



STATUTORY INSTRUMENTS.

S.I. No. 46 of 2016



TRADE MARKS (AMENDMENT) RULES 2016

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I, RICHARD BRUTON, Minister for Jobs, Enterprise and Innovation, in exercise of the powers conferred on me by sections 81 and 90 of the Trade Marks Act, 1996 (No. 6 of 1996), hereby make the following Rules:

Citation and commencement

1. (1) These Rules may be cited as the Trade Marks (Amendment) Rules 2016

(2) When these Rules come into force, any person whose name was, immediately prior to the coming into force of these Rules, entered in the Register of Trade Mark Agents kept under the Trade Marks Rules 1996, shall be construed to be entered in the Register of Trade Mark Agents kept under the Trade Marks Rules 1996.

Interpretation

2. In these Rules, unless the context otherwise requires:—

“the Act” means the Trade Marks Act 1996 (No. 6 of 1996).

“Rules” means the Trade Marks Rules 1996 (S.I. No. 199 of 1996).

“Register of Trade Mark Agents” means the register kept under section 84 of the Trade Marks Act 1996, as amended.

“EEA Agreement” means the Agreement on the European Economic Area signed at Oporto on 2 May 1992, as adjusted by all subsequent amendments to that Agreement;

“EEA state” means—

(a) a Member State (other than the State), or

(b) a state (other than a Member State) that is a contracting party to the EEA agreement.

Substitution of Rule 51

3. The following Rule is substituted for Rule 51:

“Application for registration

51. (1) An application under section 86 for entry in the Register of Trade Mark Agents shall be in writing in a form approved by the Controller and shall in the case of an individual, state—

*Notice of the making of this Statutory Instrument was published in
“Iris Oifigiúil” of 5th February, 2016.*

- (a) the full name and home address of the person making the application and the name or style under which the person proposes to carry on business as a trade mark agent (if other than his or her full name),
- (b) the address at which the person proposes to carry on business as a trade mark agent,
- (c) the date of birth and the nationality of the person,
- (d) full particulars of the education and professional qualifications of the person

and shall be accompanied by the prescribed fee as set out in item 33 of Schedule 1 of the Trade Marks Rules, 1996.

(2) A body corporate, unincorporated body or partnership may be eligible to be entered in the Register of Trade Mark Agents if the Board established under Rule 51(5)(a) is satisfied that

- (a) the body or partnership undertakes, *inter alia*, the provision of trade mark agent services including, but not limited to, the business of acting as agent for others for the purpose of:
 - (i) applying for or obtaining trade marks in the State or elsewhere; and/or
 - (ii) conducting proceedings before the Controller or the Court relating to applications for, or otherwise in connection with trade marks described above;

and
- (b) at least one of its directors, partners, managers or employees is registered as a trade mark agent in the State.

(3) An application by a body corporate, unincorporated body or partnership for entry in the Register of Trade Mark Agents shall be in writing in a form approved by the Controller and shall state—

- (a) the name of each director, manager, partner and employee of the body corporate, unincorporated body or partnership who is registered as a trade mark agent in the State,
- (b) the date of birth and nationality of each director, manager, partner and employee who is registered as a trade mark agent in the State,
- (c) the name or style under which the body corporate, unincorporated body or partnership proposes to carry on business as a trade mark agent,

- (d) the address at which the body proposes to carry on business as a trade mark agent,
- (e) full particulars of the education and professional qualifications of each director, manager, partner and employee who is registered as a trade mark agent in the State,

and shall be accompanied by:

- (f) the prescribed fee as set out in item 33 of Schedule 1 of the Trade Marks Rules 1996,
- (g) a copy of a certificate of incorporation, an entry in a relevant register or other proof of legal personality,

(4) Subject to paragraph (7), a person shall not be entered in the Register of Trade Mark Agents unless—

- (a) (i) he or she has sat a Leaving Certificate Examination conducted by the State Examinations Commission and attained, on the basis of the standards applied by that Commission at the time of the conducting thereof, results that constituted, at least, a pass at ordinary level in that examination, or
 - (ii) he or she has attained a qualification which, in the opinion of the Board, is of equivalent standing, and
 - (b) he or she has a satisfactory knowledge of the law and practice of trade marks.
- (5) (a) An application for registration in the Register of Trade Mark Agents, in accordance with paragraphs (1) and (3) of Rule 51, shall be considered by a Board consisting of the person who is the Controller for the time being, and such other persons as may be nominated for the purpose by the Minister.

(b) The Board shall,

- (i) consider the personal character and the fitness of the applicant to perform the professional duties of a trade mark agent in the light of the educational and professional qualifications set out in paragraph (4) of Rule 51, which the applicant possesses. If the Board is in doubt as to the fitness of the person making the application, it may require the person to undergo such written or oral examinations or tests in such subjects as it considers necessary;

- (ii) fix the time and place for the holding of any examination, shall appoint one or more examiners to conduct examinations or tests and shall make such other arrangements as may be necessary in relation to such tests or examinations;
- (iii) consider applications and hold any necessary tests or examinations as expeditiously as is practicable having regard to the number of applications received;
- (iv) in the case of an application by a body corporate, unincorporated body or partnership, consider the fitness of the body or partnership to carry on the business of a trade mark agent having regard to the educational and professional qualifications of the directors, managers, partners and employees, as set out in Rule 51(4), intending to provide trade mark agent services in the State. If the Board is in doubt as to the fitness of the body or partnership making the application to carry on the business of a trade mark agent, it may require some or all of the persons intending to provide trade mark agent services in the State to undergo such written or oral examinations or tests in such subjects as it considers necessary.

(6) The Board may, for the purpose of establishing that an applicant possesses the required educational qualifications specified in paragraph (4), require that the applicant submit evidence to that effect.

(7) The Board may, however, waive or vary any of the requirements specified in subparagraphs (a) or (b) of paragraph (4) of Rule 51, if it is otherwise satisfied in the light of the educational and professional qualifications which the applicant possesses, that the applicant is fit to perform the professional duties of a trade mark agent.

Substitution of Rule 51A

4. The following Rule is substituted for Rule 51A:

“Evidence of qualifications, etc.

51A. The following are prescribed for the purposes of paragraphs (a), (b) and (c), respectively, of section 85(4B)—

- (a) evidence indicating that the person referred to in section 85(4B) is established in an EEA state for the purpose of pursuing the activities concerned,
- (b) evidence of the applicable qualifications (within the meaning of section 85) being—
 - (i) evidence such as a copy of a diploma or certificate, or

- (ii) other evidence of formal qualifications, awarded by the competent authority of the EEA state concerned which indicates that the person referred to in section 85(4B) is qualified to act as a trade mark agent in that state, and
- (c) in a case falling—
- (i) within paragraph (c)(i), a copy of a passport, national identity card or other proof of nationality, or
 - (ii) within paragraph (c)(ii), to the extent that proof of the matters referred to in the following clauses is not provided by the evidence referred to in paragraph (a)-
 - (I) a copy of a certificate of incorporation, an entry in a relevant register or other proof of the possession of the required legal personality,
 - (II) a copy of a certificate or an entry in a relevant register specifying the location of the person's registered office, central administration or principal place of business or other proof of its location."

Substitution of Rule 51B

5. The following Rule is substituted for Rule 51B:

“Controller to be informed of certain change of circumstances.

51B. If, subsequent to the provision by a person to the Controller of such evidence as is referred to in section 85(4B), there is any material change of circumstances affecting the person's continuing to be qualified to act as a trade mark agent in, an EEA state, the person shall, forthwith, notify the Controller in writing of that change of circumstances.”

Substitution of Rule 53

6. The following is substituted for Rule 53:

“Entry in the Register of Trade Mark Agents

53. (a) Subject to the provisions of section 86 and these Rules, a person shall, upon payment of the prescribed fee, be registered by the Controller in the Register of Trade Mark Agents.

- (b) The entry in that register shall include the date of registration and, in the case of a partnership, body corporate or unincorporated body, the business name and address thereof and the full name and home address of each director, manager, partner or employee registered as a trade mark agent in the State and in the case of an individual, the full name, the business name (if any), nationality and home and business address of the applicant together with such particulars

of the applicant's qualifications for entry, and such other particulars as the Controller may require.

- (c) Where the address of a person who has been entered in the register changes, the Controller shall record the new address on receipt of a written request from the person concerned."

Substitution of Rule 59

7. The following is substituted for Rule 59:

"Controller may refuse to deal with certain agents

59. The Controller may refuse to recognise in respect of any business under the Act

- (a) a person whose name has been erased from and not restored to, or who is suspended from, the Register of Trade Mark Agents;
- (b) a person who is found by the Minister to have been guilty of such conduct as would, in the case of an individual registered in that register, render such person liable to have his or her name erased from it on the grounds of misconduct;
- (c) any solicitor whose name has been struck off the roll of solicitors maintained under the Solicitors Acts, 1954 to 2011, and has not since been restored.
- (d) any person who no longer satisfies the requirements of section 85(4A);
- (e) a person referred to in section 85(4B) who does not comply with Rule 51A or 51B.



GIVEN under my Official Seal,
2 February 2016.

RICHARD BRUTON,
Minister for Jobs, Enterprise and Innovation.

EXPLANATORY NOTE.

(This note is not part of the Instrument and does not purport to be a legal interpretation)

These Rules prescribe the procedures connected with the registration of Trade Mark Agents pursuant to Part V of the Trade Marks Act, 1996.

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