

General Information Concerning

THE REGISTRATION OF TRADE MARKS FOR GOODS & SERVICES



OIFIG NA bPAITINNÍ
IRISH PATENTS OFFICE

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Introduction

This booklet summarises certain important provisions and requirements of the Trade Marks Act, 1996, and the Trade Marks Rules, 1996, in relation to the registration of Trade Marks.

It is intended as a general guide to the system of registration of trade marks and consequently does not analyse every aspect of the process of registering a Trade Mark or address particular legal provisions, which may affect a particular application. As with all guides it, of necessity, includes a number of generalisations and simplifications and should not be regarded as a legal interpretation of the law relating to Trade Marks or as a substitute for the legislation itself.

Copies of the Trade Marks Act and the Rules may be purchased by mail order from Government Publications Postal Trade Section, 4-5 Harcourt Road, Dublin 2, or may be accessed via the Patents Office website www.patentsoffice.ie.

The Patents Office cannot undertake to prepare an application to register a Trade Mark on behalf of the applicant. Furthermore, the Controller does not provide legal advice or opinions on questions of infringement or similar matters connected with trade mark law.

1. What is a Trade Mark?

Section 6 of the Trade Marks Act, 1996 defines a Trade Mark 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 Trade Mark may consist, of words, including personal names, designs, letters, numerals or the shape of goods or their packaging.

The Act requires that a Trade Mark must be represented “graphically”. To meet this requirement the following tests should be satisfied: -

- (a) The representation should be defined with sufficient precision to allow infringement to be assessed;
- (b) The representation should be capable of standing in place of the Trade Mark, without the need for supporting samples, etc.;
- (c) It should be reasonably practicable for persons inspecting the register, or reading the Patents Office Journal, to understand from the graphical representation what the Trade Mark is.

The following are some examples of familiar trade marks:

Aer Lingus 



KERRYGOLD

GLANBIA

SIÚCRA

2. The benefits of trade mark registration

A trade mark is a form of 'industrial property', which can be bought and sold, licensed or used by the owner either in whole or in part. A trade mark can be the most valuable asset of a business, consequently adequate protection of this asset in the relevant market(s) is crucial.

- Trade mark registration grants a statutory right, subject to certain conditions, to prevent others from using the trade mark without the proprietor's permission - i.e. to prevent infringement.
- Registration confers an exclusive right to authorise others by means of licensing to use the trade mark for the goods and /or services for which the trade mark is registered.
- Although registration is not obligatory, registration makes it easier to prevent others from benefiting from the reputation established by the use of a trade mark by providing the proprietor of the registered trade mark with access to infringement proceedings.
- Trade marks make it possible for consumers to differentiate between the products/ services of one undertaking from similar products/services of other undertakings.
- They can be an extremely valuable business asset.
- They can assist in building brand image and reputation and can be a superb marketing tool.
- They may be a source of investment and financing.

3. Is registration of a trade mark compulsory?

While it is not compulsory, it is highly advisable as registration provides stronger protection, particularly in the event of a conflict with an identical or confusingly similar trade mark.

If a trademark has not been registered, it is possible to take action under Common Law for misrepresentation and damage to the business reputation or goodwill which attaches to unregistered trade marks through the tort of "passing off". Passing off

may provide a remedy in a scenario where a business has been trading under an unregistered trade mark for many years, and a rival business starts using the same or a similar mark.

If a trademark has been registered, then it is much easier and generally less expensive for the trademark owner to demonstrate its trademark rights and to enforce these rights through an infringement action before the court. Unauthorised use of a registered trade mark need not be intentional in order for infringement to occur, although damages in an infringement lawsuit will generally be greater if there was an intention to deceive.

It is the responsibility of the trade mark owner to protect their trade mark. If a trade mark is being infringed, legal advice should be sought as soon as possible, as it may be necessary to apply to the courts to protect the mark against infringement. A range of remedies are possible, such as the award of damages, injunctions, or orders for seizure of goods. A trade mark agent or solicitor specializing in intellectual property law will be able to advise as to the most appropriate course of action to follow.

4. Grounds for refusal of registration of a trade mark

Not all trade marks are registrable. Sections 8 and 9 of the Trade Marks Act 1996 deal with absolute grounds for refusal of registration and section 10 deals with relative grounds. Essentially registration will be refused for a trade mark which:

- is not capable of being represented graphically or not capable of distinguishing good or services of one business from those of other businesses,
- does not have any distinctive character,
- consists exclusively of signs or indications that designate essential characteristics of goods or services (e.g. their quality, intended purpose, geographical origin etc.),
- consists exclusively of signs or indications which are customary in the language in the trade,
- consists exclusively of the shape, arising from the goods themselves, or which is necessary to obtain a technical result, or gives substantial value to the goods,

- is contrary to public policy or principles of morality,
- is likely to deceive the public, e.g. as to the nature, quality, or geographical origin of the goods or services,
- is applied for in bad faith,
- is identical with or similar to a trade mark that is already on the Register in respect of identical or similar goods.

Applications may be refused when the trade mark conflicts with prior trade mark rights. Having two identical (or very similar) trade marks for the same type of product could cause confusion among consumers. If the trade mark is considered to be identical or confusingly similar to an existing one for identical or similar products, it will be refused. Use of generic or descriptive terms, marks that are misleading or considered to be contrary to public order or morality will be likely to be refused.

Generic terms. For example, an application to register the trade mark “CHAIR” to sell chairs would be refused since “chair” is the generic term for the product as would “Milk” to sell milk products.

Descriptive terms. These are words that are usually used in trade to describe the product in question. For example, the mark SWEET is likely to be rejected for marketing chocolates as being descriptive. In fact, it would be considered unfair to give any single chocolate manufacturer exclusivity over the word “sweet” for marketing its products. Similarly, qualitative or laudatory terms such as “SOUR”, “SALTY”, “BEST”, “CLASSIC” or “INNOVATIVE” are likely to give rise to similar objections unless they are part of an otherwise distinctive mark.

Deceptive trade marks. These are trade marks that are likely to deceive or mislead consumers as to the nature, quality or geographical origin of the product. For example, “ALLWOOL” for cotton garments or AQUACLEAN for dry cleaning are likely to be objected to as they could be considered misleading for consumers.

Marks considered to be contrary to public order or morality. In general words and illustrations that are considered to violate commonly accepted norms of morality and religion are not allowed to be registered as trade marks.

5. Use of State Emblems

Any person who wishes to obtain registration of a trade mark containing a State emblem (harp, shamrock) or to use a State emblem in connection with any business must first obtain consent from the Minister. The Minister is also empowered to take lawful steps against any person outside the State in the event of misuse of trade marks that would falsely indicate that the goods on which the trade mark is used were of Irish origin.

Application for the consent of the Minister may be made in writing or by e-mail to: The Intellectual Property Unit of the Department of Jobs, Enterprise and Innovation, Government Buildings, Patents Office, Hebron Road, Kilkenny.

Telephone Number: 056 7720139 Fax: 056 7720100 Email: ipu@djei.ie

There is no formal application form.

NOTE: Consent for use of marks containing the Harp is confined to Government Departments and Government Agencies. Further information is available from the Department of Jobs, Enterprise and Innovation's website: <https://www.djei.ie/en/What-We-Do/Innovation-Research-Development/Intellectual-Property/Trade-Marks/State-Emblems/>

Article 6ter of the Paris Convention for the protection of Industrial Property, protects armorial bearings, flags, other emblems, abbreviations and names of international intergovernmental organisations, of States party to the Paris Convention. Flags, armorial bearings, official hallmarks and emblems of states and international organisations (which have been communicated to the International Bureau of WIPO) are usually excluded from registration. Please see paragraph 7 for details on how to identify these protected emblems etc.

6. Classification of goods and services

An application for registration of a trade mark must include a list of all the goods and or services for which the mark is to be used. The Nice Classification is an internationally recognised classification system of goods and services in respect of trade marks. Ireland applies the classification system to the

examination and registration of trade mark applications. Generally this classification system is revised every five years. The 10th Edition came into force on 1 January 2011.

Under the Nice Classification, goods and services are categorised in classes each of which relate to a particular field or fields of commercial activity, for example, food and drink, pharmaceuticals, financial services, etc. When a trade mark is registered, it may be registered in respect of particular product(s) or service(s) within a class or, indeed, for goods and services in several different classes. The registration of a mark in respect of a specific product or service or class of products/services serves to define the extent of the protection afforded by that registration.

The Nice Classification consists of 34 classes of goods (classes 1 - 34 inclusive) and 11 classes of services (35 - 45 inclusive). A list of the classes and the heading of the classes is available at Annex 1.

TMclass is an on-line tool that helps you to search for and classify Goods and Services (terms) needed to apply for trade mark protection. Further information is available in the Classification of Goods and Services section of the Patents Office website www.patentsoffice.ie

It is important to ensure that when an application is made that all the goods and/or services for which the mark will be used are listed on the application form. Additional goods or services cannot be added to the application after it has been filed at the Patents Office.

Range of Goods / Additional Classes

If a company is producing knives and forks, then its trade mark application should be made for cutlery in Class 8.

If however, the company wished to market kitchen utensils (such as containers, pots or pans) using the same trade mark, it should apply to register its mark for the corresponding goods which are proper to Class 21.

A trade mark application may consist of multiple classes of goods and/or services.

7. Trade Mark Searches

Before filing an application to register a trade mark, a search should be carried out to ascertain whether or not an identical or similar mark has already been registered or if there is a pending application for registration of a similar or identical trade mark. This can be done by the following means:

- Via the Patents Office website: www.patentsoffice.ie
- Via the EUIPO website: www.euipo.europa.eu
- In person by calling to the Patents Office Information Centre in Kilkenny
- By written request accompanied by the prescribed fee (€35), in which case the Patents Office will undertake a search on your behalf.
- By consulting a registered trade mark agent.

The following databases are available for searching:

- The **Irish Patents Office Trade Mark Register**/database, which contains marks registered and those applications currently pending registration in Ireland.
- **TMview** is an online consultation tool allowing any internet user to search, free of charge, the trade marks of all participating Trade Mark Offices. It is easy-to-use, and gives access to trade mark applications and registrations of the participating official trade mark offices in a single place.
- The **European Union Trade Mark database**, which contains all European Union Trade Marks (EUTM) filed with the European Union Intellectual Property Office. EUTM's when registered, are protected in all 28 countries of the EU and have the same status as a trade mark registered in Ireland. A search may be carried out online at www.euipo.europa.eu or you can access this website via a link from the Patents Office website.
- **ROMARIN**. This database contains information regarding all international trade mark registrations under the Madrid Agreement concerning the international registration of marks and the Protocol relating to that agreement that have been entered in the international register kept by the International Bureau of the World Intellectual Property Organisation (WIPO) www.wipo.org.
- **Madrid Express database**. This database includes all international trade mark registrations that are currently in force or have expired within the past six months. It also includes data relating to international applications and subsequent designations that have been received by the International Bureau of WIPO but have not yet been registered in the International Register. Both the ROMARIN database and the Madrid Express database can be accessed from the WIPO website at: www.wipo.org or you can access this website via a link from the Patents Office website.
- **Article 6ter** of the Paris Convention for the protection of Industrial Property, protects armorial bearings, flags, other emblems, abbreviations and names of international intergovernmental organisations, of States party to the Paris Convention. The WIPO database of 6ter emblems is available on the WIPO website at: www.wipo.org or you can access this website via a link from the Patents Office website.

8. Cross Class Searching

When an application is being searched to see if there are any earlier marks, which may conflict with the mark that is the subject of the application, it is necessary to identify which other classes of goods or services may contain similar goods or services to those for which registration is being sought. The cross class search list at Annex 2 sets out the other classes which you should consider searching, in addition to the class(es) for which protection is being sought.

9. Classification of Figurative Trade Marks

A trade mark, which contains a picture/logo/design or figurative element, may be referred to as a figurative trade mark. The Vienna Classification is the internationally agreed system of categorising the figurative elements of trade marks. Its essential purpose is to provide a means of searching figurative trade marks.

The Vienna Classification may be accessed on the WIPO website at: www.wipo.org or you can access this website via a link from the Patents Office website.

10. How to Apply for Registration

Any individual or company who uses or proposes to use a trade mark can apply to register that trade mark. The applicant must have a bona fide intention to use the trade mark if the mark is not already in use. An application for registration of a trade mark may be made either before the trade mark is used or when the trade mark is actually in use. Generally speaking an application to register a trade mark should be made as soon as possible so as to ensure that no one else applies to register the same or similar mark.

The application should be made on-line via the Patents Office website www.patentsoffice.ie. This e-filing facility introduces an easy to navigate application form and facilitates the electronic payment of the trade mark application fee by credit or debit card. Alternatively, the application should be made on the official application form (Form No. 1), which may be obtained from the Patents Office or accessed from the Office's website. A guide to completing the application form is also available on-line or on request from the Patents Office. The completed application form should then be lodged at the Patents Office.

A Guide to completing the application form is at Annex 3.

Fees for Application and Registration

The initial application fee is €70.00. If an application contains goods or services in more than one class then there is a fee of €70 for each additional classification. The application fee must be paid **within one month** of the date of filing the application. If this deadline is not met the application will be deemed to have been abandoned.

When the examination process is completed by the Office and the opposition period expires without notice of opposition being received or where notice of opposition is received and the opposition is unsuccessful, the registration fee of €177.00 will be requested by the Patents Office.

Renewal of trade mark registration

The duration of registration of a trade mark is 10 years from the date of registration. In order to keep a trade mark in force it must be renewed. Registration may be renewed for further period(s) of 10 years.

The renewal fees are €250.00 in respect of one class and €125.00 for each additional class of goods/services.

There are various other fees for matters such as requests to amend an application and requests to record transactions such as assignments and licenses etc.

A copy of the schedule of fees relating to trade marks is available online at www.patentsoffice.ie or on request from the Patents Office.

Payment

The following methods of payment will be accepted.

- **Online** Payment - this option should be used for **all fees relating to national Trade Marks**. You can pay by Debit or Credit card on www.patentsoffice.ie
- **Over the telephone** - our office is open Monday to Friday 9.30am to 5pm.
- **EFT** - please contact the Office at (056) 7720111 or e-mail patlib@patentsoffice.ie for more details.

Please quote your application or registration/grant number on all correspondence when making payment and please allow three working days for payments by EFT to ensure your payment reaches us within the prescribed time limits.

Collective Mark

A collective trade mark is a mark that distinguishes the goods or services of the members of the association, which is the proprietor of the mark, from those of other undertakings.

The following are examples of some collective trade marks from the trade mark register.

| | | |
|--|---|--|
|  |  |  |
| Registration Number 246727 | Registration Number 227352 | Registration Number 226730 |

Certification Trade Mark

A certification trade mark is a mark indicating that the goods or services in connection with which it is used are certified by the proprietor of the mark in respect of origin, material, mode of manufacture of goods, or performance of services, quality, accuracy or other characteristics. A certification trade mark shall not be registered if the proprietor carries on a business involving the supply of goods or services of the kind certified.

The following are examples of some certification trade marks from the trade mark register.

| | | |
|---|---|---|
|  |  |  |
| Registration Number 227988 | Registration Number 177258 | Registration Number 251637 |

A Series of Trade Marks

A series of trade marks is a number of marks (no more than six), which resemble each other as to their material particulars and differ only in respect of matter of a non-distinctive character which does not substantially affect the identity of the trade mark.
Here are examples of some series of trade marks from the trade mark register.

| Series of four marks | Series of three marks | Series of two marks |
|--|---|--|
|  |  |  |
| Registration Number 245342 | Registration Number 242449 | Registration Number 218613 |

Three-dimensional Trade Mark

A three-dimensional trade mark is a trade mark relating to the shape of the product or its packaging, for example: perfume bottles, liqueur bottles, various containers, etc.

The following are some examples of three-dimensional trade marks from the trade mark register.

| | | |
|--|---|--|
|  |  |  |
| Registration Number 205203 | Registration Number 216158 | Registration Number 206992 |

11. What are the requirements for a filing date?

When an application which contains the required minimum information is received at the Patents Office, a filing date and an application number is assigned and a filing receipt is issued. The following are the minimum requirements in order that the Patents Office may accord a filing date for an application to register a trade mark:

- A request to register the trade mark (completion of the prescribed application form meets this requirement),
- The name and address of the person requesting the registration,
- A representation of the trade mark,
- A statement or list of the goods and/or services for which registration of the mark is sought.

12. Claiming Priority

A right to priority for a period of 6 months may be claimed by an applicant who has already applied for registration of the same trade mark and the same goods and services (or some of the goods and services) in a country party to the Paris Convention. The filing date of the earlier application becomes the priority date of the new application. The rights of such applicants take precedence over other applications filed during the priority period in respect of the same trade mark.

Where an application to the Patents Office claims priority, the “priority document” i.e. a certified copy of the original application as filed in the original country must be received not later than 3 months from the date of application. This certified copy should be obtained from the office where this earlier application was made.

Similarly, applicants may claim priority in other states based on an earlier Irish application and in such cases applicants should obtain for this purpose a certified copy of the Irish trade mark application from the Patents Office on payment of the prescribed fee.

13. Amendment to an application after filing

Once the application has been filed, the application form may not be amended in any way that extends the scope of the application.

While it is possible to make some amendments, such as a correction of typographical errors, or amend name/address etc, the trade mark or the specification of goods and services may not be amended to broaden the scope of the application. It is permitted to remove goods/services, which the applicant no longer wishes to be part of the application.

14. The Application Procedure

An application which contains the required minimum information, is accorded a filing date and an application number, and a filing receipt is issued.

Examination:

The application is examined as to its registerability having regard to the provisions of the Trade Marks Act, 1996 and the Trade Marks Rules 1996. As part of the examination process we carry out a search of the National and the Community Trade Mark Databases to see if there is a similar or identical trade mark registered or pending with an earlier filing date.

If a trade mark examiner has a query or requests clarification or raises an objection on either absolute or relative grounds, an examination report will be issued to the applicant and the applicant will be given three months within which to respond.

Publication:

If the examiner accepts the application, the details of the mark will be advertised in the Patent Office Journal which is available on the Patents Office website. See paragraph 23 for further information regarding this official journal.

All applicants receive notification containing the acceptance number assigned to the application and the date of publication of the Journal in which the mark will be published.

Opposition:

Under the Trade Marks legislation, there is a three month window for the filing of observations or opposition to the registration of the mark.

Notice of opposition to the registration of a trade mark must be submitted in duplicate and accompanied by the prescribed fee within three months from the date of publication of the trade mark in the Patents Office Journal.

Registration:

Where there is no opposition, or the opposition is resolved or overcome, then the Office will request the registration fee which must be paid within two months from the date of request. On payment of the registration fee, a certificate of registration will be issued. The date of registration is deemed to be the date of filing of the application. If the registration fee is not paid within the prescribed time the trade mark application will be deemed to be withdrawn.

A flowchart summarising the application procedure is shown at Annex 3.

15. Duration of registration & renewal of registration

A trade mark is initially registered for ten years (from the date of filing of the application). Registration may be renewed indefinitely (for consecutive periods of 10 years) provided the renewal fees are paid in time.

If the registered trade mark has not been used (or use of the mark has been suspended) in relation to the goods or services for which it is registered in the five years since the trade mark was registered, or that there are no valid reasons as to why the trade mark has not been used, revocation proceedings may be instituted to revoke the trade mark registration in respect of all or some of the goods and/or services.

16. Assignment of a Trade Mark

A trade mark is an item of property and as such it can be sold or assigned by the proprietor. An application to register an assignment may be made under Section 29 of the Trade Marks Act 1996 and must be accompanied by the prescribed fee. The application form to register an assignment is available from the Patents Office website www.patentsoffice.ie

17. Licensing of Trade Marks

The proprietor of a Trade Mark may licence the use of his trade mark to others. Under Section 29, of the Trade Marks Act 1996, application may be made to the Controller to have the details of the licence entered in the Register. An application for the recordal of a licence must be accompanied by the prescribed fee. The application form to record a licence is available from the Patents Office website www.patentsoffice.ie

18. Alteration to Registered Trade Marks

Many trade marks, including some of the most famous, have slightly changed or evolved over the years in order to modernize the image of a company or adapt to new advertising media. The proprietor of a registered trade mark may apply to the Controller for leave to alter the trade mark in any manner which does not substantially affect its identity.

19. Protection Abroad

It should be noted that trade mark registration is territorial, i.e. a registration resulting from an application filed at the Patents Office is only valid in Ireland. If trade mark protection is required beyond the Irish jurisdiction, the following options are available:

- European Union Trade Mark registration
- International trade mark registration
- Trade mark registration in other countries

The European Union Trade Mark

European Union Intellectual Property Office
(Trade Marks and Designs)
Avenida de Europa, 4
E-03008 Alicante
SPAIN



The European Union Trade Mark (EUTM) represents a useful possibility for proprietors wishing to obtain trade mark protection in Europe.

The European Union Trade Mark system provides owners of trade marks with the option of applying to register their trade marks in all the countries of the EU using a single registration procedure with the **EUIPO (European Union Intellectual Property Office)** located in Alicante, Spain. The EUTM system is therefore said to be unitary in character, in that an EUTM registration is valid everywhere in the European Union, and gives proprietors **exclusive rights** enabling them to prohibit any third parties from using their sign in commercial or industrial activities. However, the EUTM system does not replace the national trade mark registration systems; the EUTM system and the national systems continue to operate in parallel to each other. Business enterprises are free to file national trade mark applications, an EUTM application, or both.

The European Union trade mark has been designed to complement the national systems of protection. If applicants or proprietors of a European Union trade mark already hold a prior identical national trade mark for identical goods and services they may claim the **seniority** of that mark. This allows them to preserve their prior rights even if they surrender their national trade mark or do not renew it.

All natural or legal persons who are domiciled or have their seat or who have a real and effective establishment within a country which is either a member of the European Union, party to the Paris Convention or signatory to the TRIPs Agreement may be proprietors of European Union trade marks.

What criteria must a European Union Trade Mark application meet in order to obtain a filing date

The filing date of a EUTM application is the date on which it was actually received at the EUIPO (or, in the case of a filing through the Irish Patents Office, the date of actual receipt at that Office), provided that the application contains, and is accompanied by the following:

- a request for the registration of a EUTM, that is to say the indication that a EUTM (and not another industrial property right) is sought;
- information identifying the applicant;
- a list of the goods or services in respect of which the registration is requested;
- a graphic representation of the trade mark;
- the payment of the basic application fee to EUIPO, within one month from the date of receipt of the application at the EUIPO or the Irish Patents Office.

How to apply

EUTM applications can be filed directly with the European Union Intellectual Property Office, (EUIPO). EUTM applications may be filed on-line using *e-filing*, by fax or by post. Applications sent by post should be addressed to:

European Union Intellectual Property Office,
Receiving Unit,
Avenida de Europa 4,
E-03008 Alicante,
Spain.

Fax: 00 34 965 131 344. If filing by fax, you do not have to send a confirmation copy. The facsimile signature on the fax is equivalent to an original signature.

EUIPO's website : <http://euipo.europa.eu> has detailed instructions on how to file online.

| | | |
|---|---|---|
|  |  |  |
| EUTM Registration No. 000601526 | EUTM Registration No. 009214529 | EUTM Registration No. 003388782 |

Registration

On receipt of the application, an examiner at the EUIPO will check that it includes all the items necessary and that the fees have been paid. If necessary, the applicant is requested to rectify any irregularities.

Search reports

Search reports on existing earlier trade marks are drawn up by the EUIPO and by the offices of some Member States of the European Union once a date of filing has been accorded. Mandatory time limits are set for the completion of all these reports, which are forwarded to the applicant by the EUIPO.

Absolute grounds for refusal

The application may be refused by the EUIPO on 'absolute' grounds, on the basis of the characteristics of the trade mark in respect of which the application for registration has been made (see paragraph 4 for more information on absolute grounds of refusal).

As for all EUIPO's decisions, an appeal may be made against the refusal of registration.

The application is published if there are no absolute grounds for refusal.

Within a period of three months following the publication of a European Union trade mark application, third parties may give notice of opposition to registration of the trade mark.

If no opposition is raised within a period of three months following publication, the trade mark is registered.

The Register of European Union Trade Marks is a database containing particulars of all trade marks registered by the EUIPO. The Register is constantly updated to take into account any change, such as a transfer of ownership, a change of name or address or the granting of a licence. The Register is available for inspection, subject to a written request to EUIPO and the payment of fees. Ready access to information on European Union trade mark applications and European Union trade marks, updated on a daily basis, is provided by **eSearch plus** which is a searchable database available via the EUIPO website.

The Cost of a European Union Trade Mark Registration

Each application for a European Union trade mark is subject to the payment of a basic fee which includes one class of goods and services. If an application contains goods or services in more than one class additional fees apply.

You do not have to pay the application fee when you apply. However, if you do not pay the fee within one month of the filing date of your application, you will lose your filing date and be given the date on which the fee was actually received. If you do not pay your fee within three months of the filing date, the application will be deemed never to have been made.

A European Union trade mark is registered for **ten years** from the date of filing of the application. Registration is renewable for further periods of ten years. The basic fees are as follows:

| <i>Application fees (e-filing)</i> | | | |
|---|-----------|--|-----------|
| EU – Individual Mark | Basic Fee | EU – Collective Mark or Certification mark | Basic Fee |
| First Class | €850 | First Class | €1500 |
| Second Class | €50 | Second Class | €50 |
| Third Class | €150 | Third Class | €150 |
| Fourth and all subsequent classes | €150 | Fourth and all subsequent classes | €150 |

| <i>Renewal fees (e-filing)</i> | | | |
|---------------------------------------|-----------|--|-----------|
| EUTM – Individual Mark | Basic Fee | EU – Collective Mark or Certification mark | Basic Fee |
| First Class | €850 | First Class | €1500 |
| Second Class | €50 | Second Class | €50 |
| Third Class | €150 | Third Class | €150 |
| Fourth and all subsequent classes | €150 | Fourth and all subsequent classes | €150 |

Payments

All fees must be paid straight to EUIPO. You can pay EUIPO:

- by cheque;
- straight from an EUIPO current account; or
- by bank transfer to either of the following accounts:

| | |
|-------------------------------------|-------------------------------------|
| Banco Bilbao Vizcaya Argentaria | La Caixa |
| 0182-5596-90-0092222222 | 2100-2353-01-0700000888 |
| Swift code: BBVAESMMXXX | Swift code: CAIXESBBXXX |
| IBAN: ES88 0182 5596 9000 9222 2222 | IBAN: ES03 2100 2353 0107 0000 0888 |

Some computer programmes do not accept the last three digits XXX of the Swift code. Should this be the case, users must indicate BBVAESMM or CAIXESBB.

Comprehensive details relating to the European Union Trade Mark Registration System, including application forms and notes regarding completion of same, procedures, guidelines, fees and methods of payment may be obtained from the EUIPO website www.euipo.europa.eu/ or on request from the Irish Patents Office.

Representation before EUIPO

You can file your EUTM application yourself. However, the experience and advice of a professional representative can help applicants without experience in trade mark matters to avoid the difficulties which may arise from insufficient knowledge of trade mark law, procedural rules and time limits.

Only legal practitioners, qualified in one of the member states of the EU and professional representatives entered on the lists kept by EUIPO, can act as representatives in matters before EUIPO. Entry on the list of professional representatives is restricted to people qualified to act before national industrial property offices. A list of Irish registered trade mark agents is available on the Patents Office website (www.patentsoffice.ie) or on application from the Patents Office.

International trade mark registration - The Madrid Protocol

This international system of trade mark registration is administered by the International Bureau of the World Intellectual Property Organisation (which maintains the International Register of Marks). It gives a trade mark owner the option to apply to protect a trade mark in several countries by simply filing one application form MM2(E), in one language, with one set of fees in one currency (Swiss francs). Unlike the European Union Trade Mark, where all EU member states are automatically designated, the applicant for an international trade mark may designate any countries that have ratified the Protocol. Ireland ratified the Madrid Protocol on the 19th of July 2001 and the Protocol entered into force, with respect to Ireland, on the 19th October 2001.

International application forms received in the Patents Office will be governed by the Madrid Protocol. Therefore all designated countries must also be governed by the Protocol. As the list of designated countries under the Protocol are subject to change from time to time, the International Trademark application form is altered accordingly by the World Intellectual Property Organisation. As a consequence, the Patents Office does not provide copies of the form and applicants are advised to download an editable Word version of the application form from the WIPO website (<http://www.wipo.int/madrid/en/forms/>). A guide to completion of the form is also available at <http://www.wipo.int/madrid/en>. The Patents Office can only accept international trademark applications for transmission to WIPO where Ireland is the country of origin.

In order for Ireland to be the Country of Origin the applicant must be:

- An Irish citizen,
- A body or a corporation solely incorporated or constituted under the law of the State,
- A person domiciled in the State, or
- A person who has a real and effective industrial or commercial establishment in the State.

The International Application must be based on **either** an application for a trade mark or a registered trade mark in the State. The International application must have the same owner(s), have an identical mark and the goods and services must be the same as or within the scope of the goods and services identified on the basic application/registration.

The Patents Office does not collect the Official application fees for international applications and applicants must pay these fees directly to the International Bureau of WIPO and these fees must be paid in Swiss francs.

The application form for an International Trade Mark Registration may be accessed via the Patents Office website or the WIPO website. The WIPO website also has a calculator to calculate the fees due based on the countries designated.

To obtain trade mark protection in other countries it is necessary to pursue an application for a national trade mark registration in each country in which protection is required unless the options offered by the European Union Trade Mark (EUTM) or the International trade mark (Madrid Protocol) routes are availed of.

20. Signs Used to identify Trade Marks

TM

The TM symbol can be used alongside a mark at any time, whether or not it is registered. It indicates that the use of the relevant 'sign', whether a word, phrase, picture, logo, letter, numeral, shape, colour, sound, scent or aspect of packaging is being claimed as a trade mark.

®

The ® symbol may only be used with a registered trade mark.

It is an offence for a person to falsely represent that a mark is a registered trade mark, or to make a false representation as to the goods or services for which the mark is registered.

21. Trade Mark Agents

The law relating to the registration of trade marks sometimes raises questions requiring specialised knowledge, and sometimes it is desirable, though not mandatory, that intending applicants should, in their own interests, consult a registered trade mark agent.

The Controller maintains a register of Trade Mark Agents. Any person who complies with the prescribed conditions and satisfies the educational/professional qualifications is eligible for registration in this register. The list of registered trade mark agents is available on the Patents Office website www.patentsoffice.ie or a copy may be obtained from the Patents Office.

The Patents Office cannot advise applicants as to choice of agent.

22. The Patents Office Journal

The Office publishes the Patents Office Journal on a fortnightly basis. The Journal is in two parts.

Part I concerns patents and designs and includes information under a number of headings.

Part II of the Journal contains information relating to trade marks, including the trade mark applications accepted. Any person may oppose the registration of a trade mark published in the Journal within three months of the date of publication of the Journal. There is a prescribed fee payable for filing a notice of opposition, which must be paid on the date of filing the opposition.

Journals may be viewed and searched online via the Office's website or consulted on request at our office in Kilkenny.

23. Business Names

The Patents Office does not deal with the registration of the names of businesses or firms as such, and enquiries relating to these should be addressed to the Companies Registration Office (www.cro.ie).

In some instances a business name may also be a trade mark. If such is the case an application should be made to the Companies Registration Office in respect of the business name registration, and a separate application made to the Patents Office in respect of the trade mark registration.

24. Domain Names

Domain names are Internet addresses, and are commonly used to find websites. In some instances a domain name may also be registered as a trade mark. Domain names have come to constitute business identifiers and as such often come into conflict with trade marks. Care should be taken not to attempt to register a trade mark which is already used as a domain name and vice versa.

An application to register a domain name in Ireland can be made to the IE Domain Registry.

www.iedr.ie

The IEDR is the registry for .ie Internet Domain Names and maintains the database of .ie registered Internet names. The IEDR is an independent not-for-profit organisation that manages the .ie country code Top Level Domain (ccTLD) namespace in the public interest of the Irish and global Internet communities. The IE Domain Registry is not a governing or regulatory body, but provides a public service for the .ie namespace on behalf of the Internet community.

USEFUL WEBSITES

| | |
|--|--|
| The Irish Patents Office. | www.patentsoffice.ie |
| European Union Intellectual Property Office. | www.euipo.europa.eu |
| World Intellectual Property Organisation. | www.wipo.org |
| UK Patent Office. | www.patent.gov.uk |
| US Patent & Trademark Office. | www.uspto.gov/main/trademarks.htm |
| InnovAccess (Provides access to general information on IP issues in EU member states) | http://www.innovaccess.eu |

Annex 1: NICE CLASSIFICATION 10th EDITION

List of General Indications of the Class headings from 1st January 2016.

| GOODS | |
|-----------------|--|
| Class 1 | Chemicals used in industry, science and photography, as well as in agriculture, horticulture and forestry; unprocessed artificial resins, unprocessed plastics; manures; fire extinguishing compositions; tempering and soldering preparations; chemical substances for preserving foodstuffs; tanning substances; adhesives used in industry. |
| Class 2 | Paints, varnishes, lacquers; preservatives against rust and against deterioration of wood; colorants; mordants; raw natural resins; metals in foil and powder form for painters, decorators, printers and artists. |
| Class 3 | Bleaching preparations and other substances for laundry use; cleaning, polishing, scouring and abrasive preparations; soaps; perfumery, essential oils, cosmetics, hair lotions; dentifrices. |
| Class 4 | Industrial oils and greases; lubricants; dust absorbing, wetting and binding compositions; fuels (including motor spirit) and illuminants; candles and wicks for lighting. |
| Class 5 | Pharmaceutical and veterinary preparations; sanitary preparations for medical purposes; dietetic substances adapted for medical use, food for babies; plasters, materials for dressings; material for stopping teeth, dental wax; disinfectants; preparations for destroying vermin; fungicides, herbicides. |
| Class 6 | Common metals and their alloys; metal building materials; transportable buildings of metal; materials of metal for railway tracks; non-electric cables and wires of common metal; ironmongery, small items of metal hardware; pipes and tubes of metal; safes; goods of common metal not included in other classes; ores. |
| Class 7 | Machines and machine tools; motors and engines (except for land vehicles); machine coupling and transmission components (except for land vehicles); agricultural implements other than hand-operated; incubators for eggs. |
| Class 8 | Hand tools and implements (hand-operated); cutlery; side arms; razors. |
| Class 9 | Scientific, nautical, surveying, photographic, cinematographic, optical, weighing, measuring, signalling, checking (supervision), life-saving and teaching apparatus and instruments; apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling electricity; apparatus for recording, transmission or reproduction of sound or images; magnetic data carriers, recording discs; automatic vending machines and mechanisms for coin-operated apparatus; cash registers, calculating machines, data processing equipment and computers; fire-extinguishing apparatus. |
| Class 10 | Surgical, medical, dental and veterinary apparatus and instruments, artificial limbs, eyes and teeth; orthopedic articles; suture materials. |
| Class 11 | Apparatus for lighting, heating, steam generating, cooking, refrigerating, drying, ventilating, water supply and sanitary purposes. |
| Class 12 | Vehicles; apparatus for locomotion by land, air or water. |
| Class 13 | Firearms; ammunition and projectiles; explosives; fireworks. |
| Class 14 | Precious metals and their alloys and goods in precious metals or coated therewith, not included in other classes; jewellery, precious stones; horological and chronometric instruments. |

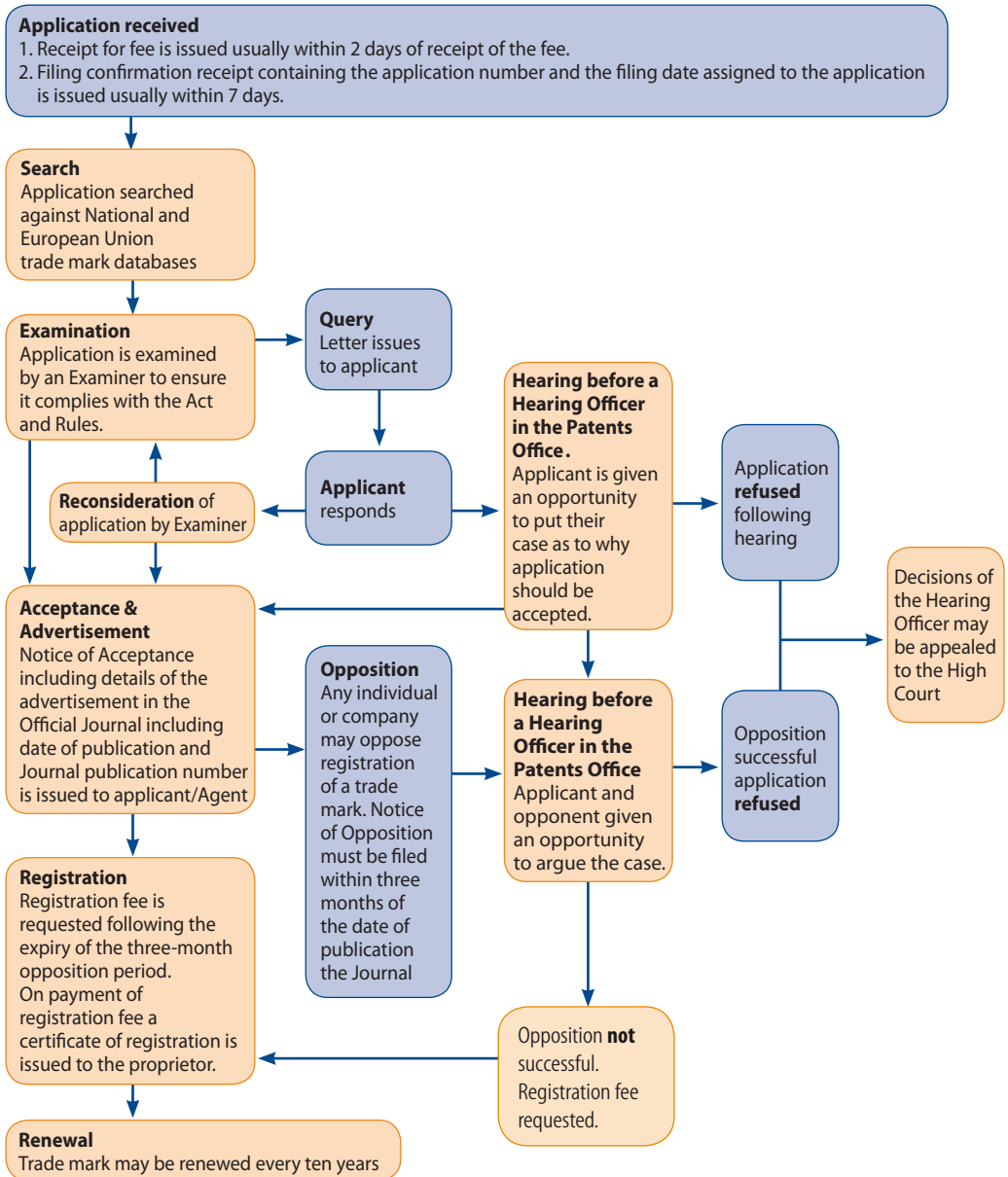
| GOODS cont. | |
|-----------------|--|
| Class 15 | Musical instruments. |
| Class 16 | Paper, cardboard and goods made from these materials, not included in other classes; printed matter; bookbinding material; photographs; stationery; adhesives for stationery or household purposes; artists' materials; paint brushes; typewriters and office requisites (except furniture); instructional and teaching material (except apparatus); plastic materials for packaging (not included in other classes); printers' type; printing blocks. |
| Class 17 | Rubber, gutta-percha, gum, asbestos, mica and goods made from these materials and not included in other classes; plastics in extruded form for use in manufacture; packing, stopping and insulating materials; flexible pipes, not of metal. |
| Class 18 | Leather and imitations of leather, and goods made of these materials and not included in other classes; animal skins, hides; trunks and travelling bags; umbrellas, parasols and walking sticks; whips, harness and saddlery. |
| Class 19 | Building materials (non-metallic); non-metallic rigid pipes for building; asphalt, pitch and bitumen; non-metallic transportable buildings; monuments, not of metal. |
| Class 20 | Furniture, mirrors, picture frames; goods (not included in other classes) of wood, cork, reed, cane, wicker, horn, bone, ivory, whalebone, shell, amber, mother-of-pearl, meerschaum and substitutes for all these materials, or of plastics. |
| Class 21 | Household or kitchen utensils and containers (not of precious metal or coated therewith); combs and sponges; brushes (except paint brushes); brush-making materials; articles for cleaning purposes; steelwool; unworked or semi-worked glass (except glass used in building); glassware, porcelain and earthenware not included in other classes. |
| Class 22 | Ropes, string, nets, tents, awnings, tarpaulins, sails, sacks and bags (not included in other classes); padding and stuffing materials (except of rubber or plastics); raw fibrous textile materials. |
| Class 23 | Yarns and threads, for textile use. |
| Class 24 | Textiles and textile goods, not included in other classes; bed and table covers. |
| Class 25 | Clothing, footwear, headgear. |
| Class 26 | Lace and embroidery, ribbons and braid; buttons, hooks and eyes, pins and needles; artificial flowers. |
| Class 27 | Carpets, rugs, mats and matting, linoleum and other materials for covering existing floors; wall hangings (non-textile). |
| Class 28 | Games and playthings; gymnastic and sporting articles not included in other classes; decorations for Christmas trees. |
| Class 29 | Meat, fish, poultry and game; meat extracts; preserved, frozen, dried and cooked fruits and vegetables; jellies, jams, compotes; eggs, milk and milk products; edible oils and fats. |
| Class 30 | Coffee, tea, cocoa, sugar, rice, tapioca, sago, artificial coffee; flour and preparations made from cereals, bread, pastry and confectionery, ices; honey, treacle; yeast, baking-powder; salt, mustard; vinegar, sauces (condiments); spices; ice. |

| | |
|-----------------|---|
| Class 31 | Agricultural, horticultural and forestry products and grains not included in other classes; live animals; fresh fruits and vegetables; seeds, natural plants and flowers; foodstuffs for animals, malt. |
| Class 32 | Beers; mineral and aerated waters and other non-alcoholic drinks; fruit drinks and fruit juices; syrups and other preparations for making beverages. |
| Class 33 | Alcoholic beverages (except beers). |
| Class 34 | Tobacco; smokers' articles; matches. |
| SERVICES | |
| Class 35 | Advertising; business management; business administration; office functions. |
| Class 36 | Insurance; financial affairs; monetary affairs; real estate affairs. |
| Class 37 | Building construction; repair; installation services. |
| Class 38 | Telecommunications. |
| Class 39 | Transport; packaging and storage of goods; travel arrangement. |
| Class 40 | Treatment of materials. |
| Class 41 | Education; providing of training; entertainment; sporting and cultural activities. |
| Class 42 | Scientific and technological services and research and design relating thereto; industrial analysis and research services; design and development of computer hardware and software. |
| Class 43 | Services for providing food and drink; temporary accommodation. |
| Class 44 | Medical services; veterinary services; hygienic and beauty care for human beings or animals; agriculture, horticulture and forestry services. |
| Class 45 | Legal services, security services for the protection of property and individuals; personal and social services rendered by others to meet the needs of individuals. |

Annex 2: CROSS CLASS SEARCH LIST

| GOODS CLASSES | | SERVICE CLASSES | |
|---------------|-----------------------|-----------------|--|
| Class | Conflicting Class(es) | Class | Conflicting Class(es) |
| 01 | 4; 17 | 30 | 29; 31 |
| 02 | 16 | 31 | 29; 30 |
| 03 | 5; 21 | 32 | 33 |
| 04 | 1; 17 | 33 | 32 |
| 05 | 3; 10 | 34 | 14 |
| 06 | 17; 19; 20; 37 | 35 | 36; 41; 42 (and potential conflicts - classes 1 to 34 inclusive) |
| 07 | 8; 11; 12 | 36 | 35; 42 |
| 08 | 7; 21 | 37 | 6; 12; 17 |
| 09 | 16; 28; 38; 42 | 38 | 9; 41; 42 |
| 10 | 5 | 39 | 42; 43 |
| 11 | 7; 21 | 40 | 42 |
| 12 | 7; 37 | 41 | 35; 38; 42; 43 |
| 13 | None | 42 | 9; 35; 36; 38; 39; 40; 41; 43; 44; 45 |
| 14 | 21; 34 | 43 | 39; 41; 42 |
| 15 | None | 44 | 42 |
| 16 | 2; 9; 28 | 45 | 42 |
| 17 | 1; 4; 6; 19; 37 | | |
| 18 | 22; 25; 28 | | |
| 19 | 6; 17 | | |
| 20 | 6; 21 | | |
| 21 | 3; 8; 11; 14; 20 | | |
| 22 | 18; 23; 24 | | |
| 23 | 22; 24; 26 | | |
| 24 | 22; 23 | | |
| 25 | 18; 28 | | |
| 26 | 23 | | |
| 27 | None | | |
| 28 | 9; 16; 18; 25 | | |
| 29 | 30; 31 | | |

Annex 3 : FLOWCHART OF TRADE MARK APPLICATION PROCEDURE



The Patents Office may be contacted at:

Patents Office

Government Buildings, Hebron Road, Kilkenny

Tel: 056 - 7720111

Lo-call: 1890 - 220223 (within Ireland)

Fax: 056 - 7720100

Lo-call Fax: 1890 - 220120 (within Ireland)

E- mail: patlib@patentsoffice.ie



The Patents Office is open to the public from 9.30 am to 5.00 pm

Notes

