



GUERNSEY STATUTORY INSTRUMENT

2015 No. 78

**The Trade Marks (Bailiwick of Guernsey)  
Regulations, 2015**

<i>Made</i>	<i>22nd October, 2015</i>
<i>Coming into operation</i>	<i>23rd October, 2015</i>
<i>Laid before the States</i>	<i>, 2015</i>

**THE COMMERCE AND EMPLOYMENT DEPARTMENT**, in exercise of the powers conferred on it by sections 34, 35, 36, 41, 43, 61, 66, 67 and 75 of the Trade Marks (Bailiwick of Guernsey) Ordinance, 2006<sup>a</sup> and all other powers enabling it in that behalf, hereby makes the following Regulations:-

**Classification of trade marks.**

1. (1) The prescribed system of classification for the purposes of the registration of trade marks is the Nice Classification.

(2) When a trade mark is registered it shall be classified according to the version of the Nice Classification having effect on the date of the application for registration.

(3) An application may be made in more than one class of the Nice Classification.

(4) Every application shall specify –

(a) the class in the Nice Classification to which it relates,  
and

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<sup>a</sup> Recueil d'Ordonnances Tome XXXI, pp. 1 and 622.

- (b) the goods or services which are appropriate to the class and they shall be described in such a way as to indicate clearly the nature of those goods or services and to allow them to be classified in the relevant class in the Nice Classification.

(5) If the application relates to more than one class in the Nice Classification the specification contained in it shall set out the classes in consecutive numerical order and the specification of the goods or services shall be grouped accordingly.

(6) If the specification contained in the application lists items by reference to a class in the Nice Classification in which they do not fall, the applicant may request, in writing, that the application be amended to include the appropriate class for those items, and upon the payment of such class fee as may be appropriate the registrar shall amend the application accordingly.

**Claims to priority from relevant countries.**

2. (1) A person who has duly filed an application for the protection of a trade mark in a country specified in the Schedule to these Regulations (a "**relevant country**") has a right to priority, for the purpose of registering the trade mark under the Ordinance for some or all of the same goods or services, for a period of six months from the date of the filing of the application in that country.

(2) Where the application for registration under the Ordinance is made within the said period of six months –

- (a) the relevant date for the purpose of establishing which rights take precedence shall be the date of the filing of the application in the relevant country, and
- (b) the registrability of the trade mark shall not be affected by any use of the mark in the Bailiwick between that date and the date of the application under the Ordinance.

(3) A subsequent application concerning the same subject as the first application, duly filed in the same relevant country, shall be considered the first application to be filed in that country (of which the filing date shall be the starting date of the period of priority) if at the time of the subsequent application –

- (a) the previous application has been withdrawn, abandoned or refused, without having been laid open to public inspection and without leaving any rights outstanding, and
- (b) it has not yet served as a basis for claiming a right of priority.

(4) A previous application may not serve as a basis for claiming a right of priority where a subsequent application is considered, in accordance with paragraph (3) above, as the first application to be duly filed.

(5) A right to priority conferred by this regulation –

- (a) shall (unless otherwise stated in the application) vest in the person filing the application or his successor in title, and
- (b) may be assigned or otherwise transmitted, either with the application or independently.

(6) Where a right to priority is claimed by reason of an application to which this regulation relates, particulars of that claim shall be included in the application for registration filed under the Ordinance and, unless a certificate as is referred to in paragraph (7) is filed with the application, such particulars shall include the relevant country and the date of filing.

(7) There shall be filed within three months of the filing of the application for registration under the Ordinance a certificate by the registering or other competent authority of the relevant country certifying, or verifying to the satisfaction of the Registrar –

- (a) the date of the filing of the application,
- (b) the relevant country or registering or competent authority,
- (c) the representation of the mark, and
- (d) the goods or services covered by the application.

(8) For the purpose of this regulation, "**duly filed**" means a filing which is adequate to establish the date on which the application was filed in the relevant country in question, whatever may be the subsequent fate of the application.

**Manner of claiming right to priority.**

3. (1) Where a right to priority is claimed by reason of an application for protection of a trade mark duly filed in a Convention country under section 35 of the Ordinance or in another country or territory in respect of which provision is made under regulation 2 (an "overseas application"), the application for registration shall specify –

- (b) the country in which the overseas application was filed,
- (b) the number accorded to the overseas application by the registering or other competent authority of that country, and
- (c) the date of filing.

(2) The Registrar may, in any particular case, by notice require the applicant to file, within such period of less than one month as the notice may specify, such documentary evidence as the Registrar may require certifying, or verifying to the satisfaction of the Registrar, the date of the filing of the overseas

application, the country or registering or competent authority, the representation of the mark and the goods or services covered by the overseas application.

(3) For the purpose of this regulation, "**duly filed**" means a filing which is adequate to establish the date on which the application was filed in the country or territory in question, whatever may be the subsequent fate of the application.

(4) An applicant who fails to comply with the requirements of this regulation shall lose any right to priority claimed in respect of an overseas application.

#### **Division of application.**

4. (1) At any time before registration an applicant may send to the Registrar a request in the form and in such manner as the Registrar may direct to divide the specification of the application for registration (the original application) into two or more separate applications (divisional applications), indicating for each division the specification of goods or services.

(2) Each divisional application shall be treated as a separate application for registration with the same filing date as the original application.

(3) Where the request to divide an application is sent after publication of the application, any objections in respect of, or opposition to, the original application shall be taken to apply to each divisional application and shall be proceeded with accordingly.

(4) Upon division of an original application in respect of which notice has been given to the Registrar of particulars relating to the grant of a licence, or a security interest or any right in or under it, the notice and the particulars shall be deemed to apply in relation to each of the applications into which the original application has been divided.

#### **Merger of separate applications or registrations.**

5. (1) The proprietor of two or more registrations of a trade mark, the applications relating to which were filed on the same date, may request the

Registrar in the form and in such manner as the Registrar may direct to merge them into a single registration and the Registrar shall, if satisfied that the registrations are in respect of the same trade mark, merge them into a single registration.

(2) No application under paragraph (1) may be granted in respect of the registration of a trade mark which is the subject of proceedings for its revocation or invalidation.

(3) Where any registration of a trade mark to be merged under paragraph (1) is subject to a disclaimer or limitation, the merged registration shall also be restricted accordingly.

(4) Where any registration of a trade mark to be merged under paragraph (1) has had registered in relation to it particulars relating to the grant of a licence or a security interest or any right in or under it, or of any memorandum or statement of the effect of a memorandum, the Registrar shall enter in the Register the same particulars in relation to the merged registration.

(5) The date of registration of the merged registration shall, where the separate registrations bear different dates of registration, be the latest of those dates.

**Registration of a series of trade marks.**

6. (1) An application may be made in accordance with section 32 of the Ordinance for the registration of a series of trade marks in a single registration provided that the series comprises no more than six trade marks.

(2) Where such an application is for registration of a series of trade marks comprising three or more trade marks, the application shall be subject to the payment of the appropriate fee for each trade mark in excess of two trade marks.

(3) Following an application under paragraph (1) the Registrar shall, if satisfied that the marks constitute a series, accept the application.

(4) At any time the applicant for registration of a series of trade marks or the proprietor of a registered series of trade marks may request the deletion of a mark in that series and, following such request, the Registrar shall delete the mark accordingly.

(5) Where under paragraph (4) the Registrar deletes a trade mark from an application for registration, the application, in so far as it relates to the deleted mark, shall be treated as withdrawn.

**Restoration of registration.**

7. Where the Registrar has removed a trade mark from the Register for failure to renew its registration in accordance with section 43(5) of the Ordinance, the Registrar may, following receipt of a request in the form and in such manner as the Registrar may direct within one year of the date of the removal of the mark, accompanied by the appropriate renewal fee and the appropriate restoration fee –

- (a) restore the mark to the Register, and
- (b) renew its registration,

if, having regard to the circumstances of the failure to renew, the Registrar is satisfied that it is just to do so.

**Public inspection of Register.**

8. (1) The Register shall be open for public inspection at the Intellectual Property Office during the hours of business of the said Office as published on the Office website.

(2) Where any portion of the Register is kept otherwise than in documentary form, the right of inspection is a right to inspect the material on the Register.

**Supply of certified copies etc.**

9. The Registrar shall, subject to payment of the appropriate fee, supply a certified copy or extract or uncertified copy or extract, as requested in the form and in such manner as the Registrar may direct, of any entry in the Register.

**General powers of Registrar in relation to proceedings.**

10. (1) Except where the Ordinance or these Regulations otherwise provide, the Registrar may give such directions as to the management of any proceedings as the Registrar thinks fit, and in particular may –

- (a) require a document, information or evidence to be filed within such period as the Registrar may specify,
- (b) require a translation of any document,
- (c) require a party or a party's legal representative to attend a hearing,
- (d) hold a hearing by telephone or by using any other method of direct oral communication,
- (e) allow a statement of case to be amended,
- (f) stay the whole or any part of the proceedings, either generally or until a specified date or event,
- (g) consolidate proceedings,
- (h) direct that part of any proceedings be dealt with as separate proceedings.

(2) The Registrar may control the evidence by giving directions as to –

- (a) the issues on which evidence is required, and
- (b) the way in which the evidence is to be placed before the Registrar.

(3) Directions under these Regulations may be subject to

conditions and may specify the consequences of failure to comply with the directions or any such condition.

**Evidence and procedure in proceedings before the Registrar.**

11. (1) Subject to regulation 10(2) and the provisions of this regulation, evidence in any proceedings before the Registrar may be given –

- (a) by affidavit, or
- (b) in any other form which would be admissible as evidence in proceedings before a court,

and the Registrar shall afford the parties a reasonable opportunity of being heard or submitting evidence and making representations by affidavit or otherwise.

(2) The Registrar may admit any evidence given for the purposes of the hearing and determination of any proceedings notwithstanding any rule of law relating to hearsay or otherwise as to the admissibility of evidence.

(3) The parties are entitled to be present during any hearing by the Registrar of representations made in person, and for the purposes of this paragraph a party may be represented by any person, whether or not legally qualified, except that if in a particular case the Registrar is satisfied that there are good and sufficient reasons for doing so, it may refuse to permit a particular person, other than one who is legally qualified, to represent the party.

(4) The Registrar may at any time require any party to furnish further particulars in writing within such time as the Registrar may direct with regard to any matter or question and shall afford any other party a reasonable opportunity of replying in writing.

(5) The Registrar may call for such documents and examine such persons (including any party) on oath, affirmation or otherwise as appear likely to afford evidence which is relevant and material to any question to be determined by the Registrar.

(6) Any party may, if authorised to do so by the Registrar, cause a summons to be served on any person, in the same manner as that in which a summons may be served in a civil action before the Royal Court, summoning that person to attend any hearing before the Registrar to give evidence or produce any document likely to assist the Registrar in determining any question, and a person so summoned is under a like obligation as to the giving of any evidence or the production of any document as if that person were summoned to give the evidence or produce the document in a civil action before the Royal Court.

(7) The Registrar may adjourn any hearing from time to time as the Registrar thinks fit.

(8) If it is proved to the satisfaction of the Registrar that the parties have been notified of the place, date and time of proceedings, and one of the parties fails to appear at the hearing, the Registrar may proceed to determine any matter in dispute in the absence of that party.

(9) The decision of the Registrar shall be in writing, signed by the Registrar and transmitted as soon as reasonably practicable to the parties.

(10) The Registrar shall cause a notice of the decision to be displayed on the Office website for a minimum period of seven days.

**Costs of proceedings.**

12. The Registrar may, in any proceedings before him, by order award to any party to such proceedings such of the Registrar's costs as the Registrar may consider reasonable and may direct how and by which parties such costs are to be paid.

**Security for costs.**

13. (1) The Registrar may require any person who is a party in any proceedings before him to give security for costs in relation to those proceedings; and may also require security for the costs of any appeal from the Registrar's decision.

(2) In default of security for costs being given in the case of

proceedings before the Registrar, the Registrar may treat the party in default as having withdrawn the application, opposition, objection or intervention, as the case may be.

**Interpretation.**

14. (1) In these Regulations, unless the context requires otherwise -

**"enactment"** means any Law, Ordinance or subordinate legislation,

**"the Nice Agreement"** means the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15th June 1957, as from time to time amended, which was last amended on 28th September 1979,

**"the "Nice Classification"** means the system of classification under the Nice Agreement,

**"the Ordinance"** means the Trade Marks (Bailiwick of Guernsey) Ordinance, 2006,

**"subordinate legislation"** means any regulation, rule, order, rule of court, resolution, scheme, byelaw or other instrument made under any enactment and having legislative effect,

and other expressions have the same meanings as in the Ordinance.

(2) The Interpretation (Guernsey) Law, 1948<sup>b</sup> applies to the interpretation of these Regulations.

(3) Any reference in these Regulations to an enactment is a reference thereto as from time to time amended, re-enacted (with or without modification), extended or applied.

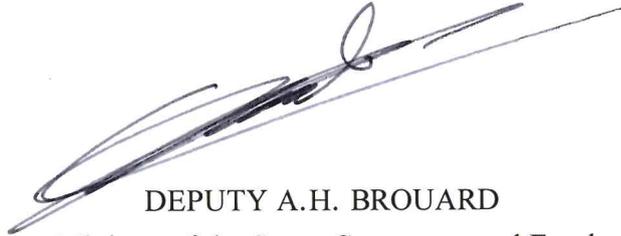
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<sup>b</sup> Ordres en Conseil Vol. XIII, p. 355.

**Citation and commencement.**

15. These Regulations may be cited as the Trade Marks (Bailiwick of Guernsey) Regulations 2015 and shall come into force on the 23rd October, 2015.

Dated this 22nd day of October, 2015



DEPUTY A.H. BROUARD  
Deputy Minister of the States Commerce and Employment  
Department  
For and on behalf of the Department

SCHEDULE  
RELEVANT COUNTRIES

Regulation 2

Antigua and Barbuda	India
Bahrain	Jamaica
Belize	Kuwait
Bolivia	Macau
Botswana	Maldives
Brunei Darussalam	Mozambique
Colombia	Myanmar
Djibouti	Namibia
Dominica	Nicaragua
Ecuador	Pakistan
Guatemala	Sierra Leone
Hong Kong	Thailand

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EXPLANATORY NOTE

*(This note is not part of the Regulations)*

These Regulations make provision for various matters for the purposes of the Trade Marks (Bailiwick of Guernsey) Ordinance, 2006, including (a) that the prescribed system of classification for trade marks is the Nice Classification made under the Nice Agreement, (b) under section 35 and 36 of the Ordinance for claims to priority arising from Convention and relevant overseas applications, (c) under section 41 for division and merger of applications and for registration of a series of trade marks, (d) under section 43 for restoration of a trade mark to the register, (e) under section 61 for public inspection of the register and provision of copies of entries, and (f) under sections 66 and 67 for costs and evidence and procedure in proceedings before the Registrar.

These Regulations come into force on the 23rd day of October, 2015.

