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TRADE MARKS ACT (CHAPTER 332)

TRADE MARKS (INTERNATIONAL REGISTRATION) (AMENDMENT) RULES 2019

In exercise of the powers conferred by sections 54(1) and 108(1) of the Trade Marks Act, the Minister for Law makes the following Rules:

Citation and commencement

1. These Rules are the Trade Marks (International Registration) (Amendment) Rules 2019 and come into operation on 1 April 2019.

Deletion and substitution of rule 5A

2. Rule 5A of the Trade Marks (International Registration) Rules (R 3) (called in these Rules the principal Rules) is deleted and the following rule substituted therefor:

“Request for division of international registration designating Singapore

5A.—(1) Subject to the provisions of this rule, the holder of an international registration designating Singapore (called in this rule a principal registration) for 2 or more goods or services (called in this rule the subject goods or services) may make a request to the International Bureau through the Registrar, to divide the principal registration into 2 international registrations designating Singapore (called in this rule a divisional registration), each for —

- (a) one or more classes of goods or services to which the subject goods or services belong; or
- (b) one or more of the subject goods or services.

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- (2) A request made under paragraph (1) must —
- (a) be made before the date the principal registration becomes a protected international trade mark (Singapore);
 - (b) be made in Form MM 22(E);
 - (c) specify the name of the holder of the principal registration;
 - (d) specify the number of the principal registration given by the International Bureau;
 - (e) contain, for each divisional registration sought and each class of goods or services for which the divisional registration is sought, a specification in accordance with rule 19 of the Trade Marks Rules (R 1) (as applied under rule 5 of the principal Rules) setting out the goods or services to which that divisional registration relates; and
 - (f) be accompanied by the address for service in Singapore of the holder of the principal registration, if the address has not been furnished to the Registrar under rule 11(6) or filed with the Registrar under rule 14(1)(b).
- (3) The Registrar must notify the International Bureau of a request for a division of a principal registration that is made in accordance with paragraph (2).
- (4) Where the Registrar is notified by the International Bureau that the principal registration has been divided into 2 divisional registrations, the Registrar must —
- (a) record the details of each divisional registration in the register, and for this purpose, each divisional registration must be recorded in the register as having the same date as the principal registration; and
 - (b) inform the holder of the principal registration of the details of each divisional registration by notice in writing sent to the address —

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- (i) furnished to the Registrar under rule 11(6) or filed with the Registrar under rule 14(1)(b) as the holder's address for service in Singapore; or
 - (ii) accompanying the request made under paragraph (1) as the holder's address for service in Singapore,

as the case may be.

(5) Upon the division of the principal registration into 2 divisional registrations by the International Bureau —

(a) any notice of opposition to the conferring of protection on the principal registration filed with the Registrar must —

- (i) if the notice relates only to some (but not all) of the goods or services to which the principal registration relates, be treated as having been given in relation only to the divisional registration for the goods or services to which the notice relates; or
- (ii) if the notice relates to all of the goods or services to which the principal registration relates, be treated as having been given in relation to both of the divisional registrations,

and the opposition proceedings are to continue as if the notice had been so given; and

(b) any notice given to the Registrar under section 41(3) of the Act claiming an interest in or under the principal registration must —

- (i) if the notice relates only to some (but not all) of the goods or services to which the principal registration relates, be treated as having been given in relation only to the divisional registration for the goods or services to which the notice relates; or

- (ii) if the notice relates to all of the goods or services to which the principal registration relates, be treated as having been given in relation to both of the divisional registrations.”.

Deletion and substitution of rule 7

3. Rule 7 of the principal Rules is deleted and the following rule substituted therefor:

“Protected international trade mark (Singapore) and international registration designating Singapore as objects of property

7. The provisions of sections 36, 37, 38, 40 and 41 of the Act apply, with the necessary modifications, in relation to a protected international trade mark (Singapore) or an international registration designating Singapore as they apply in relation to a registered trade mark or an application for the registration of a trade mark, as the case may be.”.

Amendment of rule 8

4. Rule 8 of the principal Rules is amended —

- (a) by inserting, immediately after the words “protected international trade mark (Singapore)” in paragraph (1)(a), the words “or an international registration designating Singapore”;
- (b) by deleting sub-paragraph (b) of paragraph (1) and substituting the following sub-paragraphs:

“(b) an order of the Court or other competent authority transferring —

- (i) a protected international trade mark (Singapore);
- (ii) an international registration designating Singapore; or
- (iii) any right in or under a protected international trade mark (Singapore)

or an international registration designating Singapore;

(c) the making by personal representatives of an assent to a licence in relation to —

(i) a protected international trade mark (Singapore);

(ii) an international registration designating Singapore; or

(iii) any right in or under a protected international trade mark (Singapore) or an international registration designating Singapore.”;

(c) by inserting, immediately after the words “protected international trade mark (Singapore)” in paragraph (2)(a), the words “or an international registration designating Singapore”;

(d) by deleting sub-paragraphs (b), (c) and (d) of paragraph (3) and substituting the following sub-paragraphs:

“(a) an assignment of —

(i) a protected international trade mark (Singapore);

(ii) an international registration designating Singapore; or

(iii) any right in a protected international trade mark (Singapore) or an international registration designating Singapore;

(b) the making by personal representatives of an assent (other than an assent to a licence) in relation to —

(i) a protected international trade mark (Singapore);

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- (ii) an international registration designating Singapore; or
 - (iii) any right in or under a protected international trade mark (Singapore) or an international registration designating Singapore;
 - (c) the granting of any security interest (whether fixed or floating) over —
 - (i) a protected international trade mark (Singapore);
 - (ii) an international registration designating Singapore; or
 - (iii) any right in or under a protected international trade mark (Singapore) or an international registration designating Singapore.”;
 - (e) by deleting the words “in ignorance of it” in paragraph (4) and substituting the words “or the international registration designating Singapore in ignorance of the transaction”;
 - (f) by deleting paragraph (5) and substituting the following paragraph:
 - “(5) A person who becomes the proprietor of a protected international trade mark (Singapore) or an international registration designating Singapore by virtue of a notifiable transaction mentioned in paragraph (1)(b) or a relevant transaction is not entitled to damages, an account of profits or statutory damages under section 31(5)(c) of the Act in respect of any infringement of the protected international trade mark (Singapore) or the international registration designating Singapore occurring —
 - (a) after the date of the transaction and before the notifiable transaction is entered in the register; or

(b) after the date of the transaction and before the relevant transaction is recorded in the International Register,

as the case may be.”;

(g) by deleting paragraph (5A); and

(h) by deleting paragraph (6) and substituting the following paragraph:

“(6) In this rule, “relevant particulars” means —

(a) in relation to a notifiable transaction mentioned in paragraph (1)(a) or (c) —

(i) the name and address of the licensee;

(ii) where the licence is an exclusive licence — that fact;

(iii) where the licence is limited — a description of the limitation; and

(iv) the duration of the licence if the same is, or is ascertainable as, a definite period; and

(b) in relation to a notifiable transaction mentioned in paragraph (1)(b) —

(i) the name and address of the transferee;

(ii) the date of the order; and

(iii) where the transfer is in respect of a right in or under a protected international trade mark (Singapore) or an international registration designating Singapore, a description of the right transferred.”.

Amendment of rule 28**5. Rule 28 of the principal Rules is amended —**

(a) by deleting paragraph (1) and substituting the following paragraph:

“(1) Where the Registrar has submitted an application for international registration, the Registrar must —

(a) notify the International Bureau of the occurrence of any of the events specified in paragraph (2); and

(b) if applicable, request the International Bureau to cancel the international registration as regards those goods or services covered by the international application in respect of which the basic application or basic registration has ceased to subsist by reason of that event.”;

(b) by deleting sub-paragraph (b) of paragraph (2) and substituting the following sub-paragraph:

“(b) proceedings opposing the basic application that begun before the expiry of the period of 5 years after the date of the international registration have resulted in a final decision —

(i) to register or not to register the trade mark as regards some or all of the goods or services covered by the international registration — where the final decision is made after the expiry of that period of 5 years; or

(ii) not to register the trade mark as regards some or all of the goods or services covered by the international registration — where the final

decision is made before the expiry of that period of 5 years;”;

(c) by deleting sub-paragraph (e) of paragraph (2) and substituting the following sub-paragraph:

“(e) proceedings that begun before the expiry of the period of 5 years after the date of the international registration have resulted in a final decision —

(i) to revoke or declare invalid the registration resulting from the basic application, or the basic registration, as regards some or all of the goods or services covered by the international registration, or not to effect such revocation or make such declaration — where the final decision is made after the expiry of that period of 5 years; or

(ii) to revoke or declare invalid the registration resulting from the basic application, or the basic registration, as regards some or all of the goods or services covered by the international registration — where the final decision is made before the expiry of that period of 5 years;”;

(d) by deleting the full-stop at the end of sub-paragraph (f) of paragraph (2) and substituting a semi-colon, and by inserting immediately thereafter the following sub-paragraph:

“(g) proceedings mentioned in sub-paragraph (a), (b), (c), (e) or (f) that begun before the expiry of the period of 5 years after the date of the international registration have not resulted in a final decision by the expiry of that period.”.

Deletion of rule 33

6. Rule 33 of the principal Rules is deleted.

Amendment of First Schedule

7. The First Schedule to the principal Rules is amended by deleting “—” in item 4 under the heading “*Corresponding Form(s)*” and substituting “MM2(E)”.

Amendment of Second Schedule

8. The Second Schedule to the principal Rules is amended by inserting, immediately after the item relating to MM2(E), the following item:

“MM 22(E) Request to divide an international registration designating Singapore that relates to 2 or more goods or services into 2 international registrations designating Singapore, each for one or more of those goods or services”.

Saving and transitional provisions

9.—(1) Despite rule 4, an application for the registration of the relevant particulars of a notifiable transaction mentioned in rule 8(1)(b) of the principal Rules as in force immediately before 1 April 2019 that is made at any time before that date, and any subsequent entry of those particulars in the register, are each treated as a record of a relevant transaction in the International Register under rule 8(4)(b) of the principal Rules, for the purposes of rule 8(4) and (5) of those Rules.

(2) Despite rule 4, a record in the International Register of a relevant transaction under rule 8(3)(d) of the principal Rules as in force immediately before 1 April 2019 that is made at any time before that date is treated —

- (a) as an application for the registration of the relevant particulars of a notifiable transaction under rule 8(4)(a) of the principal Rules for the purposes of rule 8(4) of those Rules; and

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- (b) as an entry of a notifiable transaction in the register under rule 8(5)(a) of the principal Rules for the purposes of rule 8(5) of those Rules.
- (3) Despite rule 5 —
- (a) rule 28 of the principal Rules as in force immediately before 1 April 2019 continues to apply in relation to any event occurring before that date; and
- (b) rule 28 of the principal Rules as amended by rule 5 applies only in relation to any event occurring on or after that date.

*[G.N. Nos. S 372/2004; S 853/2005; S 162/2007;
S 597/2008; S 589/2011; S 740/2014; S 23/2017;
S 150/2017]*

Made on 27 February 2019.

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