



STATUTORY INSTRUMENTS.

**S.I. No. 628 of 2019**



TRADE MARKS (AMENDMENT) RULES 2019

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I, JOHN HALLIGAN, Minister of State at the Department of Business, Enterprise and Innovation, in exercise of the powers conferred on me by section 81 of the Trade Marks Act 1996 (No. 6 of 1996) (as adapted by the Jobs, Enterprise and Innovation (Alteration of Name of Department and Title of Minister) Order 2017 (S.I. No. 364 of 2017)), and the Business, Enterprise and Innovation (Delegation of Ministerial Functions)(No. 2) Order 2017 (S.I. No. 570 of 2017), hereby make the following rules:

*Citation and commencement.*

1. These Rules may be cited as the Trade Marks (Amendment) Rules 2019.

*Definition.*

2. In these Rules,-

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

“Principal Rules” means the Trade Marks Rules 1996 (S.I. No. 199 of 1996), and (except where the context otherwise requires), a reference to a Rule is a reference to a Rule of those Rules.

*Amendment of Rule 10.*

3. Rule 10 of the Principal Rules is amended in paragraph 3(c) by inserting “and Rule 41A” after “application under Rule 41”.

4. The Principal Rules are amended by the insertion of the following Rule after Rule 17:

*“Observations*

17A. (1) An observation made to the Controller under section 43(3) may include a request that the application be amended or refused on the grounds that it was filed in bad faith.

(2) Any such request shall be submitted in duplicate and shall contain a statement in writing of the grounds on which bad faith is claimed and shall be accompanied by evidence by way of statutory declaration.

(3) The Controller shall on receipt of a request made under paragraph (2) send a copy of the request and accompanying statutory declaration to the applicant.

(4) Unless the Controller otherwise directs, where a request made under paragraph (2) is not accompanied by evidence by way of a

*Notice of the making of this Statutory Instrument was published in  
“Iris Oifigiúil” of 13th December, 2019.*

statutory declaration, the request shall be deemed to have been abandoned and the Controller shall proceed with the application accordingly.

(5) An applicant who wishes to contest the request shall, within 28 days of the issue by the Controller of copies of the statement mentioned in paragraph (3), file a counter-statement in duplicate with the Controller setting out the extent to which that statement is admitted or disputed.

(6) Unless the Controller otherwise directs, where an applicant fails to furnish a counter-statement within the period referred to in paragraph (5), the Controller shall be entitled to presume that the applicant does not wish to contest the request and the Controller shall proceed with the application accordingly.

(7) Persons and groups or bodies who make observations in accordance with paragraph (1) shall not thereby become a party to the proceedings on the application.”.

*Amendment of Rule 18A.*

5. Rule 18A of the Principal Rules is re-numbered as Rule 18B.

6. The Principal Rules are amended by the insertion of the following after Rule 18:

*“Stay in Opposition proceedings*

(1) 18A. (1) For the purposes of section 43(2B), at any stage during opposition proceedings, the Controller shall grant the parties, at their joint request, a stay in the proceedings for a minimum period of 2 months and a maximum period of one year from the date of the request, for the express purpose of allowing for the possibility of a friendly settlement between the parties.

(2) A second joint request for a stay, limited in duration as set out in paragraph (1) above, may be granted at the discretion of the Controller, but only if the Controller is satisfied that meaningful progress to reach a friendly settlement has been made.

(3) The Controller shall refuse all subsequent requests for a stay.”.

*Amendment of Rule 19.*

7. Rule 19 of the Principal Rules is amended by inserting the following after paragraph (1):

“(1A) Where the provisions of section 43A apply, the counter-statement filed by the applicant pursuant to paragraph (1) shall explicitly require the opponent to furnish proof of genuine use.”.

*Amendment of Rule 20.*

8. Rule 20 of the Principal Rules is amended by substituting the following paragraphs for paragraph (2):

“(2) If the counter-statement filed in accordance with Rule 19 contains a request pursuant to section 43A(1) that the opponent furnish proof that the earlier mark(s) relied upon has been put to genuine use within the 5 year period allowed for doing so, and where that 5 year period had expired at or before the filing date or date of priority of the applicant’s mark, the Controller shall require the opponent to furnish such proof by way of statutory declaration in its evidence under paragraph (1) and shall send to the applicant a copy thereof.

(3) The Controller shall refuse to accept a request that an opponent furnish proof of use which is received after the opponent has filed evidence under paragraphs (1) and (2).

(4) Unless the Controller otherwise directs, an opponent who fails to file evidence, including proof of genuine use pursuant to paragraph (2), shall be deemed to have abandoned his or her opposition and the Controller shall proceed with the application accordingly.”.

*Amendment of Rule 41.*

9. Rule 41 of the Principal Rules is amended –

- (a) by substituting “*Procedure on application for revocation, and rectification of the register*” for the heading to this Rule,
- (b) in paragraph (1) by deleting “or for a declaration of invalidity under section 52”,
- (c) in paragraph (3) by deleting subparagraphs (c) and (d),
- (d) in paragraph (4) by deleting “In the case of an application to the Controller for revocation under section 51 or for the rectification of an error or omission in the register under section 67,”.

10. The Principal Rules are amended by the insertion of the following Rules after Rule 41:

*“Procedure on application for declaration of invalidity*

41A. (1) An application to the Controller for a declaration of invalidity under section 52 shall contain a statement of the grounds on which the application is made and shall be accompanied by the prescribed fee.

(2) Where any application is made under paragraph (1) of this Rule, the Controller shall send a copy of the application and the statement to the proprietor.

*Counter-statement*

41B. (1) Within three months of the issue by the Controller of the application for a declaration of invalidity to the proprietor, the proprietor may file a counter-statement in duplicate with the Controller.

(2) Subject to paragraph (1), should the proprietor of the later trade mark wish to invoke the provisions of section 52A(1), the proprietor must put the applicant for a declaration of invalidity to such notice in its counter-statement, failing which the Controller shall reject any subsequent attempts by the proprietor to put the applicant for a declaration of invalidity to such notice.

(3) The Controller shall not declare a trade mark to be invalid merely because the proprietor fails to file a counter-statement.

*Evidence in support of application for declaration of invalidity*

41C. (1) Within three months of the issue by the Controller to the applicant of a copy of the counter-statement under Rule 41B, the applicant shall file with the Controller such evidence by way of statutory declaration as he or she desires to adduce in support of his or her application for a declaration of invalidity and shall send to the other party a copy thereof.

(2) If the proprietor’s counter-statement contains a request pursuant to section 52A that the applicant furnish proof that the earlier trade mark(s) relied upon have been put to genuine use within the 5 year period allowed for doing so, and where that 5 year period had expired at the filing date or date of priority of the proprietor’s later trade mark, the applicant shall file such proof of use, (as required by section 52A(2)), by way of statutory declaration and shall send to the proprietor a copy thereof.

(3) Thereafter, the provisions of Rules 21 to 25 shall apply mutatis mutandis.

(4) An applicant for a declaration of invalidity who fails to file evidence under paragraph (1) shall be deemed to have abandoned his or her application for a declaration of invalidity.

(5) In the event of failure to file proof under paragraph (2) if so requested, the application for a declaration of invalidity on the basis of an earlier trade mark shall be rejected pursuant to section 52A(3).”.

*Amendment of Rule 60.*

11. Rule 60 of the Principal Rules is amended in paragraph 3(f) by inserting “and Rule 41A(1)” after “applications under Rule 41(1)”.

*Amendment of Rule 63.*

12. Rule 63 of the Principal Rules is amended by substituting the following paragraph for paragraph (2):

“(2) The Rules excepted from paragraph (1) of the Rules are Rule 10(3) (failure to file address for service), Rule 12(5) (time limit for payment of application fee), Rule 18(1) (time for filing opposition to registration), Rule 19(1) (time for filing counter-statement), Rule 25(3) (election by party to file written submissions in lieu of attending at a hearing), Rule 39 (delayed renewal), Rule 40 (restoration of registration) and Rule 41B(1) (time for filing counter-statement in response to an application for a declaration of invalidity).”.

13. Schedule 3 of the Patents, Trade Marks and Designs (Fees) Rules 2001 (S.I. No. 482 of 2001) is amended in reference 15 by inserting “or Rule 41A” within the brackets, after “(Rule 41)”.

GIVEN under my hand,  
11 December 2019

JOHN HALLIGAN,  
Minister of State at the Department of Business, Enterprise and  
Innovation

## EXPLANATORY NOTE

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

The amendment of Rule 10 is a consequence of the separation of procedures for dealing with rectifications of the register and revocations (Rule 41) from those dealing with applications for declarations of invalidity (now under new Rule 41A).

The inclusion of new Rule 17A is to set out the modalities for filing observations on bad faith grounds in relation to a trade mark application.

The inclusion of new Rule 18A is for the purpose of setting a maximum period for any stay requested in opposition proceedings.

The amendment to Rule 19 is to set out when, in opposition proceedings, an applicant for the registration of a trade mark may request the opponent to furnish proof of use.

The amendment to Rule 20 sets out the requirements for an opponent, subject to a request pursuant to section 43A of the Trade Marks Act of 1996, to file proof of use of their trade mark.

The amendments to Rule 41 are for the purposes of confining the rule to provisions relating to revocations and rectifications of the register.

New Rules 41A, 41B and 41C are for the purposes of setting out separate procedures for a declaration of invalidity which were previously in Rule 41.

The amendment to Rule 60 is to ensure that applications for a declaration of invalidity continue to be available for inspection under certain prescribed conditions.

The amendment to Rule 63 is to provide that the time period for filing a counter-statement in invalidity proceedings cannot be extended beyond the period provided for in Rule 41B(1).

The amendment to Schedule 3 of SI 482 of 2001 - Patents, Trade Marks and Designs (Fees) Rules, 2001 is for the purposes of inserting a reference to new Rule 41A in the fee item at reference No. 15.

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