

Ireland

Contributing firm

F R Kelly & Co

Author

Gavan Ferguson

Partner

1. Legal framework

National

The Trademarks Act 1996 currently governs trademark law in Ireland. The act was enacted primarily to implement the First Trademark Directive (89/104 IEEC), which introduced common standards on substantive trademark law throughout the European Union.

Under the act:

- service marks may be registered;
- multiple classes may be covered in a single application;
- the definition of a 'trademark' has been expanded to include any sign that can be represented graphically, including the shape of goods or their packaging;
- Parts A and B of the Trademark Register have been eliminated to create a single register;
- trademark registrants may now sue for infringement with respect to the use of confusingly similar marks for goods or services similar, but not necessarily identical, to those covered by their registration;
- new penal offences have been enacted to discourage trademark counterfeiting;
- registrations are now granted for a period of 10 years from the filing date and may be renewed for further 10-year periods; and
- collective marks may be registered.

International

Ireland is a signatory to various international treaties in relation to trademarks. These include the following:

- the Paris Convention for the Protection of Intellectual Property (1883). Ireland became a contracting party to the convention on December 4 1925;
- the Nice Agreement on the International Classification of Goods and Services for the Registration of Trademarks (1957). Ireland

became a contracting party to this agreement on December 12 1966;

- the Agreement on Trade-Related Aspects of Intellectual Property Rights, opened for signature on April 15 1994. Ireland acceded to the World Trade Organization on January 1 1995;
- the Trademark Law Treaty. Ireland became a signatory to the treaty on October 13 1999;
- the European Community Trademark Regulation (40/94); and
- the Madrid Protocol. Ireland became a party to the protocol on October 19 2001 by virtue of the Trademarks (Madrid Protocol) Regulation 2001.

2. Unregistered marks

Unregistered marks are protected in Ireland by passing off, which is part of the law of tort and is founded in common law. Therefore, this protection is based purely on case law, as it has no statutory basis in legislation.

The UK House of Lords decision in *Reckitt & Colman Products Ltd v Borden* [1990] 1 All ER 873 dealt with the issue of the essential elements in passing off as follows: "[The plaintiff] must establish a goodwill or reputation attached to the goods or services which he supplies in the mind of the purchasing public by association with the identifying get-up (whether that consists simply of a brand name or trade description or the individual features of labelling or packaging) under which his particular goods or services are offered to the public, such that the get-up is recognized by the public as distinctive, specifically as the plaintiff's goods or services. Second, he must demonstrate a misrepresentation by the defendant to the public (whether or not intentional) leading or likely to lead the public to believe the goods or services offered by him are the goods or services of the

plaintiff ... Third, he must demonstrate that he suffers or in a *quia timet* action that he is likely to suffer damage by reason of the erroneous belief engendered by the defendant's misrepresentation that the source of the defendant's goods or services is the same as the sources of those offered by the plaintiff."

Modern Irish pronouncements on passing off tend to follow the English approach.

3. Registered marks

Ownership

There are no restrictions on who can apply for and own a trademark in Ireland. An application can be filed in the name of a private individual or a company. The Trademarks Act also provides for jointly owned trademarks.

Scope of protection

The Trademarks Act defines a 'trademark' as: "Any sign capable of being represented graphically which is capable of distinguishing goods or services of one undertaking from those of other undertakings." A non-exhaustive list of examples is given in the act, including "words (including personal names), designs, letters, numerals or the shape of goods or their packaging". Some trademarks that may be *prima facie* registrable but are difficult to represent graphically are sound marks, smells and tastes.

4. Procedures

Examination

The Irish Patents Office will examine an application within approximately three months from the date of filing to establish whether the requirements of the Trademarks Act and Trademark Rules 1996 have been met. This

means that there is examination as to both formalities and substantive matters.

An examination as to the formalities will determine whether the application form has been correctly completed and the attendant requirements satisfied, such as payment of fees and submission of priority documents within the stated time.

The substantive requirements of the application relate to the following:

- whether the mark is a trademark within the statutory definition, which requires the mark to be capable of being represented graphically and of distinguishing the applicant's goods or services from those of others;
- absolute grounds for refusal, including an examination as to distinctiveness and whether the mark is deceptive or contrary to law or public policy;
- whether the mark includes a specially protected emblem of Ireland or the national flag;
- whether the mark includes national flags or state or other emblems that have been notified under Article 6ter of the Paris Convention; and
- relative grounds for refusal, insofar as they relate to earlier trademarks. This necessitates the Patents Office carrying out searches of the Irish and Community trademark registers. In practice, the search is not limited to identical conflicting earlier trademarks and there is also cross-searching to related classes in order to assess the position with respect to similarity of goods or services.

If, as a result of the examination of either the formalities or the substantive requirements, the Patents Office takes the view that the requirements have not been met, an official action issues to the applicant or its authorized agent, providing an opportunity to make representations or to amend the application.

There is no specific statutory time period within which to respond to an official action; the period allowed is stated in the official communication and is extendible.

If the registration requirements are met, the application is accepted and allowed to proceed to publication in the *Patents Office Journal*.

Opposition

The purpose of publication is to give third parties an opportunity to oppose an application before it can proceed to registration. Under the Trademarks Act, a non-extendible three-month opposition period is provided. The grounds for opposition are those which form the basis for the general refusal of a trademark application. There are no restrictions on who can lodge an opposition, but this must be done by way of a written statement of the grounds for opposition accompanied by an official fee. Within three months of filing of the notice of opposition, the applicant must file a counter-statement with the Patents Office. This period is also non-extendible. If the applicant fails to file a counter-statement, the application is deemed withdrawn. Both sides then submit evidence in support of their contentions. Each party will generally be entitled to a period of 12 months, granted in increments of three months each, to file its evidence. When the evidence is complete, the Patents Office may invite the parties to attend a hearing. Following the hearing, or if no hearing is requested, the parties are notified of the decision. This decision can be appealed to the High Court within three months of notification.

Registration

If there is no opposition, or if any oppositions are withdrawn or decided in favour of the applicant, a registration certificate will issue upon payment of the final registration fee. An exception arises where, having regard to matters that come to the attention of the Patents Office since acceptance of the application, it is believed that the acceptance was made in error. This would normally arise

following a written observation by a third party.

The registration fee must be paid and the fact of registration is then published in the *Patents Office Journal*. This date of publication is important because it determines the date of completion of the registration procedure, which is the date from which the five-year period runs for revocation on the grounds of non-use and from which infringement proceedings can commence. However, the date of registration is the date of filing of the application, and this or any claimed priority date is the effective date from which rights accrue to the trademark owner.

The duration of trademark protection is 10 years from the date of registration and the registration is renewable for successive 10-year periods.

Removal from register

Surrender: Under the Trademarks Act, it is possible for a trademark owner to surrender a registration in respect of some or all of the goods or services for which it is registered. Notice of the surrender or partial surrender is published in the *Patents Office Journal* and it becomes effective from this date. However, no action for infringement subsists in respect of any act carried out before that date.

Revocation: The Trademarks Act provides that a trademark must be put to genuine use in Ireland by the owner or with its consent in relation to the goods or services for which it is registered within five years of the date of publication of the registration, unless there are proper reasons for non-use. A mark may be revoked for non-use. Revocation can also occur where use has been made of the mark, but such use has been suspended for an uninterrupted period of five years without proper reasons for the suspension of use. A mark may also be revoked where, because of the use made of it, the mark has become liable to mislead the public in relation to the goods or services, their quality or geographical origin.

Where revocation proceedings are instituted, use of the mark in the three months before the application is filed is disregarded, unless preparations for the commencement or resumption of use began before the owner became aware that the application for revocation might be made. Any person can institute revocation proceedings and the burden of proving 'use' rests with the trademark owner. Revocation can be in relation to some or all of the goods or services covered by the mark.

If the revocation proceedings succeed, the registration in question will be revoked and the rights of the owner will be deemed to have ceased from the date of application for revocation or at any earlier date, if requested and if so determined by the Patents Office.

Invalidation: The validity of a trademark registration can be challenged based on absolute or relative grounds for refusal. Essentially, this action is available against trademarks which, although registered, should not in fact have been registered. It is a requirement for registration that there be use or, at a minimum, a good-faith intention to use a trademark. Therefore, failure to comply with this requirement could also be considered grounds for invalidation. Post-registration use cannot subsequently remedy this position. The grounds for invalidation must exist at the time of registration and a trademark cannot be declared invalid on the grounds that it has subsequently ceased to be distinctive.

Relative grounds for refusal of registration can also form the basis for an invalidation action, unless the owner of the earlier trademark or earlier right has consented to the registration. The effect of a successful action, which declares a registration invalid, is that the registration is deemed never to have existed.

Because of transitional provisions that provide that the validity of registrations dated prior to

July 1 1996 must be determined under the Trademarks Act 1963, it is necessary in such cases to consider the grounds which exist under both the 1963 and the 1996 legislation.

The 1996 act allows for invalidation on the basis of unregistered earlier rights. This requires the owner of an earlier right to have enforceable IP rights such as copyright, registered designs or grounds to sustain an action for passing off. The definition of 'earlier trademark' includes well-known trademarks under Article 6*bis* of the Paris Convention. Therefore, such a trademark, although unregistered, may constitute grounds on which to seek invalidation of a later trademark.

An application for invalidation under the 1996 act can be made by any person, not necessarily an aggrieved person, and can be made to the High Court or the Patents Office.

Where the grounds for invalidation exist in respect of only some of the goods or services for which the trademark is registered, the trademark will be declared invalid as regards those goods or services only. Where the registration of a trademark is declared invalid to any extent, the registration shall, to that extent, be deemed never to have been made, with the exception of transactions past and closed.

5. Enforcement

The enforcement of trademark rights is the sole responsibility of the owner of the mark and/or its representatives.

Registered trademarks: The protection afforded under the Trademarks Act includes protection against infringing acts. The grounds for infringement correspond to those for determining whether earlier trademark rights exist (relative grounds for refusal). However, the

infringement provisions require not just a comparison of the respective marks and the goods or services, but also an examination of the nature of the offending act. Infringement requires use of a sign in the course of trade. This extends infringement to use of an identical or similar sign where the registered trademark has a reputation in Ireland and the use of the sign is without due cause and takes unfair advantage of, or is detrimental to, the distinctive character or the reputation of the registered trademark. It also includes a non-exhaustive list of examples of what constitutes 'use' of a sign – namely:

- affixing it to goods or their packaging;
- offering or exposing goods for sale, putting them on the market or stocking them for such purposes under the sign, or offering or supplying services under the sign;
- importing or exporting goods under the sign; and
- using the sign on business papers or in advertising.

The act also provides for contributory infringement where someone applies a registered trademark to certain materials, if that person knew or had reason to believe that this was unauthorized. It also makes it permissible to engage in comparative advertising by using another's registered trademark for the purpose of identifying the goods or services of the owner of the registered trademark or its licensee. However, such use must accord with honest practices in industrial or commercial matters, and should not without due cause take unfair advantage of, or be detrimental to, the distinctive character or reputation of the trademark.

It is not possible to bring infringement proceedings prior to the date of publication of registration, but as the effective date of registration is the application date, damages for infringement can be claimed from this date.

The owner of an Irish trademark registration can sue on the basis of infringement only within

Ireland. However, the act prohibits infringement by way of export under the offending trademark.

The act provides for both civil and criminal remedies for infringement of a trademark. Civil remedies include:

- damages;
- injunctions;
- an account of the defendant's profits;
- an order for erasure, removal or obliteration of any infringing sign;
- an order for destruction of the goods, if erasure is not possible; and
- an order for surrender of the infringing goods (which is subject to a six-year time limit).

The penalties for committing acts that amount to offences under the act are:

- on summary conviction – up to six months' imprisonment or a fine of up to €1,269.74, or both; and
- on indictment – up to five years' imprisonment or a fine of up to €126,973.80, or both.

The act also provides for certain forms of relief in the event of groundless threats of infringement where a defendant is given relief if the alleged infringement cannot be proven by the plaintiff.

The following acts do not constitute trademark infringement:

- use of another's registered mark where there is concurrent registration by the defendant and use of the mark on goods or services embraced by the defendant's registration;
- use of a person's name or address;
- use of purely descriptive indications (eg, quantity, quality, geographical origin);
- use of a registered trademark to indicate the purpose of a product or service, particularly as accessories or spare parts;
- use of a prior or earlier unregistered mark which has been in continuous use since before the first use or registration of the

registered mark, where the earlier mark has a goodwill protected by the law of passing off; and

- where trademark rights have been exhausted, use of the registered mark with the consent of the trademark owner on goods in another country in the European Union which are resold from that country to Ireland. The owner of the registered trademark in Ireland cannot invoke infringement rights to prevent the parallel imports.

However, the act states that acquiescence occurs where the owner of an earlier trademark or right tolerates the use of a later registered trademark in Ireland, while aware of such use, for a continuous period of five years. The effect of acquiescence is that it is no longer possible to seek invalidation of the later registration or to oppose continued use of the later mark for those goods or services in relation to which there has been acquiescence. Essentially, when acquiescence is invoked, an enforced coexistence of trademarks takes place. A claim of acquiescence will not be upheld if it can be shown that the registration of the later trademark was applied for in bad faith.

Unregistered marks: Unregistered rights are protected by the common law tort of passing off (as discussed above). Here, the owner of the unregistered right must show:

- reputation or goodwill in the mark;
- a likelihood of confusion between the marks; and
- damage or a likelihood of damage arising out of such confusion.

In passing off cases, the plaintiff usually seeks an interlocutory injunction against the defendant as a temporary measure in a bid to prevent the defendant from causing further damage to its reputation. However, damages and an account of profits are also available in such actions. In

passing off actions, time is usually of the essence, and as such, any delay in bringing an action against an offender is likely to be viewed harshly by the courts.

6. Ownership changes – legalization requirements

Provision is made in the act for recordation in the Trademark Register of certain interests that are termed ‘registrable transactions’, such as assignments, licences, grants of security, assents and court orders, or an order of any other competent authority transferring a registered trademark or any right in or under it. Until an application has been made to record a registrable transaction, it is ineffective against a person that acquires a competing interest in ignorance of the transaction.

The act provides penalties for failure to record registrable transactions with the Patents Office. These do not arise until six months have elapsed from the transaction date. Even then, the courts may excuse a failure to record if they are satisfied that it was not practical to make an application earlier and steps were taken as soon as practically possible. The penalties are a denial of any entitlement to damages or an account of profits for infringement between the date of the transaction and the application for recordation.

The formalities for recordation of a registrable transaction are set out in the Trademark Rules 1996, and require the application to be accompanied by a certified copy of the instrument or document upon which the claim is based. The Patents Office does not require the documents submitted to be legalized or notarized, but does require any document submitted in a foreign language to be translated into English.

7. Areas of overlap with related rights

There is a degree of overlap between trademark law and copyright law, as well as with the law of industrial designs. In many instances, copyright protection will be claimed for device marks that are original. In addition, since shapes have become registrable under the 1996 act, there is a degree of overlap between the protection of shapes under trademark legislation and industrial design legislation.

8. Online issues

Any online use of registered or unregistered trademarks will enjoy the relevant protection, as discussed above, if the infringing activities take place within Ireland. However, this matter has not yet come before the Irish courts and there is thus very little jurisprudence on the issue.

The country-code top-level domain for Ireland is the '.ie' namespace, which is managed by the IE Domain Registry (IEDR). Although new domain name requests are processed and registered on a first come, first served basis, the IEDR operates a regulated system. All applicants for a '.ie' domain name that are not situated in Ireland must demonstrate a real and substantive connection with Ireland (with the exception of those applying on the basis of a Community trademark registration). The requirements to prove such connection vary according to the category of registrant.

The IE Dispute Resolution Policy was launched on July 31 2003 and follows the Uniform Dispute Resolution Policy model. Complaints are filed with and administered by the World Intellectual Property Organization Arbitration and Mediation Centre.