

REGULATION

on the applications for and registration of trademarks, collective marks and guarantee and quality marks as amended with Regulation No. 59/2023 (valid as of 30 January 2023).

(In-house translation)

CHAPTER I

Scope and definitions.

Article 1

Scope.

The provisions of this Regulation apply to applications for trademarks, collective marks and guarantee and quality marks that are to be registered in Iceland on the basis of the Trademarks Act no. 45/1997, as amended.

Article 2

Definitions.

For the purposes of this Regulation the following terms shall have the meanings hereinafter assigned to them:

1. *Eradicated:* When the registration of a mark has been cancelled at the proprietor's request, registration has not been renewed or it has been revoked following a case concerning opposition, invalidation or revocation.
2. *Withdrawn:* When the applicant has retracted the application.
3. *The World Intellectual Property Organisation:* The World Intellectual Property Organisation (WIPO) is a specialised United Nations agency that has the role of promoting the protection of intellectual property throughout the world.
4. *International registration:* A registration of a mark by the World Intellectual Property Organisation that is based on a national basic trademark application or registration in accordance with the Protocol Relating to the Madrid Agreement.
5. *The Protocol Relating to the Madrid Agreement:* The Madrid Protocol (MP), an annex to the Madrid Agreement, is handled by the World Intellectual Property Organisation and concerns a harmonised registration system.
6. *Priority document:* A certificate from the registrar that received the application on which the applicant bases their priority, along with a copy of the application, attested by the relevant authority.
7. *Priority:* A six-month period from the submission of the basic application in a member state of the Paris Convention or a member state of the World Trade Organization (WTO), which the applicant can use to connect applications for the registration of a mark in other states so that the mark will have the same application date and thereby priority over later applications.
8. *Partial assignment:* When the ownership of an application or registration is transferred between parties in such manner that the application or registration is divided in two. The information and documentation for each part remains unaltered, but the application or registration that is assigned gets a new number and a new proprietor.
9. *Basic application or registration:* An application or registration that can create priority in other signatory states to the Paris Convention or member states of the World Trade Organization.
10. *Rejected:* When an application for registration has been finally rejected.
11. *Division:* When an application or registration is divided and a new, independent application or registration is created that retains the same application, registration and priority dates, but is assigned a new number.
12. *National application:* An application submitted in a specific state, in this country at the Icelandic Intellectual Property Office.
13. *National registration:* A mark that is registered in a specific state, in this country at the Icelandic Intellectual Property Office.

14. *Mark*: The instances where certain provisions of this Regulation apply to all types of marks, i.e. trademarks, collective marks and guarantee and quality marks.
15. *Use requirement*: The beginning of a 5-year use requirement period, in accordance with Article 25 of the Trademark Act, is based on the date of registration, in accordance with item 11 above.
16. *Subsequent designation*: When a new state is added to an international registration with a later application.
17. *[Date of registration]*: For marks applied for or registered prior to 1 September 2020, the date of registration is the actual date of registration in Iceland, whereas for marks applied for or registered after 1 September 2020, the registration date is the date on which the marks application procedure is finally completed, irrespective of whether the application in question is for a national application or an international registration, i.e.:
 - a. after two months have passed from the notification of the Icelandic Intellectual Property Office's decision to register the mark, if there is no opposition to the registration,
 - b. the date of the ruling in opposition proceedings,
 - c. the date of the ruling in an appealed case, or
 - d. the date of a court ruling.¹⁾

1) Regulation No. 59/2023, Article 1, effective 30 January 2023.

Article 3

Submission of applications.

An application to register a mark in Iceland shall be submitted to the Icelandic Intellectual Property Office, cf. Chapter II.

Application for international registration of a mark shall be submitted to the Icelandic Intellectual Property Office on a form issued by the World Intellectual Property Organisation for that purpose, cf. Chapter V.

A request for designating Iceland as part of an international registration shall be submitted to the World Intellectual Property Organisation, cf. Chapter IV.

CHAPTER II

Applications in Iceland.

Article 4

Language of the application.

An application for the registration of a mark shall be in Icelandic.

Irrespective of Paragraph 1, the list of goods and/or services in the application shall be in English, although it should be noted that the Icelandic Intellectual Property Office can always require that the list of goods and/or services is translated.

The Icelandic Intellectual Property Office can also demand a certified translation of accompanying documents that are not in Icelandic.

If the Icelandic Intellectual Property Office demands a translation in accordance with Paragraph 2 or 3, the applicant is granted a short time limit in order to obtain and submit it. If the translation is not received within the required time limit, the application is cancelled.

Article 5

Requirements for applications.

An application for the registration of a mark may be submitted in electronic form, or on a form issued by the Icelandic Intellectual Property Office for that purpose.

The application shall include the following:

1. Information on whether the application is for a trademark, collective mark or a guarantee and quality mark;
2. The mark for which registration is desired in accordance with the provisions of Article 2 of the Trademark Act;

3. The type of the mark that is the subject of the application, cf. paragraph 2 of Article 7 of this Regulation;
4. The applicant's name or designation, address and identification number, if the applicant is Icelandic, and an e-mail address and telephone number if the applicant has no representative; If there are more than one applicant, it shall be specified in the application who will act as their representative; If it is not specified who will act as the representative for the applicants, it will be assumed that the person named first on the list will do so;
5. The name, address, identification number, e-mail address and telephone number of the representative, if the applicant is not domiciled in Iceland, and if an Icelandic applicant has assigned to a representative the task of handling the application and registration on their behalf;
6. The goods and/or services which the registration shall apply to, along with the number of the relevant goods or service class, in accordance with the provisions of the 1957 Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks, as amended, and a notification of such register;
7. Information about the priority on which the application is based, if applicable;
8. The international registration number and the international registration date, as well as information about priority if applicable, if it is requested that the registration shall take effect based on Article 57 of the Trademark Act;
9. Information about registration in the country of residence, if there is no mutual legal protection, cf. Article 12 of this Regulation.
10. Information about registration in the country of residence, if registration in Iceland depends on another registration in accordance with Paragraph 1 of Article 34 of the Act (the *telle quelle* principle). The Icelandic Intellectual Property Office can demand an attested certificate of registration in the country of residence.

The application shall be signed or identified in an electronic manner by the applicant or a representative acting on their behalf.

Documentation accompanying the application:

1. If the design of the mark and the extent of protection which shall apply to it requires special explanation, a description may be enclosed with the application. A description shall always be submitted if the type of mark is another than that defined in Paragraph 2 of Article 7.
2. An application for the registration of a collective mark or a guarantee and quality mark shall be accompanied by the rules on the use of the mark in accordance with Paragraph 3 of Article 12 of the Trademark Act.
3. Verification of registration in the country of residence, if there is no mutual legal protection, cf. [Article 11]¹⁾ of this Regulation.

1) Regulation No. 59/2023, Article 2, effective 30 January 2023.

Article 6

Application fee.

An application for the registration of a mark shall be accompanied by the required fee in accordance with the applicable tariff, cf. item a of Article 65 of the Trademark Act. If the fee has not been paid within the specified grace period, the application will not be processed and will be considered to have been revoked.

Article 7

Presentation of mark.

It must be possible to identify the mark in the Trademark Register in such manner that authorities and the general public are able to understand the clear and precise extent of the protection that the registration grants the proprietor. The presentation shall also be clear, precise, self-contained, accessible, intelligible, durable and objective.

If the application concerns the following types of marks, this shall be specified in the application, and the application shall in such cases meet the following requirements:

1. A **wordmark** consists solely of words, letters, digits or other symbols and/or a combination thereof, and in the application the mark shall be identified with a simple font and in standardized form and manner of expression, without graphic elements or colour.
2. A **figurative mark** is a symbol with a graphic layout, with or without colours, such as a picture or a composite of graphic elements, with or without words. A copy of the mark shall be submitted with the application, showing all aspects of the mark and, where applicable, its colour.
3. A **three-dimensional mark** can for example be wrapping, packaging, the product itself or the appearance thereof, with or without words. The mark shall be represented graphically in the application, for instance with a computer-generated image or a photograph that illustrates the three-dimensional qualities of the mark.
4. A **position mark** is a symbol that is placed on a specific part of a product. The application must display the product itself and clearly indicate the position of the symbol. The parts of the product for which no protection is claimed shall be indicated in a clear manner, for instance with a dotted line.
5. A **pattern mark** includes symbols that are repeated at regular intervals and form a specific pattern. The repetition of the symbols, i.e. the pattern as such, shall be specified in the application.
6. A **colour mark** consists of a single colour or a combination of colours, without outlines.
 - a. When a mark is a single colour, the application shall include a clear reproduction of the colour and reference to the relevant colour (colour code) in a recognised colour system.
 - b. When a mark consists of combination of colours, a reproduction of the colour combination shall be submitted in the application in a clear and precise manner. The relevant colours shall also be referenced in a generally recognised colour system (colour code).
7. A **sound mark** consists solely of a sound or a combination of sounds, and the application shall include either an audio file with a reproduction of the sound, or a precise description of the sound in musical notation.
8. A **motion mark** includes movement or a change in the location of specific symbols in a mark. The application shall include a video file or a series of still images that precisely illustrate the movement or alteration of the symbols which shall be covered by the desired protection. The still images may be numbered in order to clearly illustrate the movement or alteration.
9. A **multimedia mark** consists of both sound and picture, with or without text, and the application shall include an audio-visual file that contains the picture/text and sound combination.
10. A **hologram mark** is a symbol with holographic qualities, i.e. it changes according to the visual angle from which the mark is viewed. The application shall be accompanied with a visual file or a graphic reproduction of the mark which indicates the angles from which the mark must be viewed in order to discern the overall image it projects.

If a description is submitted with the application, it shall match the presentation of the mark and may not expand its scope of protection.

Part of the description of a mark can be that the mark is in colour and the colours of the mark can be specified. If the mark is presented in black and white or grey level, and it is not specified in the description that the mark is in colour, the extent of protection is limited to the colours stated in the application and/or the description of the mark.

If the mark does not fit into one of the aforesaid categories, the application shall include a description of the mark, cf. item 1 of Paragraph 4 of Article 5 of this Regulation, and the mark shall be in accordance with Paragraph 1.

Article 8

Technical requirements regarding the presentation of the mark.

The mark shall be presented with such technology as is generally available, and electronic presentation of the mark in the application shall be in accordance with the requirements as regards the file format and file size that is decided by the Icelandic Intellectual Property Office at each time and published on the Office's website.

If the application is submitted on paper, additional copies of the mark shall be enclosed. All representations of the mark shall be displayed, if appropriate, and the size of the mark may not exceed DIN A4 size with a space of at least 2.5 cm around the mark.

Copies of the mark shall be of such quality that they can be reduced to a size of 8x8 cm or enlarged to the aforesaid size.

Article 9

Right of priority.

A request that the application shall enjoy priority in accordance to Articles 17 and 18 of the Trademark Act shall be included in the application. It shall be specified on what grounds priority is claimed, as shall the date of the application for priority, where it was first submitted, and the number of the application. This information shall be submitted to the Icelandic Intellectual Property Office no later than one month after the date of the application.

The Icelandic Intellectual Property Office can require the applicant to provide satisfactory verification of the accuracy of the aforesaid information, such as a priority document.

If the applicant does not provide the information and documents in accordance with Paragraphs 1 and 2 within the time limit specified, the application is not considered to enjoy priority.

[Article 9.a

Priority of a later application.

When a mark has been registered but prior rights of a national application or a designation for Iceland of an International Registration are later detected, the Icelandic Intellectual Property Office examines whether the later detected application would have hindered the registration of the mark. If this is the case, a notification is sent to the proprietor of the mark, providing a two months' time limit to submit observations. The time limit may be extended once for further two months unless specific arguments are submitted in support of further extension.

The Icelandic Intellectual Property Office issues, if applicable, a provisional refusal of the later detected application or designation, in accordance with relevant legal provisions, however, its further processing is otherwise postponed, based on substantiated argumentation in that regard. The Icelandic Intellectual Property Office re-examines the registrability of the later detected application upon receipt of the observations from the owner of the registered mark.

If no argumentation leading to the continued registration of the mark is received the registration is annulled in whole or in part. The effective date is the filing date. The proprietor is notified of the annulment and informed of the time limit for appeal.

An appeal will postpone the legal effect of a decision of the registrability of the later detected application or designation.]¹⁾

1) Regulation No. 59/2023, Article 3, effective 30 January 2023.

Article 10

Application based on Article 57 of the Trademark Act.

An application in accordance with Article 57 of the Trademark Act and Article 9 *quinquies* of the Madrid Protocol (central attack) shall include the number of the international registration, the international registration date and information about priority, if applicable. The prescribed fee shall accompany the application.

Specification of the goods and/or services shall be in accordance with the former specification, expansion of the extent of protection is not permitted.

It is permitted according to Article 4 to submit the specification in English, although if the Icelandic Intellectual Property Office should require a translation it shall be submitted within the time limit specified by the Office. If the translation is not received within the specified time limit, the application will be cancelled.

Article 11

Mutual legal protection.

Parties domiciled in states that are signatories to neither the Paris Convention on the Protection of Industrial Property nor the Agreement Establishing the WTO shall enjoy, in the cases where this has been agreed, mutual legal protection.

In cases where mutual legal protection applies in accordance with Paragraph 1 of Article 33 of the Trademark Act, there is no requirement for verification of registration in the country of residence.

Article 12

Application based on Article 6 quinquies of the Paris Convention.

Parties domiciled in states that are signatories to the Paris Convention on the Protection of Industrial Property or the Agreement Establishing the WTO enjoy mutual legal protection.

In the cases where mutual legal protection applies, the applicant from the foreign state can demand, with the conditions stated in Article 6 *quinquies* of the Paris Convention, that their mark will be registered in the same manner as it is registered in the foreign state (*telle quelle* registration).

Registration on these grounds does not provide more extensive rights than the registration in the country of residence.

CHAPTER III

Handling of applications and registration.

Article 13

Determination of date of application.

An application is assigned a number and date of application upon reception thereof at the Icelandic Intellectual Property Office, provided that it is clearly stated what mark is the subject of the application for protection, cf. Paragraph 2 of Article 7, the name or designation of the applicant along with contact information and a specification of the goods and/or service as well as the class numbers, cf. Paragraphs 1 and 2 of Article 12 of the Trademark Act.

The date of application is the day on which the conditions according to Paragraph 1 are met.

Article 14

Formal requirements for application.

An application is accepted for processing once the application fee has been paid in accordance with Article 12 of the Trademark Act and Article 6 of this Regulation. If the application does not meet the formal requirements of law and this Regulation, the applicant shall be granted a suitable time limit to redress the faults of the application. This time limit can be extended if a request to that effect is submitted.

[After 6 months have passed, the Icelandic Intellectual Property Office can require explanations if more time extension is desired. After 12 months have passed, processing of the case will continue based on the available data, provided that the applicant or his representative have failed to reply within the time limit.]¹⁾

Unless the corrections are received within the required time limit, the application is cancelled. The processing of an application will only recommence if the conditions of Paragraph 3 of Article 19 of the Trademark Act are met.

1) Regulation No. 59/2023, Article 4, effective 30 January 2023.

Article 15

Examination of applications.

An application will be examined, in accordance with the provisions of the Trademark Act and the relevant provisions of this Regulation, cf. also Article 19 of the Trademark Act, once it has met the requirements regarding formal conditions.

[The Icelandic Intellectual Property Office may, without consulting the applicant, correct obvious mistakes in an application or registration i.e., in the list of goods and/or services or the description, provided that the corrections do not affect any substantive elements of the application. The Icelandic Intellectual Property Office shall notify the applicant that such corrections have been made.]¹⁾

If an application is to be rejected, the applicant is notified and informed about the grounds for the decision. A reasonable time limit will be granted for the submission of comments. This time limit can be extended if a request to that effect is submitted.

If the arguments and documentation submitted do not alter the decision to reject the application, the application is rejected again and a reasonable time limit granted, cf. Paragraph 2, to submit further arguments.

After 12 months have passed, the Icelandic Intellectual Property Office can require explanations if more time extension is requested. After 24 months have passed, processing of the case will continue based on the available data [provided that the applicant or his representative have failed to reply within the time limit.]¹⁾

If the applicant decides not to comment on the Office's rejection, and neither arguments nor documentation that can alter the Office's decision are received, the application will be cancelled after the time limit expires, and will only be accepted again for processing after the conditions of Paragraph 3 of Article 19 of the Trademarks Act have been met.

If an application is rejected in full or in part, cf. Paragraph 2 or 4 of Article 19 of the Trademark Act, the legal effects of the decision are delayed until the final decision in the case has been reached.

When the application is considered to meet the requirements of the Trademark Act, the mark will be published in the IP Gazette.

1) Regulation No. 59/2023, Article 5, effective 30 January 2023.

Article 16

Third party observations against an application.

A third party may file observations against the registration of a mark according to Article 20 of the Trademark Act. The filing of observations does not result in the party becoming a party to the application proceedings, however, the party is provided with guidelines on the options for opposition if the mark is registered.

The Icelandic Intellectual Property Office informs the applicant if observations are filed. If the Icelandic Intellectual Property Office decides that the observations will result in the mark not being registered, the relevant application shall be treated in accordance with the provision on examination.

Article 17

Suspension of proceedings.

The Icelandic Intellectual Property Office has the right to suspend application proceedings if it is likely that the decision in another case will have an effect on the case. This remedy shall be applied carefully and only if it is highly likely that the decision will have an effect.

If the Icelandic Intellectual Property Office suspends proceedings, the applicant shall be sent a notice containing the grounds for the decision.

Article 18

Registration and certificate.

When the registration process is completed, the mark will be assigned a date of registration, cf. [item 17 of Paragraph 1 of Article 2]¹⁾, and a certificate will be issued in confirmation of the registration.

1) Regulation No. 59/2023, Article 6, effective 30 January 2023.

CHAPTER IV

International registrations designating Iceland.

Article 19

Iceland designated in an international registration.

The required fee shall be paid for the designation of Iceland in an application for an international registration of a mark. The fee shall be paid to the World Intellectual Property Organisation, in Swiss francs in accordance with Rules 34 and 35 in the Regulation under the Protocol.

In other respects the application shall be treated as a national application, and the provisions of the Trademark Act and this Regulation regarding the handling of applications and registrations shall also apply to applications for international registration in this country, including Article 16 of the Regulation regarding observations from third parties.

Article 20

Reception of applications for international registration.

When the Icelandic Intellectual Property Office receives a notification that Iceland has been designated in an international registration of a mark, the application will be assigned a number for identification. The date of application is based on the date of designation of Iceland in the international register, with due consideration of priority, if demanded, or the later date of designation.

The Icelandic Intellectual Property Office classifies an application in accordance with Paragraph 2 of Article 7 of this Regulation, and that classification shall conform to the presentation and description of the mark with the World Intellectual Property Organisation.

The Icelandic Intellectual Property Office will specify in the Trademark Register whether the mark in question is a trademark, collective mark or a guarantee and quality mark.

The specification of the goods and/or services for which the registration is requested is entered into the Trademark Register in English.

Article 21

Examination and publication.

The Icelandic Intellectual Property Office will examine if there is anything to prevent the mark becoming valid in this country, and whether the mark meets the requirements of the Trademark Act.

If the Icelandic Intellectual Property Office is of the opinion that an international registration of a mark cannot become valid in this country, the World Intellectual Property Organisation shall be informed of that decision and provided with information about the rejection in whole or in part. A reasonable time limit is granted for the submission of comments on the rejection and for the appointment of a representative in accordance with Article 35 of the Trademark Act. Processing of the case and time limits shall subsequently be consistent with the processing of national applications, cf. Chapters II and III of this Regulation, as appropriate.

If an application is rejected in full or in part, cf. Paragraph 2 or 4 of Article 19 of the Trademark Act, the legal effects of the decision are delayed until the final decision in the case has been reached.

If the applicant decides not to comment on the Office's rejection, the application will be cancelled after the time limit expires and will only be accepted again for processing after the conditions of Paragraph 3 of Article 19 of the Trademark Act have been met.

When the application is considered to meet the requirements of the Trademark Act, the mark will be published in the IP Gazette.

The World Intellectual Property Organisation is notified once a final decision has been reached.

CHAPTER V

Application for international registration of a mark.

Article 22

Reception of application for international registration.

An application for international registration of a mark, based on an Icelandic application or registration, shall be in English and submitted to the Icelandic Intellectual Property Office in accordance with the requirements of the World Intellectual Property Organisation at each time.

The application shall be accompanied with the required fee according to the tariff payable to the Icelandic Intellectual Property Office for receiving and processing the application (administration fee). Other fees according to Article 8 of the Madrid Protocol shall be paid directly to the World Intellectual Property Organisation.

Article 23

Requirements for applications.

The application shall meet the requirements of Rule 9 of Chapter 1 of the Madrid Protocol Regulation, and shall specify among other things:

1. The name of the applicant, address and other contact information required, such as e-mail address or telephone number;
2. The type of the mark, i.e. whether it is a trademark, collective mark, or a guarantee and quality mark;
3. The mark, clearly and precisely presented as specified in the Icelandic application or registration on which the application is based;
4. The goods and/or services to which the registration shall apply, along with the numbers of the relevant goods or service classes, in accordance with the provisions of the 1957 Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks, as amended;
5. The number and date of the Icelandic application or registration on which the application shall be based;
6. The names of the states or unions designated by the applicant.

If the applicant wishes to appoint a representative with respect to the World Intellectual Property Organisation, the name and address of the representative shall be enclosed with the application.

The application shall furthermore be in accordance with Article 3., 3 b (*bis*) and 3 c (*ter*) of the Protocol and the provisions of its Regulation.

The application can be based on more than one application or registration if the mark is the same, the applicant is the same and the goods and/or services specified in the application are also stated in one or more applications or registrations. The list of goods and/or services may not be more extensive than that of the basic application(s) or registration(s).

Article 24

Reception and forwarding of applications.

An application for international registration of a mark in accordance with Article 22 of this Regulation shall be assigned a date of reception at the Icelandic Intellectual Property Office.

The Icelandic Intellectual Property Office reviews the application with due consideration of conformity between the information in the application and the registration on which it is based.

If the Icelandic Intellectual Property Office is of the opinion that the application is insufficient, the applicant shall be notified of this and granted a short time limit to correct or redress the insufficiencies of the application.

If the Icelandic Intellectual Property Office does not receive such correction or redress within the specified time limit, the Icelandic Intellectual Property Office will decide whether to cancel the application or send it to the World Intellectual Property Organisation in its unaltered form. The applicant shall be notified about the decision.

When the conditions have been met, the Icelandic Intellectual Property Office will forward the application to the World Intellectual Property Organisation as soon as possible.

It shall be specified in the Register of Trademarks if the international registration is based on an Icelandic application or registration.

Article 25

Subsequent designations.

It is permitted to apply for subsequent designations of states or unions in accordance with paragraph 2 of Article 3 c (*ter*) of the Protocol, either from the Icelandic Intellectual Property Office or directly from the World Intellectual Property Organisation in accordance with the requirements at each time.

If such subsequent designation is received by the Icelandic Intellectual Property Office, it has an obligation to forward the application to the World Intellectual Property Organisation once all the requirements have been met.

CHAPTER VI

Opposition.

Article 26

Submission of opposition.

Notices of opposition to the registration of a trademark, collective mark or a guarantee and quality mark in accordance with Article 22 and Article 22, items a – c of the Trademarks Act shall be delivered to the Icelandic Intellectual Property Office within two months of the date of publication for the relevant mark, along with the required fee in accordance with the tariff.

Opposition can be made to either an Icelandic registration or an international registration that enters into force in this country in accordance with paragraph 2 of Article 52 of the Trademark Act.

The registration of a mark may be opposed in whole or in part.

Opposition shall be in writing and include:

1. The name of the opponent and necessary contact information, such as address and e-mail address along with the name of the representative, if any, and information about the representative;
2. The relevant mark along with the number, classes and date of publication;
3. The grounds for the opposition, including a reference to the legal provisions on which the opposition is based, to what classes and/or goods/services the opposition applies, as well as the older rights on which the opposition is based, if applicable.

If the opposition does not meet the requirements of Paragraph 3, the opponent shall be granted a short time limit to make amendments.

Article 27

Dismissal of opposition.

If amendments are not received within the required time limit, cf. Article 26 of this Regulation, or if the required fee has not been enclosed with the opposition, the Icelandic Intellectual Property Office shall dismiss the opposition.

The opponent shall be granted a one-month time limit to comment on the dismissal before a final decision is made.

If the opponent's reasoning or submitted documents do not lead to a re-examination of the decision to dismiss the opposition, the Icelandic Intellectual Property Office will finally dismiss the case and provide information about the time limit for appeal.

Article 28

Opposition proceedings.

The Icelandic Intellectual Property Office can grant an opponent two months for the submission of reasoning and/or documents in support of the opposition. That time limit will only be extended if this is deemed necessary, and if the registration in question is an international registration, in accordance with the time limit which the proprietor of the mark still has to submit a response to the opposition.

The proprietor of the registration shall be notified of the submitted opposition, and when the opponent's statement is available the proprietor will be granted a time limit of two months to submit comments. If the opposition is based on likelihood of confusion with an older mark, the owner of the registration which is opposed shall be notified of the option to request that the opponent demonstrate their use of the mark in accordance with Article 22(c) and Article 25 of the said Act.

If the opposition is to an international registration, the Icelandic Intellectual Property Office will send a notification thereof to the World Intellectual Property Organisation and grant the proprietor a time limit of three months to respond to the opposition, cf. paragraph 3 of Article 53 of the Trademark Act, and appoint a representative in accordance with Article 35 of said Act.

If the proprietor does not wish to comment on the opposition, it will be submitted for ruling without further comments from the opponent.

The Icelandic Intellectual Property Office can grant to the parties concerned a time limit of one month to submit further statements.

An extension of time limits may be requested in accordance with paragraphs 2–5. The Icelandic Intellectual Property Office can require explanations to be submitted along with requests for further extensions of time limits.

Article 29

Suspension of proceedings at the request of the parties involved.

At the request of both parties involved, proceedings may be suspended by a minimum of two months, if the parties wish to seek a reconciliation.

The request for suspension shall be received by the Icelandic Intellectual Property Office either jointly from both parties or separately with the approval of the opposing party, and the Office will then suspend the proceedings by a minimum of two months. It is permitted to take into account the requests from the involved parties regarding time limits, and to suspend the proceedings in accordance with such requests.

At the request of both parties involved, the duration of the suspension of proceedings may be extended by a minimum of two months at a time.

If the parties reach an agreement, whether it is to continue with the opposition proceedings or not, this decision shall be reported to the Icelandic Intellectual Property Office, which will either continue to process the case in whole or in part, or dismiss the opposition proceedings.

After 24 months have passed since mediation efforts began, the Icelandic Intellectual Property Office will continue the proceedings if no information on the results of the mediation efforts has been received.

Article 30

Suspension of proceedings at the initiative of the Icelandic Intellectual Property Office.

The Icelandic Intellectual Property Office has the right to suspend proceedings in an opposition case if it is likely that the decision in another case will have an effect on it. This remedy shall be applied carefully and only if it is highly likely that the decision will have an effect.

If the Icelandic Intellectual Property Office suspends proceedings, the parties involved shall be sent a notice containing the grounds for the decision.

Article 31

Combination of cases.

If opposition is submitted against the same mark by more than one party, the Icelandic Intellectual Property Office has the authority to combine the cases in such manner that one ruling will be issued regarding the oppositions.

If opposition is submitted against more than one mark owned by the same proprietor, the Icelandic Intellectual Property Office furthermore has the authority to combine the cases in such manner that one ruling will be issued regarding the oppositions.

Before taking a decision to combine cases, the Icelandic Intellectual Property Office will give to the parties involved an opportunity to express their viewpoints, if this is deemed necessary. The combination of cases does not have an effect on the right to appeal or to refer cases to courts of law.

Article 32

Decisions in opposition proceedings.

An opposition can be granted, in whole or in part, or rejected or the rights can be transferred to the opponent if they have so requested.

If the Icelandic Intellectual Property Office is of the opinion that based on the available data, the rights shall be transferred to the opponent, the parties involved shall be informed of that decision. The opponent will be granted a time limit of one month in order to pay a new application fee. A decision will be made regarding the case once the fee has been paid. If the opponent does not pay the fee within the required time limit, the Icelandic Intellectual Property Office will resume the proceedings.

The Office's ruling in opposition proceedings is sent to the opponent and the proprietor of the registration. The conclusion shall be published in the IP Gazette, and the ruling shall be published on the Office's website along with the statements from the parties.

If the opposition concerns an international registration, the Icelandic Intellectual Property Office will send a notification of the decision to the World Intellectual Property Organisation.

If a registration remains valid, the mark will be assigned a date of registration after expiry of the time limit granted to the parties involved for referring the case to the Board of Appeal or a court of law, cf. Article 63 of the Trademark Act, if the case does not proceed in such manner. If a ruling by the Icelandic Intellectual Property Office regarding the transfer of rights in opposition proceedings is overturned, the Office will refund the application fee in accordance with Paragraph 2.

CHAPTER VII

Invalidation of registration.

Article 33

Request for the invalidation of a registration.

A request for the invalidation of a registration in accordance with Article 28 and Article 28 a and b of said Act shall be submitted to the Icelandic Intellectual Property Office, along with the required fee according to the tariff.

Everyone has the right to submit a request for the invalidation of a registration if they consider that a trademark, collective mark or a guarantee and quality mark has been registered in violation of the provisions of the Act, and the case can concern either a national or an international registration effective in this country, in accordance with paragraph 2 of Article 52 of the Trademark Act.

It is permitted to request the invalidation of a registration in whole or in part, and the request for the invalidation of a registration shall include:

1. The name of the party requesting the invalidation of a registration, and necessary contact information, such as address and e-mail address along with the name of the representative, if any, and information about the representative;
2. The relevant mark, along with the classes and number of the registration that shall be invalidated according to the request;
3. Reasoning for the request for the invalidation of the registration; and
4. The necessary documents in support of the request, if applicable.

If the request for invalidation does not meet the requirements of paragraph 3, the petitioner shall be granted a short time limit to make amendments. If amendments are not received within the specified time limit, and the Icelandic Intellectual Property Office is of the opinion that there is no reason to extend that time limit, the request for invalidation shall be dismissed.

Article 34

Dismissal of request for the invalidation of registration.

If amendments are not received within the required time limit, cf. Article 33 of this Regulation, if the request has no legal basis, or if the required fee has not been enclosed with the request for invalidation, the Icelandic Intellectual Property Office shall dismiss the request.

A request for invalidation shall also be dismissed if a case regarding the same registration is being processed at judicial level.

The petitioner shall be granted a one-month time limit to comment on the dismissal before a final decision is made.

If the petitioner's reasoning or submitted documents do not lead to a re-examination of the decision to dismiss, the Icelandic Intellectual Property Office will finally dismiss the case and provide information about the time limit for appeal.

Article 35

Processing of invalidation cases.

The proprietor of a registration shall be informed about the submitted request for invalidation and granted a time limit of two months to submit comments. If the request concerns an international registration, the Icelandic Intellectual Property Office will inform the registered proprietor of the mark of this and give a time limit of three months to respond. A representative, involved with the case at earlier stages, will be sent a copy of the notice.

If the invalidation request is filed on the basis of an earlier registered mark, the proprietor of the registration shall be notified of the option to request that the petitioner demonstrate their use of the mark in accordance with Article 28 a and Article 25 of the Act. The proprietor shall also be informed of the option to invoke the provisions of Article 28 b of the Act.

If the proprietor does not wish to comment on the request for invalidation, a decision will be reached in the case without further comments from the petitioner.

The Icelandic Intellectual Property Office can grant to the parties concerned a time limit of one month to submit further statements.

An extension of the time limits granted may be requested according to this provision. The Icelandic Intellectual Property Office can require explanations to be submitted along with requests for further extensions of time limits.

If the proprietor invokes the provisions of Article 28 a or b of the Act, the Icelandic Intellectual Property Office will assess the submitted documents with reference to the conditions according to the provisions. Proceedings in that regard are the responsibility of the parties involved, and therefore the Office will not request more data.

Article 36

Suspension of proceedings.

According to item 2 of Paragraph 5 of Article 28 d of the Trademark Act, the Icelandic Intellectual Property Office shall suspend the proceedings of an invalidation case if judicial proceedings are initiated regarding the registration before the Office has reached a decision in the case.

The Icelandic Intellectual Property Office furthermore has the right to suspend proceedings in an invalidation case if it is likely that the decision in another case will have an effect on that process. This remedy shall be applied carefully and only if it is highly likely that the decision will have an effect.

If the Icelandic Intellectual Property Office suspends proceedings, the parties involved shall be sent a notice containing the grounds for the decision.

Article 37

Combination of cases.

If more than one request for the invalidation of the same mark is filed, the Icelandic Intellectual Property Office has the authority to combine the cases in such manner that one decision will be issued regarding the requests of the parties involved.

If a request is filed for the invalidation of more than one mark owned by the same proprietor, the Icelandic Intellectual Property Office furthermore has the authority to combine the cases in such manner that one decision will be issued regarding the demands.

Before taking a decision to combine cases, the Icelandic Intellectual Property Office will give to the parties involved an opportunity to express their viewpoints, if this is deemed necessary. The combination of cases does not have an effect on the right to appeal or to refer cases to courts of law.

Article 38

Decisions in invalidation cases.

Requests for invalidation can be decided on in whole or in part and the legal consequences of an invalidation of the registration of a mark shall be regarded as having effect from the date of application.

A decision in an invalidation case will be sent to the petitioner and proprietor of the registration. The conclusion shall be published in the IP Gazette, and the decision shall be published on the Office's website along with the statements from the parties.

If the registration of a mark is invalidated in whole or in part, a notification thereof shall be published in the IP Gazette, and the registration shall be eradicated from the Register of Trademarks in accordance with the decision once the final ruling from the Board of Appeal or a court of law has been issued, if applicable.

If the demand for invalidation concerns an international registration, and the registration of the mark has been invalidated in whole or in part, the Icelandic Intellectual Property Office will send a notification of this decision to the World Intellectual Property Organisation.

CHAPTER VIII

Revocation of registration.

Article 39

Request for the revocation of a registration.

A request for the revocation of a registration in accordance with Article 28 c of the Trademark Act shall be sent to the Icelandic Intellectual Property Office, along with the required fee according to the tariff.

Everyone has the right to submit a request for the revocation of a registration of a trademark, collective mark or a guarantee and quality mark if the conditions stated in Article 28 c of the Act are considered to be met, and the case can concern either a national or an international registration effective in this country, in accordance with Paragraph 2 of Article 52 of the Trademark Act.

With reference to Paragraph 1 of Article 25 of the Trademark Act, a request for revocation cannot be based on the failure to use the mark unless five years have passed since the date of registration, cf. [item 17 of paragraph 1 of Article 2]¹⁾. If the mark of which revocation is requested has been registered before the entry into effect of Act no. 71/2020, the reference day for the use requirement will be the actual date of registration of the mark in this country if the registration is a national one, whereas in cases of international registration that enters into effect in this country, it shall be the date of publication.

It is permitted to request the revocation of a registration in whole or in part, and a request for the revocation of a registration shall include:

1. The name of the party requesting the revocation of a registration, and necessary contact information, such as address and e-mail address along with the name of the representative, if any, and information about the representative;
2. The relevant mark, along with the classes and number of the registration that shall be revoked according to the request;
3. Reasoning behind the request for the revocation of the registration; and
4. The necessary documents in support of the request, if applicable.

If the request for revocation does not meet the requirements of Paragraph 4, the party submitting it shall be granted a short time limit to make amendments. If amendments are not received within the specified time limit, and the Icelandic Intellectual Property Office is of the opinion that there is no reason to extend that time limit, the request for revocation shall be dismissed.

1) Regulation No. 59/2023, Article 6, effective 30 January 2023.

Article 40

Dismissal of a request for revocation of a registration.

If amendments are not received within the required time limit, cf. Article 39 of this Regulation, if the request has no legal basis, or if the required fee has not been enclosed with the request for revocation, the Icelandic Intellectual Property Office shall dismiss the request.

A request for revocation shall also be dismissed if a case regarding the same registration is being processed at judicial level.

The petitioner shall be granted a one-month time limit to comment on the dismissal before a final decision is made.

If the petitioner's reasoning or submitted documents do not lead to a re-examination of the decision to dismiss, the Icelandic Intellectual Property Office will finally dismiss the case and will provide information about the time limit for appeal.

Article 41

Processing of revocation cases.

The proprietor of a registration shall be informed about the submitted request for revocation and granted a time limit of two months to submit comments regarding the revocation. If the request concerns an international registration, the Icelandic Intellectual Property Office will inform the registered proprietor of the mark of this and give a time limit of three months to respond. A representative, involved with the case at earlier stages, will be sent a copy of the notice.

If the proprietor does not wish to comment on the request for revocation, a decision will be reached in the case without further comments from the petitioner.

The Icelandic Intellectual Property Office can grant to the parties concerned a time limit of one month to submit further statements.

An extension of the time limits granted may be requested according to this provision. The Icelandic Intellectual Property Office can require explanations to be submitted along with requests for further extensions of time limits.

Article 42

Suspension of proceedings.

According to item 2 of Paragraph 5 of Article 28 d of the Trademark Act, the Icelandic Intellectual Property Office shall postpone the proceedings of a revocation case if judicial proceedings are initiated regarding the registration before the Office has reached a decision in the case.

The Icelandic Intellectual Property Office furthermore has the right to suspend proceedings in a revocation case if it is likely that the decision in another case will have an effect on that process. This remedy shall be applied carefully and only if it is highly likely that the decision will have an effect.

If the Icelandic Intellectual Property Office suspends proceedings, the parties involved shall be sent a notice containing the grounds for the decision.

Article 43

Combination of cases.

If more than one demand for the revocation of the same mark is submitted, the Icelandic Intellectual Property Office has the authority to combine the cases in such manner that one decision will be issued regarding the requests of the parties involved.

If a request is filed for the [revocation]¹⁾ of more than one mark owned by the same proprietor, the Icelandic Intellectual Property Office furthermore has the authority to combine the cases in such manner that one decision will be issued regarding the demands.

Before taking a decision to combine cases, the Icelandic Intellectual Property Office will give to the parties involved an opportunity to express their viewpoints, if this is deemed necessary. The combination of cases does not have an effect on the right to appeal or to refer cases to courts of law.

1) Regulation No. 59/2023, Article 7, effective 30 January 2023.

Article 44

Decisions in revocation cases.

Requests for revocation can be taken into consideration in whole or in part and the legal consequences shall be regarded as having effect from the date of the request, or an earlier date if a reasoned request to that effect has been submitted.

When a decision has been reached in a case regarding the request for the revocation of a registration, it will be sent to the petitioner and the proprietor of the registration. The decision reached shall be published in the IP Gazette, and the decision shall be published on the Office's website along with the statements from the parties.

If the registration of a mark is revoked in whole or in part, a notification thereto shall be published in the IP Gazette, and the registration shall be eradicated from the Register of Trademarks in accordance with the decision once the final ruling from an appellate body or a court of law has been issued, if applicable.

If the revocation request concerns an international registration, and the registration of the mark has been revoked in whole or in part, the Icelandic Intellectual Property Office will send a notification of this decision to the World Intellectual Property Organisation.

CHAPTER IX

Renewal.

Article 45

Time limit for renewal and notification.

If an application has been submitted before 1 September 2020, the term of validity is 10 years from the date of registration of the mark, cf. paragraph 3 of Article 39 of Act no. 71/2020, and the date of the renewal and time limits for renewal in accordance with Article 26 of the Trademark Act are based on the date of registration of the mark.

If an application has been submitted on 1 September 2020 or later, the time of validity is 10 years from the date of application, cf. Article 26 of the Trademark Act, and the date of renewal and time limits are based on the date of application.

If renewal is not applied for within the time limits specified in Paragraph 1 of Article 27 of the Trademark Act, an application for renewal will be received in accordance with Paragraph 6 of Article 27 of the Trademark Act, if a request to that effect is submitted along with a request for resumption and the payment of the requisite resumption fee within two months after the end of the six month period following the end of the registration period.

The Icelandic Intellectual Property Office will, in accordance with Paragraph 2 of Article 27 of the Trademark Act, notify the registered owners or their representatives that it is time to renew the mark. This notification is sent once, to the registered e-mail address in the Trademark Register or to the address of the applicant or the representative, if one has been appointed. If the Office's notification does not reach the registered recipient, no other notification will be sent.

If the application for renewal has not been received within the time limits specified according to Article 27 of the Trademark Act, the mark will be eradicated from the Trademark Register after the time limit for revision has expired, and a notification to that effect will be published in the IP Gazette.

If payment is received outside time limits, the application for renewal of the mark will be rejected and the proprietor or their representative will be notified of this.

Article 46

Application for renewal.

An application for the renewal of a mark shall be submitted to the Icelandic Intellectual Property Office in an electronic manner or on a form made for that purpose and supplied by the Office and shall be accompanied with the required fee in accordance with the tariff. The application shall be signed or identified in an electronic manner by the applicant or their representative.

An application for the renewal of an international registration shall be sent to the World Intellectual Property Organisation. For the renewal of an international registration that is valid in this country, the required fee shall be paid in accordance with the tariff. The fee shall be paid to the World Intellectual Property Organisation, in Swiss francs in accordance with Articles 34 and 35 of the Regulation under the Protocol.

The provisions of Chapter II of this Regulation shall apply to renewal applications where appropriate.

If the Icelandic Intellectual Property Office is of the opinion that it is necessary to specify further the type of the mark which is renewed in accordance with paragraph 2 of Article 7 of the Regulation, the Office will notify the owner or their representative about this and grant a short time limit to submit comments.

Article 47

Specification of goods and/or services upon renewal.

The specification of goods and/or services shall be consistent with the registration of the mark and the specification of goods and/or service classes shall be in accordance with the provisions of the 1957 Nice

Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks, as amended.

In the event of alterations to the international classification of goods and services according to the 1957 Nice Agreement that require the addition of new classes of goods and/or services, an additional fee shall be paid for each class in accordance with the tariff.

In accordance with the decision of the Icelandic Intellectual Property Office regarding a narrower interpretation of class headings as of 1 January 2014, it is permitted at the first renewal of a mark after that time limit to further specify the goods and/or services for which the mark is registered. Expansion of the extent of protection is not permitted. If there is no request for reclassification, the list of goods and/or services remains unaltered.

Upon the reclassification permitted according to Paragraph 3, care shall be taken to ensure that specification is clear and precise. It is the responsibility of the owners or their representatives to further specify the goods and/or services upon renewal in accordance with this provision.

[The list of goods and/or services shall upon renewal be in Icelandic if the application for registration of the mark was filed prior to 1 April 2021 or a mark has been registered and published with the list of goods and/or services in Icelandic.]¹⁾

1) Regulation No. 59/2023, Article 8, effective 30 January 2023.

Article 48

Alterations regarding the owner or representative.

When an application is submitted for the renewal of the registration of a mark, information shall be provided regarding the alterations that have taken place regarding the owner or representative, address or other aspects. This information shall be in writing and in the event of transfer of title, information shall be accompanied with the associated documents or data attesting the alterations and the required fee, cf. Article 57 of this Regulation.

Article 49

Processing of applications for renewal.

The Icelandic Intellectual Property Office will examine an application for renewal with reference to the provisions of the Trademark Act and this Regulation once the fee for renewal has been paid.

If an application or the specification of goods and/or services is deemed insufficient, the owner of the mark shall be granted a time limit of three months to make the necessary amendments to the application. It is permitted to extend that time limit upon request thereof.

If the application is still deemed insufficient, or the Icelandic Intellectual Property Office does not approve the wishes for alterations after the expiry of the time limit, the owner will be notified that the mark will be renewed as it was upon registration.

When an application for renewal meets the specified conditions, the information about the renewal is entered into the Register of Trademarks and published in the IP Gazette. The owner is also sent a copy from the register for confirmation.

CHAPTER X

Alterations to applications or registrations.

Article 50

Alteration of a registered mark.

A request for alteration to a registered mark in accordance with Article 24 of the Trademark Act shall be accompanied with the required fee in accordance with the tariff. The request shall include the following:

1. The relevant mark;
2. [The number of the mark;]¹⁾
3. The name and address of the proprietor of the registration and the proprietor's other contact information, and information about the representative, if applicable; and

4. A description of the requested alteration to the mark, along with copies of a new image, if applicable. If the alteration concerns the rules for a collective mark or a guarantee or quality mark, new rules shall be submitted.

The Icelandic Intellectual Property Office will examine if the conditions of Article 24 of the Trademark Act are met. If the requested alteration is considered to be too extensive or if the submitted data is insufficient, a time limit of one month is granted to amend this.

If upon expiry of the time limit the Icelandic Intellectual Property Office is of the opinion that it is not possible to grant the request for alteration of the mark, the request will be rejected. The party submitting the request will be informed of this decision and notified of the time limit for appeal.

If the proposed alterations to the mark are accepted, the mark will be entered into the Trademark Register and information about the alteration will be published in the IP Gazette.

Altered rules for a collective mark will take effect upon entry into the Trademark Register.

1) Regulation No. 59/2023, Article 9, effective 30 January 2023.

Article 51

Alteration of the type of mark.

The owner of a mark which was applied for or registered before 1 September 2020 can, for further explanation and by payment of the required fee according to the tariff, request an alteration of the type of mark in the following cases:

1. The relevant mark is a figurative mark;
2. The request for alteration includes a description of the mark that is consistent with the type of the mark in accordance with Paragraph 2 of Article 7 of this Regulation.

If the Icelandic Intellectual Property Office is of the opinion that the submitted documents are insufficient, the party submitting the request is granted a time limit of one month to submit more detailed documents or explanations.

If the Icelandic Intellectual Property Office does not receive more detailed documents or explanations within the specified time limit, the request shall be dismissed.

Alterations to the Register of Trademarks shall be published in the IP Gazette.

Article 52

Division of applications or registrations.

A request for division in accordance with Article 24 a. of the Act shall include:

1. The number of the application and registration that is to be divided;
2. A list of the goods and/or services that each application or registration shall cover after the division;
3. The fee in accordance with the tariff.

The application or registration that is created with the division may not be of more extensive scope than the original application or registration. The new application or registration may not apply to the same goods and/or services as the original application or registration.

The Icelandic Intellectual Property Office will examine whether the request for division complies with Paragraphs 1 and 2. If the application is insufficient, the petitioner shall be granted a time limit of one month to make amendments. If amendments are not received within the specified time limit, the request for division shall be rejected.

When a request for partition has been approved, the new application or registration will be assigned a separate number but will retain the same application or registration date and priority date as the original application or registration, if priority has been claimed. Power of attorney, assignment documents and other documents relating to the original application or registration will also apply to the new application that is created upon division.

Information about division is published in the IP Gazette.

Article 53

Alteration of the specification of goods and/or services.

The applicant or the proprietor of a mark can request that certain goods and/or services will be removed from the list of goods and/or services, or that the specification of goods and/or services will be explained further. Expansion of the extent of protection is not permitted.

The required fee according to the tariff shall be paid for a request for alteration. The request shall include the following:

1. [The relevant mark along with its number;¹⁾ and
2. A clear and precise description of what goods and/or services shall be removed or explained further.

The Icelandic Intellectual Property Office will review the request, and if it is considered insufficient in any way, a time limit of one month will be granted for the submission of more detailed documents or explanations.

If the Icelandic Intellectual Property Office does not receive more detailed documents or explanations within the specified time limit, the request will be denied.

When alterations have been approved, the list of goods and/or services will be updated in the Trademark Register. Information about alterations to the list of goods and/or services of registered marks shall also be published in the IP Gazette.

1) Regulation No. 59/2023, Article 10, effective 30 January 2023.

Article 54

Withdrawal of application or eradication of registration.

A notification of the withdrawal of an application or a demand for the eradication of a trademark from the Trademark Register shall be in writing and come from such parties that are entitled to submit such a request. The notification shall specify the relevant mark, its number and owner. The Icelandic Intellectual Property Office can request more detailed explanations or information about power of attorney if this is considered necessary.

The Icelandic Intellectual Property Office will render an application invalid or eradicate a registration once the conditions of paragraph 1 have been met. Information about rights that have been cancelled are published in the IP Gazette.

Article 55

Alterations to international registrations.

The Icelandic Intellectual Property Office will register and enter into the Trademark Register any alterations to international registrations that designate Iceland and are sent to the Office from the World Intellectual Property Organisation. Such alterations are published in the IP Gazette.

Article 56

Request based on Article 54 of the Trademark Act.

A request in accordance with Article 54 of the Trademark Act and Article 4 b (*bis*) of the Protocol (*replacement*) shall be submitted to the Icelandic Intellectual Property Office and it shall include information about the national registration to which the request pertains, along with the number of the international registration.

The Icelandic Intellectual Property Office will review the request, and if it is considered insufficient in any way, a time limit of one month will be granted for the submission of more detailed documents or explanations.

If the Icelandic Intellectual Property Office does not receive more detailed documents or explanations within the specified time limit, the request will be denied.

When a request has been approved, the alteration is entered into the Trademark Register and published in the IP Gazette.

Article 57

Transfer of title.

A request for transfer of title shall be submitted to the Icelandic Intellectual Property Office. The request shall be accompanied by the required fee in accordance with the tariff and the necessary documentation, such as:

1. An assignment document;
2. An agreement regarding the transfer of title, an extract or part of an agreement regarding the transfer of title; or
3. A confirmation from a public official of the change in ownership of a company, alterations regarding a company's type and name, or merger with another company.

The documents can be submitted as originals, copies, or in an electronic manner. The documents must clearly indicate the party assigning the rights, the party who receives the rights, and the rights concerned. Also, the assignor must be the same party as the registered owner of the mark or must be able to demonstrate that his/her right comes from the registered owner.

If transfer of title has occurred more than once by the time when the request is submitted, the history of transfer of title shall be specified, and proof of each instance thereof shall be provided.

If the Icelandic Intellectual Property Office is of the opinion that the request is insufficient, the party submitting the request is granted a time limit of one month to submit more detailed documents or explanations.

If the Icelandic Intellectual Property Office does not receive further information within the specified time limit, the transfer of title will not be entered into the Register of Trademarks.

If, despite amendments being made, the Icelandic Intellectual Property Office remains of the opinion that there exists an impediment to the transfer of title, the request shall be dismissed, and notification given of the time limit for appeal.

If the request for transfer of title satisfies the aforesaid requirements, the alterations will be entered into the Register of Trademarks and published in the IP Gazette.

Article 58

Altered name or address.

If the applicant/owner or his/her representative requests that an altered name or address will be entered into the Register of Trademarks, it is sufficient to send a written request thereof to the Icelandic Intellectual Property Office. [Documents demonstrating the alteration need not be enclosed, however, the Icelandic Intellectual Property Office may at any time request further clarifications or documentation if necessary.]¹⁾

The Icelandic Intellectual Property Office has the authority, in accordance with Article 65 of the Trademark Act, to establish a cooperative relationship with domestic Offices that supervise the registration of information on individuals and legal persons in this country.

If alterations occur regarding the name, designation or address of an individual or legal person in public records in connection with an identification number, such information will be updated in the Trademark Register at no cost to the proprietor, for the duration of such contractual relationship. The proprietors of marks are still responsible for ensuring, based on Article 37 of the Trademark Act, that their information in the Trademark Register is correct.

1) Regulation No. 59/2023, Article 11, effective 30 January 2023.

Article 59

Mortgaging and legal execution.

A request for information regarding mortgaging or legal execution being entered into the Trademark Register in accordance with Article 39 of the Trademark Act shall be accompanied by documents concerning the right in question and the required fee in accordance with the tariff. Documents can be submitted as originals, copies, or in an electronic manner.

In the event of mortgaging or legal execution in this country, a copy of the fidelity bond, mortgage deed, or any other registered document shall be enclosed. If mortgaging has taken place in another country, the mortgage agreement or other documentation verifying the mortgaging or legal execution in the relevant country shall be submitted.

If the Icelandic Intellectual Property Office is of the opinion that the submitted documents are insufficient, the party submitting the request is granted a one-month time limit to submit more detailed documents or explanations.

If the Icelandic Intellectual Property Office does not receive more detailed documents or explanations within the specified time limit, the information about mortgaging or legal execution will not be entered into the Trademark Register.

If, despite amendments being made, the Icelandic Intellectual Property Office remains of the opinion that there exists an impediment to the information regarding mortgaging or legal execution being entered into the Trademark Register, the request shall be dismissed and notification given of the time limit for appeal.

If the request satisfies the aforesaid requirements, the alterations will be entered into the Trademark Register and published in the IP Gazette.

Information in the Trademark Register regarding mortgaging or legal execution is only intended for the information of third parties. The owner of a mark or the mortgage holder is responsible for notifying the Icelandic Intellectual Property Office about the cancellation of a mortgage.

Article 60

Licenses.

A request for the entry of a trademark license in accordance with Article 38 of the Trademark Act shall be accompanied by the required fee according to the tariff as well as documents stating the name and address of the license holder, the time when the license was granted, the extent thereof and verification from the license holder of the granting of the license. Documents can be submitted as originals, copies, or in an electronic manner.

If the Icelandic Intellectual Property Office is of the opinion that the submitted documents are insufficient or that the license holder's use of the mark can result in a risk of confusion, the party submitting the request is granted a one-month time limit to submit more detailed documents or explanations.

If the Icelandic Intellectual Property Office does not receive more detailed documents or explanations within the specified time limit, the information about the trademark license will not be entered into the Trademark Register.

If, despite amendments being made, the Icelandic Intellectual Property Office remains of the opinion that there exists an impediment to the information regarding a trademark license being entered into the Trademark Register, the request shall be denied and notification given of the time limit for appeal.

If the request regarding a trademark license satisfies the aforesaid requirements, the alterations will be entered into the Trademark Register and published in the IP Gazette.

Information in the Trademark Register regarding a trademark license is only intended for the information of third parties. The owner of a mark or the license holder is responsible for notifying the Icelandic Intellectual Property Office about the cancellation of a trademark license.

CHAPTER XI

Trademark Register

Article 61

National applications.

The Icelandic Intellectual Property Office maintains a Trademark Register. In the Trademark Register, the following information shall be entered on national applications:

1. The number of the mark;
2. The date of application, which in cases concerning applications based on Article 57 of the Trademark Act is the same date as the international date of registration for the registration on which they are based;
3. The mark, along with a specification of the words included in the mark, if applicable;
4. Information about the type of the mark, in accordance with Paragraph 2 of Article 7 of this Regulation;
5. Information relating whether the mark includes colours, if applicable;
6. Image classification, if applicable;

7. [Description of the mark in accordance with paragraph 3 of Article 7 of this regulation, when applicable. Text in the description not matching the presentation of the mark is not entered in the Trademark Register;]¹⁾
8. Information about whether the mark in question is a trademark, collective mark or a guarantee and quality mark;
9. List of the goods and/or services designated in the application, along with the numbers of goods and/or service classes;
10. Priority claim, i.e. the number, date and country of the application or registration on which priority is based;
11. Information about registration in the country of residence in accordance with Article 33 [or Article 34]¹⁾ of the Trademark Act, if applicable;
12. The applicant's name, address and identification number, along with other principal contact information;
13. The representative's name, address and identification number, along with other principal contact information, if one has been appointed;
14. Information about whether the application has been used as the basis for an international registration;
15. The status of the application;
16. The rules for a collective mark or a guarantee or quality mark, along with the date of entry into force;
17. Information about the date of division and the number of the new application if division of the application took place;
18. The number of the basic application, if the application has undergone partition.

1) Regulation No. 59/2023, Article 12, effective 30 January 2023.

Article 62

National registrations.

When a mark has been accepted, the following information shall be indicated in the Trademark Register, in addition to the information in accordance with Article 65 of this Regulation:

1. The date of publication;
2. The date of registration, once that information is available in accordance with Article 25 of the Trademark Act;
3. Alterations, restrictions or other comments regarding the mark and the scope of the registration;
4. Alterations to the rules regarding the use of a collective mark and a guarantee and quality mark, and the date of entry into effect where applicable;
5. Information on opposition, invalidation, revocation and appeal, and also the conclusion of proceedings;
6. Information about whether the registration has been used as the basis for an international registration;
7. The status of the registration;
8. Information about whether the mark was registered on the basis of acquired distinctiveness (reputation on the market);
9. Information about the date of division and the number of the new registration if division of the registration took place;
10. The number of the basic registration, if the registration in question is divided;
11. Information about renewal;
12. Information about licenses, mortgaging or legal execution.

Article 63

International registrations.

In addition to the information that shall be recorded in accordance with Articles 61 and 62 of this Regulation, the following information shall be indicated in the Trademark Register concerning international registrations:

1. Number of the international registration;
2. Date of the international registration;
3. Date of subsequent designation, if applicable.
4. [Description of the mark in accordance with paragraph 3 of Article 7 of this regulation, when applicable. Text in the description not matching the presentation of the mark is not entered in the Trademark Register.]¹⁾

1) Regulation No. 59/2023, Article 13, effective 30 January 2023.

CHAPTER XII

Publication in the IP Gazette.

Article 64

The IP Gazette.

The IP Gazette may be published and distributed electronically, including on the Internet.
[...]¹⁾

1) Regulation No. 59/2023, Article 14, effective 30 January 2023.

Article 65

National registrations.

Publication of information about national registration shall include information on:

1. The number of the mark;
2. The date of application;
3. The mark;
4. The type of the mark, in accordance with Paragraph 2 of Article 7 of this Regulation;
5. The proprietor;
6. The representative, if one has been appointed;
7. The number of classes and specification of goods and/or services to which the registration applies;
8. Priority, if applicable.

It results from Paragraph 1 of Article 25 of the Trademark Act, cf. Article 18 of this Regulation, that the date of registration is not published concomitantly with information about registration.

Article 66

International registrations.

Publication of an international registration shall include information about:

1. Number of the international registration;
2. Date of the international registration;
3. Date of subsequent designation, if applicable;
4. The mark;
5. The type of the mark, in accordance with Paragraph 2 of Article 7 of this Regulation;
6. The proprietor;
7. Numbers of the classes to which the registration applies;
8. Priority, if applicable;
9. The number of the copy of the Gazette of International Marks, published by the World Intellectual Property Organisation, in which the registration was published;

It results from Paragraph 1 of Article 25 of the Trademark Act, cf. Article 18 of this Regulation, that the date of registration in this country is not published concomitantly with information about registration.

Article 67

Collective marks and guarantee and quality marks.

In addition to the information indicated in Articles 65-66, as applicable at each time, the rules regarding the use of a collective mark or a guarantee and quality mark shall be published when such a mark is at issue.

Article 68

Protection of international marks

A notification regarding protection of marks in accordance with Article 6 c (*ter*) of the Paris Convention shall include the name of the owner and the mark to which the protection applies.

Article 69

Renewal or eradication of a mark.

A notification that a mark has been renewed or that it has been eradicated from the Register of Trademarks shall include information about the number of the registration or the international registration number.

Article 70

Opposition, invalidation or revocation.

A notice of opposition to the registration of a mark shall include information about the number of the mark or the international registration number, the mark and the type of the mark, cf. Paragraph 2 of Article 7 of this Regulation.

A ruling in an opposition case or a decision regarding a request for the invalidation or revocation of a registration shall include information about:

1. The number of the mark;
2. The date of the ruling or decision;
3. The number of the ruling or decision;
4. The mark;
5. The type of the mark, in accordance with Paragraph 2 of Article 7 of this Regulation;
6. The proprietor;
7. Numbers of the classes to which the registration of the mark applies;
8. The party submitting the demand;
9. The principal arguments submitted in support of the invalidation or revocation;
10. The ruling or decision as such.

Article 71

Appeal.

A notice of the appeal of a ruling in opposition proceedings or a decision in application for invalidation or revocation shall include information about:

1. The number of the ruling or the decision that is appealed;
2. The number of the mark;
3. The mark; and
4. The type of the mark, in accordance with Article 7 of this Regulation.

A notification about the ruling of the Board of Appeal for Industrial Intellectual Property rights shall include information about:

1. The number of the mark;
2. The date of the ruling;
3. The number of the ruling;
4. The mark;
5. The type of the mark, in accordance with Paragraph 2 of Article 7 of this Regulation;
6. The proprietor;
7. Numbers of the classes to which the registration of the mark applies;

8. The appellant;
9. The principal arguments submitted by the appellant;
10. The ruling.

Article 72

Alterations in the Trademark Register

A notification of alterations regarding owners or representatives shall include the following information:

1. The number of the registration;
2. The proprietor;
3. The representative, if applicable.

If a notification concerns altered rules regarding the use of a collective mark or a guarantee or quality mark, a new copy of the rules shall be published in addition to the information according to Paragraph 1.

If a notification concerns an alteration of classes or limitations of a registration, it shall include the number of the registration, the number of the classes for which the mark was registered, and it shall specify to what classes the alteration applies. This provision applies equally to national as well as international registrations.

If a notification concerns an alteration of a mark in accordance with Article 24 of the Trademark Act, the information required in accordance with Article 65 of this Regulation shall be published.

Article 73

Division or partial transfer of title.

A notification of division or partial transfer of title shall include the following information:

1. The number of the basic application or registration, or international registration, as applicable;
2. The number of the devised application or registration, or international registration, as applicable;
3. The date of the application, date of registration or the date of international registration, where applicable.
4. The mark;
5. The type of the mark, in accordance with Paragraph 2 of Article 7 of this Regulation;
6. The proprietor;
7. The numbers of the relevant classes;
8. Information about priority, if applicable;
9. The number of the copy of the Gazette of International Marks, published by the World Intellectual Property Organisation, in which the division or transfer of title was published;

Article 74

Mortgaging, enforcement and trademark license

A notification of mortgage, legal execution or trademark license shall include the following information:

1. The number of the registration;
2. The relevant mark;
3. The type of the mark, in accordance with paragraph 2 of Article 7 of this Regulation.

CHAPTER XIII

Various provisions.

Article 75

Language and form of communication.

Communication with the Icelandic Intellectual Property Office shall take place in Icelandic. All documents and notifications sent to the Icelandic Intellectual Property Office shall in principle be in Icelandic, although the Intellectual Property Office can in exceptional cases waive that requirement. In accordance with Article 4 of this Regulation, lists of goods and/or services may be in English.

The Icelandic Intellectual Property Office can require documents to be translated, which includes certified translations.

Article 76

Power of Attorney.

Representatives shall have reached the age of majority, and his/her Power of Attorney shall at a minimum meet the requirements of Article 35 of the Trademark Act.

The Icelandic Intellectual Property Office has the right to demand information regarding the scope of the Power of Attorney, including a separate document attesting the Power of Attorney, especially if:

1. There is any doubt regarding whether the representative has Power of Attorney to act on behalf of the applicant or proprietor;
2. There are more than one representative representing the applicant or proprietor;
3. Actions are undertaken that can be considered onerous to the applicant or proprietor, such as a transfer of title, withdrawal of an application or registration, or alterations to the scope of an application or registration.

[If a representative is not appointed in accordance with paragraph 1 of Article 35 of the Trademark Act or if a representative resigns his post as representative in accordance with paragraph 2 of Article 35 of the Trademark Act, the Icelandic Intellectual Property Office will grant to the proprietor of the mark, who is obliged in accordance with Paragraph 1 of Article 35 of the Trademarks Act to appoint a representative, a time limit of two months to appoint a representative. A notification of the time limit will be published in the IP Gazette if the address of the proprietor is unknown along with information on the consequences of non-appointment.

If an applicant fails to respond in accordance with paragraph 3, the application will be eradicated from the Trademark Register when the time limit has expired.

If a proprietor of a registration fails to respond in accordance with paragraph 3, the Icelandic Intellectual Property Office may, instead of immediately eradicate the registration from the Trademark Register, allow the mark to remain registered without representation until an action concerning the registration is required, such as renewal or upon receipt of a request of annulment or revocation. The proprietor will be sent a new notification in accordance with paragraph 3 in these instances.

The proprietor of a mark who is required in accordance with paragraph 1 of Article 35 of the Trademark Act to appoint a representative is not authorized to request renewal of the registration, request changes of the mark as registered or submit arguments concerning requests in relation to the registration if a representative has not been appointed and a registration will be eradicated if the owner fails to respond to notifications concerning appointment of a representative.]¹⁾

1) Regulation No. 59/2023, Article 15, effective 30 January 2023.

Article 77

Entry into effect.

This Regulation is issued on the basis of Articles 62 and 65 of the Trademark Act No. 45/1997, as amended, and shall take effect immediately.

Irrespective of Paragraph 1, the provisions of Paragraph 2 of Article 4 and Paragraph 4 of Article 7 shall enter into force on 1 April 2021.

At the same time, Regulation No. 310/1997 on the registration of trademarks etc. is repealed.

The Ministry of Industries and Innovation, 28 August 2020.

For the Minister of Tourism, Industry and Innovation,

Sigrún Brynja Einarsdóttir.

Brynhildur Pálmarsdóttir.

Regulation 59/2023:

Article 16

This regulation is issued on the basis of Articles 62 and 65 of the Trademark Act No. 45/1997 as amended and shall take effect immediately.

The Ministry of Higher Education, Industry and Innovation, 9 January 2023.

Áslaug Arna Sigurbjörnsdóttir.

Ásdís Halla Bragadóttir.

Department B – Date of issue: 30 January 2023