

Trademark Act

No. 45/1997 with amendments according to Acts Nos. 67/1998, 82/1998, 13/2000, 54/2004, 88/2008, 117/2009, 126/2011, 44/2012, 130/2014, 32/2019 and 71/2020.

Should there be a discrepancy between the English translation and the original text, the original text takes precedence.

CHAPTER I

General provisions

Article 1

This Act applies to all marks that identify goods or services, irrespective of whether such marks are trademarks, collective marks, or guarantee and quality marks.

For the purposes of this Act the following terms shall have the following meanings:

1. *Trademark*: A specific identification for goods or services for commercial use.
2. *Collective mark*: A trademark that is described as a collective mark in an application and distinguishes the goods and services provided by a member of an organisation or a society from the goods and services provided by other companies.
3. *Guarantee and quality mark*: A trademark that is described as a guarantee or quality mark in an application and distinguishes the goods and services certified by the proprietor of the mark with regard to the material, the production method of goods or the provision of services, quality, precision or other characteristics from other goods or services that have not received such certification.

Article 1 a.

Individuals and legal entities can apply for the registration of a trademark in accordance with this Act.

Societies or organisations that can have rights and obligations, as well as public bodies, can apply for the registration of a collective mark.

Any party that establishes standards related to or provides monitoring of goods or services, e.g. an individual, an institution, organisations or other societies, can apply for and own a guarantee and quality mark, provided that the relevant party is not engaged in economic activities that involve the delivery of goods or the provision of services of a comparable type as those certified by the mark.

Article 2

Trademarks can be any kind of signs, such as words (personal names included), designs, patterns, letters, numerals, colours, sounds and shapes or the packaging of goods, provided they are suited for:

1. distinguishing the goods and services provided by one party from the goods and services of other parties, and
2. being identified in the Trademark Register in such manner that authorities and the general public are able to understand the clear and precise subject matter of the protection which the proprietor is granted.

Article 3

Trademark rights may be established by:

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

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

Article 4

The proprietor of a trademark shall have exclusive rights to the use thereof in accordance with the provisions of this Act. This includes the proprietor's right to prohibit a third party, not having his consent, the use in the course of trade and in relation with goods and services any sign that is:

1. identical with the trademark and used for the same goods and services,
2. identical with or similar to the trademark and used for the same or similar goods and services as those covered by the trademark rights, if there exists a likelihood of confusion, including the likelihood of association between the marks, or
3. identical with or similar to the trademark and is used, without a legitimate reason, for the same, similar or dissimilar goods and services, if the trademark is considered to be well known in Iceland and the use of the sign results in misuse of or is detrimental to the distinctive character or the reputation of the known mark.

Article 5

Commercial use of a trademark includes, for instance:

1. that the mark is placed on a product or its packaging, such as on a label or sticker, or equipment to ensure safety and verify authenticity, or any other item on which the trademark can be affixed,
2. importing or exporting goods, services or other items identified with a mark, offering them for sale, marketing them, preparing them for marketing, or stocking them for that purpose,
3. using a mark in advertisements or on business documents, or
4. using a mark as a trade name or a company name, or as part thereof.

Article 6

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

1. his name or address, in cases involving individuals.;
2. signs or indications that are devoid of any distinctive characteristics, or that concern a type of goods or services, the quality, quantity, intended purpose, value, geographical origin, the time of production of goods or provision of services, or other characteristics of goods or services.
3. the proprietor's trademark for the purpose of identifying or referring to the fact that the goods and services in question are those of the proprietor of the relevant trademark, especially if use of the trademark is necessary to indicate the intended use of the goods or services, particularly in cases concerning accessories or spare parts,
4. the proprietor's trademark in comparative advertising, provided that the provisions of Article 15 of Act no. 57/2005 on Supervision of Unfair Commercial Practices and Transparency of the Market are adhered to.

If the owner of a trademark has placed on the market goods or services which enjoy trademark right or authorised such within the European Economic Area, he may not subsequently hamper the use, sale, rental, import, export or other distribution of the goods or services in that area. Nevertheless, if there are compelling reasons to do so, the proprietor of the trademark is permitted to prevent the continued sale of goods, especially if its condition has been altered or it has been damaged after being placed on the market.

Article 7

If two or more parties individually claim a trademark right to marks where there exists a likelihood of confusion an earlier right shall take priority over a later one unless otherwise implied by provisions below.

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

Article 8

A later right to a registered trademark may enjoy protection parallel to the right of an earlier mark, even though there exists likelihood of confusion, if an application for registration was filed in good faith and the proprietor of the earlier trademark, despite knowledge of the later mark, has raised no opposition to its use in Iceland for a continuous five-year period from the date of registration.

Article 9

A later right to a trademark may also enjoy protection parallel to the right of an earlier mark, even though there exists likelihood of confusion, if the proprietor of the earlier trademark has not, within a reasonable time, taken the necessary steps to prevent the use of the later mark.

Article 10

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

Article 11

Upon the request of the proprietor of a registered trademark, authors and publishers of dictionaries, encyclopaedias, or similar reference work, whether printed or in electronic form, are obliged to ensure that it is not indicated that the registered mark is a generic name of goods or services.

Publishers are obliged to ensure that in the reproduction of a written work or its next edition there is included a correction stating that the mark is a registered trademark, and such corrections shall be done at the expense of the publisher.

CHAPTER II

Registration of trademarks

Article 12

An application for the registration of a trademark must be filed in writing to the Icelandic Intellectual Property Office, which handles the registration of trademarks and maintains the Trademark Register. The application shall specify the mark in a clear and precise manner, including an illustration if appropriate, and for what goods or services registration is requested. It shall also give the name, address and other necessary contact information of the individual or enterprise applying and be accompanied by the prescribed fee. In addition, the application shall be in accordance with the provisions of a Regulation, cf. Article 65.

The date of filing shall be the date on which the applicant files the application along with the required information and/or documents in accordance with Paragraph 1.

An application for a collective mark and a guarantee and quality mark shall be accompanied with the rules applicable to the use of the mark, and they shall be published concomitantly with the registration. The rules shall for instance state the following:

1. Who is authorised to use the mark.
2. What conditions apply to the use of the mark and what consequences and disciplinary actions would result from unlawful use of the mark.
3. What rights and obligations the proprietor of the mark has vis-à-vis those using the mark.
4. What rules apply to membership in the society that owns the mark, if the relevant mark is a collective mark.

Parties that manufacture goods or provide services that originate from the same geographical area as the society that is applying for or owns a registered collective mark that indicates this origin shall be permitted to become members of the relevant society or organisation as long as they meet all other requirements of the rules that apply to the use of the mark.

Article 13

The following signs or marks shall not be registered:

1. Signs that cannot constitute a trademark, cf. Paragraph 1 of Article 2.
2. Trademarks which are devoid of distinctive characteristics in relation to the goods or services for which they shall be registered.
3. Trademarks that consist exclusively of signs or indications which in trade only, or with minor alterations or additions, designate among other things the kind of goods or services, quality, quantity, intended purpose, value, geographical origin or the time of the production of the goods or the provision of the services.
4. Trademarks that exclusively consist of signs, word combinations or indications that are customary in daily speech or in the bona fide and established practices of the trade.
5. Signs that consist exclusively of the shape, or other characteristics that result from the nature of the goods, are necessary for the technical purpose thereof, or give substantial value to the goods.

6. Trademarks that are contrary to law or public policy, accepted principles of morality or have special symbolic meaning.
7. Trademarks that are likely to deceive the public, for example regarding the nature, condition or geographical origin of goods or services.
8. Trademarks that without authorisation include coats of arms or other government or national symbols, flags, marks of Icelandic municipalities, official inspection or quality marks or other items that are likely to be confused with the aforesaid marks and symbols. The prohibition therefore only applies to official inspection and quality marks if registration is requested for goods that are the same or similar to those for which the relevant mark is used.
9. Trademarks that include a product name which is protected under the Act on the protection of product names as designation of origin, geographical indications or traditional speciality, for the same or similar goods as designated in the application for the registration of the mark, and the application for the protection of the product name was filed before the application for the registration of said trademark.
10. Trademarks that are desired to be registered for wines and spirits and include geographical names for wines and spirits, except when the product originates at the location in question.
11. Trademarks that consist of, or reproduce in their essential elements an earlier plant variety denomination that is registered in accordance with the Act on Plant Variety Rights, and the mark is desired to be registered for a plant variety of the same or a closely related species.
12. A collective mark, if the rules regarding the mark are contrary to public policy or accepted principles of morality, or if the rules regarding the mark do not meet the requirements of Paragraph 3 of Article 12.
13. A collective mark, if the rules for the use of the mark prevent all manufacturers in the relevant geographical area from using the mark.
14. Trademarks that have been applied for in bad faith.

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

Irrespective of item 3 of Paragraph 1, it is permitted to register a collective mark and a guarantee and quality mark that indicates the geographical origin of goods or services. However, a mark of that kind does not confer upon its proprietor the right to prohibit a third party to use a geographical term or information for commercial purposes, as long as the use is consistent with good business practices.

Article 14

A trademark shall not be registered, except with the approval of the relevant proprietor:

1. if the mark is likely to be confused with a trademark which has been registered in Iceland or which has been in use here when the application for registration was filed and is still in use here,
2. if the mark is likely to be confused with a mark which is considered to be well known, in the sense of Article 6(a) of the Paris Convention for the Protection of Industrial Property, in Iceland at the time of filing of the application,
3. if the mark is likely to be confused with a mark which has been in use in another country, at the time when the application was filed or from the priority date, and is still in use there for the same or similar goods or services as the later mark is to be registered for, and the applicant was acting in bad faith with regard to the registration and use of the mark,
4. if the mark gives the impression that it refers to the name of an active commercial operation, or the name or portrait of another person, provided that this does not involve individuals long dead, or if the mark includes a distinctive name of real property or an illustration thereof,
5. if the mark indicates or can be interpreted to be the distinctive title of a protected literary or artistic work, or if it infringes the copyright of another person with regard to such work, or any other intellectual property rights,
6. if an agent applies for the registration of a mark under his/her own name and without permission from the proprietor, unless the agent can justify such action.

Article 15

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

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

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

Article 16

According to Article 12, it shall be specified in a sufficiently clear and precise manner in the application for what goods and services the mark is to be registered, so that the desired scope of protection is clear. Marks may not be registered for an entire class or classes without specifying the goods or services for which trademark registration is requested.

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

Article 17

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

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

Article 18

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

Article 19

If an application for the registration of a trademark does not comply with legal provisions or if the Icelandic Intellectual Property Office is of the opinion that other barriers should cause the rejection of the registration, the applicant shall be sent a reasoned statement of refusal and he shall be given the opportunity to express himself or amend the application within a specified time limit. Upon the expiry of this period the Icelandic Intellectual Property Office will re-examine its position towards the application.

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

At the request of the applicant, an application shall be resumed if the applicant, within two months of the expiration of the time limit referred to in the first paragraph, expresses himself concerning the case or amends the application, and provided the fee for resumption is paid.

In cases where the reason for rejection only applies to part of the goods and services designated in an application for registration, the rejection of registration shall only apply to that part of the application.

Article 20

Should anyone claim to the Icelandic Intellectual Property Office that he is the proprietor of a registered trademark, or a trademark for which registration has been sought, the Office may recommend that the party concerned institute proceedings within a specified time limit to establish this. In this recommendation mention shall be made of the fact that failure to institute proceedings may result in the Icelandic Intellectual Property Office ignoring his claims.

If legal proceedings are initiated to establish the right to a trademark, processing by the Icelandic Intellectual Property Office may be postponed.

Article 20 a.

After an application for registration has been filed to the Icelandic Intellectual Property Office, and before a trademark is registered, a third party can submit observations against the registration of the mark. Submission of such observations does not confer upon the relevant party the right to be a party to the proceedings of the Office.

Observations can also be submitted with regard to the registration of collective marks and quality and guarantee marks.

More detailed rules of the handling of third-party observations shall be outlined in a regulation established by the Minister.

Article 21

If an application for the registration of a trademark is deemed to fulfil the requirements for registration the mark shall be registered and published. The published notification shall include the principal information concerning the registration and an illustration of the mark if appropriate. Trademarks shall be published in the IP Gazette, published by The Icelandic Intellectual Property Office.

The IP Gazette may be published and distributed electronically, for example on the Internet.

Article 22

After the publication of the registration of a trademark, collective mark or a guarantee an opposition may be filed. Anyone may file an opposition to a registration. The opposition shall be reasoned and sent to the Icelandic Intellectual Property Office within two months from the date of publication along with the payment of the required fee.

Opposition shall also meet the requirements stated in the Trademark Regulation. If an opposition does not meet formal requirements, the opponent shall be granted a suitable time limit to amend it. If amendments are not received within the stated time period, the opposition shall be dismissed.

When opposition to the registration of a trademark is received, information to that effect is entered into the Trademark Register and a notification published in the IP Gazette.

Article 22 a.

The proprietor of a registration shall be notified of opposition and given the opportunity to submit comments thereon within a reasonable time limit. If the proprietor does not wish to comment on the opposition, it will be submitted for ruling without further comments from the opponent.

If an opposition to the same mark is submitted by more than one party, it is permitted to combine the cases unless the parties concerned present material viewpoints against such a decision.

At the request of both parties involved, it is permitted to suspend proceedings by a minimum of two months, if the parties wish to seek a reconciliation.

Article 22 b.

Registration of the mark that is the subject of the opposition is reviewed exclusively with reference to the arguments from the parties involved.

Opposition can be accepted, in whole or in part, or rejected or the rights can be transferred to the opponent if they have so requested. If rights are transferred, the opponent shall pay a new application fee.

A ruling in an opposition case is sent to the opponent and the proprietor of the registration and published on the Offices website. The decision that is reached regarding the case shall be published in the IP Gazette.

If a registration is invalidated in whole or in part following an opposition, the mark will be eradicated from the Trademark Register in accordance with that decision once the final decision of the Board of Appeal or a court of law has been made, if appropriate.

Article 22 c.

If non-use is brought up as a defence in opposition proceedings, and the five year period to put the earlier mark into genuine use in the manner specified in Article 25 was expired on the filing date or the priority date of the later mark, the opponent shall, at the request of the proprietor of the opposed mark, furnish proof that the earlier mark has been put to genuine use in accordance with Article 25 during a five year period

preceding the filing date or the priority date of the later mark, or that there are valid reasons for non-use of the mark. If use is not considered to have been proved in the required manner, the opposition will be rejected.

If the earlier mark has only been used to identify part of the goods or services for which it is registered, it shall, with regard to the submitted opposition, only be considered to be protected for that part of the goods or services.

Article 23

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

The provisions of the first paragraph shall also apply when the Icelandic Intellectual Property Office receives notice requesting that an international registration also apply in Iceland and it is evident that such registration would have prevented the registration of a mark which was applied for after the international registration entered into force here, cf. Article 59.

Article 24

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

If changes occur to the rules that apply to the use of a collective mark, the proprietor shall notify the changes to the Icelandic Intellectual Property Office without delay and submit a new copy thereof. The Office will review the changes with reference to the requirements in Article 12 and will grant a time limit for making amendments if the rules do not meet the stated requirements. The Icelandic Intellectual Property Office will only consider altered rules to be valid from the date on which the altered rules were entered into the Trademark Register. The rules shall be republished in the IP Gazette.

Article 24 a

The Icelandic Intellectual Property Office may, at the proprietor's request and after payment of the prescribed fee, divide an application into two or more applications. The same applies to registrations. The request must specify to which goods or services each application or registration applies following the division. The new application or registration shall have the same filing and priority dates as the basic registration, but a new registration number shall be issued. A decision on division of an application shall be published in the IP Gazette.

Article 25

If the proprietor of a registered trademark has not, within five years following the completion of the registration procedure, put the trademark into genuine use in Iceland for the goods or services for which it is registered, or if such use has been suspended during a continuous five-year period, the registration may be invalidated by a court ruling or at the decision of the Icelandic Intellectual Property Office, cf. Article 28 c., unless there are valid reasons for non-use of the trademark.

The following shall be considered the equivalent of use in accordance with paragraph 1:

1. when a trademark is used in a form, different from its representation in the Trademark Register, yet in such manner that constitutes a deviation that does not compromise its distinctive character and distinguishability and regardless of whether or not that form of presentation is also registered in the Trademark Register in the name of the proprietor, or
2. when a mark has been affixed to goods in Iceland that are only intended for export, or to the packaging of such goods.

If a trademark is used by a party other than the proprietor but with his authorisation, such shall be considered to constitute use by the owner. If a collective mark or a guarantee and quality mark is used by one or more parties authorised to do so, this shall be considered use in the sense of Paragraph 1.

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

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

The date which shall mark the beginning of the five-year period in accordance with Paragraph 1 shall be entered into Trademark Register.

Article 26

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

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

Article 27

An application for renewal of a trademark registration may be filed with the Icelandic Intellectual Property Office as early as six months prior to the expiration of a registration period but no later than six months after the expiration of this period. The application shall be accompanied by the required fee that shall be paid in this period.

The Icelandic Intellectual Property Office will notify the proprietor of a trademark about the impending expiry of the registration period at least six months before the period ends. The Office is not responsible for the lapse of proprietary rights if such notification is not sent or does not reach the recipient.

Should the Icelandic Intellectual Property Office regard the application as satisfactory, the renewal of registration shall be entered into the Trademark Register and published in the IP Gazette. Should the application be considered unsatisfactory, the applicant shall be notified of such and given a specific time limit within which they may rectify the application.

If a request is submitted regarding part of the goods or services to which the registration of the trademark applies, the registration shall only be renewed for that part of the goods or services.

Should no application for the renewal of the registration of a trademark have been filed within the time limit referred to in Paragraph 1, the registration of the mark will be eradicated.

At the request of the proprietor of a trademark registration, an application for renewal of a trademark registration shall be resumed if the proprietor, within two months of the expiration of the time limit referred to in Paragraph 1, files an application for renewal and pays the required fee for resumption.

CHAPTER III

Cancellation of registration

Article 28

If a trademark, collective mark or a guarantee and quality mark has been registered contrary to the provisions of this Act, the registration can be invalidated, in whole or in part, by court ruling or decision of the Icelandic Intellectual Property Office, subject, however, to the provisions of Articles 8–10. Any party can request the invalidation of a registration.

If the reason for invalidation is a lack of distinctiveness of the mark or other causes referred to in Article 13, the assessment shall also include consideration of use that has occurred after registration.

The request for invalidation may be based on more than one older right, as long as the older rights wholly belong to the same proprietor.

Article 28 a.

In an invalidation case based on a registered mark with an earlier filing or priority date, the proprietor of the earlier mark, if so requested by the proprietor of the later mark during the proceedings, shall furnish proof that the trademark has been in use, as stipulated in Article 25, in connection with the goods or services for which it is registered, over the period of the last five years before the request for invalidation was submitted, or

submit sound and valid arguments for non-use of the mark. It is required that the registration procedure for the earlier trademark was, at the date of the submission of the request for invalidation, completed at least five years previously.

In addition to the evidence required in accordance with Paragraph 1, the proprietor of the earlier mark, if the five year time limit for putting the earlier trademark into genuine use as stipulated in Article 25 had expired by the filing or priority date of the later trademark, shall provide evidence that the earlier trademark was in genuine use during the five year period before the filing or priority date thereof, or that there are sound and valid reasons for non-use of the mark, should the proprietor of the later mark so request during the proceedings.

If use in accordance with paragraphs 1 and 2 is considered not to have been proven, the request for invalidation based on earlier rights shall be rejected.

If use is demonstrated for part of the goods or services, the request can be granted to that extent.

Article 28 b.

A request for invalidation based on an earlier trademark shall not be considered if the request would not have been granted on the filing or priority date of the later mark for the following reasons:

- a. The earlier mark had not acquired a distinctive character in the meaning of Article 13 on the date of filing of the later mark or on its priority date, if priority is claimed in accordance with Article 17.
- b. The earlier mark had not acquired a sufficiently distinctive character to support a finding of likelihood of confusion in the meaning of item 2 of Article 4 on the date of filing of the later mark or on its priority date, if priority is claimed in accordance with Article 17.
- c. The earlier mark was not well known in Iceland in the sense of item 3 of Article 4 on the filing date of the later mark or on its priority date, if priority is claimed in accordance with Article 17.

Article 28 c.

Registration can be revoked, in whole or in part, by court ruling or decision of the Icelandic Intellectual Property Office, if the mark:

- a. has not been used in Iceland in accordance with Article 25 within a period of five years from the end of the registration procedure for the goods or services for which it is registered, or it has not been used for a continuous five year period, unless valid reasons are given for non-use,
- b. has, due to acts or inactivity of the proprietor, become the common name for goods or services in respect of which it is registered,
- c. is used by its proprietor or with its proprietor's consent in a manner that is likely to mislead the general public, among other things with regard to the nature, quality or geographical origin of the goods or services.

Anyone can request that a registration shall be revoked.

It is also permitted to revoke a registration of a collective mark or a guarantee and quality mark if the rules for the use of the mark were not available at the time of registration, if they have not been updated, if they are otherwise found lacking or if the proprietor does not prevent use that is incompatible with the rules.

It is not permitted to request that a registration of a trademark is revoked if the proprietor has started genuine use of the trademark or such use has been resumed at the time where the five year period of non-use is considered to have ended, and before a request for revocation of the trademark is submitted.

If the use of a trademark commences or is resumed at any time during a three month period before the request for revocation of the trademark was submitted, which began at the earliest on expiry of the five year period of non-use, such use shall be disregarded if it results from the proprietor having acquired knowledge about the intention to request that the trademark be revoked.

Article 28 d.

A request to the Icelandic Intellectual Property Office for the invalidation or revocation of a trademark shall be in writing and substantiated and include the payment of the required fee. A request shall also meet the requirements stated in the Trademark Regulation.

If a request does not meet the requirements of Paragraph 1 and the Regulation at the time of submission, the submitting party is given a time limit to make amendments to the request. If the request is not

amended within the time limit given, or if the Icelandic Intellectual Property Office does not find that there is reason to extend the time limit, the request shall be dismissed.

If a request for invalidation or revocation is submitted by more than one party, it is permitted to combine the cases unless the parties concerned present material viewpoints against such decision.

The proprietor of the registration shall be informed about the request and given an opportunity to submit comments regarding the case within a specified time limit before a decision is reached in the case.

If a case regarding the same registration is being processed at judicial level, the request shall be dismissed. If a court action is brought concerning a registration on the same basis as stated in paragraph 1, and before the Icelandic Intellectual Property Office has reached a decision in the case, the Office shall postpone processing the case until the court's decision is available.

Article 28 e.

The legal consequences of the invalidation of a mark, wholly or in part, by court ruling or decision of the Icelandic Intellectual Property Office, shall be based on the date of filing.

The legal consequences of a mark being revoked, wholly or in part, by court ruling or decision of the Icelandic Intellectual Property Office, shall be based on the date of the request for revocation. However, at the request of either of the parties involved, an earlier date, on which the grounds for revocation occurred, may be fixed in the decision on the application for revocation.

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

Article 29

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

The Icelandic Intellectual Property Office is the proper plaintiff in litigation based on Articles 13, 25 and 28 c.

Article 30

Anyone with legitimate interests at stake may request that the Icelandic Intellectual Property Office eradicate the registration of a trademark if it is demonstrated that the activities of its proprietor have ceased.

Before the Icelandic Intellectual Property Office eradicates a registration in response to a demand under the first paragraph, the proprietor of the trademark should be notified and given the opportunity to express his comments within three months' time. Such notification should be sent in a verifiable manner. If the address of the proprietor of a trademark is unknown the notification should be published in the IP Gazette. If the proprietor fails to contact the Icelandic Intellectual Property Office within the above-mentioned time limit the mark shall be eradicated from the Register.

Article 31

Should the Icelandic Intellectual Property Office make an obvious error in the registration, renewal or entry into the Trademark Register, the Office may correct the mistake. The correction shall be published in the IP Gazette.

The proprietor of an application or trademark registration may submit a request to have obvious errors in an application or registration corrected.

Article 32

Trademarks shall be eradicated from the Trademark Register:

1. if the registration is not renewed,
2. at the request of the proprietor of the mark,
3. if the registration is declared invalid following oppositions,
4. if the registration is declared invalid in accordance with Article 23,
5. upon a verdict of a Court for the invalidation of a trademark,
6. upon a decision by the Icelandic Intellectual Property Office if the activities of the proprietor of a trademark have been confirmed to have ceased, cf. Article 30,

7. in accordance with a decision by the Icelandic Intellectual Property Office if an obvious mistake has occurred in the registration, renewal or amendment, cf. Article 31,
8. if no representative has been appointed, cf. Article 35,
9. upon request by the Ministry responsible for Iceland's national flag if a trademark where the Icelandic national flag has been used without its permission, has been registered by mistake,
10. according to the decision of the Icelandic Intellectual Property Office if a registration is invalidated or revoked in accordance with Article 28 or Articles 28 a. – 28 e.

The eradication of trademarks in accordance with the first paragraph shall be published in the IP Gazette.

CHAPTER IV

Special rules on the registration of foreign trademarks

Article 33

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

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

Article 34

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

Article 35

The proprietor of a trademark, who is not domiciled in Iceland, must have a representative residing in the European Economic Area, a member state of the European Free Trade Association (EFTA) or the Faroe Islands. The representative must be authorised by the proprietor of the mark to receive summons, as well as other notifications concerning the mark, on his behalf with binding effect on the proprietor. The name and address of the representative shall be entered in the Trademark Register.

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

The legal venue in court cases filed in accordance with this Act, where the proprietor of a trademark is not domiciled in Iceland, shall be in Reykjavík.

The Icelandic Intellectual Property Office shall communicate with applicants and proprietors of trademark registrations or their representatives in Icelandic. In exceptional instances the Office may accept documentation in foreign languages.

CHAPTER V

Transfer, licences, etc.

Article 36

Rights to a trademark or an application for the registration of a trademark can be transferred in whole or in part, individually or along with the economic activities for which it is used.

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

If a trademark has been registered in the name of an agent or a representative for the relevant trademark, without consent from the proprietor, the latter shall have the right to request that the trademark is assigned to them. However, this does not apply if the agent can justify their actions.

Article 37

Anyone who acquires the right to a registered trademark or an application for the registration of a trademark shall notify the Icelandic Intellectual Property Office thereof and the Office shall enter the change of ownership in the Trademark Register and publish a notification thereof in the IP Gazette.

Until a transfer has been notified the latest registered proprietor of a mark shall be deemed its proprietor.

Article 38

The proprietor of a trademark or an applicant for the registration of a trademark may grant to others the authorisation to use the mark for commercial purposes (license). A license can be specific or general and can apply to all or part of the goods and services for which the trademark is registered or for which it is desired to be registered. Unless expressly agreed, the holder of the license (licensee) may not transfer their rights.

The proprietor of a registered trademark or an applicant for the registration of a trademark can invoke the rights conferred by that trademark against a licensee, if the latter contravenes any provision in the license agreement with regard to:

1. the duration of the license agreement,
2. the permitted manner of presentation of the mark,
3. the scope of the goods or services for which the license is granted,
4. the geographical area covered by the trademark license,
5. the quality of the goods manufactured by the licensee or the services which he/she offers.

The proprietor of a trademark, an applicant for the registration of a trademark, or a licensee may, upon payment of a required fee, request that a license be entered in the Trademark Register and published in the IP Gazette. The same applies if a license is transferred or cancelled. The Icelandic Intellectual Property Office may refuse to register a license if it is considered that the licensee's use of the mark could lead to a risk of confusion.

Article 39

It is permitted to mortgage a registered trademark or an application for the registration of a trademark, irrespective of the economic activities for which it is used.

It is permitted to carry out a levy of execution on a registered trademark or an application for the registration of a trademark.

If the right to a registered trademark or an application for the registration of a trademark has been mortgaged or been subject to a levy of execution, this shall be entered in the Trademark Register if the proprietor of the mark, the applicant, mortgage holder or attaching party so requests.

CHAPTER VI

Prohibition against the use of deceptive trademarks

Article 40

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

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

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

CHAPTER VII

Legal Protection

Article 41

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

Article 42

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

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

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

Article 43

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

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

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

Article 44

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

Article 45

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

The proprietor of a collective mark or a guarantee and quality mark is entitled to issue a claim for compensation on behalf of parties who have the right to use the mark, if they have suffered damage due to unlawful use of the mark.

Article 46

A licensee can only bring an action regarding an infringement of trademark rights with the approval of the proprietor of the trademark, unless otherwise agreed. The holder of a specific license can nonetheless bring such action if the proprietor of the trademark fails to bring action himself within a suitable time limit after the licensee's formal request to do so.

A licensee may become a party to a case that the proprietor of a trademark has brought due to infringement of trademark rights, for the purpose of requesting compensation for damage which they have suffered.

CHAPTER VIII

International Registration of Trademarks

Article 47

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

In Iceland the Icelandic Intellectual Property Office accepts applications for international registration of trademarks and handles international registrations.

Article 48

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

Article 49

An application must be filed in writing to the Icelandic Intellectual Property Office on an application form for this purpose. The application shall be in English and shall specify the mark, including an illustration if

appropriate, and for what goods or services registration is requested. It shall also give the name of the applicant or the name of the commercial activity. The prescribed fee for reception and handling must be paid.

Article 50

The Icelandic Intellectual Property Office shall investigate whether the information in an international application corresponds with information in the application or registration of the trademark in Iceland.

Should there be any discrepancies the applicant shall be notified of such and set a time limit for the submission of his comments or corrections. Should no comments have been received from the applicant within the prescribed time limit his application shall be considered to have been withdrawn; if, despite his comments, discrepancies remain the Icelandic Intellectual Property Office may refuse to forward the application to the International Bureau.

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

Article 51

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

Article 52

Should the Icelandic Intellectual Property Office consider the international trademark registration not registrable in Iceland, the proprietor of the registration may express his comments on the matter and request that it be re-examined. The proprietor of the registration shall in such case appoint a representative in accordance with Article 35. The conclusion of the Icelandic Intellectual Property Office shall be sent to the International Bureau, together with its grounds, before 18 months have elapsed from the date of notification by the International Bureau, cf. Article 51.

If the Icelandic Intellectual Property Office is of the opinion that there is nothing to prevent an international trademark registration from being valid in Iceland it shall be published in the IP Gazette. The notification shall include the date which the International Bureau has decided as the registration date of the international registration.

Article 53

Oppositions may be raised to the validity of an international registration in Iceland after its publication in the IP Gazette. Reasoned oppositions must reach the Icelandic Intellectual Property Office within two months of the date of publication.

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

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

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

When the final conclusion is available the Icelandic Intellectual Property Office shall notify the International Bureau thereof. If the oppositions are taken into consideration, the registration is wholly or partly cancelled in Iceland. The conclusion shall be published in the IP Gazette.

Article 54

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

A change in accordance with the first paragraph shall be entered into the Trademark Register and published in the IP Gazette.

Article 55

If an international registration is wholly or partly cancelled it shall in the same manner be cancelled in Iceland. A notice of such shall be entered into the Trademark Register and published in the IP Gazette.

Article 56

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

Article 57

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

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

Information in accordance with the first paragraph shall be entered in the Trademark Register and published in the IP Gazette.

Article 58

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

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

Information in accordance with the first paragraph shall be entered in the Trademark Register and published in the IP Gazette.

Article 59

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

Article 60

Information concerning international trademark registrations, such as amendments, renewals, assignments, expiry or deletion of registration, etc. shall be published in the IP Gazette.

Article 61

Decisions of The Icelandic Intellectual Property Office concerning the processing of applications for international registration of trademarks may be referred to the Board of Appeal in accordance with the provisions of Article 63.

Article 62

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

CHAPTER IX
Miscellaneous provisions

Article 63

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

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

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

Article 64

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

The Icelandic Intellectual Property Office may not grant the public access to supporting documents or documentation, in full or in part, which contain business secrets and do not generally concern the registration of or exclusive right to the mark.

Article 65

The Minister shall set detailed rules¹⁾ on the preparation and submission of trademark applications and their processing, and on the administration of registered trademarks by the Icelandic Intellectual Property Office, on the format of the Trademark Register and its keeping, on the issuance of registration certificates and their contents and the handling of opposition, invalidation and revocation cases, as well as fees for appeals. The Minister shall also set detailed rules for appeals and the Board of Appeal.²⁾

¹⁾ Regulation No. 850/2020

²⁾ Regulation No. 275/2008

Article 65 a

A Regulation issued by the Minister shall provide for fees referred to in this Act and compensation for the services provided by the Icelandic Intellectual Property Office.¹⁾

Fees, including application and renewal fees, must cover the cost of operation and services provided by the Icelandic Intellectual Property Office in connection with trademarks, including for national and international applications for trademarks, the examination by the Icelandic Intellectual Property Office of the requirements concerning form and contents of trademark applications, issuance and forwarding of documents on priority rights, registration of trademarks and renewal, processing as referred to in Art. 22, publication in the IP Gazette, amendments to the Trademark Register and transcripts from the Register and other services.

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

Fees provided for in this Act shall accrue to the Icelandic Intellectual Property Office, which shall collect the fees.

¹⁾ Regulation No. 60/2020 (until 31 December 2020). No. 1050/2020 (as of 1 January 2021).

Article 66¹⁾

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

¹⁾ Applicable to Act No. 45/1997 as it originally entered into force.

Article 67¹⁾

This Act is made for the introduction of Directive of the European Parliament and of the Council (EU) 2015/2436 to approximate the laws of the Member States relating to trademarks, as referred to in Appendix XVII to the Agreement on the European Economic Area as amended by the Decision of the EEA Joint Committee no. 27/2020 of 7 February 2020.

¹⁾ Applicable to Act No. 71/2020 amending Act No. 45/1997 as of 1 September 2020.

Article 68¹⁾

This Act shall enter into effect on 1 June 1997.

¹⁾ Applicable to Act No. 45/1997 as it originally entered into force.

Final provisions of Act No. 71/2020 amending the Trademark Act as of 1 September 2020:

Article 38

This Act shall enter into force on 1 September 2020.

Act no. 155/2002 Respecting Collective Marks as amended, shall be cancelled upon the entry into effect of this Act.

Article 39

An application for the registration of a trademark, collective mark and a guarantee and quality mark that has been filed with the Icelandic Intellectual Property Office upon the entry into effect of this Act shall be considered to meet the requirements for applications in accordance with this Act, if the application met the requirements of the former Act upon the entry into effect of this Act.

A trademark, collective mark or a guarantee and quality mark that was registered before the entry into effect of this Act can only be cancelled or limited on the basis of objections, invalidation or cancellation if such decision was possible on the basis of the Trademark Act before the amendments thereto according to this Act took effect. However, it will not be required from a party who brings an invalidation or a revocation case that he/she demonstrate that there are legal interests at stake, as required in the former Act.

The provisions of Article 23 only apply to applications that are received by the Icelandic Intellectual Property Office after the entry into effect of this Act. The term of validity of older applications and registrations shall remain unaltered.

In other respects, this Act also applies to trademarks, collective marks and guarantee and quality marks that were registered before the entry into effect of this Act.