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**No. S 23**

**TRADE MARKS ACT  
(CHAPTER 332)**

**TRADE MARKS (INTERNATIONAL REGISTRATION)  
(AMENDMENT) RULES 2017**

In exercise of the powers conferred by sections 54 and 108 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 2017 and come into operation on 31 January 2017.

**Amendment of rule 13**

2. Rule 13 of the Trade Marks (International Registration) Rules (R 3) (called in these Rules the principal Rules) is amended —

- (a) by deleting “(8)” in paragraphs (4) and (5) and substituting in each case “(7)”; and
- (b) by inserting, immediately after paragraph (6), the following paragraph:

“(7) Despite paragraphs (4) and (5), rule 29(3) to (8) of the Trade Marks Rules as in force immediately before 31 January 2017 continues to apply, with the necessary modifications, to any notice of opposition to be filed in relation to an international registration designating Singapore the particulars of which were published in the Trade Marks Journal before that date.”.

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**Amendment of rule 14****3. Rule 14 of the principal Rules is amended —**

(a) by deleting sub-paragraph (b) of paragraph (1) and substituting the following sub-paragraph:

“(b) an address for service in Singapore in the same Form HC6, unless an address for service has previously been filed.”;

(b) by deleting paragraph (4) and substituting the following paragraphs:

“(4) A request for an extension of time to file the counter-statement —

(a) must be made to the Registrar in Form HC3 within 4 months after the date of the Registrar’s notification of refusal based on opposition to the International Bureau; and

(b) must state —

(i) the reason for the extension; and

(ii) the name and address of every person likely to be affected by the extension.

(4A) The holder must, at the time the request mentioned in paragraph (4) is filed with the Registrar, serve on the opponent, and on each person likely to be affected by an extension of time to file the counter-statement, a copy of that request.”; and

(c) by deleting paragraphs (6) to (9) and substituting the following paragraphs:

“(6) The Registrar may refuse to grant an extension of time to file the counter-statement if the holder —

(a) fails to show a good and sufficient reason for the extension; or

(b) fails to show to the Registrar’s satisfaction that the request mentioned in paragraph (4) has been served on the opponent and on each person likely to be affected by the extension.

(7) Upon granting an extension of time to file the counter-statement, the Registrar must send a notification of the extension to the opponent and each person mentioned in paragraph (4)(b)(ii).

(8) The opponent or any person likely to be affected by an extension of time to file the counter-statement may, not later than 2 weeks after the receipt of the Registrar’s notification of the extension, apply in writing to the Registrar for the revocation of the extension on the ground that the request mentioned in paragraph (4) had not been served on the opponent or on that person (as the case may be).”.

#### **Amendment of rule 15**

4. Rule 15 of the principal Rules is amended —

- (a) by deleting “32” in paragraphs (1) and (2) and substituting in each case “31A”; and
- (b) by inserting, immediately after paragraph (2), the following paragraphs:

“(3) Despite paragraphs (1) and (2) —

- (a) rules 31A to 34 of the Trade Marks Rules do not apply to any evidence to be adduced in any further proceedings mentioned in paragraph (1) where a counter-statement is filed before 31 January 2017 under rule 14; and
- (b) rules 32, 33 and 34 of the Trade Marks Rules as in force immediately before that date continue to apply, with the necessary modifications, to any such evidence.

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(4) Despite paragraphs (1) and (2), rule 38 of the Trade Marks Rules as in force immediately before 31 January 2017 continues to apply to or in relation to any opposition hearing under rule 37 of the Trade Marks Rules, arising from any further proceedings mentioned in paragraph (1), that ended before that date.”.

### **Amendment of rule 18**

5. Rule 18 of the principal Rules is amended by inserting, immediately after paragraph (4), the following paragraphs:

“(5) Despite paragraph (3), rule 58 of the Trade Marks Rules as in force immediately before 31 January 2017 continues to apply, with the necessary modifications, to the procedure relating to any counter-statement filed or to be filed in relation to any of the following:

- (a) an application filed before that date for revocation of the protection of a protected international trade mark (Singapore);
- (b) an application filed before that date for a declaration of invalidity of the protection of a protected international trade mark (Singapore).

(6) Despite paragraph (3), rule 59 of the Trade Marks Rules as in force immediately before 31 January 2017 continues to apply, with the necessary modifications, to the procedure relating to any further proceedings on any of the following applications where a counter-statement is filed before that date:

- (a) an application for revocation of the protection of a protected international trade mark (Singapore);
- (b) an application for a declaration of invalidity of the protection of a protected international trade mark (Singapore).”.

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**Amendment of rule 25**

6. Rule 25 of the principal Rules is amended by inserting, immediately after paragraph (3), the following paragraphs:

“(4) Despite paragraph (2)(b), rule 29 of the Trade Marks Rules as in force immediately before 31 January 2017 continues to apply, subject to such modifications as the Registrar may determine, to any notice of opposition filed or to be filed in relation to a transformation application made in respect of an international registration designating Singapore the particulars of which were published under rule 12 before that date.

(5) Despite paragraph (2)(b), rule 31 of the Trade Marks Rules as in force immediately before 31 January 2017 continues to apply, subject to such modifications as the Registrar may determine, to any counter-statement filed or to be filed in relation to either of the following:

- (a) a notice of opposition filed before that date under rule 13 that is treated as a notice of opposition against a transformation application;
- (b) a notice of opposition filed before that date under rule 29 of the Trade Marks Rules against a transformation application.

(6) Despite paragraph (2)(b) —

- (a) rules 31A to 34 of the Trade Marks Rules do not apply to any evidence to be adduced in any opposition proceedings arising from a transformation application where a counter-statement is filed before 31 January 2017 under rule 31 of the Trade Marks Rules; and
- (b) rules 32, 33 and 34 of the Trade Marks Rules as in force immediately before that date continue to apply, subject to such modifications as the Registrar may determine, to any such evidence.

(7) Despite paragraph (2)(b), rule 38 of the Trade Marks Rules as in force immediately before 31 January 2017 continues to apply, subject to such modifications as the Registrar may

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determine, to or in relation to any opposition hearing, arising from either of the following, that ended before that date:

- (a) a notice of opposition filed under rule 13 that is treated as a notice of opposition against a transformation application;
- (b) a notice of opposition filed under rule 29 of the Trade Marks Rules against a transformation application.”.

### **Amendment of rule 34**

7. Rule 34 of the principal Rules is amended by inserting, immediately after paragraph (2), the following paragraph:

“(3) Despite paragraph (2), rule 69(1B) of the Trade Marks Rules does not apply to any statutory declaration filed before 31 January 2017.”.

### **Saving and transitional provision**

8. Despite rule 3, rule 14 of the principal Rules as in force immediately before 31 January 2017 continues to apply to or in relation to any counter-statement filed or to be filed in relation to a notice of opposition filed before that date under rule 13 of the principal Rules, as if rule 3 had not been enacted.

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

Made on 22 December 2016.

NG HOW YUE  
*Permanent Secretary,  
Ministry of Law,  
Singapore.*