

REGULATION

on the registration of trade marks, etc. No. 310/1997 as subsequently amended, cf. Reg. No. 528/2004.

Article 1

An application for the registration of a trade mark shall be submitted to the Icelandic Patent Office. Applications shall be in Icelandic on forms provided by the Patent Office or corresponding forms. The Patent Office may demand an authorized translation of any documents which are not in Icelandic.

Article 2

An application shall be signed by the applicant or his agent and shall specify:

- 1) the trade mark; if the mark is not only a word mark written in normal letters an illustration of it shall be supplied on the form; this illustration must be clear and not larger than 8 x 8 cm; two additional copies of the illustration shall accompany the application,
- 2) the name, address and identification number of the applicant,
- 3) the name, address and identification number of the agent, in the case of an applicant who is not domiciled in Iceland or if an Icelandic applicant has appointed an agent to handle the application and registration on his behalf,
- 4) the goods or services for which registration is requested, together with the class of goods or services in accordance with the provisions of the Nice Agreement of 1957 on International Classification for the purpose of the Registration of Trade Marks, as subsequently amended and advertisements thereof,
- 5) the registration number in the home country, if registration in Iceland is dependent upon this registration, cf. the first paragraph of Article 33 of the Act; the Patent Office may demand a certified attest of registration in the home country.

If three-dimensional registration is requested for the mark, e.g. if it involves the appearance or get-up of a product, this shall be mentioned in the application.

Article 3

An application for the registration of a trade mark shall be accompanied by the prescribed fee according to the current fee tariff. If the fee has not been paid within one month of the date of filing, the application shall be cancelled.

Article 4

If an agent has been appointed the original power of attorney shall accompany the application. The power of attorney shall indicate that the applicant has empowered the agent to apply for registration of a trade mark on his behalf, to receive summons on his behalf, as well as other binding notifications concerning the mark, both before and after its registration. The agent shall sign the power of attorney to confirm that he accepts the assignment.

Right of Priority

Article 5

A request that an application benefit from right of priority, in accordance with the provisions of Articles 17 and 18 of the Act, shall be included in an application. It shall state the basis for demanding right of priority and specify furthermore the date of the application, where it was first filed and the application number. Such a request may also be submitted in writing no later than one month after the date of filing, in which case the above-mentioned information shall be included.

The Patent Office may demand that an applicant provide, within a prescribed time limit, satisfactory evidence of the validity of the above-mentioned information.

Article 6

In the case of reciprocity, an applicant from a foreign country may demand, under the conditions of Article 6e of the Paris Convention, that his trade mark be registered in the same manner as it is registered in that foreign country ("telle-quelle" registration). Parties domiciled in countries which are signatories of the Paris Convention for the Protection of Industrial Property or the agreement on the establishment of the World Trade Organization (WTO) shall enjoy reciprocity.

A request for such registration must be made in the application or be received in writing by the Patent Office within two months of the date of filing. Proof of registration in the foreign state shall accompany the request.

Article 7

A request for priority, in accordance with Article 57 of the Act must be made in the application for registration in this country or be received in writing by the Patent Office within two months of the date of filing. The request shall specify the number of the international registration which has expired.

Processing of applications

Article 8

The Patent Office shall, upon receiving the application, assign to it a date and application number, provided that the application includes the mark for which registration is sought, the applicants name, and the type of goods or services together with their classification numbers.

Article 9

When the processing of the application for the registration of a trade mark is complete and the application has been approved the trade mark is registered and published in the Patent Gazette. The applicant is subsequently sent a transcript of the registration (certificate of registration).

If the registration is refused the applicant shall be notified thereof and the grounds for the decision stated. The applicant shall be given a time limit within which he may submit his comments. If the applicant fails to submit evidence or arguments which could alter the decision for rejection the application shall be cancelled.

The Register of Trade Marks

Article 10

The Patent Office shall maintain a Register of Trade Marks. The following shall be entered in the Register of Trade Marks:

Prior to registration:

- 1) the application number,
- 2) the date of filing,
- 3) a request for right of priority,
- 4) the name, address and identification number of the applicant,
- 5) the mark,
- 6) the name, address and identification number of the agent, if one has been appointed,
- 7) the goods or services specified in the application together with the relevant class of goods or services,
- 8) documents received and sent,
- 9) the fee paid,
- 10) the result of the processing.

After registration:

- 1) the registration number,
- 2) the date of registration,
- 3) restrictions or other comments concerning the mark and the scope of registration,
- 4) any changes made to the mark, the registration or its owner,
- 5) information on licenses, use as collateral or attachment, if so requested.

Article 11

Opposition to the registration of a trademark, in accordance with Article 22, must be made in writing, in duplicate, and include:

- 1) the name and address of the opponent, together with the name of his agent,
- 2) the number of the registration objected to and the number of the issue of the Patent Gazette in which the registration was published,
- 3) the principal arguments for the demand for cancellation of the registration.

In special instances the Patent Office may grant the opponent a period of one month in which to submit further information in support of his objections.

Objections which do not include the information referred to in the first paragraph shall be dismissed.

Article 12

The Patent Office shall notify the proprietor of the registration of the objections raised and give him the opportunity to express his comments within a prescribed time limit.

If the proprietor of the registration submits comments on the objections the Patent Office shall decide whether there is need for further correspondence between the parties.

All correspondence and accompanying documents in an opposition case shall be in duplicate.

The results of an opposition case shall be published in the Patent Gazette.

Alterations and entries in the Register of Trade Marks

Article 13

A request for alteration of a registered trade mark, in accordance with Article 24 of the Act, shall be made in writing and include:

- 1) the name and address of the proprietor of the registration together with the name and address of the agent,
- 2) the registration number of the mark,
- 3) a description of the alteration requested,
- 4) two copies of the mark, in the case of a figure mark.

The request shall be signed by the proprietor of the registration or his agent and shall be accompanied by the prescribed fee.

Article 14

A demand for the eradication of a mark from the Register of Trade Marks, in accordance with Article 30 of the Act, shall be made in writing and shall include the registration number of the mark for which eradication is requested. It shall state the grounds for the demand.

Article 15

A request for the eradication of a mark from the Register of Trade Marks, in accordance with Point 2 of the first paragraph of Article 32 of the Act, shall be made in writing and shall state the registration number for which eradication is requested. The request shall be signed by the proprietor of the registration or his agent.

Article 16

The proprietor of a trade mark may request that specific goods or services be deleted from the registration of the mark. The request must be made in writing and shall indicate the registration number of the mark and which goods or services shall be deleted. The request shall be signed by the proprietor of the registration or his agent.

Article 17

A request that a transfer, license, pledge as collateral or attachment be entered in the Register of Trade Marks must be made in writing. It shall be accompanied by the relevant evidence and the prescribed fee. Such alterations to the Register of Trade Marks shall be published in the Patent Gazette.

Article 18

A request that an agent be entered in the Register of Trade Marks, or a change concerning an agent, shall be made in writing and shall be accompanied by the required documents.

Requests for alterations to other items in the Register of Trade Marks shall be made in writing and signed by the proprietor of the registration or party with the power of attorney to do so and shall be accompanied by the necessary evidence together with the prescribed fees. Alterations in accordance with the first and second paragraphs shall be published in the Patent Gazette.

Article 19

Requests in accordance with Articles 13-18 must be signed by a competent party in accordance with the corresponding provisions or shall be accompanied by the prescribed power of attorney for the person signing the request.

Article 20

A request that a trade mark be eradicated from the Register of Trade Marks, cf. Article 32 of the Act, shall be signed by its proprietor or be accompanied by the prescribed power of attorney for the person signing the request.

Renewal

Article 21

An application for the renewal of a trade mark registration shall be submitted to the Patent Office. The application must be in Icelandic on forms provided by the Patent Office or corresponding forms. The Patent Office may demand an authorized translation of any accompanying documents which are not in Icelandic. The prescribed fee shall accompany the application.

The provisions of Articles 1-4 shall apply mutatis mutandis to renewal notices.

Article 22

Applications for the renewal of a trade mark which was registered without listing the goods or services concerned shall specify in the application for which goods or services renewal is requested. Specification of the classes of goods or services shall be made according to the provisions of the Nice Agreement of 1957 on International Classification for the purpose of the Registration of Trade Marks, as subsequently amended. No new classes of goods or services may be added.

Article 23

When application is filed for the renewal of a trade mark registration shall be provided regarding any changes which have occurred concerning the proprietor or agent. This information shall be made in writing and shall be accompanied by the relevant documents or information concerning the changes.

Article 24

If an application for the renewal of a trade mark is not in accordance with the provisions of the Act or the Regulations the proprietor of the trade mark shall be given a time limit to

rectify the situation. If, upon the expiration of this time limit, the application is still defective it shall be refused and the proprietor notified of such.

If an application for the renewal of a trade mark is without fault the renewal shall be entered in the Register of Trade Marks and published in the Patent Gazette. Furthermore the applicant is sent a transcript of the registration as confirmation.

If an application for renewal has not been received by the Patent Office within 6 months from the end of the period of registration of the trade mark it shall be eradicated from the Register of Trade Marks and an advertisement of such published in the Patent Gazette.

Application for international registration

Article 25

An application for international registration of a trademark must be made in English and typewritten on an application form provided by the International Office or a corresponding form.

The application shall fulfil the requirements of Rule 9 in the Regulation of the Protocol to the Madrid Agreement.

The application must be accompanied by the prescribed fee to the Patent Office for receiving and processing the application (reception fee). Other fees in accordance with Article 8 of the Protocol to the Madrid Agreement (the Protocol) must be paid directly to the International Office.

Article 26

The date of receipt by the Patent Office shall be entered on an application for the international registration of a trade mark.

The application shall specify:

- 1) the name and address of the applicant,
- 2) the trade mark,
- 3) the names of the states or communities of states designated by the applicant,
- 4) the goods or services for which registration is requested, together with the class of goods or services in accordance with the provisions of the Nice Agreement of 1957 on International Classification for the purpose of the Registration of Trade Marks, as subsequently amended,
- 5) the number and date of the application (basic application) or number and date of registration (basic registration) upon which the international registration is based.

Furthermore, the application must be in accordance with Articles 3, 3 b) and 3 c) of the Protocol and provisions of the Regulation thereto.

Article 27

An application may be based upon more than one application for or registration of a trade mark if the mark is the same, the applicant is the same and the goods and services specified in the application are also included in one or more of the basic applications or registrations.

Article 28

If an application fulfils the requirements of this Regulation and the Act and the information in the application corresponds to that of the basic application or basic registration, the Patent Office shall forward the application to the International Office as quickly as possible.

If the Patent Office finds any fault with the application the applicant shall be notified thereof and given a time limit to correct or adjust the application.

If an application has not been adjusted prior to the expiry of the time limit the Patent Office shall decide whether the application shall be cancelled or forwarded unchanged to the International Office. The applicant shall be informed of the decision by the Patent Office.

Article 29

If an international registration is based on an application or trade mark registered in Iceland this shall be entered in the Register of Trade Marks.

Iceland designated in an application for international registration

Article 30

The prescribed fee shall be paid for a request that an international trade mark be validated in this country (designation of Iceland). The fee must be paid to the International Office in Swiss francs in accordance with Rules 34 and 35 of the Regulation of the Protocol.

Article 31

When the Patent Office receives notification that Iceland has been designated in an application for international registration of a trade mark the Office shall examine whether there are any obstacles to the validation of the mark in Iceland.

If the Patent Office is of the opinion that an international trade mark registration should be valid in this country it shall be published in the Patent Gazette.

The list of goods or services for which registration is requested shall be entered in the Register of Trade Marks in English.

The announcement of the international trade mark registration published in the Patent Gazette shall include the name and address of the proprietor, the numbers of the classes of goods or services and the date of international registration. It shall, furthermore, specify the number of the international publication "Gazette of International Marks", published by the World Intellectual Property Organization (WIPO), in which the registration was published.

Article 32

An application, in accordance with Article 57 of the Act and subparagraph e) of Article 9 of the Protocol, must include the international registration number, the date of international registration and the date of right of priority, if applicable, together with the date of any subsequent designations. The application shall be accompanied by the prescribed fee.

In other respects the application shall be handled as if it were a national application.

Article 33

An international trade mark registration shall be valid for 10 years from the date of registration. A request for the renewal of an international registration must be sent to the International Office.

The prescribed fee must be paid for the renewal of the validity of an international registration in Iceland. The fee must be paid to the International Office in Swiss francs as provided for in Rules 34 and 35 of the Regulation of the Protocol.

Miscellaneous provisions

Article 34

The Patent Gazette may be published and distributed electronically, for example on the Internet.

Should the publication of the ELS Gazette become solely electronic, those who still wish shall be allowed to buy a printout of the Gazette from the Patent Office by paying the cost of printing and sending it.

Article 35

This Regulation is issued in accordance with Articles 62 and 65 of the Trade Marks Act No. 45/1997, and shall enter into force on 1 June 1997. Regulation No 1/1969, concerning the notification and registration of trade marks, etc. is repealed as of the same date.

Ministry of Industry, 20 May 1997.

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