

# REGULATION

## on the registration of trademarks etc., as subsequently amended

### 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. [An application can only be re-examined if the conditions of the third paragraph of Art. 19 of the Act are satisfied.]<sup>1)</sup>

*1) Reg. No 511/2012, Art. 1 (with effect from 14 June 2012).*

## **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.

### **[Opposition.]<sup>1)</sup>**

#### Art. 11

Opposition to the registration of a trade mark, in accordance with Art. 22 of the Act, [must be accompanied by the prescribed fee]<sup>2)</sup>, 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 ELS Gazette in which the registration was published;
- 3) the principal arguments for the request for cancellation of the registration.

[The Patent Office may grant an opponent a time limit of two months to submit further documentation in support of his opposition.]<sup>2)</sup>

[If the opposition does not include the information provided for in the first paragraph, or if the prescribed fee has not been paid, the opposition shall be dismissed.]<sup>2)</sup>

*1) Reg. No 511/2012, Art. 2 (with effect from 14 June 2012).*

*2) Reg. No 511/2012, Art. 3 (with effect from 14 June 2012).*

#### 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 comments are received [on the opposition from the proprietor of the registration, the Patent Office may set a time limit for the parties to submit further expositions if deemed necessary.]<sup>1)</sup>

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.

*1) Reg. No 511/2012, Art. 4 (with effect from 14 June 2012).*

### **[Administrative revocation.]<sup>1)</sup>**

#### Art. 13

[A request for administrative revocation, as provided for in Art. 30. a. of the Act, must be accompanied by the prescribed fee, must be made in writing in duplicate, and must include:

- 1) the name and address of the party requesting the revocation of the registration together with the name of the agent if one has been appointed;
- 2) the number of the registration for which revocation is requested;
- 3) the principal arguments for the request for revocation of the registration and
- 4) necessary documentation in support of the request.

If arguments are not included with the request, the Patent Office shall set a time limit of two months to rectify this. Should arguments not be received, or if the prescribed fee is not paid, the request shall be dismissed.]<sup>2)</sup>

1) *Reg. No 511/2012, Art. 5 (with effect from 14 June 2012).*

2) *Reg. No 511/2012, Art. 6 (with effect from 14 June 2012).*

#### Art. 14

[The Patent Office shall notify the proprietor of the registration that a request for administrative revocation has been submitted and give him the opportunity to submit his comments within a prescribed time limit.

If comments are received on the request from the proprietor of the registration, the Patent Office may set a time limit for the parties to submit further expositions if deemed necessary.

Decisions taken with reference to Art. 30 a. of the Act, cf. Art. 13 of this Regulation shall be published in the Gazette “*ELS-tíðindi*”.]<sup>1)</sup>

1) *Reg. No 511/2012, Art. 7 (with effect from 14 June 2012).*

#### **[Division of applications and registrations.]<sup>1)</sup>**

#### Art. 15

[A request for division of an application, as referred to in the first paragraph of Art. 24 a. of the Act, must include:

- 1) the number of the application which is to be divided;
- 2) a list of the goods and/or services to which each application is to apply after division.

An application which results from division may not be broader in scope than the original application. Furthermore, the new application must not apply to the same goods or services as the original application.

The request for division may not be accepted if it is unclear whether the division can be accommodated within the original application.

When a request for division has been processed, the new application which is created receives a new, separate application number but retains the same filing date and priority date as the original application, if such exists.

Power of attorney, transfer documents and other documents connected to the original application shall also be valid as documentation for the new application created by division.]<sup>1)</sup>

*1) Reg. No 511/2012, Art. 8 (with effect from 14 June 2012).*

*2) Reg. No 511/2012, Art. 9 (with effect from 14 June 2012).*

## Art. 16

[A request for division of a registration, as referred to in the second paragraph of Art. 24 a. of the Act, must include:

- 1) the number of the registration which is to be divided;
- 2) a list of the goods and/or services to which each registration is to apply after division.

A registration which results from division may not be broader in scope than the original registration. Furthermore, the new registration may not apply to the same goods or services as the original registration.

The request for division may not be accepted if it is unclear whether the division can be accommodated within the original registration.

When a request for division has been processed, the new registration which is created receives a new, separate registration number but retains the same filing date and priority date as the original registration, if such exists.

Power of attorney, transfer documents and other documents connected to the original registration shall also be valid as documentation for the new registration created by division.]<sup>1)</sup>

*1) Reg. No 511/2012, Art. 10 (with effect from 14 June 2012).*

## **[Changes and entries in the Register of Trade Marks.]<sup>1)</sup>**

### 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.

*1) Reg. No 511/2012, Art. 11 (with effect from 14 June 2012).*

### 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

[A request for alteration of a registered trade mark, as referred to in Art. 24 of the Act, must be made in writing, signed by the proprietor of the registration or his agent and accompanied by the prescribed fee. The request must state:

- 1) the name and address of the proprietor of the registration, together with the name and address of his 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 proprietor of a trade mark may request that certain goods or services be deleted from the registered trade mark in return for payment of a fee. The request must be made in writing and include the registration number of the mark and what goods or services are to be deleted. The request must be signed by the proprietor of the trade mark or his agent.

Alterations to registered trademarks as referred to in the first and second paragraph are advertised in the Gazette „*ELS-tíðindi*“.<sup>1)</sup>

*1) Reg. No 511/2012, Art. 12 (with effect from 14 June 2012).*

#### Article 20

[A request that a trade mark be eradicated from the Register of Trade Marks, as referred to in Art. 30 of the Act, must be made in writing and include the registration number of the mark for which eradication is requested. The grounds for the demand must be included.

A request that a trade mark be eradicated from the Register of Trade Marks, as referred to in Art. 32 of the Act, must be made in writing and specify the registration number of the mark for which eradication is requested.

A request as referred to in the first or second paragraph must be signed by the competent party or his agent.]<sup>1)</sup>

*1) Reg. No 511/2012, Art. 13 (with effect from 14 June 2012).*

#### **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.

[An application for renewal can only be processed if the conditions of Art. 27 of the Act are satisfied.]<sup>1)</sup>

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

*1) Reg. No 511/2012, Art. 14 (with effect from 14 June 2012).*

## 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.]<sup>1)</sup>**

#### [Art. 34

The Gazette “*ELS-tíðindi*” may be published and distributed electronically, including via the Internet.

Should the publication of the Gazette “*ELS-tíðindi*” become exclusively electronic, parties who wish to do so will continue to be able to purchase a print-out of the Gazette from the Patent Office by paying the cost arising from the print-out and its delivery.]<sup>2)</sup>

1) *Reg. No 528/2004, Art. 1 (with effect from 14 June 2004).*

2) *Reg. No 528/2004, Art. 2 (with effect from 14 June 2004).*

### 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 trademarks, etc. is repealed as of the same date.

Ministry of Industry, 20 May 1997.

**Finnur Ingólfsson**

---

*Halldór J. Kristjánsson*