

## **RENEWAL**

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**RENEWAL**

<b>Contents</b>	<b>Page</b>
1. INTRODUCTION.....	3
2. RELEVANT LEGISLATION.....	4
3. BACKGROUND.....	15
3.1. Duration of Registration.....	15
3.2. Renewal Term.....	15
4. APPLICATION TO RENEW A TRADE MARK.....	16
4.1. Renewal Notice.....	16
4.2. Renewal Application.....	16
4.3. Renewal Timeline.....	18
4.4. Late Renewal Application.....	19
4.5. Examination of Application for Renewal of Registration.....	19
4.6. Removal of the Mark from the Register.....	19
4.7. Restoration Application.....	19
4.8. Expired and Removed Marks.....	20
4.9. Effect of Late Registration.....	20
4.10. Citation of Expired and Removed Marks.....	21
4.11. Fee Structure for Form TM 19.....	22
4.12. Effect of Change of Registered Proprietor's Details on Renewal Application.....	22
5. ADDRESS FOR SERVICE.....	23
6. INTERNATIONAL REGISTRATION.....	24
6.1. Duration of Registration.....	24
6.2. Renewal Application.....	24
6.3. Late Renewal Application.....	25

6.4. Non-Renewal.....25

## **1. INTRODUCTION**

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This chapter is concerned with the renewal of a registered trade mark application.

## **2. RELEVANT LEGISLATION**

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### **Trade Marks Act (Cap. 332, 2005 Rev. Ed.)**

#### **Relative grounds for refusal of registration**

##### **8.**

...

(11) A trade mark which is an earlier trade mark by virtue of paragraph (a) of the definition of “earlier trade mark” in section 2(1) and whose registration expires, shall continue to be taken into account in determining the registrability of a later mark for a period of one year after the expiry, unless the Registrar is satisfied that there was no bona fide use of the mark during the 2 years immediately preceding the expiry.

#### **Registration**

##### **15.**

...

(2) A trade mark when registered shall be registered as of the date of the application for registration, and that date shall be deemed for the purposes of this Act to be the date of registration.

#### **Duration of registration**

**18.—**(1) A trade mark shall be registered for a period of 10 years from the date of registration.

(2) Registration may be renewed in accordance with section 19 for further periods of 10 years.

#### **Renewal of registration**

**19.—**(1) The registration of a trade mark may be renewed at the request of the proprietor, subject to payment of the fee referred to in subsection (4) or the fees referred to in subsection (5), as the case may be.

(2) The Minister may make rules for the Registrar to inform the proprietor of a registered trade mark, before the expiry of the registration, of the date of expiry and the manner in which the registration may be renewed.

(3) A request for renewal shall be made not later than 6 months after the date of expiry of the registration.

(4) Where the request for renewal is made on or before the date of expiry of the registration, the fee payable shall be the prescribed renewal fee.

(5) Where the request for renewal is made within the period of 6 months after the date of expiry of the registration, the fees payable shall be the prescribed renewal fee and the prescribed late renewal fee.

(6) Renewal shall take effect from the expiry of the previous registration.

(7) If the registration is not renewed in accordance with this section and the rules referred to in subsection (2), the Registrar shall remove the trade mark from the register.

(8) The Minister may make rules to provide for the restoration of the registration of a trade mark which has been removed from the register, subject to such conditions, if any, as may be prescribed.

## Trade Marks Rules

### Address for service

**9.**—(1) For the purposes of any proceedings before the Registrar, an address for service in Singapore shall be filed in accordance with paragraph (2) or (5) by or on behalf of —

...

(f) every applicant for the renewal of the registration of a trade mark or for the restoration of a trade mark to the register;

...

(2) Where the application for a matter requires an address for service in Singapore to be furnished, the address for service in Singapore shall be furnished on the form filed for the matter.

(3) The filing of an address for service in accordance with paragraph (2) shall be effective only for the matter for which the form is filed.

(4) Notwithstanding paragraph (3) —

...

(b) subject to sub-paragraph (f), the address for service of a proprietor of a registered trade mark shall be effective for the purposes of all proceedings in respect of the registered trade mark, except for any application for the second or any subsequent renewal of the registered trade mark;

...

(g) where an applicant for the renewal of the registration of a trade mark, or the restoration of a trade mark to the register, furnishes an address for service in Form TM 19, the address for service shall be effective for the purposes of all renewal applications or proceedings, and all restoration applications or proceedings, in respect of the trade mark in relation to which that form is filed;

...

(5) In a case where paragraphs (2) and (4) do not apply, the address for service shall be furnished in writing.

### Renewal of registration

**49.**—(1) Subject to paragraph (2), an application for the renewal of registration of a trade mark shall be made not earlier than 6 months before, and not later than 6 months after the date of expiry of the registration.

(2) Where a trade mark is registered after the date on which it becomes due for renewal by reference to the date of the application for its registration, an application for the renewal of its registration shall be made not later than 6 months after the actual date of its registration.

(3) An application for the renewal of registration of a trade mark shall —

(a) be in Form TM 19, if made on or before the date of expiry of the registration; or

- (b) be in Form TM 19 and be accompanied by the additional late payment fee, if made within 6 months after the date of expiry of the registration.

(4) Notwithstanding paragraph (3) (b), where —

(a) a trade mark is registered —

- (i) within 6 months before; or
- (ii) after,

the date on which it becomes due for renewal by reference to the date of the application for its registration; and

- (b) an application for the renewal of its registration is made not later than 6 months after the actual date of its registration,

the application for the renewal of its registration shall be in Form TM 19.

(5) To avoid doubt, the application for the renewal of the registration of the trade mark under paragraph (4) need not be accompanied by any additional late payment fee.

#### **Notice of renewal**

**50.** —(1) Subject to paragraphs (2) and (3), the Registrar shall, not less than one month nor more than 6 months before the date of expiry of the registration of a trade mark, send a notice in writing to the proprietor, at the proprietor's address for service, notifying him of the date of expiry of the registration.

(2) Subject to paragraph (3), where a trade mark is registered —

- (a) within 6 months before; or
- (b) after,

the date on which it becomes due for renewal by reference to the date of the application for its registration, the Registrar shall, within one month after the actual date of its registration, send a notice in writing to the proprietor —

- (i) where an application for the renewal of registration of the trade mark has previously been made in accordance with rule 49, at the address for service as indicated in the application; or
- (ii) in any other case, at the proprietor's address for service,

notifying him of the date of expiry of its registration.

(3) The Registrar need not send any notice referred to in paragraph (1) or (2) if an application for the renewal of registration of the trade mark has been made in accordance with rule 49.

#### **Notice of non-compliance**

**50A.**—(1) If, in the course of an examination of an application for renewal of registration, it appears to the Registrar that the application is not in order, the Registrar shall give written notice of this to the applicant.

(2) If the applicant fails to —

- (a) respond in writing to the Registrar on the notice; or
- (b) comply with any requisition of the Registrar set out in the notice,

within the time specified in the notice, the Registrar may treat the application as having been withdrawn.

### **Removal of trade mark from register**

**51.** The Registrar may remove a trade mark from the register if —

- (a) no application for the renewal of registration of the trade mark is filed in accordance with rule 49; or
- (b) where an application for the renewal of registration of the trade mark is filed in accordance with rule 49, the applicant for the renewal of registration —
  - (i) fails to comply with any direction of the Registrar relating to the renewal; or
  - (ii) notifies the Registrar that he wishes to withdraw or abandon the application.

### **Restoration of registration**

**53.—**(1) An application for restoration of a trade mark which has been removed from the register under rule 51 shall be filed with the Registrar on Form TM 19 within 6 months from the date of the removal of the trade mark from the register.

...

(3) The Registrar may, in any case, require the applicant for restoration to furnish such additional evidence or information, by statutory declaration or otherwise, as he thinks fit, within such time as the Registrar may specify.

...

(4) The Registrar may restore the trade mark to the register and renew its registration if he is satisfied that it is just to do so, and upon such conditions as he may think fit to impose.

### **Reinstatement of application, right or thing**

#### **77B**

...

(5) Paragraphs (1) to (4) do not allow the reinstatement of —

...

- (b) any application which is treated as withdrawn, any right which has been abrogated or any thing which has ceased to be in force or to exist by reason of —

...

- (iii) a failure to pay the fee for the renewal or restoration of the registration of a trade mark under rule 49(3) or (4) or 53, as the case may be.

**Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks (Adopted at Madrid on June 27, 1989, as amended on October 3, 2006, and on November 12, 2007)**

**Article 6**

**Period of Validity of International Registration; Dependence and Independence of International Registration**

(1) Registration of a mark at the International Bureau is effected for ten years, with the possibility of renewal under the conditions specified in Article 7.

(2) Upon expiry of a period of five years from the date of the international registration, such registration shall become independent of the basic application or the registration resulting there from, or of the basic registration, as the case may be, subject to the following provisions.

(3) The protection resulting from the international registration, whether or not it has been the subject of a transfer, may no longer be invoked if, before the expiry of five years from the date of the international registration, the basic application or the registration resulting therefrom, or the basic registration, as the case may be, has been withdrawn, has lapsed, has been renounced or has been the subject of a final decision of rejection, revocation, cancellation or invalidation, in respect of all or some of the goods and services listed in the international registration. The same applies if

- (i) an appeal against a decision refusing the effects of the basic application,
- (ii) an action requesting the withdrawal of the basic application or the revocation, cancellation or invalidation of the registration resulting from the basic application or of the basic registration, or
- (iii) an opposition to the basic application

results, after the expiry of the five-year period, in a final decision of rejection, revocation, cancellation or invalidation, or ordering the withdrawal, of the basic application, or the registration resulting therefrom, or the basic registration, as the case may be, provided that such appeal, action or opposition had begun before the expiry of the said period. The same also applies if the basic application is withdrawn, or the registration resulting from the basic application or the basic registration is renounced, after the expiry of the five-year period, provided that, at the time of the withdrawal or renunciation, the said application or registration was the subject of a proceeding referred to in (i), (ii) or (iii) and that such proceeding had begun before the expiry of the said period.

(4) The Office of origin shall, as prescribed in the Regulations, notify the International Bureau of the facts and decisions relevant under paragraph (3), and the International Bureau shall, as prescribed in the Regulations, notify the interested parties and effect any publication accordingly. The Office of origin shall, where applicable, request the International Bureau to cancel, to the extent applicable, the international registration, and the International Bureau shall proceed accordingly.

## **Article 7**

### **Renewal of International Registration**

(1) Any international registration may be renewed for a period of ten years from the expiry of the preceding period, by the mere payment of the basic fee and, subject to Article 8(7), of the supplementary and complementary fees provided for in Article 8(2).

(2) Renewal may not bring about any change in the international registration in its latest form.

(3) Six months before the expiry of the term of protection, the International Bureau shall, by sending an unofficial notice, remind the holder of the international registration and his representative, if any, of the exact date of expiry.

(4) Subject to the payment of a surcharge fixed by the Regulations, a period of grace of six months shall be allowed for renewal of the international registration.

## **Article 8**

### **Fees for International Application and Registration**

(7)

(a) Any Contracting Party may declare that, in connection with each international registration in which it is mentioned under Article 3*ter*, and in connection with the renewal of any such international registration, it wants to receive, instead of a share in the revenue produced by the supplementary and complementary fees, a fee (hereinafter referred to as “the individual fee”) whose amount shall be indicated in the declaration, and can be changed in further declarations, but may not be higher than the equivalent of the amount which the said Contracting Party’s Office would be entitled to receive from an applicant for a ten-year registration, or from the holder of a registration for a ten-year renewal of that registration, of the mark in the register of the said Office, the said amount being diminished by the savings resulting from the international procedure. Where such an individual fee is payable,

- (i) no supplementary fees referred to in paragraph (2)(ii) shall be payable if only Contracting Parties which have made a declaration under this subparagraph are mentioned under Article 3*ter*, and
- (ii) no complementary fee referred to in paragraph (2)(iii) shall be payable in respect of any Contracting Party which has made a declaration under this subparagraph.

(b) Any declaration under subparagraph (a) may be made in the instruments referred to in Article 14(2), and the effective date of the declaration shall be the same as the date of entry into force of this Protocol with respect to the State or intergovernmental organization having made the declaration. Any such declaration may also be made later, in which case the declaration shall have effect three months after its receipt by the Director General, or at any later date indicated in the declaration, in respect of any international registration whose date is the same as or is later than the effective date of the declaration.

**Common Regulations under the Madrid Agreement Concerning the International Registration of Marks and the Protocol Relating to that Agreement (as in force on April 1, 2016)**

**Rule 29  
Unofficial Notice of Expiry**

The fact that the unofficial notice referred to in Article 7(4) of the Agreement and Article 7(3) of the Protocol is not received shall not constitute an excuse for failure to comply with any time limit under Rule 30.

**Rule 30  
Details Concerning Renewal**

(1) [*Fees*] (a) The international registration shall be renewed upon payment, at the latest on the date on which the renewal of the international registration is due, of

- (i) the basic fee,
- (ii) where applicable, the supplementary fee, and,
- (iii) the complementary fee or individual fee, as the case may be, for each

designated Contracting Party for which no statement of refusal under Rule 18*ter* or invalidation, in respect of all the goods and services concerned, is recorded in the International Register, as specified or referred to in item 6 of the Schedule of Fees. However, such payment may be made within six months from the date on which the renewal of the international registration is due, provided that the surcharge specified in item 6.5 of the Schedule of Fees is paid at the same time.

(b) If any payment made for the purposes of renewal is received by the International Bureau earlier than three months before the date on which the renewal of the international registration is due, it shall be considered as having been received three months before the date on which renewal is due.

(2) [*Further Details*] (a) Where the holder does not wish to renew the international registration in respect of a designated Contracting Party for which no statement of refusal under Rule 18*ter*, in respect of all the goods and services concerned, is recorded in the International Register, payment of the required fees shall be accompanied by a statement by the holder that the renewal of the international registration is not to be recorded in the International Register in respect of that Contracting Party.

(b) Where the holder wishes to renew the international registration in respect of a designated Contracting Party notwithstanding the fact that a statement of refusal under Rule 18*ter* is recorded in the International Register for that Contracting Party in respect of all the goods and services concerned, payment of the required fees, including the complementary fee or individual fee, as the case may be, for that Contracting Party, shall be accompanied by a statement by the holder that the renewal of the international registration is to be recorded in the International Register in respect of that Contracting Party.

(c) The international registration may not be renewed in respect of any designated Contracting Party in respect of which an invalidation has been recorded for all goods and services under Rule 19(2) or in respect of which a renunciation has been recorded under Rule

27(1)(a). The international registration may not be renewed in respect of any designated Contracting Party for those goods and services in respect of which an invalidation of the effects of the international registration in that Contracting Party has been recorded under Rule 19(2) or in respect of which a limitation has been recorded under Rule 27(1)(a).

(d) Where a statement under Rule 18~~ter~~(2)(ii) or (4) is recorded in the International Register, the international registration shall not be renewed in respect of the designated Contracting Party concerned for the goods and services that are not included in that statement, unless payment of the required fees is accompanied by a statement by the holder that the international registration is to be renewed also for those goods and services.

(e) The fact that the international registration is not renewed under subparagraph (d) in respect of all the goods and services concerned, shall not be considered to constitute a change for the purposes of Article 7(2) of the Agreement or Article 7(2) of the Protocol. The fact that the international registration is not renewed in respect of all of the designated Contracting Parties shall not be considered to constitute a change for the purposes of Article 7(2) of the Agreement or Article 7(2) of the Protocol.

(3) [*Insufficient Fees*] (a) If the amount of the fees received is less than the amount of the fees required for renewal, the International Bureau shall promptly notify at the same time both the holder and the representative, if any, accordingly. The notification shall specify the missing amount.

(b) If the amount of the fees received is, on the expiry of the period of six months referred to in paragraph (1)(a), less than the amount required under paragraph (1), the International Bureau shall not, subject to subparagraph (c), record the renewal, and shall reimburse the amount received to the party having paid it and notify accordingly the holder and the representative, if any.

(c) If the notification referred to in subparagraph (a) was sent during the three months preceding the expiry of the period of six months referred to in paragraph (1)(a) and if the amount of the fees received is, on the expiry of that period, less than the amount required under paragraph (1) but is at least 70% of that amount, the International Bureau shall proceed as provided in Rule 31(1) and (3). If the amount required is not fully paid within three months from the said notification, the International Bureau shall cancel the renewal, notify accordingly the holder, the representative, if any, and the Offices which had been notified of the renewal, and reimburse the amount received to the party having paid it.

(4) [*Period for Which Renewal Fees Are Paid*] The fees required for each renewal shall be paid for ten years, irrespective of the fact that the international registration contains, in the list of designated Contracting Parties, only Contracting Parties whose designation is governed by the Agreement, only Contracting Parties whose designation is governed by the Protocol, or both Contracting Parties whose designation is governed by the Agreement and Contracting Parties whose designation is governed by the Protocol. As regards payments under the Agreement, the payment for ten years shall be considered to be a payment for an installment of ten years.

### **Rule 31**

#### **Recording of the Renewal; Notification and Certificate**

(1) [*Recording and Effective Date of the Renewal*] Renewal shall be recorded in the International Register with the date on which renewal was due, even if the fees required for

renewal are paid within the period of grace referred to in Article 7(5) of the Agreement and in Article 7(4) of the Protocol.

(2) *[Renewal Date in the Case of Subsequent Designations]* The effective date of the renewal shall be the same for all designations contained in the international registration, irrespective of the date on which such designations were recorded in the International Register.

(3) *[Notification and Certificate]* The International Bureau shall notify the Offices of the designated Contracting Parties concerned of the renewal and shall send a certificate to the holder.

(4) *[Notification in Case of Non-Renewal]* (a) Where an international registration is not renewed, the International Bureau shall notify accordingly the holder, the representative, if any, and the Offices of all of the Contracting Parties designated in that international registration.

(b) Where an international registration is not renewed in respect of a designated Contracting Party, the International Bureau shall notify the holder, the representative, if any, and the Office of that Contracting Party accordingly.

### **Rule 34** **Amounts and Payment of Fees**

(1) *[Amounts of Fees]* The amounts of fees due under the Agreement, the Protocol or these Regulations, other than individual fees, are specified in the Schedule of Fees that is annexed to these Regulations and forms an integral part thereof.

(2) *[Payments]* (a) The fees indicated in the Schedule of Fees may be paid to the International Bureau by the applicant or the holder, or, where the Office of the Contracting Party of the holder accepts to collect and forward such fees, and the applicant or the holder so wishes, by that Office.

(b) Any Contracting Party whose Office accepts to collect and forward fees shall notify that fact to the Director General.

(3) *[Individual Fee Payable in Two Parts]* (a) A Contracting Party that makes or has made a declaration under Article 8(7) of the Protocol may notify the Director General that the individual fee to be paid in respect of a designation of that Contracting Party comprises two parts, the first part to be paid at the time of filing the international application or the subsequent designation of that Contracting Party and the second part to be paid at a later date which is determined in accordance with the law of that Contracting Party.

(b) Where subparagraph (a) applies, the references in items 2, 3 and 5 of the Schedule of Fees to an individual fee shall be construed as references to the first part of the individual fee.

(c) Where subparagraph (a) applies, the Office of the designated Contracting Party concerned shall notify the International Bureau when the payment of the second part of the individual fee becomes due. The notification shall indicate

- (i) the number of the international registration concerned,
- (ii) the name of the holder,
- (iii) the date by which the second part of the individual fee must be paid,
- (iv) where the amount of the second part of the individual fee is dependent on the number of classes of goods and services for which the mark is protected in the designated Contracting Party concerned, the number of such classes.

(d) The International Bureau shall transmit the notification to the holder. Where the second part of the individual fee is paid within the applicable period, the International Bureau shall record the payment in the International Register and notify the Office of the Contracting Party concerned accordingly. Where the second part of the individual fee is not paid within the applicable period, the International Bureau shall notify the Office of the Contracting Party concerned, cancel the international registration in the International Register with respect to the Contracting Party concerned and notify the holder accordingly.

(4) [*Modes of Payment of Fees to the International Bureau*] Fees shall be paid to the International Bureau as specified in the Administrative Instructions.

(5) [*Indications Accompanying the Payment*] At the time of the payment of any fee to the International Bureau, an indication must be given,

- (i) before international registration, of the name of the applicant, the mark concerned and the purpose of the payment;
- (ii) after international registration, of the name of the holder, the number of the international registration concerned and the purpose of the payment.

(6) [*Date of Payment*] (a) Subject to Rule 30(1)(b) and to subparagraph (b), any fee shall be considered to have been paid to the International Bureau on the day on which the International Bureau receives the required amount.

(b) Where the required amount is available in an account opened with the International Bureau and that Bureau has received instructions from the holder of the account to debit it, the fee shall be considered to have been paid to the International Bureau on the day on which the International Bureau receives an international application, a subsequent designation, an instruction to debit the second part of an individual fee, a request for the recording of a change or an instruction to renew an international registration.

(7) [*Change in the Amount of the Fees*] (a) Where the amount of the fees payable in respect of the filing of an international application is changed between, on the one hand, the date on which the request to present the international application to the International Bureau is received, or is deemed to have been received under Rule 11(1)(a) or (c), by the Office of origin and, on the other hand, the date of the receipt of the international application by the International Bureau, the fee that was valid on the first date shall be applicable.

(b) Where a designation under Rule 24 is presented by the Office of the Contracting Party of the holder and the amount of the fees payable in respect of that designation is changed between, on the one hand, the date of receipt, by the Office, of the request by the holder to present the said designation and, on the other hand, the date on which the designation is received by the International Bureau, the fee that was valid on the first date shall be applicable.

(c) Where paragraph (3)(a) applies, the amount of the second part of the individual fee which is valid on the later date referred to in that paragraph shall be applicable.

(d) Where the amount of the fees payable in respect of the renewal of an international registration is changed between the date of payment and the due date of the renewal, the fee that was valid on the date of payment, or on the date considered to be the date of payment under Rule 30(1)(b), shall be applicable. Where the payment is made after the due date, the fee that was valid on the due date shall be applicable.

(e) Where the amount of any fee other than the fees referred to in subparagraphs (a), (b), (c) and (d) is changed, the amount valid on the date on which the fee was received by the International Bureau shall be applicable.

### **Rule 38**

#### **Crediting of Individual Fees to the Accounts of the Contracting Parties Concerned**

Any individual fee paid to the International Bureau in respect of a Contracting Party having made a declaration under Article 8(7)(a) of the Protocol shall be credited to the account of that Contracting Party with the International Bureau within the month following the month in the course of which the recording of the international registration, subsequent designation or renewal for which that fee has been paid was effected or the payment of the second part of the individual fee was recorded.

### 3. BACKGROUND

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#### 3.1. Duration of Registration

Under the Trade Marks Act, the duration of validity of a registered mark is for an initial period of 10 years from the date of registration (*see Section 18(1) of the Act*).

The date of registration of the registered mark is deemed to be the **date of application** (*see Section 15(2) of the Act*).

Accordingly, the registered mark becomes due for renewal by reference to the date of application for registration (*see Rule 50(2) of the Trade Marks Rules*).

#### 3.2. Renewal Term

A registered mark may be renewed in accordance with Section 19 of the Act for further periods of 10 years (*see also Section 18(2) of the Act*).

Renewal takes effect from the expiry of the previous registration (*see Section 19(6) of the Act*).

Under the statutory provisions for renewal, the validity of a registered mark may therefore last indefinitely, subject to (a) the request for renewal having been filed under the prescribed form within the prescribed time frame, and (b) the payment of the relevant renewal fees.

## **4. APPLICATION TO RENEW A TRADE MARK**

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### **4.1. Renewal Notice**

Prior to the expiry of a registered mark, the Registry will issue to the registered proprietor a letter to notify the proprietor of the date of expiry of the registration. This letter, termed as the “First and Only Notice” (FON), will be sent 1 to 6 months before the date of expiry of the registered mark (*see Rule 50(1) of the Rules*).

The FON will be sent to the registered proprietor at his address for service (*see Rule 50(2) of the Rules*). Registrations may be renewed by lodging Form TM 19 with the prescribed renewal fees on or before the date of expiry of the registration (i.e. the deadline for renewal).

If there has been a change in the details of the registered proprietor or his address for service, the appropriate forms as shown in Section 4.12: *Effect of Change of Registered Proprietor's Details on Renewal Application* shall be filed with the Registrar to update the address for service appearing in the Register.

The Registry need not send the FON if a renewal application has already been made (*see Rule 50(3) of the Rules*).

### **4.2. Renewal Application**

Prior to the expiration of a registered mark, or on its expiry date, the registered proprietor may request for the mark to be renewed by lodging Form TM 19 with the prescribed renewal fees. (*see Section 19(1) and (4) of the Act*).

This application may be filed electronically or in hard copy with the Registry.

**Electronic filing of Form TM 19**

Form TM 19 can be used for the following types of renewal:

- **Request for renewal made on or within 6 months before date of expiry of registration (subject to payment of prescribed renewal fee).**
- Where a mark is registered within 6 months before the expiry of the mark provided that the request for renewal is made within 6 months from the date of the actual registration of the mark (subject to payment of prescribed renewal fee)
- Where a mark is registered after its expiry date provided that the request for renewal is made within 6 months from the date of the actual registration of the mark (subject to payment of prescribed renewal fee)
- **Request for renewals made within 6 months from the date of expiry of registration (subject to payment of additional late payment fee)**
- **Request for renewal made between 6 to 12 months from the date of expiry of registration (subject to payment of restoration and renewal fees)**

Should you wish to file a request for renewal electronically, please take note of the following: Upon entering the trade mark number, you will be able to view the details of the proprietor on record for the mark and the details of the mark. The details of the mark include:

- The class number in which the renewal pertains to
- Due date of renewal
- Type of renewal applicable

Please ascertain that these details are correct. If they are not, please check that you have entered the correct trade mark number.

After the renewal request has been made, you may like to print a copy of the payment receipt for your own record.

For electronic filing of Form TM 19, the request for renewal will be automatically processed and the registered mark will be renewed for a further period of 10 years upon the completion of the renewal request. No confirmation letter will be sent out by the Registry for electronic filing of Form TM 19 but the *Expiry Date* of the registered mark will be updated in the Register.

For manual filing of Form TM 19, a confirmation letter will be sent to the address for service as indicated on Form TM 19 and the *Expiry Date* of the registered mark will be updated in the Register.

To ensure that the renewal notices are sent to the correct address, or that the registered mark is renewed with the correct registered proprietor's details, please take note of the following:

If you wish to merely update the registered proprietor's details such as the name, address and/or Singapore address for service of the proprietor, you will have to file Form CM2 to effect such change.

If there is a change of ownership of the registered trade mark, you will have to file Form CM8 to update the details in the Register as appropriate.

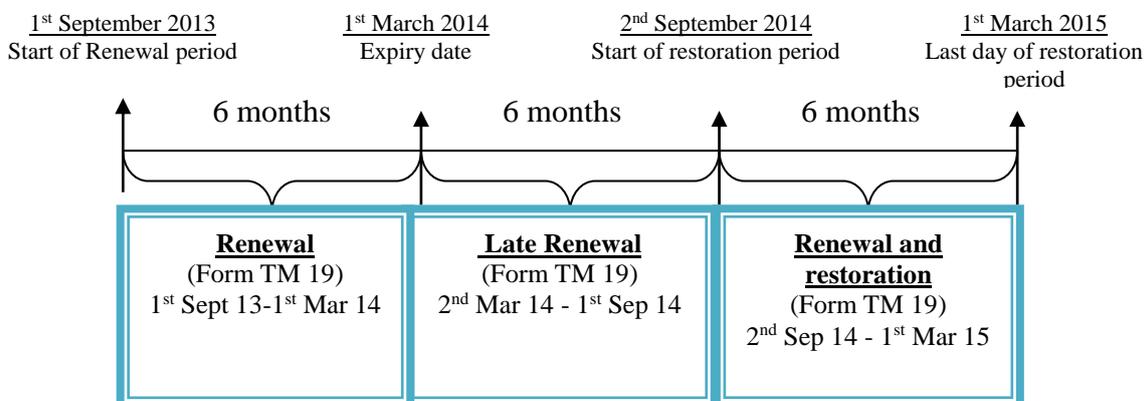
Upon filing Form CM2 or Form CM8, whichever is the appropriate, please notify the Registrar of the same by attaching a cover letter to your request for renewal under Form TM 19.

### 4.3. Renewal Timeline

In this example, an application for registration of a mark has an expiry date of 1 March 2014. From the period between 1 September 2013 till 1 March 2014 (being 6 months before expiry date), the renewal can be made via Form TM 19 with the prescribed renewal fee.

If the proprietor fails to renew the mark by 1 March 2014, he may still file for a late renewal of the mark by 1 September 2014 (being 6 months from 1 March 2014), by lodging Form TM 19 with the additional late payment fee.

If the proprietor fails to renew the mark by 1 September 2014, the mark will be removed from the Register. Accordingly, to restore the mark, the proprietor may lodge Form TM 19 with prescribed renewal and restoration fees by 1 March 2015.



#### **4.4. Late Renewal Application**

Once the mark has expired, the Act provides that a request for renewal may still be filed **within 6 months from the date of expiry of the registration** (*see Section 19(3) of the Act, Rule 49(1) of the Rules*).

The 6-month time frame to file a request for late renewal is **non-extendible**.

A request for renewal filed up to 6 months after the date of expiry of a registration is known as a “late renewal”.

The registered proprietor may request for the late renewal of a registered mark by lodging Form TM 19 with additional late payment fee (*see Rule 49(3) of the Rules*).

#### **4.5. Examination of Application for Renewal of Registration**

The Registrar will examine the application for renewal.

If in the course of such an examination, if it appears to the Registrar that the application is not in order, the Registrar shall notify the registered proprietor of any non-compliance (*see Rule 50A(1) of the Rules*).

Failure by the registered proprietor to respond to the notification shall result in the Registrar treating the application as having been withdrawn (*see Rule 50A(2) of the Rules*).

#### **4.6. Removal of the Mark from the Register**

The status of the registered mark on the Register will be updated to “Removed” in the event where:

- No application for renewal and restoration has been filed under Section 19 of the Act;
- The registered proprietor fails to comply with any direction of the Registrar relating to renewal under Rule 49 of the Rules; or
- The registered proprietor notifies the Registrar that he wishes to withdraw or abandon the application under Rule 49 of the Rules.

(*see Rule 51 of the Rules*)

#### **4.7. Restoration Application**

Where a registered mark has been removed from the Register pursuant to Rule 51 of the Rules, the mark will be reflected as "Removed (Restoration Possible)" on the Register.

The registered proprietor may apply for such a mark to be restored to the Register by lodging Form TM 19 within 6 months after the date of the removal of the trade mark from the Register (*see Rule 53(1) of the Rules*).

The 6-month time frame to file a request for restoration is **non-extendible**.

It is not possible to file for restoration of the removed mark after 6 months from the date of which the trade mark status is updated to "Removed (Restoration Possible)".

Where an application for restoration is filed, the Registrar may request for additional evidence or information to be furnished by the applicant for restoration, by way of a statutory declaration (*see Rule 53(3) of the Rules*).

#### **4.8. Expired and Removed Marks**

Marks that are not renewed in accordance with the Act would be reflected on the Register as "Expired".

If no request for late renewal is made within 6 months after the date of expiry of the registration (*see Rule 49(3) of the Rules*), the mark will be reflected as "Removed (Restoration Possible)" on the Register.

If no request for restoration and renewal is made within 6 months after the date of the removal of trade mark from the register (*see Rule 53(1) of the Rules*), the mark will be reflected as "Removed".

Once a mark is expired or removed, it is impossible to process any other action on the expired or removed mark, for example, transactions such as assignment, licence, grant of security interest, amendment of registered mark or removal for non-use applications etc.

#### **4.9. Effect of Late Registration**

Where a trade mark is registered after the date on which it becomes due for renewal by reference to the date of application for its registration i.e. a late registration, an application for the renewal of the mark shall be made within 6 months after the actual date of its registration (*see Rule 49(2) of the Rules*).

Such an application to renew shall be made by way of payment of prescribed renewal fee with Form TM 19 (*see Rule 49(4) of the Rules*).

In the case of a late registration, the Registry will send the FON letter to notify the proprietor of the date of expiry of the registration within 1 month after the actual date of its registration (*see Rule 50(2) of the Rules*).

**Example of restoring a late registration**

An application for registration of a mark was filed in on 1 January 2000. The application was registered, and certificate of registration was only dispatched to the proprietor on 1 January 2011 due to protracted opposition proceedings.

As it is more than 10 years since 1 January 2000, the registered mark is treated as a "late registration". In such case, for the purposes of renewal of the mark, the proprietor should lodge Form TM 19, and pay the prescribed renewal fees by 1 July 2011 (being 6 months from the actual date of registration).

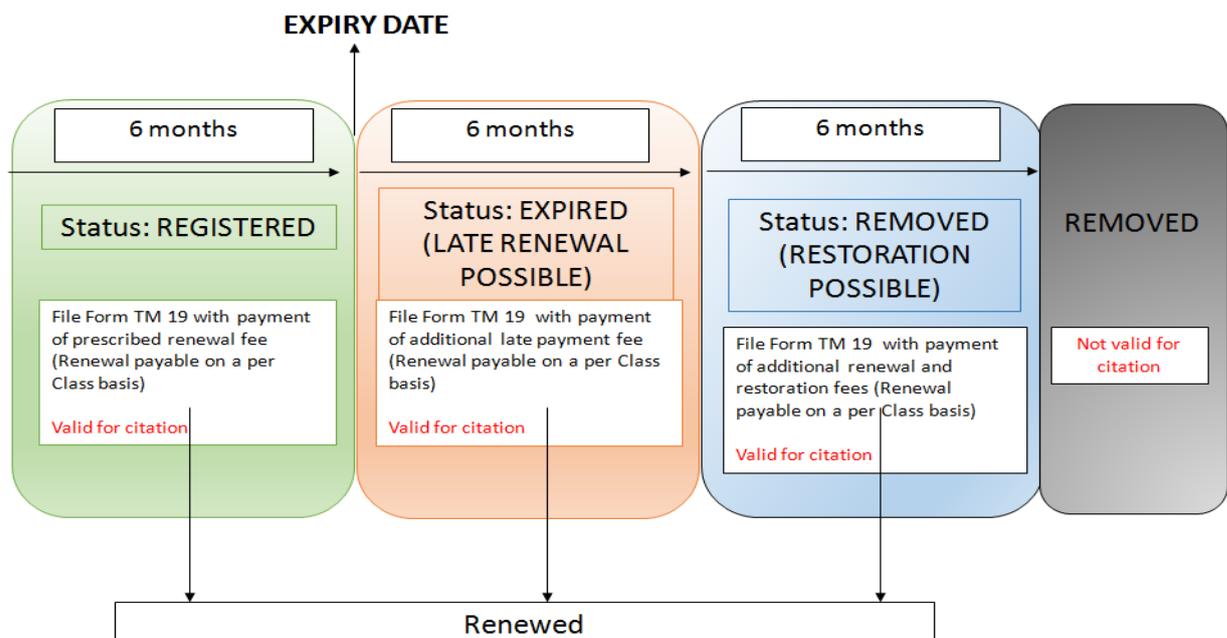
If the proprietor fails to renew the mark by 1 July 2011, he may still file for a late renewal of the mark by 1 January 2012 (being 6 months from 1 July 2011), by lodging Form TM 19 with additional late payment fee.

If the proprietor fails to renew the mark by 1 January 2012, the mark will be removed from the Register. Accordingly, to restore the mark, the proprietor may lodge Form TM 19 and the prescribed renewal and restoration fees by 1 July 2012.

**4.10. Citation of Expired and Removed Marks**

For the purpose of relative grounds of refusal of registration, marks with “Registered”, “Expired (Late Renewal Possible)” and “Removed (Restoration Possible)” status will be valid for citation. However, marks with "Removed" status will not be cited against other marks with later filing date (*see Section 8(11) of the Act*).

**Renewal & Citation of Expired/Removed Marks**



#### **4.11. Fee Structure for Form TM 19**

##### For renewal

*[To be made on or 6 months before the date of expiry of the registered mark]*

You may renew the registration of your trade mark by completing and submitting Form TM 19 at a prescribed fee of S\$380.00 per class before the expiry of the mark.

Please note that for manual (hard copy) filing, an additional [Service Bureau charge](#) will apply.

##### For late renewal

*[To be made within 6 months from the date of expiry of the registered mark]*

You may apply for late renewal by submitting Form TM 19 at a prescribed fee of S\$560.00 per class.

Please note that for manual (hard copy) filing, an additional [Service Bureau charge](#) will apply.

##### For restoration and renewal

*[To be made between 6 to 12 months from the date of expiry of the registered mark]*

You may apply for renewal and restoration by submitting Form TM 19 at a prescribed fee of S\$610.00 per class.

Please note that for manual (hard copy) filing, an additional [Service Bureau charge](#) will apply.

#### **4.12. Effect of Change of Registered Proprietor's Details on Renewal Application**

If there has been a change in the details of the registered proprietor, whether by way of:

- (a) A mere change in the name and address of the proprietor, or
- (b) A change of ownership of the registered mark by way of transfer or assignment

the proprietor shall effect such changes using the prescribed forms before the application to renew.

The appropriate forms are as follows:

Form CM1	For request to appoint, change or remove an agent
Form CM2	For request to change name, address or Singapore address or entry of Singapore address for service
Form CM8	For change of ownership

## **5. ADDRESS FOR SERVICE**

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For renewal applications lodged on or after 1 January 2006, the address for service entered on the renewal request form (including late renewal and restoration of registration) is effective for all renewal matters in respect of the registered mark in relation to which the form is filed (*see Rule 9 of the Rules*).

This means that FONs issued subsequent to that renewal request would be sent to this address.

## **6. INTERNATIONAL REGISTRATION**

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Renewals of International Registrations ("IR") must be done with the World Intellectual Property Office (WIPO).

### **6.1. Duration of Registration**

An IR is valid for an initial period of 10 years with the possibility of renewal under Article 7 of the Madrid Protocol (*see also Article 6(1) of the Madrid Protocol ("MP")*).

### **6.2. Renewal Application**

Any IR may be renewed for a period of 10 years from the expiry of the preceding period subject to the payment of the prescribed fees and lodgment of the prescribed form (*See Article 7(1) of the MP*) before the date of expiry of the IR.

WIPO will send an unofficial reminder to the holder of the IR stating the exact date of expiry of the IR 6 months before the expiry of the IR (*see Article 7(3) of the MP*).

If the holder does not receive such a notice, this will not constitute an excuse for failure to comply with the any time limit for payment due for renewal (*see Rule 29 of the MP Common Regulations*). This reminder will also be copied to the holder's representative (if any) in the country of origin of the mark.

The renewal may be effected electronically via the WIPO Website under *Forms Required for the International Registration of a Mark* and also under *Online Services*.

No official form is prescribed for the renewal of an IR, as electronic renewal may effected by giving the necessary information numbers of the IR concerned and the purpose of payment.

Holders may however use the optional WIPO form MM11 to file for a renewal.

A request to renew an international registration may be sent to WIPO up to 6 months before the renewal date (*see Rule 30(1) of the MP Common Regulations*).

However, holders should be aware that if they file a request for renewal more than 3 months in advance of the renewal date, it shall be considered as having been received by the International Bureau 3 months before the date on which renewal is due (*see Rule 30(1) of the MP Common Regulations*) and if the prescribed fees for renewal are changed before the date of expiry of the IR, the holder will be expected to pay the new fee (*See Rule 34(7) of the MP Common Regulations*).

An international registration is dependent on the national basic mark for a period of five years following the recordal date of the IR (*see Article 6 of the MP*).

After the 5 year duration, the IR becomes independent of the basic mark (*see Article 6(2) of the MP*). In order to extend the validity of the IR, it is not necessary for the basic mark to be renewed and the IR will not extend its protection to country upon which it is originally based.

#### **Renewal of Subsequent Designations**

The period of protection under the subsequent designation expires on the same date as the international registration.

The effective date of the renewal is the same for all designations contained in the IR, irrespective of the date on which such designations were recorded in the IR (*see Rule 31 of the MP Common Regulations*).

For example, if a holder has an IR dated 31 December 2005 designating Australia and Japan and he makes a subsequent designation in the USA and Vietnam on 31 December 2008. In order to maintain the validity of the IR beyond the expiry date of 31 December 2015 in **all** the individual designated countries, the holder must:

- Renew the IR with WIPO by 31 December 2015; and
- Select all the individual designations in Australia, Japan, the USA and Vietnam for renewal.

### **6.3. Late Renewal Application**

It is possible to renew international trade marks within a grace period of 6 months after the date of expiry of the IR, subject to the payment of a surcharge (*see Article 7(4) of the MP*).

### **6.4. Non-Renewal**

Where an international registration is not renewed, the International Bureau shall notify the Offices of all of the Contracting Parties designated in that international registration. Where an international registration is not renewed in respect of a designated Contracting Party, the International Bureau shall notify the Office of that Contracting Party (*see Rule 31(4) of the MP Common Regulation*).

For more details on the Madrid Protocol regime, please refer to the IPOS Website or to the WIPO Trademarks Gateway Website.