

TRADE MARKS ACT
(CHAPTER 332, SECTIONS 54 AND 108)

TRADE MARKS (INTERNATIONAL REGISTRATION) RULES

ARRANGEMENT OF RULES

PART I

PRELIMINARY

Rule

1. Citation
2. Definitions
3. Fees
4. Forms
- 4A. Electronic online system

PART II

INTERNATIONAL REGISTRATIONS DESIGNATING SINGAPORE

5. Entitlement to protection
- 5A. No division of international registration designating Singapore
6. Effects of protected international trade mark (Singapore)
7. Protected international trade mark (Singapore) as object of property
8. Notification of transactions
9. Licensing
10. Priority
11. Examination
12. Publication
13. Notice of opposition
14. Counter-statement
15. Further procedures
16. Notifications of refusal
17. Protection
18. Revocation and invalidity
19. Effect of acquiescence
20. Certificate of validity of contested registration
21. Importation of infringing goods
22. Offences

Rule

23. Falsely representing trade mark as protected international trade mark (Singapore)

PART III

TRANSFORMATION OF INTERNATIONAL REGISTRATION INTO
NATIONAL APPLICATION

24. Transformation application
25. Procedure on transformation application

PART IV

CONCURRENT REGISTRATIONS

26. Effects of international registration where trade mark is also registered under Act

PART V

INTERNATIONAL APPLICATIONS ORIGINATING IN SINGAPORE

27. Application for international registration
28. Notification to International Bureau

PART VI

MISCELLANEOUS PROVISIONS

29. Evidence of certain matters relating to international registration
30. Agents
31. Burden of proving use of protected international trade mark (Singapore)
32. Communication of information to International Bureau
33. Transmission of fees to International Bureau
34. Application of Trade Marks Rules
The Schedules

[31st October 2000]

PART I

PRELIMINARY

Citation

1. These Rules may be cited as the Trade Marks (International Registration) Rules.

Definitions

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

“Common Regulations” means the regulations adopted under Article 10 of the Madrid Protocol, with effect from 1st April 1996, as replaced, revised or amended from time to time;

“electronic online system” means the electronic online system established under rule 78A of the Trade Marks Rules (R 1);

[S 740/2014 wef 13/11/2014]

“international application” means an application to the International Bureau for registration of a trade mark in the International Register;

[Deleted by S 740/2014 wef 13/11/2014]

“International Register” means the register of trade marks maintained by the International Bureau for the purposes of the Madrid Protocol;

“international registration” means the registration of a trade mark in the International Register;

“international registration designating Singapore” means an international registration in which a request has been made (either in the relevant international application or subsequently) for extension of protection to Singapore under Article 3ter (1) or (2) of the Madrid Protocol;

“protected international trade mark (Singapore)” has the meaning given by rule 17, and references to “protection” and “protected” shall be construed accordingly.

Fees

3.—(1) The fees set out in the First Schedule shall be payable to the Registrar in respect of the matters set out in that Schedule.

(2) Unless otherwise provided for in these Rules, or the Registrar permits or directs otherwise —

(a) where a fee is specified in the First Schedule in respect of any matter, the fee shall be paid at the same time as the filing of the form corresponding to the matter; and

(b) if the fee is not paid, the form shall not be treated as filed.

[S 740/2014 wef 13/11/2014]

(3) Unless the Registrar permits or directs otherwise, payment of a fee in connection with an act referred to in rule 4A(a) shall be made using any mode of payment designated by the electronic online system if the act is carried out using that system.

[S 740/2014 wef 13/11/2014]

Forms

4.—(1) The Registrar shall publish on the Office's Internet website at <http://www.ipos.gov.sg> the forms referred to in these Rules.

[S 740/2014 wef 13/11/2014]

(2) Any form may be modified on the direction of the Registrar for use in a case other than the case for which it is intended.

(3) The Registrar may accept, in lieu of any form, any document which is filed with the Registry for any purpose for which the form was published but which deviates from the form, if the document —

(a) complies with every direction of the Registrar referred to in paragraph (2) which relates to the use of the form; and

[S 740/2014 wef 13/11/2014]

(b) is in a format that is acceptable to the Registrar.

[S 372/2004 wef 01/07/2004]

(4) Any reference in these Rules to a numbered form shall be construed as a reference to the current version of the form bearing the corresponding number which is described —

- (a) in the case of Forms MP1 and MP2, in the Second Schedule; or
- (b) in the case of any other form, in the Second Schedule to the Trade Marks Rules.

[S 740/2014 wef 13/11/2014]

Electronic online system

4A. The electronic online system may be used —

- (a) by any person for giving, sending to, filing with or serving on the Registrar or the Registry any document (other than a notice or document to be served in proceedings in court); and
- (b) by the Registrar or the Registry for giving, sending to or serving on any person any notice or other document (other than a notice or document to be served in proceedings in court).

[S 740/2014 wef 13/11/2014]

PART II

INTERNATIONAL REGISTRATIONS DESIGNATING SINGAPORE

Entitlement to protection

5.—(1) Subject to the provisions of rules 11 to 17, an international registration designating Singapore shall be entitled to become protected where, if the particulars of the international registration were comprised in an application for registration of a trade mark under the Act, such an application would satisfy the requirements for registration of a trade mark under the Act, including any imposed by the Trade Marks Rules.

(2) For the purpose of paragraph (1), sections 5 and 6 of the Act and rules 9, 15, 16, 18, 19(1), (2)(a) and (b)(i), (ii)(B) and (iii) and (3), 20 and 21 of the Trade Marks Rules shall be disregarded.

[S 853/2005 wef 01/01/2006]

[S162/2007 wef 02/07/2007]

No division of international registration designating Singapore

5A. Section 5A of the Act and rule 17 of the Trade Marks Rules (R 1) shall not apply to an international registration designating Singapore.

[S 162/2007 wef 02/07/2007]

Effects of protected international trade mark (Singapore)

6.—(1) The proprietor of a protected international trade mark (Singapore) has, subject to the provisions of these Rules, the same rights and remedies as are given by or under sections 26 to 29 and 31 to 34 of the Act to the proprietor of a registered trade mark.

(2) Paragraph (1) is subject to the provisions relating to acts not amounting to infringement and exhaustion which are applicable to a registered trade mark by virtue of sections 28 and 29 of the Act, respectively.

(3) For the purposes of the application of section 26 of the Act —

- (a) the rights of the proprietor shall have effect as of the date on which the protected international trade mark (Singapore) is to be treated as registered under rule 17 or 26; and
- (b) a protected international trade mark (Singapore) shall be treated as being in fact registered when it becomes protected under rule 17.

(4) For the purposes of paragraph (1), references in sections 27 and 28 of the Act to goods or services in respect of which a trade mark is registered shall be treated as references to goods or services in respect of which a protected international trade mark (Singapore) confers protection in Singapore.

(5) Where the holder of an international registration designating Singapore, by notice in writing sent to the Registrar —

- (a) disclaims any right to the exclusive use of any specified element of the trade mark; or
- (b) agrees that the rights conferred in Singapore by the international registration shall be subject to a specified territorial or other limitation,

the Registrar shall enter the disclaimer or limitation in the register and shall publish the disclaimer or limitation.

(6) Where a protected international trade mark (Singapore) is subject to a disclaimer or limitation, the rights conferred in relation to it by the application of section 26 of the Act are restricted accordingly.

(7) The remedy for groundless threats of infringement proceedings given by section 35 of the Act applies to a protected international trade mark (Singapore) as it applies in relation to a registered trade mark.

(8) For the purpose of paragraph (7) —

- (a) the reference in section 35(4) of the Act to the registration of the trade mark shall be treated as a reference to the protection of a protected international trade mark (Singapore); and
- (b) the reference in section 35(5) of the Act to notification that a trade mark is registered, or that an application for registration has been made, shall be treated as a reference to notification that a trade mark is a protected international trade mark (Singapore) or is the subject of an international application or international registration designating Singapore.

Protected international trade mark (Singapore) as object of property

7. The provisions of sections 36, 37, 38 and 40 of the Act shall, with the necessary modifications, apply in relation to a protected international trade mark (Singapore) as they apply in relation to a registered trade mark.

Notification of transactions

8.—(1) The following are notifiable transactions for the purpose of this rule:

- (a) the grant of a licence under a protected international trade mark (Singapore);

(b) the granting of any security interest (whether fixed or floating) over a protected international trade mark (Singapore) and any right in or under it.

(2) On application being made to the Registrar by —

(a) a person claiming to be entitled to an interest in or under a protected international trade mark (Singapore) by virtue of a notifiable transaction; or

(b) any other person claiming to be affected by such a transaction,

the relevant particulars of the transaction shall be entered in the register.

(3) The following are relevant transactions for the purpose of this rule:

(a) [*Deleted by S 372/2004 wef 01/07/2004*]

(b) an assignment of a protected international trade mark (Singapore) or any right in it;

(c) the making by personal representatives of an assent in relation to a protected international trade mark (Singapore) or any right in or under it;

(d) an order of the Court or other competent authority transferring a protected international trade mark (Singapore) or any right in or under it.

(4) Until —

(a) in the case of any notifiable transaction referred to in paragraph (1)(b), an application has been made for the registration of the relevant particulars of the transaction; or

(b) in the case of any relevant transaction, the transaction has been recorded in the International Register,

the transaction is ineffective as against a person acquiring an interest in or under the protected international trade mark (Singapore) in ignorance of it.

[*S 372/2004 wef 01/07/2004*]

(5) A person who becomes the proprietor of a protected international trade mark (Singapore) by virtue of any notifiable transaction referred to in paragraph (1)(b) or 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) occurring after the date of the transaction and before the transaction is recorded in the International Register.

[S 372/2004 wef 01/07/2004]

(5A) For the avoidance of doubt, paragraph (4) shall not apply to any relevant transaction relating to —

- (a) a licence under a protected international trade mark (Singapore); or
- (b) any right in or under the licence.

[S 372/2004 wef 01/07/2004]

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

- (a) in the case of the grant of a licence under a protected international trade mark (Singapore) —
 - (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;
- (b) in the case of the grant of any security interest over a protected international trade mark (Singapore) or any right in or under it —
 - (i) the name and address of the grantee;
 - (ii) the nature of the interest (whether fixed or floating); and
 - (iii) the extent of the security and the right in or under the trade mark secured.

Licensing

9.—(1) The provisions of sections 42 to 45 of the Act shall, with the necessary modifications, apply in relation to licences to use a protected international trade mark (Singapore) as they apply in relation to licences to use a registered trade mark.

(2) The reference in section 42(2) of the Act to goods or services for which a trade mark is registered shall be treated as a reference to goods or services in respect of which a trade mark is protected in Singapore.

Priority

10.—(1) Subject to paragraph (2), the provisions of section 10 of the Act shall apply so as to confer a right of priority in relation to protection of an international registration designating Singapore, as they apply in relation to registering a trade mark under the Act.

(2) The manner of claiming priority shall be determined in accordance with the Madrid Protocol and the Common Regulations.

Examination

11.—(1) Upon receiving from the International Bureau notification of an international registration designating Singapore, the Registrar shall examine whether it satisfies the requirements of rule 5.

(2) For the purpose of paragraph (1), the Registrar may carry out a search, to such extent as he considers necessary, of earlier trade marks.

(2A) Where the mark to which the international registration relates contains or consists of a word or words in characters other than Roman or in a language other than English, the Registrar may require the holder to —

- (a) file with the Registrar a translation in English to the satisfaction of the Registrar and, if the case requires, a transliteration in English to the satisfaction of the Registrar, of the word or words; and
- (b) indicate on the translation and the transliteration (if any) the language to which the word or words belong.

[S 740/2014 wef 13/11/2014]

(3) If it appears to the Registrar that the requirements of rule 5 are not met, or are met only in relation to some of the goods or services in respect of which protection in Singapore has been requested, he shall give notification of refusal to the International Bureau.

(4) The notification of refusal shall specify a period within which the holder may make representations.

(5) If the holder requires an extension of time to make representations, he shall file with the Registrar his request for an extension of time in Form CM5 before the expiry of the period in question or any extended period previously granted by the Registrar.

[S 740/2014 wef 13/11/2014]

(6) A holder making representations shall file with the Registrar an address for service in Singapore in Form CM2.

[S 740/2014 wef 13/11/2014]

(7) A request by the holder to the Registrar to change or correct an address for service shall be made in Form CM2.

[S 740/2014 wef 13/11/2014]

(8) The following shall be notified to the Registrar in Form CM1:

(a) any appointment of an agent for a matter for which no form is prescribed;

(b) any change of an agent for a matter.

[S 740/2014 wef 13/11/2014]

(9) Where an agent for a party to any proceedings intends to cease to act on the party's behalf —

(a) the agent shall file, and serve on the party and on the Registrar, a notice in Form CM1 of the intention to cease to act on the party's behalf; and

(b) upon complying with sub-paragraph (a), the agent shall cease to be the agent for the party.

[S 740/2014 wef 13/11/2014]

Publication

12. Where following examination it appears to the Registrar that the requirements of rule 5 are met in relation to some or all of the goods or services comprised in the international registration, the Registrar shall publish the particulars of the international registration in the Trade Marks Journal.

Notice of opposition

13.—(1) A person (referred to in these Rules as the opponent) may, within 2 months after the date of the publication of the international registration in the Trade Marks Journal, file with the Registrar a notice opposing the conferring of protection on the international registration (referred to in these Rules as the notice of opposition) in Form TM 11.

[S 853/2005 wef 01/01/2006]

[S 740/2014 wef 13/11/2014]

(2) The opponent shall enter an address for service in Singapore in the form referred to in paragraph (1).

(3) [*Deleted by S 597/2008 wef 01/12/2008*]

(4) Rules 29(3) to (7) and 30 of the Trade Marks Rules (R 1) shall, with the necessary modifications, apply to the filing and contents of a notice of opposition.

[S 23/2017 wef 31/01/2017]

(5) For the purposes of applying rule 29(3) to (7) of the Trade Marks Rules —

(a) a reference in that rule to the date of the publication of the application for registration shall be treated as a reference to the date of publication of the international registration in the Trade Marks Journal; and

(b) a reference in that rule to the applicant shall be treated as a reference to the holder.

[S 23/2017 wef 31/01/2017]

(6) Upon filing of a notice of opposition, the Registrar shall, within 5 months after the date of the publication of the international

registration in the Trade Marks Journal, give notification of refusal to the International Bureau stating the matters relating to the opposition.

[S 740/2014 wef 13/11/2014]

(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.

[S 23/2017 wef 31/01/2017]

Counter-statement

14.—(1) Within 4 months after the date of the Registrar’s notification of refusal based on opposition to the International Bureau, the holder shall file with the Registrar —

- (a) a counter-statement in Form HC6 setting out the grounds on which he relies as supporting the international registration designating Singapore, and the facts alleged in the notice of opposition which he admits, if any (referred to in these Rules as a counter-statement); and

[S 853/2005 wef 01/01/2006]

[S 740/2014 wef 13/11/2014]

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

[S 23/2017 wef 31/01/2017]

(2) *[Deleted by S 597/2008 wef 01/12/2008]*

(3) The holder shall at the same time serve on the opponent a copy of both documents.

(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.

[S 23/2017 wef 31/01/2017]

(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.

[S 23/2017 wef 31/01/2017]

(5) The total extension of time for which the Registrar may allow to file the counter-statement shall not exceed 6 months after the date of the Registrar's notification of refusal based on opposition to the International Bureau.

[S 740/2014 wef 13/11/2014]

(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.

[S 23/2017 wef 31/01/2017]

(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).

[S 23/2017 wef 31/01/2017]

(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).

[S 23/2017 wef 31/01/2017]

(9) *[Deleted by S 23/2017 wef 31/01/2017]*

(10) For the avoidance of doubt, if the holder fails to comply with paragraph (1) or (3) in relation to any class of goods or services in respect of which protection is opposed, the Registrar shall be entitled to treat the holder's request for protection in Singapore in respect of those goods or services as withdrawn, and the refusal shall subsist in respect of those goods or services.

[S 372/2004 wef 01/07/2004]

[S 597/2008 wef 01/12/2008]

Further procedures

15.—(1) Upon the filing of a notice of opposition under rule 13 and a counter-statement under rule 14, rules 31A to 40 of the Trade Marks Rules shall, with the necessary modifications, apply to further proceedings thereon.

[S 23/2017 wef 31/01/2017]

(2) For the purposes of applying rules 31A to 40 of the Trade Marks Rules —

- (a) a reference in those rules to the applicant shall be treated as a reference to the holder; and
- (b) a reference in those rules to the application shall be treated as a reference to the international registration designating Singapore.

[S 23/2017 wef 31/01/2017]

(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.

[S 23/2017 wef 31/01/2017]

(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.

[S 23/2017 wef 31/01/2017]

Notifications of refusal

16.—(1) Except where refusal is based on an opposition, a notification of refusal shall not be given after the expiry of 18 months after the date on which the notification of the international registration designating Singapore was sent to the Registrar.

[S 740/2014 wef 13/11/2014]

(2) Where there is a possibility that opposition may be filed after the expiry of the period of 18 months, the Registrar shall inform the International Bureau accordingly.

(3) A notification of refusal shall set out the matters required by Article 5 of the Madrid Protocol and Rule 17 of the Common Regulations.

(4) Where —

- (a) after a notification of refusal has been given under rule 11(3), the holder makes representations within the period specified in rule 11(4) or any extended period; or
- (b) after a notification of refusal based on opposition has been given under rule 13(6), the holder files a counter-statement within the period specified in rule 14(1) or any extended period,

the Registrar shall, upon a final decision being made in relation to the refusal, notify the International Bureau of that decision.

(5) For the purposes of paragraph (4), a final decision shall be regarded as being made where —

- (a) the Registrar or the Court on appeal from the Registrar decides whether the refusal shall be upheld, in whole or in relation to only some of the goods or services in relation to which protection in Singapore is requested, and any right of appeal against that decision expires or is exhausted;
- (b) the representations or counter-statement is withdrawn; or
- (c) the proceedings relating to the refusal are discontinued or abandoned.

Protection

17.—(1) Where —

(a) after examination and publication under rules 11 and 12 —

(i) the period of 18 months after the date on which the notification of the request for extension of protection to Singapore was sent to Singapore has not expired, but the period for giving notification of refusal based on an opposition in accordance with rule 13(6) expires without a notification of refusal (whether based on opposition or otherwise) having been given;

[S 740/2014 wef 13/11/2014]

(ii) the period of 18 months after the date on which the notification of the request for extension of protection to Singapore was sent to Singapore has expired, and the period for giving notice of opposition specified in rule 13(1) (including any extended period) expires without a notice of opposition having been given;

[S 740/2014 wef 13/11/2014]

(iii) notification of refusal has been given in respect of only some of the goods or services in respect of which protection in Singapore has been requested and the holder has made no representations within the period specified in rule 11(4) (including any extended period) or has filed no counter-statement within the

period specified in rule 14(1) (including any extended period), as the case may be; or that the holder has informed the Registrar that he does not intend to make such representations or file a counter-statement; or

(iv) notification of refusal has been given in respect of all or some of the goods or services in respect of which protection in Singapore has been requested and the Registrar notifies the International Bureau in accordance with rule 16(4) that a final decision has been made that the refusal is withdrawn, or is withdrawn in respect of some of the goods or services in respect of which protection in Singapore has been requested; or

(b) the period of 18 months after the date on which the notification of the request for extension of protection to Singapore was sent to Singapore expires without any notification of refusal having been given and without the International Bureau having been informed that oppositions may be filed after the expiry of that period,

[S 740/2014 wef 13/11/2014]

the trade mark which is the subject of the request for protection shall thereupon be protected as a protected international trade mark (Singapore); and in a case where a refusal subsists in respect of some of the goods or services in respect of which protection in Singapore has been requested, protection shall apply only as regards the remaining goods or services.

(2) For the purposes of the application by these Rules of the provisions of the Act, a trade mark so protected shall be treated as being registered under the Act as of —

(a) where the request for extension of protection to Singapore is mentioned in the international application, the date of the international registration; or

(b) where the request for such extension is made subsequently to the international registration, the date on which the request is recorded in the International Register.

(3) Paragraph (2) is subject to rule 26.

Revocation and invalidity

18.—(1) The provisions of sections 22 and 23 of the Act shall, with the necessary modifications, apply so as to permit the protection of a protected international trade mark (Singapore) to be revoked or declared invalid.

(2) For the purposes of applying sections 22 and 23 of the Act —

(a) the reference in section 22(1) of the Act to the date of completion of the registration procedure shall be treated as a reference to the date the protected international trade mark (Singapore) became protected;

(b) the reference in section 22(2) of the Act to the form in which a trade mark was registered shall be treated as a reference to the form in which it is protected;

(c) references in sections 22(6) and 23(9) of the Act to goods or services for which the trade mark is registered shall be treated as references to those in respect of which it is protected;

[S 162/2007 wef 02/07/2007]

(d) references in section 22 of the Act to the registration of a trade mark being revoked shall be treated as references to the protection of a protected international trade mark (Singapore) being revoked; and

(e) references in section 23 of the Act to the registration of a trade mark being declared invalid shall be treated as references to the protection of a protected international trade mark (Singapore) being declared invalid.

(3) The provisions of rules 57 to 60 of the Trade Marks Rules (R 1) shall, with the necessary modifications, apply to the procedure upon an application for revocation or a declaration of invalidity of protection of a protected international trade mark (Singapore).

(4) Where the protection of a protected international trade mark (Singapore) is revoked or declared invalid to any extent, the Registrar shall notify the International Bureau and —

- (a) in the case of a revocation, the rights of the proprietor shall be deemed to have ceased to exist to that extent as from the date of the application for revocation, or if the Registrar or the Court is satisfied that the grounds for revocation existed at an earlier date, that date;
- (b) in the case of a declaration of invalidity, the trade mark shall to that extent be deemed never to have been a protected international trade mark (Singapore), but this shall not affect transactions past and closed as at the date when the invalidity is recorded in the International Register.

(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).

[S 23/2017 wef 31/01/2017]

(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).

[S 23/2017 wef 31/01/2017]

Effect of acquiescence

19.—(1) Section 24 of the Act applies where the proprietor of an earlier trade mark has acquiesced for a continuous period of 5 years in the use of a protected international trade mark (Singapore).

(2) For the purpose of applying section 24 of the Act —

- (a) the reference in that section to a registered trade mark shall be treated as a reference to a protected international trade mark (Singapore); and
- (b) references in that section to registration shall be treated as references to protection of a protected international trade mark (Singapore).

Certificate of validity of contested registration

20. The provisions of section 102 of the Act shall, with the necessary modifications, apply in relation to proceedings before the Court in which the validity of the protection of a protected international trade mark (Singapore) is contested.

Importation of infringing goods

21.—(1) The provisions of Part X of the Act and the Trade Marks (Border Enforcement Measures) Rules (R 2) shall, with the necessary modifications, apply in relation to goods which are, in relation to a protected international trade mark (Singapore), infringing goods within the meaning of section 3 of the Act.

(2) For the purpose of paragraph (1), references in section 3 and Part X of the Act and in the Trade Marks (Border Enforcement Measures) Rules to a registered trade mark shall be treated as references to a protected international trade mark (Singapore).

Offences

22.—(1) The provisions of sections 46 to 49 and 53 of the Act shall, with the necessary modifications, apply in relation to a protected international trade mark (Singapore).

- (2) For the purpose of the application of those provisions —
- (a) references in those provisions to a registered trade mark shall be treated as references to a protected international trade mark (Singapore); and
 - (b) references in those provisions to goods or services for which a trade mark is registered shall be treated as references to goods or services in respect of which a protected international trade mark (Singapore) confers protection in Singapore.

Falsely representing trade mark as protected international trade mark (Singapore)

23. Any person who —
- (a) falsely represents that a mark is a protected international trade mark (Singapore); or
 - (b) makes a false representation as to the goods or services for which a protected international trade mark (Singapore) confers protection in Singapore,

knowing or having reason to believe that the representation is false shall be guilty of an offence and shall be liable on conviction to a fine not exceeding \$10,000.

PART III

TRANSFORMATION OF INTERNATIONAL REGISTRATION
INTO NATIONAL APPLICATION

Transformation application

- 24.—(1) The provisions of this rule shall apply where —
- (a) an international registration designating Singapore is cancelled at the request of the Office of Origin under Article 6(4) of the Madrid Protocol in respect of all or some of the goods or services listed in the registration;
 - (b) an application (referred to in this Part as a transformation application) is made to the Registrar, within 3 months after

the date on which the international registration was cancelled, for registration in Singapore of a trade mark identical to that comprised in the international registration in respect of all or some of the goods or services in respect of which the international registration was cancelled; and

[S 740/2014 wef 13/11/2014]

- (c) the application is made by the person who was the holder of the international registration immediately before its cancellation.

(2) A transformation application shall be filed with the Registrar on Form MP 1.

[S 372/2004 wef 01/07/2004]

(3) A trade mark registered pursuant to a transformation application shall be treated as if it were registered —

- (a) on the date of the international registration in accordance with Article 3(4) of the Madrid Protocol; or
- (b) where the request for extension to Singapore was made subsequent to the international registration, on the date of recordal of that request in accordance with Article 3^{ter} (2) of the Madrid Protocol,

and that date shall be deemed for the purposes of the Act to be the date of registration of the trade mark.

Procedure on transformation application

25.—(1) Where the protected international trade mark (Singapore) has become protected under rule 17 on or before the actual date on which the transformation application is made (referred to in this rule as the transformation date), the trade mark shall be registered under the Act.

(2) Where the international registration designating Singapore has not become protected under rule 17 by the transformation date and its particulars have been published under rule 12 —

- (a) the Registrar shall treat the publication of its particulars as the publication of the transformation application under section 13(1) of the Act; and
- (b) the Registrar shall treat any opposition to its protection under rule 13 as an opposition to its registration under section 13(2) of the Act, and rules 29 to 40 of the Trade Marks Rules (R 1) shall apply subject to such modifications as the Registrar may determine.

(3) Where particulars of the international registration designating Singapore have not yet been published under rule 12 by the transformation date and the Registrar has issued a notification of refusal under rule 11(3), the Registrar shall for the purposes of the transformation application treat the notification of refusal as a notice issued by the Registrar to the applicant under section 12(3) of the Act.

(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.

[S 23/2017 wef 31/01/2017]

(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.

[S 23/2017 wef 31/01/2017]

(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.

[S 23/2017 wef 31/01/2017]

(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 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.

[S 23/2017 wef 31/01/2017]

PART IV

CONCURRENT REGISTRATIONS

Effects of international registration where trade mark is also registered under Act

26.—(1) The provisions of this rule apply where —

- (a) a registered trade mark is also a protected international trade mark (Singapore);
- (b) the proprietor of the registered trade mark is the holder of the protected international trade mark (Singapore);

- (c) all the goods or services in respect of which the registered trade mark is registered are protected under the protected international trade mark (Singapore); and
- (d) the date of registration of the registered trade mark is earlier than the date specified in rule 17(2) in relation to the protected international trade mark (Singapore).

(2) For the purposes of the application by these Rules of the provisions of the Act, the protected international trade mark (Singapore) shall, notwithstanding the provisions of rule 17(2), be treated as being registered under the Act as of the date of registration of the registered trade mark as regards all the goods or services in respect of which the registered trade mark was registered.

(3) For the purposes of determining whether the protected international trade mark (Singapore) is an earlier trade mark, it shall be treated as having the date of application of the registered trade mark as regards all the goods or services in respect of which the registered trade mark was registered, taking account (where appropriate) of the priorities claimed in respect of the registered trade mark.

(4) Where the conditions specified in paragraph (1) are satisfied in relation to a trade mark, the provisions of paragraphs (2) and (3) shall —

- (a) continue to apply in respect of the relevant protected international trade mark (Singapore) notwithstanding that the relevant registered trade mark lapses or is cancelled; but
- (b) cease to apply if it is revoked or declared invalid.

(5) On the application of the holder of the protected international trade mark (Singapore) on Form MP 2, the Registrar shall note in the register that the international registration replaces the registered trade mark as regards the goods or services in respect of which the registered trade mark was registered.

[S 372/2004 wef 01/07/2004]

(6) The provisions of this rule are without prejudice to any right or remedy conferred on any person in respect of the registered trade mark.

PART V

INTERNATIONAL APPLICATIONS ORIGINATING IN
SINGAPORE**Application for international registration**

27.—(1) An applicant for the registration of a trade mark, or the proprietor of a registered trade mark, may, subject to the provisions of this rule, apply through the Registrar for the international registration of the trade mark —

- (a) by filing Form MM2(E); and
- (b) by filing the address for service in Singapore of the applicant or proprietor, as the case may be.

[S 740/2014 wef 13/11/2014]

(2) An application for international registration shall be filed in English and may be made only where the applicant for such registration is —

- (a) a citizen of Singapore;
- (b) a body or corporation incorporated or constituted under the law of Singapore;
- (c) a person domiciled in Singapore; or
- (d) a person who has a real and effective industrial or commercial establishment in Singapore.

(3) The particulars appearing in the application (other than the address for service in Singapore of the applicant) shall correspond with the particulars appearing at that time in the basic application or basic registration, as the case may be.

[S 740/2014 wef 13/11/2014]

(4) The applicant shall provide at the request of the Registrar such evidence as may be necessary to satisfy him that the applicant is eligible to make the application in accordance with paragraph (2).

(5) The application referred to in paragraph (1), and the applicant's address for service in Singapore referred to in that paragraph, may be filed using the electronic online system.

[S 740/2014 wef 13/11/2014]

(6) If the international application complies with the requirements set out in this rule, the Registrar shall submit the international application to the International Bureau.

(7) In this rule and rule 28 —

“basic application”, in relation to an application for international registration, means an application for registration of a trade mark in Singapore in respect of which the application for international registration is made;

“basic registration”, in relation to an application for international registration, means a trade mark registered in Singapore in respect of which the application for international registration is made.

Notification to International Bureau

28.—(1) Where the Registrar has submitted an application for international registration, he shall notify the International Bureau of the occurrence of any of the events specified in paragraph (2), and shall 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.

(2) The events referred to in paragraph (1) are as follows:

(a) before the expiry of the period of 5 years after the date of the international registration, the Registrar —

(i) refuses to accept the basic application as regards some or all of the goods or services covered by the international registration; or

(ii) after accepting the application, refuses to register the trade mark as regards some or all of those goods or services, having regard to matters coming to his notice since he accepted the application,

and in either case that decision becomes a final decision, whether before or after the expiry of that period of 5 years;

[S 740/2014 wef 13/11/2014]

(aa) the basic application —

(i) is, before the expiry of the period of 5 years after the date of the international registration, treated as withdrawn under —

(A) rule 9(6)(a), 21(5) or 24(2) of the Trade Marks Rules (R 1);

(B) paragraph 6(3) or 7(3A) of the First Schedule to the Act; or

(C) paragraph 7(3) or 8(3A) of the Second Schedule to the Act; and

[S 740/2014 wef 13/11/2014]

(ii) is not reinstated under rule 77B of the Trade Marks Rules, whether before or after the expiry of that period of 5 years.

[S 853/2005 wef 01/01/2006]

[S 162/2007 wef 02/07/2007]

(b) opposition proceedings begun before the expiry of the period of 5 years after the date of the international registration resulting in a final decision not to register the trade mark as regards some or all of the goods or services covered by the international registration;

[S 740/2014 wef 13/11/2014]

(c) the basic application is withdrawn, or is restricted as regards goods or services covered by the international registration, as a result of a request by the applicant made —

(i) before the expiry of the period of 5 years after the date of the international registration; or

[S 740/2014 wef 13/11/2014]

(ii) subsequently when the basic application was at the time of the request subject to an appeal against refusal of registration or to opposition proceedings, begun in either case before the expiry of the period of 5 years;

- (d) the registration resulting from the basic application or the basic registration expires without renewal and is removed from the register before the expiry of the period of 5 years after the date of the international registration, and no request for its restoration is made within the period specified in rule 53 of the Trade Marks Rules (R 1); or such a request is made and a final decision is made refusing the request;

[S 740/2014 wef 13/11/2014]

- (e) a final decision is made to revoke or declare invalid the registration resulting from the basic application or the basic registration, as a result of proceedings begun before the expiry of the period of 5 years after the date of the international registration;

[S 740/2014 wef 13/11/2014]

- (f) the registration resulting from the basic application or the basic registration is cancelled as a result of a request by the proprietor made before the expiry of the period of 5 years after the date of the international registration, or made subsequently where, at the time of the request —

- (i) the registration resulting from the basic application or the basic registration was subject to proceedings for revocation or invalidation; and
- (ii) such proceedings were begun before the expiry of the period of 5 years after the date of the international registration.

[S 740/2014 wef 13/11/2014]

- (3) For the purposes of this rule —

- (a) a final decision shall be regarded as made where —
- (i) any right of appeal against the decision expires or is exhausted; or
 - (ii) proceedings relating to an application or registration are discontinued or abandoned; and

- (b) a reference to an application being withdrawn includes its being deemed withdrawn, abandoned, or never to have been made.

PART VI

MISCELLANEOUS PROVISIONS

Evidence of certain matters relating to international registration

29.—(1) In all legal proceedings relating to a protected international trade mark (Singapore), the registration of a person as the holder of a protected international trade mark (Singapore) shall be prima facie evidence of the validity of the original international registration and of any subsequent assignment or other transmission of it.

(2) Judicial notice shall be taken of the following:

- (a) the Madrid Protocol and the Common Regulations;
- (b) a copy of an entry in the International Register issued by the International Bureau;
- (c) a copy of the periodical gazette published by the International Bureau.

(3) Any document mentioned in paragraph (2)(b) or (c) shall be admissible as evidence of any instrument or other act of the International Bureau thereby communicated.

(4) Evidence of any instrument issued by the International Bureau or any entry in or extract from such a document may be given in any such proceedings by production of a copy; and such document purporting to be such a copy shall be received in evidence.

(5) In this rule, “legal proceedings” include proceedings before the Registrar.

Agents

30. Any act required or authorised by these Rules to be done by or to a person in connection with a request for protection of an international registration as a protected international trade mark (Singapore), or any

procedure relating to a protected international trade mark (Singapore), may be done by or to an agent authorised by that person orally or in writing.

Burden of proving use of protected international trade mark (Singapore)

31. If in any civil proceedings relating to a protected international trade mark (Singapore), a question arises as to the use to which the trade mark has been put, it is for the holder to show what use has been made of it.

Communication of information to International Bureau

32. Notwithstanding any enactment or rule of law, the Registrar may communicate to the International Bureau any information which Singapore is required to communicate by virtue of these Rules or pursuant to the Madrid Protocol or the Common Regulations.

Transmission of fees to International Bureau

33. The Registrar may accept for transmission to the International Bureau fees payable to the International Bureau in respect of an application for international registration originating in Singapore or a renewal of such an international registration, subject to such terms and conditions as he may specify either —

- (a) generally by published notice; or
- (b) in any particular case, by written notice to the applicant desiring to make payment by such means.

Application of Trade Marks Rules

34.—(1) Except as otherwise provided in these Rules, the Trade Marks Rules (R 1) shall, with the necessary modifications, apply in relation to an international registration designating Singapore and to a protected international trade mark (Singapore) as they apply in relation to an application for registration of a trade mark and to a registered trade mark.

(2) The provisions of rules under the Trade Marks Rules relating to costs and security for costs and to evidence before the Registrar shall

apply in relation to proceedings under these Rules in the same manner as they apply in relation to proceedings relating to a registered trade mark or application for registration of a trade mark.

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

[S 23/2017 wef 31/01/2017]

FIRST SCHEDULE

Rule 3

FEES

<i>Matter</i>	<i>Corresponding Rule(s)</i>	<i>Fee</i>	<i>Corresponding Form(s)</i>
1. Filing of a transformation application	24(2)	\$374 per class of goods or services	MP 1
2. Application to record replacement of registered trade mark with international registration	26(5)	\$65 per class of goods or services	MP 2
3. <i>[Deleted by S 740/2014 wef 13/11/2014]</i>			
4. Application for international registration through Registrar	27(1)	\$250*	—
5. Request for handling a request for renewal of international registration or fee thereof payable to International Bureau	—	\$85*	—

*This fee does not include any fee payable to the International Bureau for that

FIRST SCHEDULE — *continued*

application or request.

[S 740/2014 wef 13/11/2014]

[S 589/2011 wef 01/12/2011]

SECOND SCHEDULE

Rule 4(4)

DESCRIPTIONS OF FORMS

<i>Form</i>	<i>Description of Form</i>
MP 1	Request to transform an international registration into national application(s)
MP 2	Request to replace Singapore national registration with international registration
MM2(E)	Application for international registration governed exclusively by the Madrid Protocol

[S 740/2014 wef 13/11/2014]

[[S 372/2004 wef 01/07/2004]

[G. N. Nos. S 490/2000; S 662/2001]

LEGISLATIVE HISTORY
TRADE MARKS (INTERNATIONAL REGISTRATION) RULES
(CHAPTER 332, R 3)

This Legislative History is provided for the convenience of users of the Trade Marks (International Registration) Rules. It is not part of these Rules.

1. G. N. No. S 490/2000 — Trade Marks (International Registration) Rules 2000

Date of commencement : 31 October 2000

2. G. N. No. S 662/2001 — Trade Marks (International Registration) (Amendment) Rules 2001

Date of commencement : 15 January 2002

3. 2002 Revised Edition — Trade Marks (International Registration) Rules

Date of operation : 31 January 2002

4. G. N. No. S 372/2004 — Trade Marks (International Registration) (Amendment) Rules 2004

Date of commencement : 1 July 2004

5. G. N. No. S 853/2005 — Trade Marks (International Registration) (Amendment) Rules 2005

Date of commencement : 1 January 2006

6. G. N. No. S 162/2007 — Trade Marks (International Registration) (Amendment) Rules 2007

Date of commencement : 2 July 2007

7. G. N. No. S 597/2008 — Trade Marks (International Registration) (Amendment) Rules 2008

Date of commencement : 1 December 2008

8. G.N. No. S 589/2011 — Trade Marks (International Registration) (Amendment) Rules 2011

Date of commencement : 1 December 2011

9. G.N. No. S 740/2014 — Trade Marks (International Registration) (Amendment) Rules 2014

Date of commencement : 13 November 2014

**10. G.N. No. S 23/2017 — Trade Marks (International Registration)
(Amendment) Rules 2017**

Date of commencement : 31 January 2017