

These Regulations, made pursuant to the European Communities Act, 1972, amend and extend certain provisions of the Trade Marks Act 1996 to give statutory effect in the State to Directive (EU) 2015/2436 of the European Parliament and of the Council of 16 December 2015 amending Directive 2008/95/EC relating to trade marks and to certain provisions of Council Regulation (EU) 2017/1001 of 14 June 2017, on the European Union Trade Mark.

As there is currently a prescribed legislative framework in place for trade marks, namely, the Trade Marks Act 1996, the transposition of the Directive into Irish law will necessitate the introduction of new, modernizing provisions and the revision of certain existing Irish provisions.

In terms of new provisions, the transposition provides for the opportunity to register non-traditional forms of trade marks in the future; introduces a new act of infringement relating to the affixing of a trade mark to packaging, labels, tags etc. or the offering, placing on the market etc. of such items; introduces new provisions relating to the use of trade marks; introduces intervening rights of trade mark proprietors in infringement proceedings; provides a proprietor with certain rights against a publisher where the reproduction of trade marks in dictionaries gives the impression that it is a generic name for the goods or services; introduces new procedures whereby, subject to the provisions of the license, a licensee may bring proceedings for infringement of the trade mark only with the consent of the proprietor; introduces provisions regarding the division of trade mark registrations and introduces new non-use defence mechanisms in opposition, invalidity and infringement proceedings.

With regard to the revision of certain existing Irish provisions, the transposition amends those relating to the grounds for refusal or invalidity of a trade mark; amends the rights conferred by a trade mark, particularly in relation to (a) strengthening trade mark protection and combatting counterfeiting more effectively, by conferring a right on a proprietor to prevent third parties from bringing infringing goods into Ireland, without being released for free circulation, (b) the use of a trade mark as a trade or company name, (c) the use of a trade mark in comparative advertising; amends the conditions of registration of a collective trade mark; amends the grounds for revocation of a collective mark; clarifies the classification of goods and services; amends provisions regarding renewal and expiry of the registration of trade marks; defines whom may file observations in relation to the registration of a trade mark; amends certain opposition procedures, and removes the possibility of opposing the registration of a trade mark on absolute grounds.

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52 FAICHE STIABHNA, BAILE ÁTHA CLIATH 2
(Teil: 01 - 6476834 nó 1890 213434; Fax: 01 - 6476843)
nó trí aon díoltóir leabhar.

DUBLIN
PUBLISHED BY THE STATIONERY OFFICE
To be purchased from
GOVERNMENT PUBLICATIONS,
52 ST. STEPHEN'S GREEN, DUBLIN 2.
(Tel: 01 - 6476834 or 1890 213434; Fax: 01 - 6476843)
or through any bookseller.

€4.06



Wt. (B33864). 285. 12/18. Essentra. Gr 30-15.