

Intellectual Property & Technology Unit

IRISH PATENTS OFFICE: ROUTINE REQUESTS FOR EXTENSIONS OF TIME IN RESPECT OF TRADE MARK MATTERS WILL BE REFUSED

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New Guidelines Regarding Extensions of Time

Yesterday, 20 April 2010, the Irish Patents Office (IPO) published its new Guidelines for Dealing with Applications for Extensions of Time in respect of Trade Marks (Guidelines).

Towards the end of last year, the Controller of Patents, Designs and Trade Marks (Controller) had expressed concern that applications for extensions of time were being submitted to the IPO routinely and not as a result of, or supported by evidence of, unusual or exceptional circumstances. This practice was creating additional unnecessary work for the IPO.

Why Apply For an Extension of Time?

Extensions of time can be useful during the application for registration process and also in the course of opposition, revocation and invalidity cases. An applicant for a trade mark registration, for example, may be required to respond to objections raised by the IPO to his/her application, perhaps on the basis of relative grounds. In such a situation, the applicant may enter into negotiations with a prior rights holder and might therefore require an extended period of time before he/she is ready to respond to the IPO's objections.

Summary of Guidelines

Following a consultation procedure where the Controller invited feedback on proposed guidelines from interested parties, the finalised Guidelines were published yesterday. The Guidelines will come into effect as and from 4 May 2010 and are summarised in the table on page 2.

The Controller has stated that the Guidelines "will be applied consistently in a fair and reasonable manner and allow fully for extensions of time, of an appropriate duration, to be granted for legitimate reasons (when supported by evidence)."

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APPLICATION FOR EXTENSION OF TIME	IPO CONSIDERATIONS	MAXIMUM TIME PERIOD
Initial application for extension of time	All initial applications for extensions of time will be granted automatically.	Three (3) months.
Second application for extension of time	<p>Applications for extensions of time will be considered only if accompanied by evidence supporting claims of unusual or exceptional circumstances including the following:</p> <ul style="list-style-type: none"> a. How much more time is being sought; b. Why the extra time is needed; c. What has already been done within the original time allowed; d. What else needs to be done; and e. Why it was not possible to do this in the time already granted. <p>If relevant, a request for an extension should be accompanied with evidence of correspondence with clients/third parties, negotiations taking place, court cases awaiting completion, decisions of international bodies awaited (e.g. WIPO, OHIM) etc.</p> <p>The granting of a second extension of time is discretionary. Applications for extensions of time will be granted where the IPO is satisfied that an extension is warranted (i.e. that genuine efforts are being made to deal with the issue concerned).</p>	As deemed appropriate by the IPO.
Third application for extension of time	<p>Applications for extensions of time will only be considered if accompanied by evidence supporting claims of unusual or exceptional circumstances, which differs from the evidence supplied in support of the second application or demonstrates clearly that further genuine progress has been made.</p> <p>The granting of a third extension of time is discretionary. If granted, it will be deemed to be the final extension.</p>	As deemed appropriate by the IPO.
Further applications for extensions of time	<p>When the IPO has notified a party that a final extension is being granted (i.e. the third extension), no further applications for extensions of time will be considered.</p> <p>While the Guidelines state that no further extensions of time will be considered once a "final extension" has been granted, they also contain a proviso that the Controller retains discretion to consider further applications in exceptional circumstances.</p>	At the discretion of the Controller.



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Conclusion

Parties dealing with the IPO should conduct their affairs in a prompt and efficient manner to ensure that matters are dealt with as quickly as possible, and to avoid any prejudice to the trade mark(s) concerned. Implementation of the Guidelines by the IPO should reduce the number of trade mark matters that are pending at the IPO for unreasonably long periods of time for no genuine reason. This should result in increased efficiency at the IPO with is good news for trade mark practitioners and brand owners dealing with the IPO.

Author



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