

Ireland

Contributing firm
Tomkins & Co

Authors
Simon Gray
Managing partner

Judy McCullagh
Attorney



1. Legal framework

Trademarks in Ireland are governed by the Trademarks Act 1996 and the Trademarks Rules 1996. The act modernised Irish trademark legislation, bringing Ireland into line with its obligations under EU law. The provisions of the act meet the requirements of the EU First Trademarks Directive (89/104/EEC).

Ireland is also a party to:

- the Madrid Protocol;
- the Paris Convention; and
- the Nice Agreement concerning International Classifications.

2. Unregistered rights

Ireland is a common law jurisdiction and the proprietor of an unregistered mark has rights under this system, including the right to take action in court under the common law tort of passing off. The tort of passing off protects the goodwill of a trader from a misrepresentation that causes damage to goodwill.

The leading case on the requirements for passing off is *Reckitt & Colman Products Ltd v Borden Inc* (1990) 1 ALL ER 873). Although this is an English case, the principles that it lays down are followed by the Irish courts. The requirements are as follows:

- The proprietor's goods or services have acquired a particular goodwill or reputation among the public;
- Persons wishing to buy the proprietor's goods or services are likely to be misled into buying the goods or services of the defendant; and
- The proprietor has suffered or is likely to suffer damage.

The onus is on the plaintiff to establish that goodwill exists. 'Goodwill' was described in *Inland Revenue Commissioners v Muller & Co Margarine Limited* ((1901) AC 217) as "the benefit and advantage of the good name, reputation, and connection of a business". Goodwill can exist even if the plaintiff does not have a current business (eg, where trading has recently ceased). In order to establish goodwill, the plaintiff must demonstrate a

trading presence in a locality or in the mind of the public. It is easier to establish goodwill if the business has a distinctive business image, even if the business has not been trading for a long period. Goodwill is often contrasted with reputation; it is well established in the Irish and English courts that there is a clear distinction between the two. It has also been established that reputation may exist in isolation from any other business activity, but goodwill may arise and subsist only through trading activities.

One of the key requirements for mounting a passing off action is that the defendant makes a misrepresentation. This is a false representation by the defendant that the goods or services offered by it are the goods or services of another proprietor. It is not enough for the average consumer to be confused – deceit plays an important part in misrepresentation. Lastly, with regard to damage, the plaintiff must prove that its goodwill and business suffered or is likely to suffer damage as a result of the defendant's activities.

3. Registered rights

Under Section 6(1) of the Trademarks Act 1996, a 'trademark' is "any sign capable of being represented graphically which is capable of distinguishing goods or services of one undertaking from those of other undertakings". Any person or legal entity may apply to register a trademark in Ireland. Section 6(2) indicates the types of mark that can be protected and confirms that a trademark may consist of words (including personal names), designs, letters, numerals or the shape of the goods or their packaging.

Section 8 sets out the absolute grounds for refusal. A trademark shall not be registered if:

- it does not satisfy the requirements of Section 6(1), whereby registration will be refused if the trademark cannot be represented graphically and is incapable of distinguishing goods or services of one undertaking from another;
- it is devoid of any distinctive character;
- it consists exclusively of signs or indications that may serve, in trade, to designate the kind, quality, quantity,

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- intended purpose, value, geographical origin or time of production of goods or of rendering of services, or other characteristics of goods or services; or
 - it consists exclusively of signs or indications that have become customary in the current language or in the good-faith and established practices of the trade.

It is possible to overcome an objection on the second, third and fourth grounds above if it can be shown that before the date of application for registration, the mark had, in fact, acquired a distinctive character as a result of the use made of it.

Under Section 8 a mark shall not be registered also on the basis of the following grounds:

- It consists exclusively of a shape that:
 - results from the nature of the goods themselves;
 - is necessary to obtain a technical result; or
 - gives substantial value to the goods;
- It is contrary to public policy or to accepted principles of morality, or is of such a nature as to deceive the public as to the nature, quality or geographical origin of the goods or service;
- The use of the trademark is prohibited in the state by any enactment or rule of law or by any provision of Community law, or the application for registration is made in bad faith by the applicant; or
- The trademark consists of any state emblem of Ireland, including the harp or the shamrock, unless consent has been given by the relevant government minister.

It is not necessary for a representative, appointed by the applicant, to file a power of attorney form at the Irish Patents Office.

- a representation of the mark;
- a list of the goods and services for which registration is sought; and
- the legal status of the company involved.

In addition, the official filing fee must be paid.

If the application meets all requirements, a filing receipt with an official filing number will be issued by the Patents Office, usually within three weeks of filing. After this period, and usually within three to six months of filing, the application will be examined on both absolute (Section 8) and relative (Section 10) grounds. As discussed in section 3 above, Section 8 of the Trademarks Act covers the absolute grounds for refusal and an objection under this section will usually arise if a trademark is descriptive of the goods and/or services for which protection is sought, and/or if it is devoid of any distinctive character.

In addition, the Patents Office undertakes a search of both the Irish and Community Registers, including the International Register, for marks designating Ireland or the European Union, to determine whether any earlier, identical or confusingly similar trademark applications or registrations exist. If they do, the Patents Office will raise an objection on relative grounds under Section 10. Objections under Section 10 can be overcome by various means, including arguing that the marks and/or the goods or services of interest are sufficiently different, or by obtaining consent from the proprietor of the earlier cited marks.

If the Patents Office raises an objection under Sections 8 and/or 10, the applicant will be informed of such objections in an initial examination report. The applicant will be granted an initial three-month period in which to file a response. Following a recent change in practice, the Patents Office now grants only one three-month extension of time in which to respond to the examination report. A second application for an extension of time will be considered only if it is accompanied by evidence supporting claims of unusual or exceptional circumstances. It is usually necessary to supply the office with evidence that genuine efforts are being made in order to progress the matter; evidence may consist of copies of correspondence with the client

4. Procedures

Examination

Once a trademark application is filed, it will be examined to establish whether it meets the standard requirements set down by the Patents Office. All applications must include:

- the name and address of the applicant;

and/or third parties, and details of negotiations or court proceedings.

Before any decision to refuse the mark becomes final, the applicant will have the right to attend an oral hearing before a hearing officer of the Patents Office.

Opposition

If no objections are raised or such objections are either successfully overcome or waived by the Patents Office, the trademark application will proceed to publication. The application is published in the *Official Journal*. The date of publication sets the period, lasting three months minus one day, during which third parties may file a notice of opposition to the registration of the application.

If a notice of opposition is filed, the applicant must file a counterstatement within three months of receiving the notice of opposition. If no counterstatement is filed, the application shall be deemed to have been withdrawn. If a counterstatement is filed, the opponent is set an initial three-month period within which to file evidence, by way of statutory declaration, in support of the opposition. It will be possible to obtain a three-month extension of time in which to file such evidence. However, as discussed above, a second request for an extension of time will be accepted only if it can be shown that genuine efforts are being made in order to progress the matter. Once the opponent's evidence is filed, the applicant is granted similar timeframes in which to file evidence in support of the application. Once this has been filed, the opponent has the opportunity to file evidence in reply. It may be possible for either party to request leave to file further evidence, if required.

Once all of the written evidence is filed, and according to a change in practice that came into effect on October 4 2010 under the Trademarks (Amendment) Rules 2010, the parties may now decide to attend a hearing or to file further written submissions. Previously, the only option available was to attend a hearing. This means that the parties may now file legal arguments and statements of opinion that would usually be presented at a hearing, but which are not appropriate for inclusion in statutory declarations.

Registration

If no opposition is encountered or if any such opposition is successfully resolved, the trademark will then proceed to registration and details of the registration will be published in the *Official Journal*. Registration fees will become payable and once paid, the certificate of registration will be issued. A trademark registration is initially granted for a period of 10 years and can be renewed indefinitely every 10 years for further 10-year periods.

Removal from register

A trademark can be removed from the register if the applicant voluntarily surrenders the mark or if it is revoked or invalidated by third parties.

Surrender: Under Section 50 of the Trademarks Act 1996, the proprietor may surrender a registered trademark in respect of some or all of the goods and/or services for which it is registered. However, an application for surrender will be accepted by the Patents Office only if the proprietor certifies that it is not precluded by contract or other agreement or arrangement from surrendering the mark. Further, it must be shown that:

- any person having an interest in the mark has been notified of the proprietor's intention to surrender the mark at least three months before the application to surrender the mark is filed; and
- no such person has objected to the surrender.

Revocation: A mark can be revoked for the following reasons:

- Within the five-year period following the date of publication of registration, the trademark has not been put to genuine use in the state by, or with the consent of, the proprietor in relation to the goods and services for which it is registered, and there are no proper reasons for non-use;
- Such use has been suspended for an uninterrupted period of five years and there are no proper reasons for non-use;
- Owing to the acts or inactivity of the proprietor, the mark has become the common name in the trade for a product or service for which it is registered; or
- In consequence of the use made of it by, or with the consent of, the proprietor in

relation to goods or services for which it is registered, the mark is liable to mislead the public, particularly as to the nature, quality or geographical origin of the goods or services.

The Trademarks Act clearly states that “use of a trademark must include use in a form differing in elements which do not alter the distinctive character of the mark and use in the state includes affixing the trademark to goods or the packaging of goods in the state solely for export purposes”. A mark will not be revoked if, after the expiry of the five-year period and before the application for revocation is made, the proprietor commences or resumes use of the mark. Any such use during the three-month period prior to the filing of a revocation application will be disregarded unless it can be shown that preparations for the commencement or resumption began before the proprietor became aware that the application to revoke the registration might be made.

Invalidity: Invalidity or cancellation is covered by Section 52 of the Trademarks Act 1996, which states that a trademark may be declared invalid on the grounds that a mark was registered in breach of Section 8 or any other provisions referred to in that section. However, a trademark shall not be declared invalid if it can be shown that after registration, as a consequence of the use made of the mark, it has acquired a distinctive character in relation to the goods or services for which it is registered. In addition, a trademark may be declared invalid under any of the relative grounds set out in Section 10, unless the proprietor of the earlier trademark has consented to the registration.

Searches

The Patents Office offers searching facilities at a cost. However, the authors would advise employing the services of private, dedicated searchers if a full availability trademark search is required. Obtaining advice from local representatives in Ireland is recommended.

As mentioned above, the Patents Office undertakes searches of the Irish and Community Registers (including international marks designating these countries/regions)

in respect of all new Irish applications filed. The office will raise an objection on relative grounds if any pertinent marks are revealed during these searches. Please refer to the subsection above entitled “Examination”.

5. Enforcement

Types of action available

Both trademark infringement and passing off actions can be taken to the Irish courts. It is also possible for criminal proceedings to be initiated for counterfeiting cases, for example. However, criminal actions are few and far between in Ireland.

The requirements in relation to mounting a passing off action are discussed in section 2 above.

Trademark infringement is dealt with under the Trademarks Act 1996. The mark must be registered before the proprietor can mount an infringement action. However, as the effective date of registration is the application date, damages for infringement can be back-dated to the date of filing of the application.

Infringing acts include:

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

The following are some of the acts that do not constitute trademark infringement:

- use by a person of his or her own name or address;
- use of indications concerning, for example, the kind, quality or quantity of the goods and/or services (ie, purely descriptive indications); and
- use of a registered trademark where it is necessary to indicate the purpose of a product or service, in particular as accessories or spare parts.

Remedies

Civil remedies available include:

- damages;
- account of profits;
- injunctions;
- erasure of the offending sign;
- an order for delivery up of the infringing goods, material or articles; and
- an order for disposal of infringing goods, material or articles.

Interim injunctions can be sought, allowing the proprietor of the mark to seek relief before a decision at full trial.

Criminal remedies available include:

- 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.

Cases of infringement or passing off can be taken to the Irish courts. The Commercial Court opened in 2004 and deals with commercial cases in a timely manner. The Commercial Court is most frequently employed for IP cases owing to the speed at which decisions are issued.

6. Ownership changes and rights transfers

Under Sections 28 to 35 of the Trademarks Act a number of transactions can be recorded on the Irish Trademarks Register. Registerable transactions include:

- assignments;
- licences; and
- the granting of a security interest.

It is advisable to record such transactions on the register as, if the transaction is not recorded, it shall be deemed ineffective against a person acquiring a conflicting interest in it or under it. In addition, it is advisable to record the transaction within six months of its effective date. If it is not recorded within this timeframe, the new proprietor or licensee shall not be entitled to damages or an account of profits in respect of an infringement action

occurring after the date of the transaction and before the application to record the transaction on the register is lodged.

The most common transactions to be recorded on the register are assignments, licences, changes of name, changes of address and security interests. In order to record any such transactions, other than a simple address change, it is necessary to file at least certified copies of the relevant documents as evidence of the particular change/transaction. Also, if these documents are not in English, a certified English translation will also be required. Official fees are payable to the Patents Office for each recordal filed.

7. Related rights

Although the Trademarks Act 1996 offers the principal protection to a trademark proprietor, other forms of intellectual property can also be used to protect the overall look of a mark or an element of the mark. There is, therefore, some overlap between trademarks and other IP rights, such as copyright and designs. Both copyright and designs can protect a trademark that incorporates a logo or device element. From a copyright perspective, a trademark proprietor can claim copyright in the artwork of a logo, for example. Copyright legislation is set out in the Copyright and Related Rights Act 2000. Design rights come into play in relation to three-dimensional marks. Designs are covered under the Industrial Designs Act 2001.

8. Online issues

The Trademarks Act 1996 does not specifically state that trademark owners can rely on their trademark rights to stop the unauthorised use of a domain name incorporating the trademark. However, as in other jurisdictions, if a third party registers and uses a domain name that incorporates a trademark or a word that is confusingly similar to a registered trademark, the trademark proprietor can file a formal complaint with Ireland's Domain Registry (IEDR) (www.domainregistry.ie).

The complainant must be able to show that it has a right to the domain and the incumbent

registrant does not.

A complaint may be filed on the following grounds:

- The disputed domain name is identical or misleadingly similar to a protected identifier in which the complainant has rights;
- The registrant has no rights in law or legitimate interests in respect of the disputed domain name; and
- The disputed domain name has been registered or is being used in bad faith.

If a complaint is lodged, the complainant must show that it has a right to the domain (ie, through trademark ownership). Complaints are not decided on by the IEDR, but by an independent and impartial panel of one or three experts appointed by the World Intellectual Property Organisation.

Unregistered rights Protection for unregistered rights?	
Specific/increased protection for well-known marks?	
Examination/registration Representative requires a power of attorney when filing? Legalised/notarised?	
Examination for relative grounds for refusal based on earlier rights?	
Registrable unconventional marks	
Opposition Opposition procedure available? Term from publication?	3 months less one day
Removal from register Can a registration be removed for non-use? Term and start date?	Continuous period of 5 years from date of publication
Are proceedings available to remove a mark that has become generic?	
Are proceedings available to remove a mark that was incorrectly registered?	
Enforcement Specialist IP/trademark court?	
Punitive damages available?	
Interim injunctions available? Time limit?	No set time limits, but delay will lessen chances of success
Ownership changes Is registration mandatory for assignment/licensing documents?	But recommended
Online issues National anti-cybersquatting provisions?	
National alternative dispute resolution policy for local ccTLD available?	