



:: Protecting Your Intellectual Property - Trademarks

Businesses often assume that once their name is registered with the Companies Office or they have registered a domain name that exclusive use of their business name is guaranteed. Unfortunately this is not the case. The best way of ensuring that distinctive brand names, logos and other distinctive features are protected from use by other businesses is by registering the brand name, logo or distinctive feature as a trademark.

What is a Trademark?

A trademark is any mark used to distinguish the goods or services of one business from those of its competitors. Any sign capable of being represented graphically which is capable of distinguishing goods or services of that business is capable of being registered as a trademark. A trademark may be the name of your business, a logo or the name of your products or services. Good examples of registered trademarks are the Tayto logo and Tayto name, the orange Eircom logo and Ballygowan.

Trademarks may be words, designs, letters, numerals or the shape of goods or of their packaging. In fact a German company once took a case to the European Court of Justice claiming that a smell was capable of being registered as a trademark!

Where is a Trademark Registered?

Trademarks are registered in the Irish Patents Office which is located in Kilkenny and is the statutory body in charge of the administration and maintenance of trademarks and other intellectual property rights.

Once registered the trademark lasts for 10 years. This may be renewed at the end of the ten year period on payment of the relevant fee to the Irish Patents Office. There is no limit to the amount of times this can be done so if desired the trademark could last forever. However if the trademark has not been put to genuine use for a period of five years, then it may be revoked.

What cannot be registered?

Marks which may not be registered include the following:

- trademarks which have no distinguishing character;
- trademarks which cannot be represented graphically or are not capable of distinguishing

the goods or services of one business from those of another business

It is not possible to register marks which conflict with earlier registered marks or pending applications unless of course the

owner of the earlier trademark consents to the registration. The flip side of this of course is that when a trademark is registered, it is protected from other conflicting trademarks being registered in the future.

What happens if another business uses the Trademark?

A trademark is infringed if another business uses an identical or confusingly similar mark in relation to the same or similar goods or services. As the owner of a registered trademark has exclusive rights in the trademark, the owner may take legal proceedings against the other business or person for infringement of the trademark.

The court has the power to grant the owner of the registered trademark an injunction preventing the unauthorised user from continuing to use the trademark. The registered owner could also sue the unauthorised user for damages caused by the infringement of the trademark, although damages are sometimes difficult to calculate. The court could also order the unauthorised user to remove any signs that contain material which infringes a registered trademark, or even order that any goods containing the unlawful use of a trademark are seized or destroyed.

Can a valuable Trademark be sold?

Yes. The transfer of a trademark to another business or person is called an assignment. This could be achieved by selling the trademark itself, or by selling the business which owns the registered trademark.

The legal contract transferring the trademark must be in writing, signed by or on behalf of the registered owner and filed at the Patents Office within six months of the date of the transfer. The assignment was previously subject to stamp duty, however, since 1 April 2004 an assignment of a trademark is no longer liable to stamp duty. If the business which owned the trademark was sold, this would however be liable to stamp duty.

A trademark can also be used as security in the same manner as other types of property.

If an application for a trademark has been lodged with the Patents Office and the trademark has not yet been granted, this may also be transferred by the applicant to another business or person.





Can a Trademark be licenced?

The registered owner of a trademark may grant another business or person the right to use the registered trademark, obviously accompanied by the payment of an appropriate licence fee to the registered owner! The registered owner may grant an "exclusive licensee" which would allow the other business or person to use the trademark to the exclusion of all other persons (including even the registered owner of the trademark).

To be fully effective the licence must be in writing, signed by or on behalf of the registered owner and recorded at the Patents Office. Similar to the assignment, the licence of a trademark is no longer subject to stamp duty.

Can a trademark be registered outside Ireland?

The Community Trademark Office (OHIM) gives applicants the opportunity to apply to a central office for a trademark covering the European Union. This system has obvious benefits if a trade or service mark is used in a number of European Union Member States.

It is also possible to use the international system known as the "Madrid Protocol". This is an international application system by which an international application is filed at the World Intellectual Property Organisation, following the registration of a trademark in the owner's home country. The applicant must specify the countries in which the international application is to have effect and then the trademarks office in each participating country can either reject or accept the application in that country. Registrations obtained under this procedure will last ten years.

Is registration really necessary?

It depends. It is really a question of how important your brand name or logo is to your business. If your business is one which has an established reputation built on a well known brand name, then registering your brand name is recommended.

This article provides an outline of the legal issues which arise and proper legal advice should be sought in all circumstances.

