

**The Trade Marks (Madrid)
(Bailiwick of Guernsey) Regulations, 2020**

<i>Made</i>	21 st December, 2020
<i>Coming into operation</i>	21 st December, 2020
<i>Laid before the States</i>	, 2020

THE COMMITTEE FOR ECONOMIC DEVELOPMENT, in exercise of the powers conferred on it by sections 53, 54 and 101 of the Trade Marks (Bailiwick of Guernsey) Ordinance, 2006^a and all other powers enabling it in that behalf, hereby makes the following Regulations:-

International applications originating from Guernsey

Filing an international application

1. (1) Any person who –
 - (a) is a British citizen or
 - (b) a resident of Guernsey, and

^a Ordinance No. I of 2006; amended by No. XXXIX of 2006 and No. IX of 2016.

- (c) who -
 - (i) has filed an application with the Registrar ("**the basic application**"), or
 - (ii) has a Guernsey trade mark ("**the basic registration**")

may file an international application with the Registrar in respect of the basic application or the basic registration (together "**the basic mark**"), as the case may be.

(2) An international application must be made to the Registrar in such form and manner as the Registrar may require and must –

- (a) include the information required by Rule 9(4)(a) of the International Regulations,
- (b) include or be accompanied by such other documents or information as the Registrar may require or as may be prescribed, and
- (c) be accompanied by the prescribed fee.

(3) If the Registrar receives an international application that does not meet the requirements of paragraph (2), the Registrar shall –

- (a) notify the applicant of the same, and

- (b) give the applicant an opportunity to correct the error or omission, as the case may be, within a prescribed time,

and if the applicant fails to correct the error or omission within the prescribed time, the international application shall be deemed to have been abandoned.

(4) If the Registrar receives an international application in accordance with paragraph (2), and is satisfied that international application may properly be made, the Registrar must submit the international application to the International Bureau together with –

- (a) a certification that -
 - (i) the Office of the Registrar is the office of origin for that application, and
 - (ii) the relevant particulars appearing in the international application correspond to those in the basic application or basic registration, as the case may be, and
- (b) confirmation of the date on which the Registrar received the application.

(5) Following submission of an international application in accordance with paragraph (5), if the International Bureau notifies the Registrar of any irregularities in that application pursuant to Rule 11, 12 or 13 of the International Regulations, the Registrar shall insofar as possible -

- (a) provide the information requested by the International Bureau within the time period specified, and
- (b) where the irregularity is to be remedied by the Registrar, consult with the applicant as it thinks fit or otherwise as required by the International Regulations.

Classification of goods and services.

2. The classification of goods and services for an international application shall be determined by the International Bureau.

Cessation of effect of a basic mark.

3. Where a basic mark ceases, or potentially ceases, to have effect wholly or partially within 5 years of the date of the international registration, the Registrar shall notify the International Bureau in accordance with Rule 22 of the International Regulations, and shall, where appropriate, request cancellation of the international registration in accordance with Article 6 of the Protocol.

Division or merger of basic application or basic registration

4. (1) This regulation applies where the Registrar submits an application to the International Bureau in accordance with regulation 1 and -

- (a) the basic application is divided into two or more applications, or
- (b) two or more basic marks are merged into a single application or registration.

(2) Where, before the end of the relevant period, a basic application has not lapsed under Article 6(3) of the Protocol and is divided or two or more basic marks are merged, the Registrar shall notify the International Bureau and shall indicate –

- (a) the number of the international registration or, where the mark has not been registered, the number of the basic application,
- (b) the name of the applicant or the proprietor of the relevant trade mark, and
- (c) the number of each application resulting from the division or the number of the application or registration resulting from the merger.

(3) The relevant period is the period of 5 years beginning with the date of the international registration.

International registrations containing designations of Guernsey

Designation of Guernsey in respect of an international registration.

5. (1) Where an international registration designates Guernsey, the Registrar shall examine the mark as if it were an application under section 32 of the Ordinance and shall provisionally either -

- (a) grant protection to the international registration, or

(b) refuse to grant protection to the international registration.

(2) Where the mark is provisionally accepted for registration under paragraph 5(1), it shall be an "**international trade mark (Guernsey)**" and –

(a) the Registrar -

(i) shall publish the mark for opposition in accordance with regulation 6, and

(ii) where the Registrar has previously issued a provisional refusal in respect of the international registration, may determine the classes of goods and services in respect of which the international registration is registered in Guernsey, notwithstanding the classes of goods and services set out in the international registration, and

(b) it shall have the same effect in Guernsey as an application made under section 32 of the Ordinance with the date of filing being the date of registration or the date of designation (if later), and the provisions of the Ordinance shall take effect accordingly.

(3) Registration of the mark must be provisionally refused under paragraph 4(1) in accordance with Article 5 of the Protocol, if the mark –

- (a) cannot be accepted,
- (b) can only be accepted with conditions,
- (c) contains elements in a language other than English where the proprietor has not declared that the word has no meaning and no English is included in the international registration,
- (d) is a collective mark and no regulations regarding the use of the mark have been filed with the Registrar within 3 months from the designation of Guernsey and otherwise in accordance with paragraph 5 of Schedule 1 of the Ordinance, or
- (e) is a certification mark and no regulations regarding the use of the mark have been filed with the Registrar within 3 months from the designation of Guernsey and otherwise in accordance with paragraph 6 of Schedule 2 of the Ordinance, or
- (f) has been published for opposition and regulation 6(2) applies,

and notice of such provisional refusal must be transmitted to the International Bureau together with a statement of grounds therefor.

- (4) Where the Registrar provisionally refuses registration -

(a) the holder has the same rights and remedies as if the mark had been filed directly with the Registrar,

(b) the holder may –

(i) where subparagraphs 3(1) - (d) apply, request a review or hearing before the Registrar, or

(ii) where subparagraph 3(f) applies, may file a counter-statement,

within 3 months from the date on which notice of the provisional refusal was sent by the International Bureau to the holder and where the holder has no address for service in Guernsey any such request must be made by an agent domiciled in Guernsey, together with the relevant power of attorney, and

(c) where the holder does not make a request or file a counter-statement, as the case may be, in accordance with subparagraph (b), the designation of Guernsey shall be deemed to be abandoned, subject to subparagraph (d), below,

(d) where the provisional refusal is only partial in respect of limited goods or services, and where the holder does not make a request or file a counter-statement, as the case may be, in accordance with subparagraph (b), the Registrar shall publish the international registration for

opposition under Regulation 6, limited to those classes of goods or services not covered by the partial refusal.

Opposition in respect of an international registration.

6. (1) Where the Registrar publishes a mark for opposition under regulation 5(2)(a) -

(a) such publication shall be in accordance with section 38 of the Ordinance and the provisions of the Ordinance shall have effect accordingly, and

(b) the time period prescribed for opposition for the purposes of section 38(2) shall be 20 days,

(2) Where notice of opposition is received within the prescribed period the Registrar shall notify the International Bureau in accordance with regulation 5(3).

(3) Following receipt of the notice of opposition and any counter-statement received in accordance with regulation 5(4)(b), and after due consideration of the same, the Registrar shall decide whether or not to protect the mark in Guernsey.

Statement of grant of protection in respect of an international registration.

7. (1) Where the Registrar publishes a mark for opposition under regulation 5(2)(a) and no notice of opposition is received, the Registrar shall send a statement of grant of protection to the International Bureau.

(2) Where the Registrar has notified the International Bureau of a provisional refusal under regulation 5(3), and is able consequently to give effect to the

mark in Guernsey (in full or part) the Registrar shall send to the International Bureau

–

- (a) notification of the withdrawal of the provisional refusal, and
- (b) a partial or full statement of grant of protection, as the case may be, detailing the goods and services for which or the conditions under which protection of the mark has been granted

in accordance with the International Regulations.

Refusal of protection in respect of an international registration.

8. (1) Where the Registrar has notified the International Bureau of a provisional refusal under regulation 5(3), and is not able to give effect to the mark in Guernsey (in full or part) the Registrar shall send to the International Bureau a statement of confirmation of total refusal ('a **Statement of Total Refusal**') in accordance with the International Regulations.

Further decision affecting the protection of a mark.

9. (1) Where a mark is an international trade mark (Guernsey) and where –

- (a) a notice of provisional refusal has not been sent under regulation 5(3), or
- (b) a statement of grant of protection (see regulation 7) or a Statement of Total Refusal (see regulation 8) has been

sent to the International Bureau,

and a further decision of the Registrar or of the Royal Court affects the protection of the mark in Guernsey, the Registrar shall, to the extent that the Registrar is aware of that decision (without prejudice to Rule 19 of the International Regulations), send to the International Bureau a further statement indicating the status of the mark and, where applicable, the goods and services for which the mark is protected in Guernsey.

(2) Where a mark is an international trade mark (Guernsey) and where a decision, judgment or order of the Court invalidates the mark (in full or part) Registrar shall, if aware of that decision, notify the International Bureau in accordance with the relevant provisions of the Protocol and the International Regulations.

Transformation applications and replacement

Transformation applications

10. (1) A transformation application is an application to register a trade mark under the Ordinance where —

- (a) the mark was the subject of an international registration and the international registration was the subject of a request for extension,
- (b) the goods and services cited in the application are identical to some or all of the goods and services included in the international registration and

(c) the international registration was cancelled at the request of the Office of origin under Article 6(4) of the Madrid Protocol.

(2) A transformation application -

(a) shall state that it is made by way of transformation,

(b) may only be made before the end of the period of three months beginning with the date on which the international registration was cancelled,

(c) may only be made by the person who was the proprietor of the international registration immediately before it was cancelled, and

(d) shall be accompanied by such information as the Registrar may require together with the prescribed fee, if any.

(3) Where on or before the date the transformation application was made –

(a) the trade mark was protected as an international trade mark (Guernsey), the mark shall be registered under the Ordinance; and it shall have the date of filing of the cancelled international trade mark (Guernsey),

- (b) the international registration is not protected in Guernsey, the application shall be treated as an application to register under the Ordinance and it shall have the date of filing of the request for extension relating to that mark.

(4) Where in relation to the international registration a right of priority was claimed on the basis of a Convention application, the transformation application shall have the same right of priority.

Replacement.

11. (1) Where at the time protection is conferred on an international trade mark (Guernsey) there is a Guernsey registered trade mark and - .

- (a) the proprietor of the registered trade mark is the proprietor of the protected international trade mark (Guernsey),
- (b) the registered trade mark is the same as the protected international trade mark (Guernsey),
- (c) the goods and services in relation to which protection is conferred by the international trade mark (Guernsey) include some of those for which the registered trade mark is registered,

the holder of the international registration may request the Registrar to take note of that international registration in the Register of Trade Mark, by filing an application for the same together with payment of the prescribed fee.

(2) Replacement of the Guernsey trade mark by an international registration –

- (a) is deemed to be automatic when Article 4bis(1) of the Protocol is satisfied and the effective date of replacement is the date of the international registration or the subsequent designation, and
- (c) does not cancel or otherwise affect the Guernsey registered trade mark.

(3) Where the Registrar has taken note of an international registration under paragraph (1) this, does not cancel or otherwise affect the Guernsey registered trade mark, and the Registrar shall notify the International Bureau that the Registrar has taken note, and shall provide –

- (a) the number of the international registration in question,
- (b) where some only of the goods and services listed in the international registration are concerned, those goods and services,
- (c) the filing date and number of the application for registration of the mark in Guernsey,
- (d) the registration date and number of the registration in Guernsey,

- (e) the priority date, if any, of the registration in Guernsey,
and
- (f) information relating to other rights acquired by virtue
of the registration in Guernsey.

(4) Replacement shall only be effective in respect of goods and services that are listed in both the international registration and in respect of the Guernsey registered trade mark.

General

Renewal of international registrations designating Guernsey

12. (1) International registrations which, in accordance with Article 7 of the Protocol, have been renewed in respect of Guernsey as a designated Contracting Party shall continue to have effect in Guernsey.

Recordings in the International Register.

13. (1) Any recording made in the International Register concerning an international registration, shall, to the extent that it applies to Guernsey as a designated Contracting Party, have the same effect as if it had been recorded by the Registrar in the Register of Trade Marks.

(2) Where the Registrar considers that the recording referred to in paragraph (1) has no effect in Guernsey as a matter of Guernsey law, the Registrar shall, where so provided for in the Regulations under the Protocol, send a communication to the International Bureau to this effect, in accordance with regulation 14.

Declaration that a change in ownership or limitation has no effect in Guernsey.

14. (1) Where the Registrar is notified by the International Bureau of –
- (a) a change in ownership of an international registration affecting Guernsey,
 - (b) a limitation of the list of goods and services in an international registration affecting Guernsey, or
 - (c) a recording of a licence in an international registration affecting Guernsey,

the Registrar may declare that the change, limitation or licence, as the case may be, has no effect in Guernsey.

- (2) The declaration referred to in paragraph (1) shall indicate –
- (a) the reasons for which the change, limitation or licence (as the case may be) has no effect,
 - (b) where the declaration relates to a limitation or licence and the declaration does not affect all the goods and services to which the limitation relates, those which are affected by the it or those which are so not affected,
 - (d) the corresponding essential provisions of the Ordinance, and
 - (e) whether such declaration may be subject to review or

appeal,

and shall be made before the expiry of 18 months from the date on which the notification under paragraph (1) was sent to the Registrar.

(3) The effect of a declaration shall be, that with respect to Guernsey as the designated Contracting Party -

(a) in relation to a change of ownership, the international registration concerned shall remain in the name of the transferor, and

(b) in relation to a limitation or licence, that that limitation or licence, as the case may be, shall not apply to the goods and services affected by the declaration.

(4) The proprietor of the international registration may request a review of the declaration by the Registrar within a period of three months, counted from the date of the notification sent by the International Bureau.

(5) Where the proprietor has no address for service in Guernsey, the request for review must be submitted in writing through a duly appointed agent domiciled in Guernsey together with a power of attorney.

(6) Any final decision relating to a declaration made in accordance with paragraph (4) shall be notified to the International Bureau

Corrections in the international register.

15. Upon receiving a notification from the International Bureau of a correction of an international registration where Guernsey is designated, the Registrar may declare in a notification of provisional refusal to the International Bureau that it considers that protection cannot, or can no longer, be granted to the international registration as corrected.

Time periods.

16. (1) The Registrar shall send -
- (a) a notice of provisional refusal under regulation 5(3),
 - (b) a statement of grant of protection under regulation 7, and
 - (c) a notification of provisional refusal declaration under regulation 16,

to the International Bureau within one year of the date on which the International Bureau sent the relevant related notification or correction, as the case may be, to Registrar.

(2) The Registrar shall send a declaration that a change of ownership or limitation of the list of goods and services has no effect under Regulation 14 to the International Bureau within 18 months of the date on which the International Bureau sent the relevant related notification to Registrar.

Appeals from decisions of the Registrar.

17. (1) An appeal to the Ordinary Court lies from any decision of the Registrar under these Regulations in the same way in which a right of appeal lies

under section 74 of the Ordinance and the provisions of the Ordinance shall apply accordingly.

(2) Where an appeal is made under paragraph (1) the resulting decision, order or judgment shall be communicated to the International Bureau as a further decision in accordance with regulation 9.

Judicial notice.

18. (1) Judicial notice shall be taken of the following—

- (a) the Madrid Protocol and the International Regulations,
- (b) copies issued by the International Bureau of entries in the International Register,
- (c) copies of the periodical gazette published by the International Bureau in accordance with rule 32 of the International Regulations.

(2) Any document mentioned in paragraph (1)(b) or (c) shall be admissible as evidence of any instrument or other act of the International Bureau so communicated.

Communications between the Registrar and the International Bureau.

19. (1) Any communication, including an international application, for transmittal to the International Bureau through the intermediary of the Registrar shall be in English.

(2) Any communication concerning an international application or an international registration addressed to the International Bureau by the Registrar shall be in English.

(3) Notwithstanding any other enactment or rule of law, the registrar may communicate to the International Bureau any information which Guernsey is required to communicate by virtue of this Order or pursuant to the Madrid Protocol or International Regulations

Amendment to the Ordinance.

20. After paragraph 54(2)(f) of the Ordinance insert the following paragraph –

“(fa) any other matter provided for under the Protocol or the regulations made thereunder,”.

Interpretation.

21. In these Regulations, unless the context requires otherwise –

“**applicant**” means the person in whose name an international application is filed,

“**basic application**” means an application for the registration of a trade mark, filed with the Registrar under the Ordinance, which is used as the basis to file an international application,

“**basic mark**” means the basic registration, the basic application or any registration arising from the same,

“basic registration” means the registration of a trade mark, made by the Registrar under the Ordinance, which is used as the basis to file an international application,

“British citizen” has the meaning given in the British Nationality Act 1981,

“Contracting Party” means any country or intergovernmental organisation party to the Protocol,

“Contracting Party of the proprietor” means the Contracting Party of the Office of origin or, where a change in ownership has been recorded in the International Register, the Contracting Party in respect of which the new proprietor meets the requirements of Article 2 of the Protocol;

“designated Contracting Party” means a Contracting Party for which an extension of protection has been requested under Article 3ter(1) or (2) of the Protocol, as the case may be, or in respect of which such extension has been recorded in the International Register;

“designation”, means a request for the extension of protection under Article 3ter(1) or (2) of the Protocol, as the case may be; it also means such extension as recorded in the International Register, and cognate expressions shall be construed accordingly,

“international application” means an application for the registration of a trade mark in the International Register,

“International Bureau” means the International Bureau of the World

Intellectual Property Organisation (WIPO),

“International Register” means the register of the International Bureau,

“international registration” means the registration of a trade mark in the International Register,

“the International Regulations” means the Regulations under the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks,

“international trade mark (Guernsey)” has the meaning given in regulation 5(2),

“invalidation” means a final decision by the competent authority revoking or invalidating the effects of an international registration in Guernsey in respect of all or some of the goods or services covered by the designation of Guernsey.

“Office of origin” means the Intellectual Property Office through which the international application is filed in accordance with Article 2(2) of the Protocol

“the Ordinance” means the Trade Marks (Bailiwick of Guernsey) Ordinance, 2006,

“prescribed fee” means the fees prescribed by the Registrar and published on the Registrar’s website,

“the Protocol” means the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks,

“resident of Guernsey” means a person domiciled, or who has a real and effective industrial or commercial establishment, in the Bailiwick of Guernsey

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

Citation and commencement.

22. These Regulations may be cited as the Trade Marks ((Madrid) (Bailiwick of Guernsey) Regulations, 2020 and shall come into force on the date on which they are made.

Dated this 21st day of December 2020

A handwritten signature in black ink, consisting of several overlapping loops and a long horizontal stroke at the end.

DEPUTY N. INDER

President of the Committee for Economic Development
For and on behalf of the Committee

EXPLANATORY NOTE

(This note is not part of the Regulations)

These Regulations make provision for the extension of the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks to the Bailiwick.