

Intellectual Property Office of Singapore

Registry of Trade Marks

Circular No. 1/2019: Trade Marks (International Registration) (Amendment) Rules 2019

Trade Marks (International Registration) (Amendment) Rules 2019

(Circular No. 1/2019, dated 4 March 2019)

Pursuant to the Trade Marks (International Registration) (Amendment) Rules 2019, amendments to the Trade Marks (International Registration) Rules (R 3, 2002 Ed.) (the “**TM (IR) Rules**”) will come into effect on 1 April 2019. Please click [here](#) to view the full list of amendments which will be made to the TM (IR) Rules.

A summary of the key amendments is listed as follows:

a. Amendments resulting from changes to the Common Regulations under the Madrid Agreement Concerning the International Registration of Marks and the Protocol Relating to that Agreement (the “Common Regulations”)

(i) Amendment to rule 5A of the TM (IR) Rules

Rule 5A is amended as a result of the introduction of a new rule (rule 27*bis*) to the Common Regulations. Rule 27*bis* is a provision which provides for the division of an international registration (“**IR**”).

With effect from 1 April 2019, section 5A of the Trade Marks Act (Cap. 332), read with the amended rule 5A of the TM (IR) Rules, will allow a holder to request to divide an IR designating Singapore into 2 separate IRs designating Singapore. The request must be submitted to IPOS via Form MM22(E) as prescribed by WIPO.

For more information on the requirements of a division request and IPOS’ division procedure, please refer to our circular “Division and Merger of International Registrations Designating Singapore” (Circular No. 2/2019, dated 4 March 2019).

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(ii) Amendment to rule 28 of the TM (IR) Rules

Rule 28 is amended as a result of changes to rule 22 of the Common Regulations. Rule 22 requires that the Office of Origin notify WIPO of a proceeding in article 6 of the Madrid Protocol that may lead to the ceasing of effect of the basic national mark, where such a proceeding began within the first five years of the date of the IR, but has yet to be completed by the end of the five-year validity period.

Under the original rule 22 of the Common Regulations, the Office of Origin shall notify WIPO upon the completion of the said proceeding, only if the proceeding results in a ceasing of effect of the basic national mark.

Under the amended rule 22 of the Common Regulations, the Office of Origin shall notify WIPO of the final decision of the said proceeding, regardless of the outcome of the basic national mark.

Accordingly, rule 28 of the TM (IR) Rules is amended to give effect to the abovementioned change to rule 22 of the Common Regulations.

b. Other amendments

(i) Amendment to rule 7 of the TM (IR) Rules

Rule 7 is amended to make clear that sections 36, 37, 38, 40 and 41 of the Trade Marks Act (Cap. 332) also apply, with the necessary modifications, in relation to pending international registrations designating Singapore.

(ii) Amendment to rule 8 of the TM (IR) Rules

Rule 8 is amended to clarify the types of transactions which can be applied directly with IPOS, (referred to in the rule as “notifiable transactions”), and those which are to be recorded directly with the International Bureau in the International Register maintained by WIPO (referred to in the rule as “relevant transactions”).

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(iii) Deletion of rule 33 of the TM (IR) Rules

Rule 33 is deleted in accordance to the withdrawal of Singapore's declaration made under rule 34(2)(b) of the Common Regulations¹. Rule 33 relates to the procedure of collecting and forwarding fees to WIPO for applications filed under the Madrid Protocol. The declaration is withdrawn in view of the availability of direct payment methods provided by WIPO, and the potential delay the fee collection and forwarding procedures would bring to the processing of such applications that are filed through IPOS.

The deletion of rule 33 of the TM (IR) Rules has no impact on the current procedure of filing such applications through IPOS (e.g., an international application filed on Form MM2(E)). Applicants may continue to submit fees payable to WIPO directly via a WIPO Current Account or via bank (telegraphic) transfer to WIPO's bank account.

For more information on WIPO's fee payment methods, please click [here](#).

¹ Rule 34(2)(b) states that an Office of the Contracting Party which accepts to collect and forward fees payable to WIPO by the holder shall declare this fact to WIPO.

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