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**TRADE MARKS ACT
(CHAPTER 332)**

**TRADE MARKS
(AMENDMENT)
RULES 2021**

In exercise of the powers conferred by section 108 of the Trade Marks Act, the Minister for Law makes the following Rules:

Citation and commencement

1. These Rules are the Trade Marks (Amendment) Rules 2021 and come into operation on 1 October 2021.

Amendment of rule 8

2. Rule 8(1) of the Trade Marks Rules (R 1) (called in these Rules the principal Rules) is amended by deleting the words “of business of the person whose address is given” and substituting the words “indicated by the address”.

Deletion and substitution of rule 15

3. Rule 15 of the principal Rules is deleted and the following rule substituted therefor:

“Application for registration

15.—(1) An application for the registration of a trade mark must be made in Form TM 4 (called in this Part the application form).

(2) The application must contain a clear indication of the nature of the mark.”.

Amendment of rule 16

4. Rule 16 of the principal Rules is amended by deleting paragraph (2).

Deletion and substitution of rule 20

5. Rule 20 of the principal Rules is deleted and the following rule substituted therefor:

“Translation and transliteration

20. Where a trade mark contains or consists of a word or words in characters other than Roman or in a language other than English, the Registrar may at any time require any of the following documents to be filed with the Registry:

- (a) a copy of the translation in English and, if the case requires, transliteration in English, of the word or words;
- (b) any supporting document certifying or verifying, to the satisfaction of the Registrar, the accuracy of the translation and transliteration (if any) in English of the word or words.”.

Amendment of rule 24

6. Rule 24 of the principal Rules is amended —

- (a) by inserting, immediately after paragraph (5), the following paragraph:

“(5A) For the purpose of paragraph (5), the Registrar may, on the Registrar’s own accord, send to the applicant the Registrar’s grounds of decision for the decision in respect of the representations of the applicant.”;

- (b) by inserting, immediately after the word “Where” in paragraph (6), the words “the Registrar’s grounds of decision are not sent to the applicant under paragraph (5A), and”; and

- (c) by inserting, immediately after the words “are sent to the applicant” in paragraph (8), the words “under paragraph (5A) or (6)(b)”.

Amendment of rule 31A

7. Rule 31A of the principal Rules is amended —

- (a) by inserting, immediately after paragraph (1), the following paragraphs:

“(1A) Subject to paragraphs (1B) and (2), the Registrar may, in any case after specifying the periods within which the evidence mentioned in paragraph (1) may be filed by the parties, shorten any of those periods.

(1B) The Registrar may only exercise the Registrar’s power under paragraph (1A) after giving the parties an opportunity to be heard.”; and

- (b) by inserting, immediately after the words “paragraph (1)” in paragraphs (2), (3)(a), (4)(a) and (5)(a), the words “, or as shortened by the Registrar under paragraph (1A) (if applicable),”.

Amendment of rule 32

8. Rule 32(1) of the principal Rules is amended —

- (a) by deleting the words “before the expiry of the later of the following periods:” and substituting the word “within —”;
- (b) by inserting, immediately after the words “rule 31A(1)” in sub-paragraph (a), the words “, or as shortened by the Registrar under rule 31A(1A) (if applicable),”; and
- (c) by inserting the word “or” at the end of sub-paragraph (a).

Amendment of rule 33

9. Rule 33(1) of the principal Rules is amended by inserting, immediately after the words “rule 31A(1)” in sub-paragraph (a), the words “, or as shortened by the Registrar under rule 31A(1A) (if applicable),”.

Amendment of rule 34

10. Rule 34(1) of the principal Rules is amended by inserting, immediately after the words “rule 31A(1)” in sub-paragraph (a), the words “, or as shortened by the Registrar under rule 31A(1A) (if applicable),”.

Amendment of rule 36A

11. Rule 36A of the principal Rules is amended —

- (a) by deleting the words “appear at” in paragraph (6) and substituting the word “attend”; and
- (b) by inserting, immediately after paragraph (7), the following paragraphs:

“(8) Despite paragraphs (1) and (2) but subject to paragraphs (9), (10) and (11), the Registrar may direct that a pre-hearing review be held in an asynchronous manner by exchange of written correspondence with the parties, and the Registrar may exercise any power conferred on the Registrar under this rule for the purpose of securing the just, expeditious and economical disposal of the proceedings.

(9) Where a pre-hearing review is held under paragraph (8), the Registrar must —

- (a) before giving any direction or imposing any requirement on the parties on any matter, give each party an opportunity to address the Registrar on the intended direction or requirement; and
- (b) before giving any direction or imposing any requirement on a party that affects a party’s rights or interests, give that party an opportunity to address the Registrar and respond to any submission made by the other party on the intended direction or requirement.

(10) For the purpose of exercising the Registrar's powers under paragraph (6) or (7) in a pre-hearing review held under paragraph (8), the references to the non-attendance of a party in paragraph (6) and the absence of a party in paragraph (7) are each to be read as a reference to the failure of a party to respond to the Registrar's written correspondence relating to the pre-hearing review within the time specified in the written correspondence.

(11) The Registrar must not hold a pre-hearing review in an asynchronous manner under paragraph (8) if any party requests that the pre-hearing review be held in accordance with paragraph (1) instead.”.

Deletion and substitution of rule 47

12. Rule 47 of the principal Rules is deleted and the following rule substituted therefor:

“Certificate of contested validity of trade mark

47.—(1) This rule applies where the Registrar or the Court has certified under section 102(1) of the Act that the registration of a trade mark is found to be wholly or partially valid in any proceedings before the Registrar or the Court (as the case may be), and the fact that the validity of the registration was contested in the proceedings.

(2) If the certificate is given by the Court, the proprietor of the registered trade mark may file a written request with the Registrar to add to the entry of the trade mark in the register a note that the certificate has been given in the course of the proceedings, and a copy of the certificate must be filed together with the written request.

(3) The Registrar must, on receipt of the request mentioned in paragraph (2) and the copy of the certificate, add the note to the entry of the trade mark in the register.