



**EIGHT DECADES AFTER
ARTHUR BELLAMY TOMKINS GAINED
THE PRESTIGIOUS CIPA INTELLECTUAL
PROPERTY QUALIFICATIONS,
WE'RE STILL PIONEERING THE FIELD.**

When Arthur Bellamy Tomkins was elected a Fellow of the UK Chartered Institute of Patent Agents in 1928, he saw something that others couldn't see. Just six years after Ireland emerged as an independent nation, Tomkins saw that Ireland would one day become an economic powerhouse. He knew that when that day came, Irish business would need to invest in IP protection – and he wanted to be there when that happened. True to our founder's vision, Tomkins & Co. have been shepherding and influencing the shape of Irish IP legislation for 80 years.

As the proud inheritors of the law firm that Mr. Tomkins pioneered, we are committed to relentlessly ensuring maximum protection for your ideas, brands and products. Acting on your behalf, we enforce your IP rights and pursue patent and trademark applications in Ireland, Europe and across the globe. When you need IP protection, you can be safe in the knowledge that you are following in the footsteps of generations of blue chip companies with whom we continue to enjoy a mutually beneficial relationship. Whatever your business or industry, and whether you're an Irish SME or a multinational, our professionalism, our expertise and our legacy will guide you smoothly through the Intellectual Property process.

TO LEARN MORE ABOUT US, PLEASE VISIT WWW.TOMKINS.COM,
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TOMKINS. SETTING IRELAND'S IP STANDARD FOR 80 YEARS. TOMKINS

Ireland

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1. Legal framework

Trademarks in Ireland are governed by the Trademarks Act 1996 and the Trademarks Rules 1996. The act modernized 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 marks

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, it is directly applicable to Ireland. 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 likely to suffer damage.

Although this case is widely accepted, it was extended in the *ADVOCAAT Case* (1979 AC 731). The criteria in this case are:

- a misrepresentation;
- made by a trader in the course of trade;
- to prospective customers of its own or the ultimate consumers of goods or services supplied by it;
- which is calculated to injure the business or goodwill of another trader; and
- which causes actual damage to the business or goodwill of the trader by which the action is brought, or is likely to do so.

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, and 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 through trading activities.

One of the key foundations of passing off is 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. In addition, in its defence the defendant cannot claim that it did not wish to trade off the goodwill of the earlier proprietor. Finally, with regard to damage, the plaintiff must prove that its goodwill and business suffered substantial damage by the defendant's trading activities and misrepresentation.

3. Registered marks

Under Section 6 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 can apply to register a trademark in Ireland. Section 6(2) indicates the types of mark that can be protected. 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 not capable of distinguishing one undertaking from another;
- the trademark is devoid of distinctive character;
- the trademark consists exclusively of signs or indications which may serve to designate the kind, quality, quantity, intended purpose, value, geographical origin or time of production of goods or of rendering of services, or other characteristics of goods or services;
- a trademark consists exclusively of signs or indications which have become customary in the current language or in the *bona fide* and established practices of the trade;
- a sign consists exclusively of a shape, which:
 - results from the nature of the goods themselves;
 - is necessary to obtain a technical result; and
 - gives substantial value to the goods;
- the trademark 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 a state emblem of Ireland, including the harp or a shamrock, unless consent of the minister for enterprise and employment is obtained.

It is not necessary for a representative to require a power of attorney before filing. A power of attorney is normally required if, during proceedings, a party wishes to change its representation.

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 Irish Patents Office. It must include:

- the name and address of the applicant;
- 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 fee must be paid.

If the application meets all requirements, a filing receipt with an official filing number will be issued within three weeks. After this period, and within a further three to six months, the application will be examined. According to the Trademarks Act 1996, Sections 8 and 10 are relevant for examination purposes. On this basis, an application is examined under absolute grounds for refusal and relative grounds for refusal. Section 8 covers absolute grounds for refusal (listed in section 3 above). A Section 8 objection will normally be raised if a trademark is descriptive or if it consists of a slogan that describes the goods or services. A shape objection will be raised under Section 8(2) if the shape proposed for registration is derived from the nature of the goods.

In addition, objections may be raised on relative grounds for refusal under Section 10. At the examination stage, the principal relative objections likely to arise under Section 10 will be on the basis of earlier registered trademarks (whether Irish, international or Community trademarks), or on the basis of conflicting earlier applications. If the proprietor of an earlier trademark consents, a relative objection will automatically be withdrawn.

If the Irish Patents Office raises a Section 8 or 10 objection, the applicant will be informed of the reasons and will be afforded an opportunity to respond to the official objection. The Patents Office normally allows three months within which to respond to an objection, and three-month extensions will normally be granted on request. Before any decision to refuse the mark becomes final, the applicant will have the right to attend an oral hearing before an official of the Patents Office.

Opposition

If no objection is raised or the objection is overcome, the mark will proceed to publication in the *Official Journal*. There is an opposition period of three months minus one day within which third parties can oppose the application. Any person that objects to the application must file a notice of opposition, together with payment of the prescribed fee. Ireland does not have a cooling-off period, although this is currently under consideration. However, it is possible to obtain extensions of up to 12 months in which to file evidence. Each party can file evidence. Once all evidence is filed, a hearing officer decides whether the mark should be registered.

Registration

Assuming that no opposition is encountered or any opposition is resolved, the mark will then be published for registration purposes. The Patents Office will invite the representative to pay the prescribed registration fee and the certificate of registration will be issued. A trademark registration can last indefinitely, provided that the registration is renewed every 10 years.

Removal from register

A trademark can be removed from the register by surrendering, revoking or invalidating a mark.

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 for which it is registered. However, an application for surrender can be made only where no other party has an interest in the mark, unless the other party has been provided with prior notification. In order to surrender or partially surrender a mark, an application must be made to the Patents Office clearly stating whether full or partial surrender is required and whether a third party has an interest in the mark.

Revocation: A mark can be revoked from the register on any of the following grounds:

- Within a 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 is no proper reason for non-use;

- Such use has been suspended for an uninterrupted period of five years and there is no proper reason for non-use;
- Due to the acts or inactivity of the proprietor, the mark has become a 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 a 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 for a three-month period prior to the filing of a revocation application. The five-year period of non-use runs from completion of the registration procedure. There are a number of decided cases in Ireland and the European Union with regard to non-use of a mark, including the *Ansul Case*, where the trademark was protected for fire extinguishers, but use on other related products and services (including components) was held to be use.

A revocation action can be defended where it is shown that there are proper reasons for non-use, including external restrictions or government restrictions. However, minor or normal business interruptions will not be seen as proper reasons. A trademark can be partially revoked (ie, revoked for some of the goods or services only).

Invalidity: Invalidity or cancellation is covered by Section 52 of the Trademarks Act 1996, which clearly 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, after registration, 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. An application for a declaration of invalidity can be made to the Patents Office setting out the grounds and reasons for the invalidity action.

Searches

The Patents Office does not carry out searches at a cost. The only searches that will be conducted are at examination stage. If a person wishes to carry out a search in Ireland, he or she is encouraged to seek advice from their representatives in Ireland.

5. Enforcement

An action can be taken in the courts under the tort of passing off. However, the owner of a registered mark can also bring an infringement action. Infringement is dealt with under the Trademark Act 1996. Under Section 18 of the act, an action for infringement can be taken where a registered trademark is being infringed. A trademark must be registered before the proprietor takes an action for infringement. An action can be taken on the basis of the use of an identical mark for identical goods, and also for similar marks and dissimilar goods and services. The infringing sign must be used in the course of trade. The act sets down examples of what constitutes use of a sign, including:

- affixing it to goods or the packaging;
- offering or exposing goods for sale, putting them on the market or stocking them for those 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.

In a decision concerning the mark CHEETAH, the court found that use on invoices and delivery notes constituted infringement. Infringement actions are taken under Section 10 grounds.

Remedies

Civil remedies: Available civil remedies include:

- damages;
- accounts 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 the hearing of the full trial of the action by the courts.

Criminal remedies: Available criminal remedies include:

- fraudulent use of a trademark, meaning that the person in question has no entitlement to use of the sign;
- falsification of the register, meaning that it is a criminal offence to make false entry onto the Trademark Register;
- falsely representing a trademark as being registered (eg, using the word 'registered' or the ®symbol alongside a mark); and
- unauthorized use of Irish state emblems.

Cases of infringement or passing off can be taken in the Irish courts depending on the monetary value of the case involved. The Commercial Court opened in 2004 and deals with commercial cases in a timely manner, whereas before other courts it can take years for a passing off action or infringement action to be concluded.

6. Ownership changes and rights transfers

Under Sections 28 to 35 a number of transactions can be recorded on the Trademark Register. Section 29(2) lists registerable transactions to include:

- assignment;
- grant or assignment of a licence;
- grant of a security interest;
- making by a personal representative of vesting asset in relation to a registered trademark or any right in or under it; and
- an order of a court or other competent authority transferring a registered trademark or any right in or under it.

If an application is not made to the Patents Office in respect of the registrable transaction, the transaction shall be deemed ineffective as against a person acquiring a conflicting interest in it or under it. In addition, if a person that has an interest in the transaction does not make a recordal application to the Patents Office within six months of the effective date of the transaction, that person shall not be entitled to damages or an account of profits in respect of an infringement action. The most common transactions that are recorded on the Trademark Register are assignments, licences, changes of name, changes of address and security interests. In order to record any of these at the Patents Office, an original of the document or a certified copy thereof will be required. In addition, if the particular transaction document is not in English, a certified translation will be required. Fees are also payable to the Patents Office for each recordal made. An application can be made to the Patents Office by a person claiming an interest in the trademark or any person claiming to be affected by any such transaction that was entered on the Trademark Register.

Sections 32 to 35 set out regulations for licensees and licensors. A licence can be recorded on the register as a limited licence or an exclusive licence. A limited licence relates to some but not all of the goods or services covered by the trademark registration or may relate to a particular manner or a particular locality of the trademark. A licence shall not be effective unless it is signed by or on behalf of the grantor or by affixing the corporate seal of the grantor. A licence can be limited for a period of time (eg, three months, one year or five years). A licensee has the right to bring proceedings for infringement in the licensee's own name, unless the licence states otherwise. If the proprietor of the mark refuses to take any proceedings when called upon or fails to do so within two months of being called upon, the licensee may bring proceedings in its own name as if it were the proprietor. The proprietor must be joined as the plaintiff or as the defendant, but is not liable for any costs in such an action. Each licence is subject to the terms agreed by the proprietor and the licensee. Therefore, sub-licences are possible.

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 a trademark or an element of the mark. Therefore, there is overlap between trademarks and other IP rights, such as copyright and designs. Both copyright and designs can protect a trademark which incorporates a logo or device. From a copyright perspective, a trademark proprietor can claim copyright on the artwork of a logo. Copyright legislation is set out in the Copyright and Related Rights Act 2000. With regard to designs, this tends to be applied to unconventional trademarks (ie, three-dimensional marks or the shape of packaging). Designs are covered under the Industrial Designs Act 2001.

8. Online issues

The Trademarks Act 1996 does not state that trademark owners are protected from the unauthorized use of domain names. However, if a person uses a sign identical or similar to a trademark on a website, an action for infringement may be possible. As in other jurisdictions, the aggrieved trademark proprietor can file a formal complaint to the national domain registry, the Irish Domain Name Registry (www.domainregistry.ie). A complaint can be filed on the following grounds:

- A 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 a domain name; or
- A 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). Decisions are issued not by the Irish Domain Name Registry, but under the ICANN Uniform Domain Name Dispute Resolution. Although this course of action can be a cost-effective way to resolve a dispute, it does not prevent the parties from taking the matter to the courts.

TOMKINS

Unregistered rights	
Protection for unregistered rights?	✓
Specific/increased protection for well-known marks?	✓
Examination/registration	
Representative requires a power of attorney when filing? Legalized/notarized?	✗ / ✗
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 chance of success ✓
Ownership changes	
Is registration mandatory for assignment/licensing documents?	but recommended ✗ / ✗
Online issues	
National anti-cybersquatting provisions?	✗
National alternative dispute resolution policy (DRP) for local ccTLD available?	✗