

Trade Mark Act

No. 45/1997 with amendments according to Acts Nos. 67/1998, 82/1998, 13/2000, 54/2004, 88/2008, 117/2009, 126/2011, 44/2012 and 130/2014

CHAPTER I

General provisions

Article 1

Individuals and legal entities may acquire exclusive right to a trade mark in accordance with the provisions of this Act. Trade marks are distinctive identifications for goods or services for commercial use.

Article 2

Trade marks may be any sort of visible sign suited to distinguish the goods or services of one party from the goods or services of others, such as:

1. a word or word combinations, including slogans, personal names, names of enterprises or real property;
2. letters and numerals;
3. illustrations and drawings;
4. the appearance, equipment or packaging of goods.

A trade mark right cannot be acquired for a sign which shows exclusively a shape which is dictated by the goods themselves, a shape which is necessary due to the technical role of the product or which is intended in some manner for a purpose other than identification.

Article 3

Trade marks right may be established by:

1. the registration of a trade mark for goods or services in accordance with the provisions of this Act, or
2. the use of a trade mark which is and has been used in this country for goods or services.

A trade mark which is deemed not to fulfil the requirements of this Act for registration cannot acquire trade mark right by being taken into use. A trade mark which does not fulfil the requirements of the Act for distinctiveness at the commencement of use may, however, establish a trade mark right if the mark acquires distinctiveness through use.

Article 4

Trade mark right prevents anyone other than the proprietor of the trade mark from using commercially a sign which is the same as or similar to his trade mark if:

1. it is used for the same or similar goods or services as are covered by the trade mark right and
2. there is a danger of confusion, including the conclusion that there is a connection between marks.

Despite the provisions of the first paragraph concerning the same or similar goods and services, the proprietor of a trade mark may also prohibit its use for other goods and services if the trade mark is well known in this country and the use would comprise misuse or lessen the distinctive nature of the characteristics or reputation of the known mark.

The mark may not be referred to in selling spare parts or accessories for a product without the consent of the proprietor, if this is done in such manner that it could be assumed that the accessories originated with the proprietor or that he had authorised the use of the mark.

Article 5

Commercial use of a trade mark includes, for instance:

1. placing a mark on goods or their packaging,
2. offering for sale, placing on the market or preparing to place on the market, goods or services identified with the mark,
3. importing or exporting goods or services identified with the mark,
4. using the mark in advertisements, letterheads or in other similar fashion.

Article 6

Provided that the use is in accordance with honest business practice, the proprietor of a trade mark may not prohibit others from using in trade or business:

1. his own name, name of real property or of his commercial operations;
2. descriptions of a type of goods or services, their condition, quantity, use, price, origin, when produced or offered to the public, or of other characteristics of goods or services.

[If the owner of a trade mark has placed on the market goods or services which enjoy trade mark right or authorised such within the European Economic Area, he may not subsequently hamper the use, sale, rental, import, export or other distribution of the goods or services in that area.]¹⁾

¹⁾Act No. 117/2009, Art 1.

Article 7

If two or more parties individually claim a trade mark right to identifications which are confusingly similar an earlier right shall take priority over a later one unless otherwise implied by provisions below.

The protection for a registered trade mark commences on the date of filing or the original date of priority, cf. Articles 17 and 18.

Article 8

A later right to a registered trade mark may enjoy protection parallel to the right of an earlier mark, even though the marks may be confusingly similar, if an application for registration was filed in good faith and the proprietor of the earlier trade mark, despite knowledge of the later mark, has raised no opposition to its use in this country for a continuous five-year period from the date of registration.

Article 9

A later right to a trade mark may also enjoy protection parallel to the right of an earlier mark, even though the marks may be confusingly similar, if the proprietor of the earlier trade mark has not, within a reasonable time, taken the necessary steps to prevent the use of the later mark.

Article 10

In the instances referred to in Articles 8 and 9 the Courts may, should this be considered reasonable, decide that one or both of the marks may only be used in a special manner, e.g. that they be of a certain type, include an additional place name or be distinguished by other means.

Article 11

Upon the request of the proprietor of a registered trade mark, authors and publishers of dictionaries, reference works, school books and other specialised literature, are obliged to ensure that the mark is not used without express mention being made of the fact that this is a registered trade mark.

Anyone failing to fulfil the obligation in the first paragraph must pay for a correction to be published in a manner deemed reasonable.

CHAPTER II

Registration of trade marks

Article 12

An application for the registration of a trade mark must be filed in writing to the Icelandic Patent Office, which handles the registration of trade marks and maintains the Trade Mark Register. The application shall specify what is the mark, including an illustration if appropriate, and for what goods or services registration is requested. It shall also give the name of the individual or enterprise applying and be accompanied by the prescribed fee. In addition the application shall be in accordance with the provisions of a Regulation, cf. Article 65.

Article 13

It is a condition for registration that a trade mark be suitable for distinguishing the goods [and services]¹⁾ of the proprietor from those of other parties. A mark which indicates exclusively, or with only minor alterations or additions, the type of product [or service]¹⁾, condition, quantity, use, price, origin or when it was produced [or the service provided]¹⁾, shall not be deemed to possess sufficiently distinctive characteristics. The same shall apply to a sign or word combination which is common in trade or is used in everyday speech.

In order to determine whether a mark has sufficiently distinctive characteristics all circumstances must be considered, in particular how long and to what extent the mark has been in use.

1) Act No. 44/2012, Art. 1.

Article 14

A trade mark may not be registered:

1. if it contains, without authorisation, state emblems, official international symbols, emblems of Icelandic municipalities, official inspection or quality signs, specific names of these identifications of anything else likely to be confused with the abovementioned symbols and emblems; the prohibition shall include only official inspection and quality signs if registration of the mark is sought for the same or similar products as those for which the above-mentioned signs and symbols are used;
2. if the mark is liable to cause confusion, for instance, as to the type of product, condition or origin.
3. if the mark is contrary to law or public order or likely to cause offence,
4. if the mark contains anything which may give cause to conclude that it is the name of an active commercial operation or the name or portrait of another person, providing this does not involve individuals long dead or if the mark includes a distinctive name of real property or an illustration of it,
5. if the mark contains anything which may cause it to be interpreted as the distinctive title of a protected literary or artistic work or if it infringes the copyright of another person to such work or other intellectual property right,
6. if the mark is liable to be confused with a trade mark which has been registered in this country or which has been in use here when the application for registration was filed and is still in use here,
7. if the mark is liable to be confused with a mark which may be considered to have been [widely known]¹⁾ in this country at the time the application for registration was filed,
8. if the mark is liable to be confused with a trade mark which has been internationally registered, provided that this registration was valid in this country before the application was filed, cf. Article 59.
- [9. if the mark is liable to be confused with a mark which has been in use in another country, at the time the application was filed or from the priority date, and is still in use there for the same or similar goods/services as the younger mark is to be registered for, and the applicant knew or should have known of the foreign mark.]¹⁾

[10. if there already is a product name, protected under the Law on protection of product names referring to origin, geographical area or traditional specialities, for the same or similar products as the application for the registration of a mark applies and the application for the protection of the product name was filed before the application for the registration of said trademark.]²

Notwithstanding the provisions of points [4-9]¹⁾, a mark may be registered if the consent of the trade mark proprietor or other rightholder has been given.

A trade mark for wines and spirits which implies a geographical name for wine or spirits may not be registered unless the product originates at the location in question.

¹⁾Act No. 44/2012, Art. 2. 2) Act No. 130/2014, Art. 42

Article 15

The trade mark right acquired through registration does not cover such elements of the mark which could not be registered separately.

Should there be reason to expect that the registration of a mark could cause doubt as to the scope of the trade mark right, specific exclusion from protection of individual elements of it may be made at the time of registration.

Should that element of the mark which has been excluded from protection subsequently prove eligible for registration such elements of the mark, or the mark as a whole, may be registered without the restrictions referred to in the second paragraph.

Article 16

A trade mark shall be registered for a specific class or classes of goods or services. Marks may not be registered for an entire class or classes without specifying the goods or services for which trade mark registration is requested.

The classification of goods and services shall be determined by the Minister and advertised.¹⁾

1) *Trademark advertisement No. 100/2070, Trademark advertisement 1190/2011.*

Article 17

If an application for the registration of a trade mark is filed in this country within six months of the time first application was made for its registration in a country party to the Paris Convention for the Protection of Industrial Property or the agreement on the establishment of the World Trade Organisation (WTO), this application shall have the right of priority from the first date of application if a request is filed to this effect. An application having the right of priority is considered, with regard to later occurrences such as applications from other parties for registration or use of the mark, to have been filed simultaneously with the filing of the application for the mark abroad.

In the case of reciprocal legal protection, the Minister may decide in a Regulation that the provisions of the first paragraph shall also apply to applications filed in countries which are not parties to the Paris Convention or agreement on the founding of the WTO.

Article 18

If application is made for the registration of a trade mark within six months from the first use of the mark for goods or services displayed at an official exhibition or at an international exhibition in this country, the mark shall be considered, with respect to later occurrences such as applications from other parties for registration or use of the mark by others, to have been filed simultaneously with the presentation of the mark at the exhibition.

Article 19

If an application for the registration of a trade mark does not comply with legal provisions or if the Patent Office is of the opinion that other barriers should cause the rejection of the registration, the applicant shall be sent a reasoned statement of refusal and [he shall be given the

opportunity to express himself or emend the application within a specified time limit.]¹⁾ Upon the expiry of this period the Patent Office will re-examine its position towards the application.

[Should the applicant fail to submit comments or emend the application within the specified time limit referred to in the first paragraph, the application shall be cancelled.

At the request of the applicant, an application shall be re-examined if the applicant, within two months of the expiration of the time limit referred to in the first paragraph, expresses himself concerning the case or emends the application, and provided the re-examination fee is paid.]¹⁾

¹⁾Act No. 44/2012, Art. 3.

Article 20

Should anyone claim to the Patent Office that he is the proprietor of a registered trade mark, or a trade mark for which registration has been sought, the Office may recommend that the party concerned institute proceedings within a specified time limit to establish this. In this recommendation mention shall be made of the fact that failure to institute proceedings may result in the Patent Office ignoring his claims. If legal proceedings are initiated to establish the right to a trade mark, processing by the Patent Office may be postponed.

Article 21

If an application for the registration of a trade mark is deemed to fulfil the requirements for registration the mark shall be registered and published. The published announcement shall include the principal information concerning the registration and an illustration of the mark if appropriate. Trade marks shall be published in the Patent Gazette, published by the Patent Office.

[The Patent Gazette may be published and distributed electronically, for example on the Internet.]¹⁾

¹⁾ Act No. 54/2004, Art. 2

Article 22

The registration of a trade mark may be opposed after its publication. Oppositions shall be filed in writing to the Patent Office within two months of the date of publication and include the grounds for opposition [and the prescribed fee.]¹⁾

If oppositions are raised to the registration of a trade mark the Patent Office shall re-examine the registration in accordance with the provisions of Article 19. The proprietor of the registration shall be notified of the oppositions and given the opportunity to file his comments thereon.

If the Patent Office does not take the oppositions into consideration a formal ruling to this effect shall be made known to the opponent and the proprietor of the registration.

If the Patent Office does take the oppositions into consideration a formal ruling on the full or partial invalidation of the registration of the mark, shall be made known to the opponent and the proprietor of the registration.

The result of the ruling referred to in the third and fourth paragraphs shall be published in the Patent Gazette.

¹⁾Act No. 44/2012, Art. 4.

Article 23

If an application for the registration of a trade mark, which is based on the right of priority in accordance with Articles 17 or 18, is filed after a similar mark has been registered and the Patent Office is of the opinion that the application would have prevented the registration, the proprietor of the registered trade mark shall be notified thereof and given the opportunity to express his comments thereupon. Should the application based on right of priority be accepted the registration shall be wholly or partially invalidated.

The provisions of the first paragraph shall also apply when the Patent Office receives notice requesting that an international registration also apply in this country and it is evident that such registration would have prevented the registration of a mark which was applied for after the international registration took effect here, cf. Article 59.

Article 24

At the request of the proprietor of a trade mark and upon payment of the prescribed fee, minor alterations may be made to a registered trade mark, provided that the general impression of the mark is not influenced. Alterations to a registered trademark shall be entered in the Register of Trade Marks and shall be published in the Patent Gazette.

[Article 24 a

The Patent Office may, at the proprietor's request and after payment of the prescribed fee, divide an application which includes more than one category of goods or services into two or more applications. The request must specify which category of goods or services each application applies to following the division. When a request for division has been processed, the application which is created receives a new, separate application number but retains the same filing date and priority date as the original registration. A decision on division shall be published in the ELS Gazette.

The Patent Office may, at the proprietor's request and after payment of the prescribed fee, divide a registration which includes more than one category of goods or services into two or more registrations. The request must specify which category of goods or services each registration applies to following the division. When a request for division has been processed, the registration which is created receives a new, separate registration number but retains the same filing date and priority date as the original registration. A decision on division shall be published in the ELS Gazette.]¹⁾

¹⁾Act No. 44/2012, Art. 5.

Article 25

If the proprietor of a registered trade mark has not, within five years of the date of registration, used the trade mark in this country for the goods or services for which it was registered, or if such use has not occurred during a continuous five-year period, the registration may be invalidated [by a court judgement or decision by the Patent Office, cf. Articles 28 and 30 a]¹⁾, unless there are valid reasons for the failure to use the trade mark.

If a trade mark is used in a version different from that in the Register of Trade Marks, but such difference is, however, only insignificant and does not affect its distinctiveness, or if the mark has been used on goods or packaging in this country which are intended exclusively for export, such shall be considered to constitute use as referred to in the first paragraph.

If a trade mark is used by a party other than the proprietor but with his authorisation, such shall be considered to constitute use by the owner.

The registration shall not, however be eradicated if use of the mark commences after the end of the five-year period but before a request for invalidation is filed. If a request for invalidation has not been filed until at least three months have passed from the expiry of the five-year period, and the proprietor of the mark has commenced or re-commenced its use during the three months prior to the submission of the request for invalidation such use shall not have effect on the request for invalidation, provided the proprietor of the mark knew that the request would be filed when commencing preparations for its use.

Should the use requirement have been complied with for part of the goods or services for which the trade mark was registered the invalidation shall not extend to this part of the registration.

¹⁾Act No. 44/2012, Art. 6.

Article 26

The protection of a registered trade mark begins on the date upon which the application in accordance with Article 12 was filed and shall apply for ten years from the date of registration.

In accordance with an application from the proprietor of the mark the registration shall be renewed for a ten-year period at a time, calculated from the end of each period of registration.

Article 27

An application for renewal of a trade mark registration may be filed to the Patent Office as early as six months prior to the expiration of a registration period but no later than six months after the expiration of this period. The prescribed fee shall accompany the application.

Should the Patent Office regard the application as satisfactory the renewal shall be entered into the Register of Trade Marks and published in the Patent Gazette. Should the application be considered unsatisfactory the applicant shall be notified of such and given a specific time limit within which he may rectify the application.

Should no application for renewal be filed within the time limit referred to in the first paragraph the registration of the mark is no longer valid.

[At the request of the proprietor of a trade mark registration, the application for renewal shall be examined if the owner, within two months of the expiration of the time limit referred to in the first paragraph, files an application for renewal and pays the prescribed re-examination fee.]¹⁾

¹⁾Act No. 44/2012, Art. 7.

CHAPTER III

Cancellation of registration

Article 28

If a trade mark has been registered contrary to this Act the registration may be cancelled by verdict of a Court [or a decision by the Patent Office]¹⁾, subject, however, to the provisions of Articles 8-10. If the reason for invalidation is a lack of distinctiveness of the mark or other causes referred to in Article 13, assessment shall also have regard to use which has occurred after registration.

Registration may also be invalidated by verdict of a Court [or a decision by the Patent Office]¹⁾ if a trade mark:

1. is not used in accordance with the provisions of Article 25,
2. has, due to activity or inactivity on the part of the proprietor, acquired a general significance for a product or service in the area covered by the registration,
3. is used in a manner which could mislead persons, for instance, as to the type, condition or origin of goods or services.

[If invalidation is demanded due to a danger of confusion with an older mark, this demand can only be accepted if the party demanding invalidation demonstrates that the use of the older mark complies with Art. 25. If usage is demonstrated only for part of the goods or services the provision of the fifth paragraph of Art. 25 shall apply.]¹⁾

¹⁾Act No. 44/2012, Art. 8.

Article 29

Anyone who has legitimate interests at stake is entitled to initiate proceedings against the proprietor of a mark for the purpose of having its registration cancelled.

In instances covered by the provisions of Points 1-3 of Article 13, the first paragraph of Article 14, Article 25 and the second paragraph of Article 28, the Patent Office shall be the plaintiff in litigation.

Article 30

Anyone with legitimate interests at stake may demand that the Patent Office eradicate the registration of a trade mark if it is demonstrated that the activities of its proprietor have ceased.

Before the Patent Office eradicates a registration in response to a demand under the first paragraph, the proprietor of the trade mark should be notified and given the

opportunity to express his comments within three months' time. Such notification should be sent in a verifiable manner. If the address of the proprietor of a trade mark is unknown the notification should be advertised in the Official Gazette. If the proprietor fails to contact the

Patent Office within the above-mentioned time limit the mark shall be eradicated from the Register.

[Article 30 a

After a mark has been registered and the time limit for opposition and/or appeal has expired, any party with legitimate interests at stake may request that the Patent Office invalidate the registration if the conditions of Art. 28 are satisfied. This request must be made in writing and include the grounds and prescribed fee.

The proprietor of the mark shall be notified and is entitled to express himself on the matter within a prescribed time limit before the Patent Office takes a decision in the matter. If the Patent Office decides to invalidate the registration in full or in part a notification to this effect shall be published in the ELS Gazette. A request for invalidation as referred to in the first paragraph may not be submitted if a case concerning the same registration is being examined by a court.

If a court action is brought concerning a registration on the same basis as stated in a request as referred to in the first paragraph, and before the Patent Office has taken a final decision, the Patent Office shall postpone processing the case until the court's conclusion is available.]¹⁾

¹⁾ Act No. 44/2012, Art. 9.

Article 31

Should the Patent Office make an obvious error in the registration, renewal or entry into the Register of a trade mark, the Office may correct the mistake. The correction shall be published in the Patent Gazette.

[The proprietor of an application or trade mark registration may submit a request to have obvious errors in an application or registration corrected.]¹⁾

¹⁾ Act No. 44/2012, Art. 10.

Article 32

Trade marks shall be eradicated from the Trade Mark Register:

1. if the registration is not renewed,
2. at the request of the proprietor of the mark,
3. if the registration is declared invalid following oppositions,
4. if the registration is declared invalid in accordance with Article 23,
5. upon a verdict of a Court for the invalidation of a trade mark,
6. upon a decision by the Patent Office if the activities of the proprietor of a trade mark have been confirmed to have ceased, cf. Article 30,
7. in accordance with a decision by the Patent Office if an obvious mistake has occurred in the registration, renewal or amendment, cf. Article 31,
8. if no agent has been appointed, cf. Article 35,
9. [upon request by [the Ministry responsible for Iceland's national flag]¹⁾ if a trade mark where the Icelandic national flag has been used without its permission, has been registered by mistake].²⁾
10. [in accordance with a decision by the Patent Office, if the registration does not satisfy the requirements of Art. 28, cf. Art. 30 a.]³⁾

The eradication of trade marks in accordance with the first paragraph shall be published in the Patent Gazette.

¹⁾ Act No. 126/2011, Art. 236.

²⁾ Act No. 67/1998, Art. 14.

³⁾ Act No. 44/2012, Art. 11.

CHAPTER IV

Special rules on the registration of foreign trade marks

Article 33

An applicant who has neither activities in this country nor is a resident of a state which is a party to the Paris Convention for the Protection of Industrial Property or the agreement on the establishment of the World Trade Organisation (WTO) must prove that he has obtained registration for a corresponding mark in his home country for the goods or services covered in his application.

Subject to reciprocity the Minister may decide to waive the provisions of the first paragraph concerning the onus to prove registration in the home country.

Article 34

The Minister may decide that a trade mark which would not be registrable in this country but which has been registered in another country, may be registered here in the same manner as in the foreign country. Such registration shall not, however, provide wider protection in any respect than afforded by the registration in the foreign country.

Article 35

[The proprietor of a trade mark, who is not domiciled in this country, must have an agent residing in the European Economic Area, a member state of the European Free Trade Association (EFTA) or the Faroe Islands.]¹⁾ The agent must be authorised by the proprietor of the mark to receive summons, as well as other notification concerning the mark, on his behalf with binding effect on the proprietor. The name and address of the agent shall be entered in the Register of Trade Marks.

Should no agent be appointed or should an agent resign from such representation, the proprietor of a mark is obliged to rectify this matter within a time limit decided by the Patent Office. If the address of the proprietor of a trade mark is unknown the notice of the time limit should be published in the Patent Gazette. Should no agent be appointed in accordance with the above before the expiry of the time limit the mark shall be eradicated from the Register.

[The legal venue in court cases filed in accordance with this Act, where the proprietor of a trade mark is not domiciled in this country, shall be in Reykjavík].²⁾

[The Patent Office shall communicate with applicants and proprietors of trade mark registrations or their agents in Icelandic. In exceptional instances the Office may accept documentation in foreign languages.]¹⁾

¹⁾ Act No. 44/2012, Art. 12.

²⁾ Act No. 13/2000, Art. 1.

CHAPTER V

Transfer, licenses, etc.

Article 36

The right to a trade mark may be transferred along with the commercial activity in which it is used or separately.

If anyone transfers his commercial activities the transferee shall acquire the trade marks belonging to it unless otherwise agreed upon.

Article 37

Anyone acquiring the right to a registered trade mark shall notify such to the Patent Office, who shall enter the change of ownership in the Register of Trade Marks. Until a transfer has been notified the latest registered proprietor of a mark shall be deemed its proprietor.

Article 38

The proprietor of a trade mark may grant others authorisation to use the mark commercially (a license). Licenses may be exclusive or non-exclusive and may cover all or part of the goods or services for which a trade mark has been registered.

The proprietor of a registered trade mark may invoke his trade mark rights against a licensee who contravenes the provisions of a license agreement with regard to the duration, the version of the mark which may be used, where and when it may be used, or provisions concerning the quality of goods or services offered by the licensee under the trade mark. Unless expressly agreed, a licensee may not transfer his right.

The proprietor of a trade mark or licensee may, upon payment of a prescribed fee, request that a license be entered in the Register of Trade Marks and published in the Patent Gazette. The same shall apply upon the expiration of a license. The Patent Office may refuse to enter a license if it is of the opinion that use of the mark by the licensee could lead to a danger of confusion.

Article 39

If the right to a registered trade mark has been used as collateral or taken for execution, such shall be entered in the Register of Trade Marks if the proprietor of the mark, mortgagee or executing creditor so requests.

CHAPTER VI

Prohibition against the use of deceptive trade marks

Article 40

Should the use of a trade mark be considered deceptive, after it has been transferred or a license to use it has been notified, the party concerned may be prohibited by verdict of a Court from using the mark in its existing form.

The same applies in other cases where a trade mark is deceptive, its proprietor uses it in a deceptive manner, or another party does so with his consent.

The Patent Office, or anyone else with interests at stake, may initiate proceedings in accordance with this Article.

CHAPTER VII

Legal Protection

Article 41

A court injunction may be demanded against any activity which has already commenced or is demonstrably pending and infringes or will infringe against a trade mark right.

Article 42

Use of a trade mark which is contrary to this Act may be prohibited by verdict of a Court.

Wilful infringement of trade mark right shall be fined. Depending upon the circumstances, punishment could take the form of...¹⁾ imprisonment of up to three months

Fines as provided for in this Act may be levied against legal entities or individuals. Legal entities may be fined regardless of whether an employee of the legal entity has been found guilty of an infringement. If an employee of a legal entity has committed an infringement against this Act or rules set in accordance with it, the legal entity may also be fined, provided the infringement was carried out for the financial advantage for the legal entity or it has profited from the infringement. A legal entity is responsible for the payment of a fine levied against its employee due to an infringement against this Act, provided the infringement is connected to his work for the legal entity.

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¹⁾ Act No. 82/1998, Art. 243.

²⁾ Act No. 13/2000, Art. 2.

Article 43

Anyone who wilfully or negligently infringes a trade mark right shall be obliged to make reasonable remuneration for the exploitation of the trade mark and compensation for other damage resulting from his infringement.

Anyone profiting from an infringement of a trade mark right, which involves neither intention nor negligence, shall be obliged to make reasonable remuneration.

Such remuneration may, however, not exceed his assumed profit as a result of the infringement.

Article 44

In cases arising due to infringements of trade mark rights a Court may decide on measures to prevent abuse of a trade mark. To this end a Court may decide that the mark shall be removed from goods which are in the possession of the party concerned or otherwise at this party's disposal. If necessary a decision may be taken to destroy the goods or deliver them to the aggrieved party with or without compensation.

Article 45

Anyone who considers his interests to have been infringed against may initiate proceedings under Articles 43 and 44. These suits shall be prosecuted as civil cases, but claims under Article 43 may also be presented in a [criminal suit].¹⁾

¹⁾ *Act. No. 88/2008, Art. 234.*

Article 46

Should a licence have been issued for the use of a trade mark either the licensor or licensee shall have the right to prosecute in cases concerning infringements against trade mark rights, provided otherwise has not been agreed.

Should a licensee initiate proceedings he shall notify the licensor thereof. Failure to fulfil this obligation may result in the dismissal of the case.

CHAPTER VIII

International Registration of Trade Marks

Article 47

International registration of a trade mark means registration of a trade mark with the International Bureau operated by the World Intellectual Property Organisation (WIPO) under a Protocol of 27 June 1989 to the Madrid Agreement on the International Registration of Trade Marks of 14 April 1891.

In Iceland the Patent Office accepts applications for international registration of trade marks and handles international registrations.

Article 48

For acceptance of an international application, the applicant must be an Icelandic citizen, an individual domiciled in this country, or a party having a real and effective commercial establishment here who has already filed an application for the registration of the trade mark in this country or had the trade mark registered here.

Article 49

An application must be filed in writing to the Icelandic Patent Office on an application form for this purpose. The application shall be in English and shall specify what is the mark, including an illustration if appropriate, and for what goods or services registration is requested. It shall also give the name of the applicant or the name of the commercial activity. The prescribed fee for reception and handling must be paid.

Article 50

The Patent Office shall investigate whether the information in an international application corresponds with information in the application or registration of the trade mark in this country.

Should there be any discrepancies the applicant shall be notified of such and set a time limit for the submission of his comments or corrections. Should no comments have been received from the applicant within the prescribed time limit his application shall be considered to have been

withdrawn; if, despite his comments, discrepancies remain the Patent Office may refuse to forward the application to the International Bureau.

If the information corresponds with that referred to in the first paragraph the Patent Office shall send a certification of such, along with the international application, to the International Bureau. The certification shall include the date of filing and the number of the national application, and registration if appropriate, upon which the international application is based.

Article 51

If the Patent Office receives notification from the International Bureau that the proprietor of an international trade mark registration, which does not fulfil the requirements of Article 48, has requested the extension of the registration to include this country, it shall examine the registrability of the mark upon payment of the prescribed fee.

Article 52

Should the Patent Office consider the internationally registered trade mark not registrable in Iceland, the proprietor of the registration may express his comments on the matter and request that it be re-examined. The proprietor of the registration shall in such case appoint an agent in accordance with Article 35. The conclusion of the Patent Office shall be sent to the International Bureau, together with its grounds, before 18 months have elapsed from the date of notification by the International Bureau, cf. Article 51.

If the Patent Office is of the opinion that there is nothing to prevent an international trade mark registration from being valid in this country it shall be published in the Patent Gazette. The published announcement shall include the date which the International Bureau has decided as the registration date of the international registration.

Article 53

Oppositions may be raised to the validity of an international registration in this country after its publication in the Patent Gazette. Reasoned oppositions must reach the Patent Office within two months of the date of publication.

Upon receiving the oppositions, the Patent Office shall send notification to the International Bureau that the registration will not become valid in Iceland immediately, together with the reasons for the oppositions.

The proprietor of an international registration may express his comments within a prescribed time limit and shall in such case appoint an agent in accordance with Article 35.

The opponent and the proprietor of the international registration shall be notified of the ruling of the Patent Office when it is available.

When the final conclusion is available the Patent Office shall notify the International Bureau thereof. If the oppositions are taken into consideration, the registration is wholly or partly cancelled in this country. The conclusion shall be published in the Patent Gazette.

Article 54

If both an international and a national registration are valid in this country for the same trade mark, owned by the same party, and the registrations cover the same product the international registration shall replace the latter and shall confer the same right as formerly applied due to the national registration.

A change in accordance with the first paragraph shall be entered into the Register of Trade Marks and published in the Patent Gazette.

Article 55

If an international registration is wholly or partly cancelled it shall in the same manner be cancelled in this country. A notice of such shall be entered into the Register of Trade Marks and published in the Patent Gazette.

Article 56

Upon the expiry of a period of five years from the date of international registration, the registration shall remain valid in this country despite any cancellation of the registration or application which has been the basis for international registration.

Article 57

If an international trade mark registration, which was valid here in this country, is cancelled within five years of the date of registration on the grounds that the application or registration of the trade mark upon which the international registration is based can no longer serve as the basis for such a registration, and the proprietor of the trade mark subsequently files an application for the same mark to be registered in this country, that application shall be treated as if it had been filed on the date of the international registration, provided the following conditions are fulfilled:

1. the application must be filed no later than three months after the international registration was cancelled,
2. the application does not cover goods or services other than those of the international registration,
3. the application complies in other respects with the requirements applicable to Icelandic applications for trade marks, including the payment of the prescribed fee by the applicant.

Information in accordance with the first paragraph shall be entered in the Register of Trade Marks and published in the Patent Gazette.

Article 58

If the international registration of a trade mark which is valid in Iceland is cancelled within five years from the date of registration on the grounds that a country, which has been a party to the Protocol to the Madrid Agreement on the International Registration of Trade Marks, has denounced its membership and the proprietor of the trademark subsequently requests that the same mark be registered in this country, that application shall be treated as if it had been filed on the date of the international registration, provided the following conditions are fulfilled:

1. the application is filed within two years of the date on which the denunciation took effect,
2. the application does not cover goods or services other than those of the international registration,
3. the application complies in other respects with the requirements applicable to Icelandic applications for trade marks, including the payment of the pre-scribed fees by the applicant.

Information in accordance with the first paragraph shall be entered in the Register of Trade Marks and published in the Patent Gazette.

Article 59

An international trade mark registration shall take effect and have the same legal effect in this country as other registered trade marks from its date of registration, date of subsequent designation or date of right of priority provided that registration has not been refused here. This Act shall apply mutatis mutandis to such registrations.

Article 60

Information concerning international trade mark registrations, such as amendments, renewals, transfer of a mark, expiry or deletion of registration, etc. shall be published in the Patent Gazette.

Article 61

Decisions of the Patent Office concerning the processing of applications for international registration of trade marks may be referred to the Board of Appeal in accordance with the provisions of Article 63.

Article 62

The Minister shall set detailed rules¹⁾ on the implementation of this Chapter including, for instance, rules on the publishing of international trade mark registrations, oppositions to registration, renewal and fees.

¹⁾ Regulation No. 310/997, cf. 528/2004.

CHAPTER IX Miscellaneous provisions

Article 63

Decisions and rulings by the Patent Office in accordance with this Act may be referred to the Board of Appeal by the parties involved in the case within two months from the date the decision was taken. The appeal fee shall be paid within the same time limit. Should payment not be received with the time limit prescribed, the appeal shall be rejected as inadmissible.

A three-person committee, the Board of Appeal, appointed by the Minister shall issue a ruling in cases of dispute. The chairman of the committee, who shall be a lawyer with specialised knowledge of intellectual property rights, shall be appointed by the Minister for a three-year term at a time. The Minister shall appoint other members of the committee to issue rulings in individual cases of dispute.

Should the parties involved seek a ruling from a Court, they should initiate proceedings within three months of the date when the Patent Office or the Board of Appeal made its decision.

Article 64

[Everyone is entitled to acquaint themselves with the contents of a trade mark application or registration. Applications for trade marks shall be accessible as of the first working day after receipt.

The Patent Office may not grant the public access to supporting documents or documentation, in full or in part, which contains business secrets and does not generally concern the registration of or exclusive right to the mark.]¹⁾

¹⁾ Act No. 44/2012, Art. 13.

Article 65

The Minister shall set detailed rules on the preparation and submission of trade mark applications and their processing, and on the administration of registered trade marks, by the Patent Office, on the format of the Trade Mark Register and its keeping, on the issuance of registration certificates and their contents and the handling of opposition and invalidation proceedings, as well as fees for appeals. The Minister shall also set detailed rules for appeals and the Board of Appeal.³⁾

¹⁾Reg. 310/1997, cf. 528/2004 and 511/2012. Reg. 916/2001, cf. 15/2003, 898/2003, 540/2004, 1057/2007, 1044/2010, 512/2012 and 524/2012. ²⁾Reg. 275/2008. ³⁾ Act No. 44/2012, Art. 14.

[Article 65 a

A Regulation issued by the Minister shall provide for fees referred to in this Act and compensation for the services provided by the Patent Office.

Fees, including application and renewal fees, must cover the cost of operation and services provided by the Patent Office in connection with trade marks, including for national and international applications for trade marks, the examination by the Patent Office of the requirements concerning form and contents of trade mark applications, issuance and forwarding of documents on priority rights, registration of trademarks and renewal,

processing as referred to in Art. 22, publication in the *ELS Gazette*, amendments to the Trade Mark Register and transcripts from the Register and other services.

The fee tariff for services shall, among other things, be based on salaries and related expenses, training and continuing education, purchase of expert services, premises and facilities, equipment and supplies and international co-operation.

Fees provided for in this Act shall accrue to the Patent Office, which shall collect the fees.]¹⁾

¹⁾ *Act No. 44/2012, Art. 15*

Article 66

This Act shall not affect the validity of earlier trade mark registrations even though the trade marks may not fulfil the requirements of the Act for registration as new trade marks. With regard to trade marks which were registered in accordance with earlier Acts, the specification of goods or services, referred to in Article 12, shall not be applicable until the registration is renewed.

Article 67

This Act shall enter into effect on 1 June 1997.