



Rialtas na hÉireann
Government of Ireland

Guidance Notes on

S.I. No. 561 European Union (Trade Marks) Regulations 2018

S.I. No. 562 Trade Marks (Amendment) Rules 2018

S.I. No. 563 Trade Marks Act 1996 (Community Trade Mark) (Amendment) Regulations 2018

S.I. No. 564 Patents, Trade Marks and Designs (Fees) (Amendment) Rules 2018

Purpose of the Regulations and Rules

The Minister for Business, Enterprise and Innovation signed into law:

(i) Statutory Instrument number 561 of 2018, which is the [European Union \(Trade Marks\) Regulations 2018](#). These Regulations transpose into Irish law the EU Directive on trade marks.

(ii) Statutory Instrument number 562 of 2018, which is the [Trade Marks \(Amendment\) Rules 2018](#). These regulations provide for detailed day-to-day matters arising from the implementation of the Directive in Ireland.

(iii) Statutory Instrument number 563 of 2018, which is the [Trade Marks Act 1996 \(Community Trade Mark\) \(Amendment\) Regulations 2018](#). These Regulations amend certain technical provisions in the Community Trade Marks Regulations 2000 (S.I. 229/2000). The amendments are for the purpose of giving effect to technical changes in certain provisions and changes in terminology arising from Regulation (EU) No. 2015/2424 (now codified as Regulation (EU) No. 2017/1001)

(iv) Statutory Instrument number 564 of 2018, which is the [Patents, Trade Marks and Designs \(Fees\)\(Amendment\) Rules 2018](#). These Rules prescribe a new fee of €125 for the division of a trade mark registration (a requirement of the Directive), which corresponds directly with that as prescribed for the division of a pending trade mark application.

In addition, this Statutory Instrument introduces amendments not required by the Directive but rather aimed at complying with the charging structure set out in the DPFR in relation to the re-use of public sector information. The changes in the charging structure reflect the improvements and streamlining of the technical methodology used to provide copies of the trade mark and patent databases to bring the current statutory fees needed in line with the general principles provided for by Directive 2013/37/EU and reflected in the European Communities (Re-Use of Public Sector Information) (Amendment) Regulations 2015 (S.I. No. 525 of 2015).

These Regulations have an effective date of 14 January 2019. The Regulations aim to ensure that it will be easier to obtain and administer trade mark registrations throughout the EU as a result of EU-wide standards (through transposition of the Directive by all Member States).

Background to the EU Trade Marks Directive 2015/2436

In Europe, a trade mark can be registered at national level at the Intellectual Property (IP) offices of Member States or at EU level as a European Union trade mark (formerly known as a Community trade mark) at the European Union Intellectual Property Office (EUIPO). The trade marks Directive is a form of order to member states to implement national trade

mark legislation to achieve specific results. It is up to the national government to decide on the form and method of the legislation necessary to achieve those results. The European Union trade mark regulation applies to all member states. Regulations become part of national law and are enforceable in the national courts once they come into force. They do not need to be brought in by any national legislation.

In relation to the protection of trade marks, impact assessments carried out by the European Commission in 2013 concluded that both the Regulation and Directive needed to be revised to make EU trade mark registration systems less complex, offering advantages for business such as lower costs, quicker registration process, more legal security and greater predictability.

In December 2015, following a process of negotiations between Member States and the EU institutions, the European Parliament and Council approved the European trade mark reform package. The new trade mark Directive and the new European Union trade mark Regulation were published in the Official Journal of the European Union on 23 and 24 December 2015 respectively.

The Regulation 2015/2424 (now codified as Regulation 2017/1001), entered into force on 23 March 2016. Member States had until 14 January 2019 to transpose the provisions of Directive 2015/2436, into their national laws. Directive 2008/95/EC¹ is repealed with effect from 15 January 2019.

What are the main changes in the Directive, which the Regulations and Rules implement?

1. Removal of requirement for graphic representation of trade marks

In order to modernise the method, means and form by which a trade mark may be protected, a new provision was introduced whereby when submitting a trade mark application, it is no longer mandatory that the representation of a trade mark must be graphic. A sign can therefore be permitted to be represented in any appropriate form, using generally available technology and thus not necessarily by graphic means. However, the trademarks must still be represented in a manner which allows the Controller of the Patents Office, other competent authorities and the public to determine the clear and precise subject matter of the protection afforded to the proprietor of the trade mark. The representation should where appropriate, be complemented by an indication of the type of the mark concerned. It may be complemented by a description of the sign in

¹ The laws of the Member States relating to trade marks were previously partially harmonised by Council Directive 89/104/EEC of 21 December 1988 and codified as directive 2008/95/EC.

appropriate cases. Such an indication or description should accord with the representation.

The elimination of the graphic representation requirement from the definition of national trade marks gives rise to the possibility of accepting new types of trade marks filed in formats not previously provided for in Ireland. This will allow for the filing and possible registration of non-traditional marks for example, those represented by technological means such as a sound files and other formats not previously provided for in Ireland. New administrative provisions have been introduced to prescribe the representation requirements of these new types of trade marks.

2. Introduction of new absolute grounds for refusal or invalidity of registration of a trade mark

The absolute grounds for refusal of trade mark registrations consist of a set of situations under which the Patents Office may refuse to grant the trade mark or may later invalidate the trade mark. The Regulations introduce a number of new absolute grounds for refusal of registration of a trade mark:-

(i) Another characteristic - Under the previous legal regime, signs could be refused registration if they consisted exclusively of the shape of the goods in question or a shape necessary to achieve a technical result or otherwise provide substantial value to the goods. This exception has now been broadened to include signs which consist exclusively of another characteristic. This new provision was introduced in order to address any functionality issues of non-conventional trade marks. For example, a sound mark representing the sound of a motorbike for motorbikes could be captured by this new provision if the sound results from the nature of the goods (in the sense of its technical performance). Another hypothetical example of a sign that consists exclusively of 'other characteristics' resulting from the nature of the goods could be an olfactory mark of a scent for a perfume.

(ii) Protected Designations of Origin (PDOS), GIs, traditional terms for wine and traditional specialities guaranteed as well as prior plant varieties protected under the legislation of the Union or national laws or relevant international agreements, are also added as absolute grounds of refusal.

- Protected Designations of Origin (PDOS), GIs, - that is if the use of the trade mark constitutes direct or indirect commercial use of the designation of origin or geographical indication, or misuse, imitation or evocation, or another misleading practice and the trade mark application includes identical or comparable goods.
- Traditional terms for wine – that as long as they are used to indicate that the product has a designation of origin or geographical indication under EU or national law, or to indicate the production or ageing method or the quality, colour, type of

place or particular event linked to the history of the product with a designation of origin or geographical indication; and use of the trade mark constitutes misuse, imitation or evocation, or another misleading practice

- Traditional specialities guaranteed, which highlight the traditional characteristics of a product in either its production process or composition; and
- Plant variety rights which are identical (or highly similar) to an earlier registered plant variety denomination and which are in respect of plant varieties of the same or a closely related species. This absolute ground applies if the following requirements are met:
 - there is a registered plant variety denomination (at EU or at national level, including in third countries that are party to The International Union for the Protection of New Varieties of Plants (UPOV));
 - the plant variety denomination was registered prior to the trade mark application;
 - the trade mark application consists of, or reproduces in its essential elements, the earlier plant variety denomination;
 - the trade mark application includes plant varieties of the same species as, or of species closely related to, those protected by the registered plant variety denomination

3. Introduction of new relative grounds for refusal or invalidity of registration of a trade mark

The relative grounds for the refusal of a trade mark relate to a situation whereby there exists an earlier trade mark or earlier right (which does not have to be registered) with which the applicant's later trade mark would conflict if it were used in the course of trade in connection with identical, similar or complimentary goods and/or services. Relative grounds may be used as a basis to oppose an application for a trade mark or to seek the invalidation of a registered trade mark.

The new Regulations clarify that earlier marks with a reputation, can conflict with the applicant's later mark, irrespective of whether the goods or services involved are identical with, similar to, or not similar to those for which the earlier trade mark is registered.

The new Regulations introduce a number of additional relative grounds for the refusal or invalidation of the registration of a trade mark:-

(j) Designations of origin and geographical indications are included as autonomous grounds of refusal or invalidity, if they are prior to the trade mark application and confer upon their holder the right to prohibit the use of a later mark – that is if the use of the trade mark constitutes direct or indirect commercial use of the designation of origin or geographical indication, or misuse, imitation or evocation, or another misleading practice and the trade mark application includes identical or comparable goods.

(ii) Application by an agent – an application for registration of a trade mark by an agent or representative of a proprietor of a trade mark can be refused or invalidated if the agent applies in his or her own name, without the proprietor's consent, that is unless the agent justifies his/her action.

4. Partial refusal or invalidity

A trade mark may be refused or, if registered and upon application stating the grounds, be declared to be invalid.

In cases where grounds of refusal or invalidity of a trade mark exists only in respect of some of the goods or services for which that trade mark has been applied or registered, such refusal or invalidity will cover those goods or services only. Consequently, the application or registration of the mark will be allowed to proceed or continue in relation to those goods or services where no adverse grounds exist.

5. Declarations of invalidity

The registration of a trade mark may, upon application stating the grounds, be declared to be invalid.

New provisions specify the circumstances under which an application for invalidation may not succeed such as where an earlier trade mark had not acquired a distinctive character; or where an earlier trade mark had not become sufficiently distinctive to support a finding of likelihood of confusion; or where the earlier trade mark had not acquired a reputation.

In addition, an application for a declaration of invalidity may now under a new provision, be filed on the basis of one or more earlier trade mark rights, provided those earlier rights all belong to the same proprietor.

6. Rights conferred by a trade mark

An infringement of a trade mark can only be established if there is a finding that the infringing mark or sign is used in the course of trade for the purposes of distinguishing goods or services. The concept of infringement of a trade mark should also comprise the use of the sign as a trade name or similar designation, as long as such use is made for the purposes of distinguishing goods or services.

New provisions enable trade mark proprietors to prohibit the use of a later sign as a trade or company name or as part of a trade or company name. The rationale for introducing

this new provision is because confusion as to the commercial source from which the goods or services emanate may occur when a company uses the same or a similar sign as a trade name in a way such that a link is established between the company bearing the name and the goods or services coming from that company.

In order to ensure legal certainty and full consistency with specific Union legislation, provision is also made for the right of the trade mark owner to prevent the use of a subsequent sign in comparative advertising if that use is made in a manner contrary to the EU Comparative Advertising Directive (2006/114/EC). This Directive has been implemented into Irish law via the European Communities (Misleading and Comparative Marketing Communications) Regulations 2007 – S.I. 774/2007.

In order to strengthen trade mark protection and combat counterfeiting more effectively, the introduction of the new goods in transit provision may mean that counterfeit goods in transit in certain instances, could now be deemed to infringe a trade mark. Under new arrangements, trade mark proprietors will be able to prevent the bringing into the EU (using such custom procedures as inter alia, transit, internal processing or temporary storage) of goods bearing a mark that cannot be distinguished in its essential aspects from that of the trade mark proprietors, regardless of whether they are released for free circulation within the EU territory. That is unless the importer can prove that the trade mark owner would not be able to prevent the sale of the goods in question in the country of destination. The entitlement of the proprietor of a trade mark in these provisions will lapse if during the proceedings to determine whether trade mark has been infringed, evidence is provided by the holder of the goods that the proprietor is not entitled to prohibit the placing of the goods on the market in the country of final destination (i.e. that the trade mark concerned is not registered in the country of destination). This provision reconciles the need to ensure the effective enforcement of trade mark rights with the necessity to avoid hampering the free flow of trade in legitimate goods.

In order to ensure the smooth transit of generic medicines, the proprietor of a trade mark will not have the right to prevent a third party from bringing goods into a Member State where the trade mark is registered without being released for free circulation there based upon similarities between his or her registered trade mark and an international non-proprietary name (INN) as globally recognised generic names for active substances in pharmaceutical preparations for the active ingredient in medicines.

7. The right to prohibit preparatory acts

In order to enable proprietors of registered trade marks to combat counterfeiting more effectively, they will now be entitled to prohibit the affixing of an infringing trade mark to goods and certain preparatory acts carried out prior to such affixing.

The introduction of this new provision means that it could now constitute an infringement to affix a trade mark to material such as packaging, security or authenticity features or devices, labels or any other means to which a trade mark is affixed; and/or to sell, stock or to offer, place on the market or stock for those purposes, import or export such packaging, labels, tags, security or authenticity features or devices, or any other means to which the mark is affixed.

8. Reproduction in dictionaries

If the reproduction of a trade mark in a dictionary or other reference work gives the impression that the mark in question is generic in relation to the goods or services for which the trade mark is registered, the publisher of the reference work must now ensure that the mark, at the request of the trade mark proprietor, is forthwith accompanied by an indication that the mark in question is a registered trade mark.

9. Limitation of the effects of a trade mark

Previously, natural persons and businesses alike could defend themselves against claims of trade mark infringement if the sign they were using as a trade or company name comprised of their own given name.

Under the revised provisions, the '*own name*' defence is now limited so that only natural persons can rely on the fact that they are using their own name or address in accordance with honest business practices as a defence to claims of trade mark infringement.

Businesses can no longer use this defence. It is therefore important to consider appropriate trade mark searches prior to the adoption of trading or company names to ensure there are no relevant prior trade mark rights.

10. Use of trade marks and non-use as a defence

If without proper reason, the proprietor of a trade mark has not put the mark to genuine use within specified periods, that mark shall be liable and subject to limits and sanctions related to non-use in infringement, opposition, invalidity and revocation proceedings.

By way of providing for non-use as a defence in infringement, opposition and invalidity proceedings respectively, provision is made whereby at the request of the defendant, the proprietor of a trade mark shall furnish proof that the mark has been put to genuine use in connection with the applicable goods or services during a five-year period preceding the

date of the action or that there are proper reasons for non-use. In the absence of such proof in opposition and invalidity proceedings, the proceedings shall be rejected.

11. Intervening rights defence

Further defence mechanisms in infringement proceedings are introduced in relation to the intervening right of the proprietor of a later registered trade mark. In order to ensure legal certainty and safeguard legitimately acquired trade mark rights and without prejudice to the principle that the later trade mark cannot be enforced against the earlier trade mark, proprietors of earlier trade marks will not be entitled to obtain refusal or invalidation or to oppose the use of a later trade mark if the later trade mark was acquired at a time when the earlier trade mark was liable to be declared invalid or revoked, because it had not yet acquired distinctiveness through use, or if the earlier trade mark had not at that stage acquired the necessary reputation.

The intervening rights defence for a later trade mark applicant/proprietor continues to be available where the earlier trade mark owner has acquiesced to the use of the later trade mark for a period of five years.

Where the proprietor of a trade mark is not entitled to prohibit the use of a later registered trade mark, the proprietor of that later registered trade mark will not be entitled to prohibit the use of the earlier mark in infringement proceedings, even though that earlier right may no longer be invoked against the later trade mark.

For national trade marks only, the intervening rights defence will also apply if the later mark could not have been declared invalid at its filing date or priority date because the earlier mark was not at that stage inherently distinctive and had not acquired sufficient distinctiveness to support a finding of a likelihood confusion.

For EU trade marks only, the intervening rights defence for the later trade mark owner will also apply if the owner of the earlier trade mark has previously unsuccessfully applied for a declaration that the later EU mark is invalid and/or made a counter claim on relative grounds.

12. Licensing

A licensee of a standard trade mark or an authorised user of a collective trade mark will now be permitted to intervene in infringement actions brought by the proprietor, so as to be able to claim their own damages.

Subject to the provisions of the applicable licence, the licensees or authorised users may only take infringement proceedings with the consent of the trade mark proprietor, although exclusive licensees will have extra rights if the trade mark proprietor fails to act. This is

the first time that licensees' rights under national marks have been harmonised across the EU. In addition, all matters relating to the licensing of a registered trade mark and the rights of a licensee shall now apply to an application for registration of trade mark as an object of property.

13. Transfer of registered trade marks

A contractual obligation to transfer a business will now be taken to include an obligation to transfer any registered trade mark, unless there is agreement to the contrary or it is clear in all circumstances that this presumption should not apply.

14. Collective Marks

A collective mark distinguishes the goods and services of members of the association which is the proprietor of the mark from those of other undertakings. Associations of manufacturers, producers, suppliers of services or traders which under the terms of the law governing them have the capacity in their own name to have rights and obligations, to make contracts or accomplish other legal acts, and to sue and be sued, as well as legal persons governed by public law, may apply for collective marks. However, the term 'association' is not defined. When considering whether an applicant qualifies as an association, the key factor to consider will be whether the claimed association has a form of membership and can point towards the normal indications present in any form of association with members. Examples could include payment of membership fees; issuing of membership card/numbers; membership meetings; and conditions of membership. The fact that an association may be a Limited Company has no bearing on this matter; it is the manner of organisation and operation of the applicant that is important.

It is likely that any concerns the Controller will have on this aspect will only surface when examining the content of the regulations. Any concerns the Controller does have will be expressed to the applicant who will then be given an opportunity to provide information (and to amend their regulations) demonstrating that they do operate as an association with members.

The Regulations governing how a collective should be used form an integral part of any collective mark. In relation to the regulations themselves, new provisions have been introduced whereby the regulations must specify the conditions of use of the mark in question, including any sanctions against misuse of the mark. Furthermore, the regulations governing the use of the mark shall authorise any person whose goods or services originate in the geographical area concerned to become a member of the association which is the proprietor of the mark, provided that the person fulfils all the other conditions of the regulations.

New provisions have been introduced providing for additional grounds for the revocation and invalidity of a collective mark. In terms of additional grounds for revocation which are now mandatory, a collective mark will now also be revoked if the proprietor has not taken reasonable steps to prevent the mark being used in a manner that is incompatible with the conditions of use laid down in the regulations governing the use of the mark. However, provisions are also now included that if the proprietor by further amending the regulations governing use complies with the requirements, the mark may not be invalidated.

With regard to additional grounds for invalidation, these have now been made mandatory so that a collective mark will be declared invalid, if it is established to the satisfaction of the Controller, that the public is liable to be misled as regards the character or significance of the mark, in particular if it is likely to be taken to be something other than a collective mark; and if the regulations themselves either do not specify the required information regarding the mark or are contrary to public policy or to the accepted principles of morality. However, provisions are also now included that if the proprietor by further amending the regulations governing use complies with the requirements, the mark may not be invalidated.

15. Classification

A valid application for a trade mark must contain a list or indication of the goods and/or services for which protection is sought. For administrative purposes, those goods and services are classified in accordance with the internationally applicable Nice Classification System.

In order to ensure legal certainty with regard to the scope of trade mark rights and to facilitate access to trade mark protection, the designation and classification of goods and services covered by a trade mark application should follow the same rules in all Member States and should be aligned to those applicable to EU trade marks. In order to enable the competent authorities and economic operators to determine the extent of the trade mark protection sought on the basis of the application alone, the designation of goods and services should be sufficiently clear and precise. The use of general terms should be interpreted as including only goods and services clearly covered by the literal meaning of a term.

In line with the CJEU decision in the IP Translator case (case C-307/10), the wording of trade mark specifications is to be interpreted literally and therefore goods and services must be identified with sufficient clarity and precision. The position as set out in the IP Translator case does not change the policy or practice of the Irish Patent Office. Pending and future applications which contain claims for the full alphabetical lists by means of a reference to class headings, will continue to be examined in line with the established and accepted practices of the Office. This includes the principle that specifications of goods and services must be considered to mean what they say.

16. Observations by third parties

New provisions have been introduced clarifying the types of persons and bodies who can make observations, explaining on what grounds a trade mark should not be registered.

17. Division of applications and registrations

Alongside the existing requirement to provide for the division of trade mark applications, new provisions have been introduced to provide for the division of trade mark registrations into two or more separate registrations.

Applications for the division of a pending application can be beneficial during the process of trade mark examination, in which the Patent Office may have concerns about certain aspects of the application, such as certain classes of goods and/or services. With the division of the trade mark application, the registration proceedings can move forward with the undisputed parts of the application.

In terms of the possibility to divide a registered trade mark, particular benefits will accrue in relation to potential disputes. Permitting the division of a registration under dispute would allow the proprietor to assign the unchallenged part of a registration whilst retaining ownership of the part under dispute, or vice versa. This would have benefits for the proprietor and the third party assignee as it would permit any transaction between the two to continue without unnecessary delay and would permit legal certainty as to what rights each party would own. However, division of a registered trade mark cannot be requested or permitted if the goods and/or services involved are the subject of proceedings for revocation or invalidation.

An application for the division of a pending trade mark or a registered trade mark will incur the same prescribed fee and the divided elements of the application or registration will enjoy the same conditions and benefits as the original application or registration such as for example, the filing date, the priority date and the date of registration.

18. Opposition Procedures

Trade mark opposition is a legal procedure where a third party may formally object to an application for registration of a trade mark. Following the publication of an accepted trade mark in the Official Journal, there is a three month period within which parties may oppose its registration.

Third parties who may have either commercial concerns about possible confusion between their own trade mark and a pending application for a later trade mark, known as relative grounds, may oppose the registration of the later mark.

Under revised provisions introduced by the Directive, oppositions to trade mark registrations can now only be based on relative grounds as it is no longer permitted to use absolute grounds when filing an opposition. Absolute grounds objections include when a mark is considered devoid of distinctive character; consists solely of terms in common usage; consists of a shape required by the product itself; when a mark is considered contrary to public policy or morality; when a mark is considered liable to deceive the public, or when the application for the trade mark was made in bad faith. Third parties wishing to object to the registration of a trade mark on absolute grounds may as before do so by means of a post-registration application for a declaration of invalidity.

In order to provide for the possibility of an amicable agreement between the opposing parties in adversarial opposition proceedings, a new procedural provision has been introduced whereby the respective parties must be granted at their joint request, a minimum of two months to allow the possibility of a settlement in relation to the trade mark under dispute.

19. Renewal and expiry of a trade mark

The registration of a trade mark may be renewed for indefinite periods of 10 years. New provisions introduced by the Directive provide that where a renewal request is submitted or the fees paid in respect of only some of the goods or services for which the mark is registered, registration shall thereby only be renewed for those goods or services only.

In terms of the expiry of the registration of a trade mark, a new procedural provision has been introduced whereby the Patents Office must inform the proprietor of the trade mark of the expiry of the registration of a trade mark at least six months before the date of expiration. However, the onus remains on proprietors to pay due diligence to the continued registration of their trade mark(s) as the office shall not be held liable if it fails to give such information.

Background to the EU Trade Mark Regulation 2015/2424 (now codified as Regulation 2017/1001)

In Europe, trade marks can be registered at national level at the Intellectual property (IP) offices of Member States, or at EU level as a European Union Trade Mark (EUTM) at the European Union Intellectual Property Office (EUIPO) in Alicante. Under the overall system, national and European trade marks coexist and the same sign may be registered as a European and/or as a national trade mark. The EUTM system consists of one single registration procedure which grants to its owner an exclusive right in the 28 Member States of the EU.

National trade mark registration in the EU Member States has been harmonised for over 20 years and the European trade mark was created over 20 years ago. Since then, there have not been any major modifications. The business environment however has changed significantly over the past two decades, notably with the expansion of the internet and other electronic business tools.

The EU trade marks regulation 2015/2424 (now codified as Regulation 2017/1001), is part of the adopted trade marks reform package and entered into force on the 23rd of March 2016. The purpose of the introduction of the new Regulation was to update Council Regulation (EC) No 40/94 of 20 December 1993 on the Community trade mark, which established a stand-alone system for the registration of unitary rights having equal effect throughout the EU. In that context, the European Union Intellectual Property Office (EUIPO) was set up to be responsible for registering and administering European trade marks.

The changes introduced by the new EU trade mark regulation mainly impact directly upon the rights of applicants and proprietors of EUTMs and upon the practices and procedures of the EUIPO.

Do any changes in the new European Union trade mark regulation impact directly upon applicants for an Irish trade mark or upon the practices and procedures of the Irish Patents Office?

1. Filing of an application for a European Union Trade Mark

Under the previous Community Trade Mark Regulation (EC) No 40/94, it was possible to file an application for a European Union trade mark directly with the Irish Patents Office, who would afford the application the appropriate filing date and then forward it to the European Union Intellectual Property Office for examination and possible registration.

The new Regulation has removed this option and now it is only possible to file a European Union trade mark application **directly** with the European Union Intellectual Property Office.

2. Seniority claims in EU Trade Marks: Invalidity or revocation

As previously provided for, a registered national trade mark or a protected international trade mark having effect in Ireland, may be used to claim seniority when applying for an EU trade mark.

Existing provisions allow national marks which have been used to claim seniority for EU-wide trade marks but which have subsequently been allowed to lapse, to be attacked where it has been removed from the register or allowed to lapse, so that the seniority claim ceases to have effect. However, a new provision has been introduced to existing rules to clarify that the attack can only succeed if it would have succeeded at the time the national mark was allowed to lapse.

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Note: All of the foregoing changes to the Trade Marks Act 1996, apply *mutatis mutandis*, to international registrations designating Ireland, made under the Madrid Protocol, except as otherwise provided for in S.I. 346 of 2001 Trade Marks (Madrid Protocol) Regulations 2012

In terms of any subsequent changes to Irish legislation (Act and Rules) that do apply to International applications, Regulations 3 and 4 of S.I. No. 346/2001 – Trade Marks (Madrid Protocol) Regulations, 2001 state as follows:

<p>Application of 3. Act of 1996. Except as otherwise provided in these Regulations or where its application would be inconsistent with these Regulations, the Act of 1996 shall apply, with the necessary modifications, in relation to an international registration designating the State, including an international trade mark, as the Act of 1996 applies in relation to a registered trade mark or application.</p>
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<p>Application of 4. Rules of 1996. Except as otherwise provided in these Regulations or where their application would be inconsistent with these Regulations, the Rules of 1996 shall apply, with the necessary modifications, in relation to an international registration designating the State, including an international trade mark, as those Rules apply in relation to a registered trade mark or application</p>

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Disclaimer

These Guidance Notes are separate to the Regulations and are intended purely for information purposes in relation to the main aspects of the Regulations. The Department

of Business, Enterprise and Innovation does not take responsibility for any errors contained in these notes as all parties must use the Statutory Instruments as the legal basis for implementation of Directive 2015/2436/EU. In addition, these Guidance Notes do not constitute legal advice - any party with a legal query should acquire their own legal advice from suitably qualified professionals.