



STATUTORY INSTRUMENTS.

S.I. No. 563 of 2018



TRADE MARKS ACT 1996 (COMMUNITY TRADE MARK)
(AMENDMENT) 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 Trade Marks Act 1996 (Community Trade Mark) (Amendment) Regulations 2018.

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

2. In these Regulations, “Principal Regulations” means the Trade Marks Act, 1996 (Community Trade Mark) Regulations 2000 (S.I. No. 229 of 2000).

3. Regulation 2 of the Principal Regulations is amended, in paragraph (1)—

(a) by the deletion of the definitions of “Community Trade Mark Regulation” and “Community Trade Mark Rules”,

(b) by the insertion of the following definition:

“ ‘EU 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);”, and

(c) by the insertion of the following paragraph after paragraph (3):

“(4) A word or expression which is used in these Regulations and which is also used in the EU Trade Mark Regulation has, unless the context otherwise requires, the same meaning in these Regulations as it has in the EU Trade Mark Regulation.”.

4. Regulation 3 of the Principal Regulations is amended by the substitution of “Where the Controller receives a notification under Article 39(5) of the EU Trade Mark Regulation” for “Where the Controller receives a notification

¹OJ No. L 336, 23.12.2015, p. 1

²OJ No. L 154, 16.6.2017, p. 1

³OJ No. L 154, 16.6.2017, p. 1

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

under Rule 28(3) of the Community Trade Mark Rules pursuant to Article 34 or 35 of the Community Trade Mark Regulation”.

5. Regulation 4 of the Principal Regulations is amended—

(a) by the substitution of the following paragraph for paragraph (1):

“(1) Where the proprietor of an EU trade mark claims the seniority of a registered trade mark or an international trade mark having effect in the State which has been removed from the register under section 48 or has been surrendered under section 50 after registration of the EU 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 or an international trade mark having effect in the State had not been so removed or surrendered, it would have been liable, as at the date of such removal or surrender, to be revoked pursuant to section 51 or deemed invalid pursuant to section 52 as the case may be, and the Controller or the Court may grant such a declaration accordingly.”, and

(b) in paragraph (2), by the substitution of “as the case may be, and the seniority shall cease to produce its effects and the Controller shall notify the European Union Intellectual Property Office of any such declaration made” for “as the case may be, and the Controller shall notify the Office for Harmonisation in the Internal Market of any such declaration made”.

6. Regulation 5 of the Principal Regulations is amended by the substitution of “within the meaning of Article 120 of the EU Trade Mark Regulation” for “within the meaning of Article 89 of the Community Trade Mark Regulation”.

7. Regulation 6 of the Principal Regulations is amended by the substitution of “an EU trade mark” for “a Community trade mark” in both places that it occurs.

8. Regulation 7 of the Principal Regulations is amended—

(a) by the substitution of “EU Trade Mark Regulation” for “Community Trade Mark Regulation”,

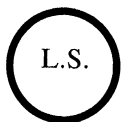
(b) in paragraph (a), by the substitution of “an EU trade mark” for “a Community trade mark”, and

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

“(b) the Court of Appeal is hereby designated as an EU trade mark court of second instance.”.

9. Regulation 8 of the Principal Regulations is amended, in paragraph (1)—
 - (a) by the substitution of “an EU trade mark” for “a Community trade mark” in both places that it occurs,
 - (b) by the substitution of “Article 139” for “Article 108”, and
 - (c) by the substitution of “Article 141 of the EU Trade Mark Regulation” for “Article 110 of the Community Trade Mark Regulation”.
10. Regulation 9 of the Principal Regulations is amended, in paragraph (2)—
 - (a) by the substitution of “an EU trade mark” for “a Community trade mark” in both places that it occurs,
 - (b) by the substitution of “Article 139” for “Article 108”, and
 - (c) by the substitution of “Article 141” for “Article 110”.
11. Regulation 10 of the Principal Regulations is amended—
 - (a) by the substitution of “an EU trade mark” for “a Community trade mark”, and
 - (b) in paragraph (b), by the substitution of “Article 212 of the EU Trade Mark Regulation” for “Article 143(4) of the Community Trade Mark Regulation”.
12. The Principal Regulations are amended by the substitution of the following Regulation for Regulation 11:

“11. A trade mark application resulting from the conversion of an EU trade mark application or EU trade mark shall maintain the date of priority of the said EU trade mark application or said EU trade mark and, where appropriate, the seniority of an earlier registered trade mark claimed under Articles 39 and 40 the EU Trade Mark Regulation.”.
13. Regulation 12 of the Principal Regulations is amended by the substitution of “Article 140 and 141 of the EU Trade Mark Regulation” for “Article 109 and 110 of the Community Trade Mark Regulation”.
14. The European Communities (Community Trade Mark) Regulations 1996 (S.I. No. 10 of 1996) are revoked.



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 amend certain technical provisions in the Community Trade Mark Regulations 2000 (S.I. 229/2000) (“the CTM Regulations”). The amendments are for the purpose of giving effect to technical changes in certain provisions and changes in terminology arising from Regulation (EU) No. 2015/2424 of the European Parliament and of the Council of 16th December 2015, Council Regulation (EU) 2017/1001 of 14 June 2017 on the European Union Trade Mark and Commission Regulation (EU) 2017/1431 of 18 May 2017 implementing certain provisions of Council Regulation (EU) 2017/1001 of 14 June 2017 on the European Union Trade Mark.

As an additional consequence of Council Regulation (EU) 2017/1001 of 14 June 2017 on the European Union Trade Mark, it is no longer possible for applicants for EU trade marks to file their applications with a national office as all applications must now be filed directly with the European Union Intellectual Property Office. Therefore, the European Communities (Community Trade Mark) Regulations, 1996 (S.I. No. 10/1996), which provides for the charging of a receiving or handling fee for receiving and forwarding EU trade mark applications to the European Union Intellectual Property Office, is revoked in these Regulations.

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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.

€2.54

