

**TRADE MARKS ACT
(CHAPTER 98)**

**TRADE MARKS (INTERNATIONAL REGISTRATION)
RULES**

S 29/2018

REVISED EDITION 2022

SUBSIDIARY LEGISLATION

TRADE MARKS (INTERNATIONAL REGISTRATION) RULES

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TRADE MARKS (INTERNATIONAL REGISTRATION) RULES

Commencement: 21st March 2017

PART 1

PRELIMINARY

Citation

1. These Rules may be cited as the Trade Marks (International Registration) Rules.

Interpretation

2. In these Rules, unless the context otherwise requires —

“Common Regulations” means the regulations adopted under Article 10 of the Madrid Protocol, with effect from 1st April 1996, as replaced, revised or amended from time to time;

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

“International Register” means the register of trade marks maintained by the International Bureau for the purposes of the Madrid Protocol;

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

“international registration designating Brunei Darussalam” means an international registration in which a request has been made (either in the relevant international application or subsequently) for extension of protection to Brunei Darussalam under Article 3ter (1) or (2) of the Madrid Protocol;

“protected international trade mark (Brunei Darussalam)” has the meaning given by rule 17, and references to “protection” and “protected” shall be construed accordingly.

Fees

3. (1) The fees specified in Schedule 1 shall be payable to the Registrar.

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(2) Unless otherwise provided for in these Rules, or the Registrar permits or directs otherwise —

(a) where a fee is specified in Schedule 1 in respect of any matter, the fee shall be paid at the same time as the filing of the form corresponding to the matter; and

(b) if the fee is not paid, the form shall not be treated as filed.

Forms

4. (1) Any form required by the Registrar to be used for the purpose of these Rules shall be published in such manner as the Registrar may direct.

(2) Any form may be modified on the direction of the Registrar for use in a case other than the case for which it is intended.

(3) The Registrar may accept, instead of a form, any document which is filed with the Registry for any purpose for which the form was published but which deviates from the form, if the document —

(a) complies with every direction of the Registrar referred to in subrule (2) which relates to the use of the form; and

(b) is in a manner acceptable to the Registrar.

(4) Any reference in these Rules to a numbered form shall be construed as a reference to the current version of the form bearing the corresponding number which is described —

(a) in the case of Forms MP 1 and MP 2, in Schedule 2; or

(b) in the case of any other form, in Schedule 2 to the Trade Marks Rules (R 1).

PART 2

INTERNATIONAL REGISTRATION DESIGNATING BRUNEI DARUSSALAM

Entitlement to protection

5. (1) Subject to the provisions of rules 11 to 17, an international registration designating Brunei Darussalam shall be entitled to become protected where, if the

particulars of the international registration were comprised in an application for registration of a trade mark under the Act, such an application would satisfy the requirements for registration of a trade mark under the Act, including any imposed by the Trade Marks Rules (R 1).

(2) For the purposes of subrule (1), sections 33 and 35 and rules 9, 13, 14, 18, 19, 20 and 21 of the Trade Marks Rules (R 1) shall be disregarded.

Effects of protected international trade mark (Brunei Darussalam)

6. (1) The proprietor of a protected international trade mark (Brunei Darussalam) has, subject to the provisions of these Rules, the same rights and remedies as are given by or under sections 12, 13, 14, 16, 17, 18 and 21 to the proprietor of a registered trade mark.

(2) Subrule (1) is subject to the provisions relating to acts not amounting to infringement which are applicable to a registered trade mark by virtue of section 14.

(3) For the purposes of the application of section 12 —

(a) the rights of the proprietor shall have effect as of the date on which the protected international trade mark (Brunei Darussalam) is to be treated as registered under rule 17 or 26; and

(b) a protected international trade mark (Brunei Darussalam) shall be treated as being in fact registered when it becomes protected under rule 17.

(4) For the purposes of subrule (1), references in sections 13 and 14 to goods or services in respect of which a trade mark is registered shall be treated as references to goods or services in respect of which a protected international trade mark (Brunei Darussalam) confers protection in Brunei Darussalam.

(5) Where the holder of an international registration designating Brunei Darussalam, by notice in writing sent to the Registrar —

(a) disclaims any right to the exclusive use of any specified element of the trade mark; or

(b) agrees that the rights conferred in Brunei Darussalam by the international registration shall be subject to a specified territorial or other limitation,

the Registrar shall enter the disclaimer or limitation in the register and shall publish the disclaimer or limitation.

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(6) Where a protected international trade mark (Brunei Darussalam) is subject to a disclaimer or limitation, the rights conferred in relation to it by the application of section 12 are restricted accordingly.

(7) The remedy for groundless threats of infringement proceedings given by section 22 applies to a protected international trade mark (Brunei Darussalam) as it applies in relation to a registered trade mark.

(8) For the purposes of subrule (7) —

(a) the reference in section 22(3) to the registration of the trade mark shall be treated as a reference to the protection of a protected international trade mark (Brunei Darussalam); and

(b) the reference in section 22(4) to notification that a trade mark is registered, or that an application for registration has been made, shall be treated as a reference to notification that a trade mark is a protected international trade mark (Brunei Darussalam) or is the subject of an international application or international registration designating Brunei Darussalam.

Protected international trade mark (Brunei Darussalam) as object of property

7. The provisions of sections 23, 24, 25 and 27, with the necessary modifications, apply in relation to a protected international trade mark (Brunei Darussalam) as they apply in relation to a registered trade mark.

Notification of transactions

8. (1) The following are notifiable transactions for the purpose of this rule —

(a) the grant of a licence under a protected international trade mark (Brunei Darussalam);

(b) the grant of any security interest (whether fixed or floating) over a protected international trade mark (Brunei Darussalam) and any right in or under it.

(2) On application being made to the Registrar by —

(a) a person claiming to be entitled to an interest in or under a protected international trade mark (Brunei Darussalam) by virtue of a notifiable transaction; or

(b) any other person claiming to be affected by such a transaction,

the relevant particulars of the transaction shall be entered in the register.

(3) The following are relevant transactions for the purposes of this rule —

(a) an assignment of a protected international trade mark (Brunei Darussalam) or any right in it;

(b) the making by personal representatives of an assent in relation to a protected international trade mark (Brunei Darussalam) or any right in or under it;

(c) an order of the court or other competent authority transferring a protected international trade mark (Brunei Darussalam) or any right in or under it.

(4) Until —

(a) in the case of any notifiable transaction referred to in subrule (1)(b), an application has been made for the registration of the relevant particulars of the transaction; or

(b) in the case of any relevant transaction, the transaction has been recorded in the International Register,

the transaction is ineffective as against a person acquiring an interest in or under the protected international trade mark (Brunei Darussalam) in ignorance of it.

(5) A person who becomes the proprietor of a protected international trade mark (Brunei Darussalam) by virtue of any notifiable transaction referred to in subrule (1)(b) or relevant transaction is not entitled to damages or an account of profits in respect of any infringement of the protected international trade mark (Brunei Darussalam) occurring after the date of the transaction and before the transaction is recorded in the International Register.

(6) For the avoidance of doubt, subrule (4) does not apply to any relevant transaction relating to —

(a) a licence under a protected international trade mark (Brunei Darussalam); or

(b) any right in or under the licence.

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- (7) In this rule, “relevant particulars” means —
- (a) in the case of the grant of a licence under a protected international trade mark (Brunei Darussalam) —
 - (i) the name and address of the licensee;
 - (ii) where the licence is an exclusive licence, that fact;
 - (iii) where the licence is limited, a description of the limitation; and
 - (iv) the duration of the licence if the same is, or is ascertainable as, a definite period;
 - (b) in the case of the grant of any security interest over a protected international trade mark (Brunei Darussalam) or any right in or under it —
 - (i) the name and address of the grantee;
 - (ii) the nature of the interest (whether fixed or floating); and
 - (iii) the extent of the security and the right in or under the trade mark secured.

Licensing

9. (1) The provisions of sections 29, 30, 31 and 32, with the necessary modifications, apply in relation to licences to use a protected international trade mark (Brunei Darussalam) as they apply in relation to licences to use a registered trade mark.

(2) The reference in section 29(1) to goods or services for which a trade mark is registered shall be treated as a reference to goods or services in respect of which a trade mark is protected in Brunei Darussalam.

Priority

10. (1) Subject to subrule (2), the provisions of section 36 apply so as to confer a right of priority in relation to protection of an international registration designating Brunei Darussalam, as they apply in relation to registering a trade mark under the Act.

(2) The manner of claiming priority shall be determined in accordance with the Madrid Protocol and the Common Regulations.

Examination

11. (1) Upon receiving from the International Bureau notification of an international registration designating Brunei Darussalam, the Registrar shall examine whether it satisfies the requirements of rule 5.

(2) For the purpose of subrule (1), the Registrar may carry out a search, to such extent as he considers necessary, of earlier trade marks.

(3) Where the mark to which the international registration relates contains or consists of a word or words in characters other than Roman or in a language other than English, the Registrar may require the holder to —

(a) file with the Registrar a translation in English to the satisfaction of the Registrar and, if the case requires, a transliteration in English to the satisfaction of the Registrar, of the word or words; and

(b) indicate on the translation and the transliteration (if any) the language to which the word or words belong.

(4) If it appears to the Registrar that the requirements of rule 5 are not met, or are met only in relation to some of the goods or services in respect of which protection in Brunei Darussalam has been requested, he shall give notification of refusal to the International Bureau.

(5) The notification of refusal shall specify a period within which the holder may make representations.

(6) If the holder requires an extension of time to make representations, he shall file with the Registrar his request for an extension of time in Form TM 6 before the expiry of the period in question or any extended period previously granted by the Registrar.

(7) A holder making representations shall file with the Registrar an address for service in Brunei Darussalam in Form TM 22.

(8) A request by the holder to the Registrar to change or correct an address for service shall be made in Form TM 22.

(9) The following shall be notified to the Registrar in Form TM 22 —

(a) any appointment of an agent for a matter for which no form is prescribed;

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(b) any change of an agent for a matter.

(10) Where an agent for a party to any proceedings intends to cease to act on the party's behalf —

(a) the agent shall file, and serve on the party and on the Registrar, a notice in Form TM 22 of the intention to cease to act on the party's behalf; and

(b) upon complying with paragraph (a), the agent shall cease to be the agent for the party.

Publication

12. Where following examination it appears to the Registrar that the requirements of rule 5 are met in relation to some or all of the goods or services comprised in the international registration, the Registrar shall publish the particulars of the international registration in the Trade Marks Journal.

Notice of opposition

13. (1) A person (in these Rules referred to as the opponent) may, within 3 months after the date of the publication of the international registration in the Trade Marks Journal, file with the Registrar a notice opposing the conferring of protection on the international registration (in these Rules referred to as the notice of opposition) in Form TM 4.

(2) The opponent shall enter an address for service in Brunei Darussalam in the form referred to in subrule (1).

(3) Upon filing of a notice of opposition, the Registrar shall, within 5 months after the date of the publication of the international registration in the Trade Marks Journal, give notification of refusal to the International Bureau stating the matters relating to the opposition.

(4) A request for an extension of time to file the notice of opposition —

(a) shall be made by filing with the Registrar Form TM 6 within 3 months after the date of the publication of the international registration in the Trade Marks Journal; and

(b) shall state —

(i) the reason for the extension; and

- (ii) the name and address of every person likely to be affected by the extension.

(5) The person requesting for the extension must, at the time the request mentioned in subrule (4) is filed with the Registrar, serve on the applicant, and on each person likely to be affected by an extension of time to file the notice of opposition, a copy of that request.

(6) The total extension of time for which the Registrar may allow to file the notice of opposition shall not exceed 4 months after the date of the publication of the application for registration.

(7) The Registrar may refuse to grant an extension of time to file the notice of opposition if the person requesting for the extension —

(a) fails to show a good and sufficient reason for the extension; or

(b) fails to show to the Registrar's satisfaction that the request mentioned in subrule (4)(a) has been served on the applicant and on each person likely to be affected by the extension.

(8) Upon granting an extension of time to file the notice of opposition, the Registrar must send a notification of the extension to the applicant and each person mentioned in subrule (4)(b)(ii).

(9) The applicant or any person likely to be affected by an extension of time to file the notice of opposition may, not later than 2 weeks after the receipt of the Registrar's notification of the extension, apply in writing to the Registrar for the revocation of the extension on the ground that the request mentioned in subrule (4)(a) had not been served on the applicant or on that person (as the case may be).

Counter-statement

14. (1) Within 4 time after the date of the Registrar's notification of refusal based on opposition to the International Bureau, the holder shall file with the Registrar —

(a) a counter-statement in Form TM 5 setting out the grounds on which he relies as supporting the international registration designating Brunei Darussalam, and the facts alleged in the notice of opposition which he admits, if any (in these Rules referred to as a counter-statement); and

(b) an address for service in Brunei Darussalam in Form TM 22.

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(2) The holder shall at the same time serve on the opponent a copy of both documents.

(3) A request for an extension of time to file the counter-statement —

(a) shall be made to the Registrar in Form TM 6 within 4 months after the date of the Registrar's notification of refusal based on opposition to the International Bureau; and

(b) shall state —

(i) the reason for the extension; and

(ii) the name and address of every person likely to be affected by the extension.

(4) The holder shall, at the time the request mentioned in subrule (3) is filed with the Registrar, serve on the opponent, and on each person likely to be affected by an extension of time to file the counter-statement, a copy of that request.

(5) The total extension of time for which the Registrar may allow to file the counter-statement shall not exceed 6 months after the date of the Registrar's notification of refusal based on opposition to the International Bureau.

(6) The Registrar may refuse to grant an extension of time to file the counter-statement if the holder —

(a) fails to show a good and sufficient reason for the extension; or

(b) fails to show to the Registrar's satisfaction that the request mentioned in subrule (3) has been served on the opponent and on each person likely to be affected by the extension.

(7) Upon granting an extension of time to file the counter-statement, the Registrar shall send a notification of the extension to the opponent and each person mentioned in subrule (3)(b)(ii).

(8) The opponent or any person likely to be affected by an extension of time to file the counter-statement may, not later than 2 weeks after the receipt of the Registrar's notification of the extension, apply in writing to the Registrar for the revocation of the extension on the ground that the request mentioned in subrule (3) had not been served on the opponent or on that person (as the case may be).

(9) For the avoidance of doubt, if the holder fails to comply with subrule (1) or (3) in relation to any class of goods or services in respect of which protection is opposed, the Registrar shall be entitled to treat the holder's request for protection in Brunei Darussalam in respect of those goods or services as withdrawn, and the refusal shall subsist in respect of those goods or services.

Further procedures

15. (1) Upon the filing of a notice of opposition under rule 13 and a counter-statement under rule 14, rules 29 to 33 of the Trade Marks Rules (R 1), with the necessary modifications, apply to further proceedings thereon.

(2) For the purposes of applying rules 29 to 33 of the Trade Marks Rules (R 1) —

(a) a reference in those rules to the applicant shall be treated as a reference to the holder; and

(b) a reference in those rules to the application shall be treated as a reference to the international registration designating Brunei Darussalam.

Notification of refusal

16. (1) Except where refusal is based on an opposition, a notification of refusal shall not be given after the expiry of 18 months after the date on which the notification of the international registration designating Brunei Darussalam was sent to the Registrar.

(2) Where there is a possibility that opposition may be filed after the expiry of the period of 18 months, the Registrar shall inform the International Bureau accordingly.

(3) A notification of refusal shall set out the matters required by Article 5 of the Madrid Protocol and Rule 17 of the Common Regulations.

(4) Where —

(a) after a notification of refusal has been given under rule 11(4), the holder makes representations within the period specified in rule 11(5) or any extended period; or

(b) after a notification of refusal based on opposition has been given under rule 13(7), the holder files a counter-statement within the period specified in rule 14(1) or any extended period,

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the Registrar shall, upon a final decision being made in relation to the refusal, notify the International Bureau of that decision.

(5) For the purposes of subrule (4), a final decision shall be regarded as being made where —

(a) the Registrar or the court on appeal from the Registrar decides whether the refusal shall be upheld, in whole or in relation to only some of the goods or services in relation to which protection in Brunei Darussalam is requested, and any right of appeal against that decision expires or is exhausted;

(b) the representations or counter-statement is withdrawn; or

(c) the proceedings relating to the refusal are discontinued or abandoned.

Protection

17. (1) Where —

(a) after examination and publication under rules 11 and 12, respectively —

- (i) the period of 18 months after the date on which the notification of the request for extension of protection to Brunei Darussalam was sent to Brunei Darussalam has not expired, but the period for giving notification of refusal based on an opposition in accordance with rule 13(3) expires without a notification of refusal (whether based on opposition or otherwise) having been given;
- (ii) the period of 18 months after the date on which the notification of the request for extension of protection to Brunei Darussalam was sent to Brunei Darussalam has expired, and the period for giving notice of opposition specified in rule 13(1) (including any extended period) expires without a notice of opposition having been given;
- (iii) notification of refusal has been given in respect of only some of the goods or services in respect of which protection in Brunei Darussalam has been requested and the holder has made no representations within the period specified in rule 11(5) (including any extended period) or has filed no counter-statement within the period specified in rule 14(1) (including any extended period), as the case may be; or that the holder has informed the Registrar that he does not intend to make such representations or file a counter-statement; or

(iv) notification of refusal has been given in respect of all or some of the goods or services in respect of which protection in Brunei Darussalam has been requested and the Registrar notifies the International Bureau in accordance with rule 16(4) that a final decision has been made that the refusal is withdrawn, or is withdrawn in respect of some of the goods or services in respect of which protection in Brunei Darussalam has been requested; or

(b) the period of 18 months after the date on which the notification of the request for extension of protection to Brunei Darussalam was sent to Brunei Darussalam expires without any notification of refusal having been given and without the International Bureau having been informed that oppositions may be filed after the expiry of that period,

the trade mark which is the subject of the request for protection shall thereupon be protected as a protected international trade mark (Brunei Darussalam); and in a case where a refusal subsists in respect of some of the goods or services in respect of which protection in Brunei Darussalam has been requested, protection shall apply only as regards the remaining goods or services.

(2) For the purposes of the application by these Rules of the provisions, subject to rule 26, a trade mark so protected shall be treated as being registered under the Act as of —

(a) where the request for extension of protection to Brunei Darussalam is mentioned in the international application, the date of the international registration; or

(b) where the request for such extension is made subsequently to the international registration, the date on which the request is recorded in the International Register.

Revocation and invalidity

18. (1) The provisions of sections 47 and 48, with the necessary modifications, apply so as to permit the protection of a protected international trade mark (Brunei Darussalam) to be revoked or declared invalid.

(2) For the purposes of applying sections 47 and 48 —

(a) the reference in section 47(1) to the date of completion of the registration procedure shall be treated as a reference to the date the protected international trade mark (Brunei Darussalam) became protected;

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(b) the reference in section 47(2) to the form in which a trade mark was registered shall be treated as a reference to the form in which it is protected;

(c) references in sections 47(5) and 48(5) to goods or services for which the trade mark is registered shall be treated as references to those in respect of which it is protected;

(d) references in section 47 to the registration of a trade mark being revoked shall be treated as references to the protection of a protected international trade mark (Brunei Darussalam) being revoked; and

(e) references in section 48 to the registration of a trade mark being declared invalid shall be treated as references to the protection of a protected international trade mark (Brunei Darussalam) being declared invalid.

(3) The provisions of rule 55 of the Trade Marks Rules (R 1), with the necessary modifications, apply to the procedure upon an application for revocation or a declaration of invalidity of protection of a protected international trade mark (Brunei Darussalam).

(4) Where the protection of a protected international trade mark (Brunei Darussalam) is revoked or declared invalid to any extent, the Registrar shall notify the International Bureau and —

(a) in the case of a revocation, the rights of the proprietor is deemed to have ceased to exist to that extent as from the date of the application for revocation, or if the Registrar or the court is satisfied that the grounds for revocation existed at an earlier date, that date;

(b) in the case of a declaration of invalidity, the trade mark, to that extent, is deemed never to have been a protected international trade mark (Brunei Darussalam), but this shall not affect transactions past and closed as at the date when the invalidity is recorded in the International Register.

Effect of acquiescence

19. (1) Section 49 applies where the proprietor of an earlier trade mark has acquiesced for a continuous period of 5 years in the use of a protected international trade mark (Brunei Darussalam).

(2) For the purposes of applying section 49 —

(a) the reference in that section to a registered trade mark shall be treated as a reference to a protected international trade mark (Brunei Darussalam); and

(b) references in that section to registration shall be treated as references to protection of a protected international trade mark (Brunei Darussalam).

Certificate of validity of contested registration

20. The provisions of section 68, with the necessary modifications, apply in relation to proceedings before the court in which the validity of the protection of a protected international trade mark (Brunei Darussalam) is contested.

Importation of infringing goods

21. (1) The provisions of Part 4 of the Act, with the necessary modifications, apply in relation to goods which are, in relation to a protected international trade mark (Brunei Darussalam), infringing goods within the meaning of section 19(1).

(2) For the purposes of subrule (1), references in section 19(1) and Part 4 of the Act to a registered trade mark shall be treated as references to a protected international trade mark (Brunei Darussalam).

Offences

22. (1) The provisions of sections 98, 99, 100, 101 and 104 shall, with the necessary modifications, apply in relation to a protected international trade mark (Brunei Darussalam).

(2) For the purposes of the application of those provisions —

(a) references in those provisions to a registered trade mark shall be treated as references to a protected international trade mark (Brunei Darussalam); and

(b) references in those provisions to goods or services for which a trade mark is registered shall be treated as references to goods or services in respect of which a protected international trade mark (Brunei Darussalam) confers protection in Brunei Darussalam.

Falsely representing trade mark as protected international trade mark (Brunei Darussalam)

23. Any person who —

(a) falsely represents that a trade mark is a protected international trade mark (Brunei Darussalam); or

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(b) makes a false representation as to the goods or services for which a protected international trade mark (Brunei Darussalam) confers protection in Brunei Darussalam, knowing or having reason to believe that the representation is false,

is guilty of an offence and liable on conviction to a fine not exceeding \$10,000.

PART 3

TRANSFORMATION OF INTERNATIONAL REGISTRATION
INTO NATIONAL APPLICATION**Transformation application**

24. (1) The provisions of this rule apply where —

(a) an international registration designating Brunei Darussalam is cancelled at the request of the Office of Origin under Article 6(4) of the Madrid Protocol in respect of all or some of the goods or services listed in the registration;

(b) an application (in this Part referred to as a transformation application) is made to the Registrar, within 3 months after the date on which the international registration was cancelled, for registration in Brunei Darussalam of a trade mark identical to that comprised in the international registration in respect of all or some of the goods or services in respect of which the international registration was cancelled; and

(c) the application is made by the person who was the holder of the international registration immediately before its cancellation.

(2) A transformation application shall be filed with the Registrar on Form MP 1.

(3) A trade mark registered pursuant to a transformation application shall be treated as if it were registered —

(a) on the date of the international registration in accordance with Article 3(4) of the Madrid Protocol; or

(b) where the request for extension to Brunei Darussalam was made subsequent to the international registration, on the date of recordal of that request in accordance with Article 3^{ter} (2) of the Madrid Protocol,

and that date is deemed for the purposes of the Act to be the date of registration of the trade mark.

Procedure on transformation application

25. (1) Where the protected international trade mark (Brunei Darussalam) has become protected under rule 17 on or before the actual date on which the transformation application is made (in this rule referred to as the transformation date), the trade mark shall be registered under the Act.

(2) Where the international registration designating Brunei Darussalam has not become protected under rule 17 by the transformation date and its particulars have been published under rule 12 —

(a) the Registrar shall treat the publication of its particulars as the publication of the transformation application under section 39(1); and

(b) the Registrar shall treat any opposition to its protection under rule 13 as an opposition to its registration under section 39(2), and rules 29 to 33 of the Trade Marks Rules (R 1) apply subject to such modifications as the Registrar may determine.

(3) Where particulars of the international registration designating Brunei Darussalam have not yet been published under rule 12 by the transformation date and the Registrar has issued a notification of refusal under rule 11(4), the Registrar shall for the purposes of the transformation application treat the notification of refusal as a notice issued by the Registrar to the applicant pursuant to section 38(3).

PART 4

CONCURRENT REGISTRATIONS

Effects of international registration where trade mark is also registered under Act

26. (1) The provisions of this rule apply where —

(a) a registered trade mark is also a protected international trade mark (Brunei Darussalam);

(b) the proprietor of the registered trade mark is the holder of the protected international trade mark (Brunei Darussalam);

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(c) all the goods or services in respect of which the registered trade mark is registered are protected under the protected international trade mark (Brunei Darussalam); and

(d) the date of registration of the registered trade mark is earlier than the date specified in rule 17(2) in relation to the protected international trade mark (Brunei Darussalam).

(2) For the purposes of the application by these Rules of the provisions of the Act, the protected international trade mark (Brunei Darussalam) shall, notwithstanding the provisions of rule 17(2), be treated as being registered under the Act as of the date of registration of the registered trade mark as regards all the goods or services in respect of which the registered trade mark was registered.

(3) For the purposes of determining whether the protected international trade mark (Brunei Darussalam) is an earlier trade mark, it shall be treated as having the date of application of the registered trade mark as regards all the goods or services in respect of which the registered trade mark was registered, taking account (where appropriate) of the priorities claimed in respect of the registered trade mark.

(4) Where the conditions specified in subrule (1) are satisfied in relation to a trade mark, the provisions of subrules (2) and (3) shall —

(a) continue to apply in respect of the relevant protected international trade mark (Brunei Darussalam) notwithstanding that the relevant registered trade mark lapses or is cancelled; but

(b) cease to apply if it is revoked or declared invalid.

(5) On the application of the holder of the protected international trade mark (Brunei Darussalam) on Form MP 2, the Registrar shall note in the register that the international registration replaces the registered trade mark as regards the goods or services in respect of which the registered trade mark was registered.

(6) The provisions of this rule are without prejudice to any right or remedy conferred on any person in respect of the registered trade mark.

PART 5

INTERNATIONAL APPLICATIONS ORIGINATING IN BRUNEI DARUSSALAM

Application for international registration

27. (1) An applicant for the registration of a trade mark, or the proprietor of a registered trade mark, may, subject to the provisions of this rule, apply through the Registrar for the international registration of the trade mark —

(a) by filing Form MM2(E); and

(b) by filing the address for service in Brunei Darussalam of the applicant or proprietor, as the case may be.

(2) An application for international registration shall be filed in English and may be made only where the applicant for such registration is —

(a) a citizen of Brunei Darussalam;

(b) a body or corporation incorporated or constituted under the law of Brunei Darussalam;

(c) a person domiciled in Brunei Darussalam; or

(d) a person who has a real and effective industrial or commercial establishment in Brunei Darussalam.

(3) The particulars appearing in the application (other than the address for service in Brunei Darussalam of the applicant) shall correspond with the particulars appearing at that time in the basic application or basic registration, as the case may be.

(4) The applicant shall provide at the request of the Registrar such evidence as may be necessary to satisfy him that the applicant is eligible to make the application in accordance with subrule (2).

(5) If the international application complies with the requirements set out in this rule, the Registrar shall submit the international application to the International Bureau.

(6) In this rule and rule 28 —

“basic application”, in relation to an application for international registration, means an application for registration of a trade mark in

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Brunei Darussalam in respect of which the application for international registration is made;

“basic registration”, in relation to an application for international registration, means a trade mark registered in Brunei Darussalam in respect of which the application for international registration is made.

Notification to International Bureau

28. (1) Where the Registrar has submitted an application for international registration, he shall notify the International Bureau of the occurrence of any of the events specified in subrule (2), and shall request the International Bureau to cancel the international registration as regards those goods or services covered by the international application in respect of which the basic application or basic registration has ceased to subsist by reason of that event.

(2) The events referred to in subrule (1) are as follows —

(a) before the expiry of the period of 5 years after the date of the international registration, the Registrar —

- (i) refuses to accept the basic application as regards some or all of the goods or services covered by the international registration; or
- (ii) after accepting the application, refuses to register the trade mark as regards some or all of those goods or services, having regard to matters coming to his notice since he accepted the application,

and in either case that decision becomes a final decision, whether before or after the expiry of that period of 5 years;

(b) the basic application is, before the expiry of the period of 5 years after the date of the international registration, treated as withdrawn under —

- (i) rule 9(6)(a) of the Trade Marks Rules (R 1);
- (ii) paragraph 6(2) of Schedule 1 to the Act; or
- (iii) paragraph 7(2) of Schedule 2 to the Act;

(c) opposition proceedings begun before the expiry of the period of 5 years after the date of the international registration resulting in a final decision not to register the trade mark as regards some or all of the goods or services covered by the international registration;

(d) the basic application is withdrawn, or is restricted as regards goods or services covered by the international registration, as a result of a request by the applicant made —

- (i) before the expiry of the period of 5 years after the date of the international registration; or
- (ii) subsequently when the basic application was at the time of the request subject to an appeal against refusal of registration or to opposition proceedings,

begun in either case before the expiry of the period of 5 years;

(e) the registration resulting from the basic application or the basic registration expires without renewal and is removed from the register before the expiry of the period of 5 years after the date of the international registration, and no request for its restoration is made within the period specified in rule 50(1) of the Trade Marks Rules (R 1) or such a request is made and a final decision is made refusing the request;

(f) a final decision is made to revoke or declare invalid the registration resulting from the basic application or the basic registration, as a result of proceedings begun before the expiry of the period of 5 years after the date of the international registration;

(g) the registration resulting from the basic application or the basic registration is cancelled as a result of a request by the proprietor made before the expiry of the period of 5 years after the date of the international registration, or made subsequently where, at the time of the request —

- (i) the registration resulting from the basic application or the basic registration was subject to proceedings for revocation or invalidation; and
- (ii) such proceedings were begun before the expiry of the period of 5 years after the date of the international registration.

(3) For the purposes of this rule —

(a) a final decision shall be regarded as made where —

- (i) any right of appeal against the decision expires or is exhausted; or
- (ii) proceedings relating to an application or registration are discontinued or abandoned; and

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(b) a reference to an application being withdrawn includes its being deemed withdrawn, abandoned or never to have been made.

PART 6

GENERAL

Evidence of certain matters relating to international registration

29. (1) In all legal proceedings relating to a protected international trade mark (Brunei Darussalam), the registration of a person as the holder of a protected international trade mark (Brunei Darussalam) shall be *prima facie* evidence of the validity of the original international registration and of any subsequent assignment or other transmission of it.

(2) Judicial notice shall be taken of the following —

(a) the Madrid Protocol and the Common Regulations;

(b) a copy of an entry in the International Register issued by the International Bureau;

(c) a copy of the periodical *gazette* published by the International Bureau.

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

(4) Evidence of any instrument issued by the International Bureau or any entry in or extract from such a document may be given in any such proceedings by production of a copy; and such document purporting to be such a copy shall be received in evidence.

(5) In this rule, “legal proceedings” include proceedings before the Registrar.

Agents

30. Any act required or authorised by these Rules to be done by or to a person in connection with a request for protection of an international registration as a protected international trade mark (Brunei Darussalam), or any procedure relating to a protected international trade mark (Brunei Darussalam), may be done by or to an agent authorised by that person orally or in writing.

Burden of proving use of protected international trade mark (Brunei Darussalam)

31. If in any civil proceedings relating to a protected international trade mark (Brunei Darussalam), a question arises as to the use to which the trade mark has been put, it is for the holder to show what use has been made of it.

Communication of information to International Bureau

32. Notwithstanding any written law or rule of law, the Registrar may communicate to the International Bureau any information which Brunei Darussalam is required to communicate by virtue of these Rules or pursuant to the Madrid Protocol or the Common Regulations.

Transmission of fees to International Bureau

33. The Registrar may accept, for transmission to the International Bureau, fees payable to the International Bureau in respect of an application for international registration originating in Brunei Darussalam or a renewal of such an international registration, subject to such terms and conditions as he may specify either —

(a) generally by published notice; or

(b) in any particular case, by written notice to the applicant desiring to make payment by such means.

Application of Trade Marks Rules (R 1)

34. (1) Except as otherwise provided in these Rules, the Trade Marks Rules (R 1), with the necessary modifications, apply in relation to an international registration designating Brunei Darussalam and to a protected international trade mark (Brunei Darussalam) as they apply in relation to an application for registration of a trade mark and to a registered trade mark.

(2) The provisions of rules under the Trade Marks Rules (R 1) relating to costs and security for costs and to evidence before the Registrar apply in relation to proceedings under these Rules in the same manner as they apply in relation to proceedings relating to a registered trade mark or application for registration of a trade mark.

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SCHEDULE 1

(rule 3)

FEES

| <i>Matter</i> | <i>Corresponding Rule(s)</i> | <i>Fee</i> | <i>Corresponding form(s)</i> |
|--|------------------------------|--------------------------------------|------------------------------|
| 1. Filling of a transformation application | 24(2) | \$374 per class of goods or services | MP1 |
| 2. Application to record replacement of registered trade mark with international registration | 26(5) | \$65 per class of goods or services | MP2 |
| 3. Application for international registration through Registrar | 27(1) | \$250* | MM2(E) |
| 4. Request for handling a request for renewal of international registration or fee thereof payable to International Bureau | — | \$85* | — |

*This fee does not include any fee payable to the International Bureau for that application or request.

SCHEDULE 2

(rule 4(4))

DESCRIPTIONS OF FORMS

| <i>Form</i> | <i>Description of form</i> |
|-------------|--|
| MP1 | Request to transform an international registration into national application(s) |
| MP2 | Request to replace Brunei Darussalam national registration with international registration |
| MM2(E) | Application for international registration governed exclusively by the Madrid Protocol |