



Oifig Maoine Intleachtúla na hÉireann
Intellectual Property Office of Ireland

General Information Concerning

Registration of Trade Marks

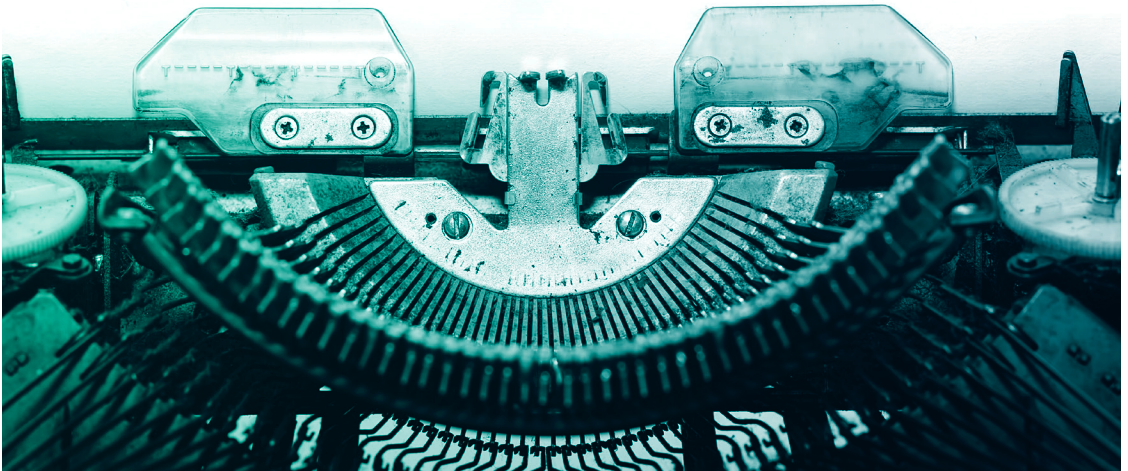


Contents

Introduction	4
1. What is a trade mark?	5
2. The benefits of trade mark registration	5
3. Is registration of a trade mark compulsory?	6
4. Grounds for refusal of registration of a trade mark	7
5. Use of State Emblems	8
6. Classification of goods and services	9
7. Trade Mark Searches	10
8. Cross Class Searching	11
9. Classification of Figurative Trade Marks	11
10. How to Apply for Registration	11
11. What are the requirements for a filing date?	15
12. Claiming Priority	15
13. Amendment to an application after filing	15
14. The Application Procedure	16
15. Duration of registration & renewal of registration	17
16. Assignment of a Trade Mark	17
17. Licensing of Trade Marks	17

18. Alteration to Registered Trade Marks	17
19. Protection Abroad	18
20. Signs Used to identify Trade Marks	24
21. Trade Mark Agents	25
22. The IPOI Journal	25
23. Business Names	25
24. Domain Names	26
25. Contact Details	26
Annex 1 Nice Classification	
Annex 2 Cross Class Search List	

Trademark



Introduction

This booklet summarises certain important provisions and requirements of the Trade Marks Act, 1996 and the Trade Mark Rules, 1996, together with the requirements of S.I. 561 of 2018 EU (Trade Mark) Regulations 2018, 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 Acts, Rules and Regulations can be accessed on www.ipoi.gov.ie or purchased directly from the Government Publications Office. Their Call centre is open Monday to Friday; telephone number is 046 942 3100 or email publications@opw.ie

The Intellectual Property Office of Ireland 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.

01

What is a Trade Mark?

Section 6 of the Trade Marks Act, 1996 defines a Trade Mark as “any sign capable of distinguishing goods or services of one undertaking from those of other undertakings”.

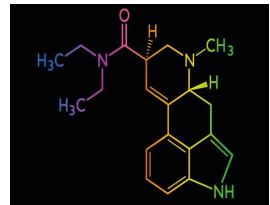
A trade mark may consist of words (including personal names) or designs, letters, numerals, colours, the shape of goods or of the packaging of goods, or sounds, provided that such signs are capable of being represented on the register in a manner which enables the Controller of Intellectual Property and the public to determine the clear and precise subject matter of the protection afforded to its proprietor.

The mark must be clear, precise, self-contained, easily accessible, intelligible, durable and objective, so as to provide legal certainty regarding what it is and what it is not.

For example, these marks met that criteria:



While these do not:



02

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 authorised 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 benefitting 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 trader from similar products/services of other traders.
- 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.

03

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 trade mark has been registered, it is possible to take legal action against infringement by others. It is also possible under Common Law to seek legal address for misrepresentation and damage to the business reputation or goodwill through the tort of 'passing off'. If a trade mark has not been registered, the only remedy available is through an action for passing off.

Therefore, it is much easier and generally less expensive for the owner of a registered trade mark to enforce its rights against unauthorised use of its mark. Unauthorised use 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 for protection.

A range of remedies are possible, such as the award of damages, injunctions, or orders for the seizure of goods. A trade mark agent or solicitor specialising in intellectual property law will be able to advise as to the most appropriate course of action to follow.

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 (which concern the prohibition on the use of certain material in a trade mark) and section 10 deals with relative grounds (based on the existence of other earlier trade marks). Essentially registration will be refused for a trade mark which:

- Is not capable of distinguishing good or services of one business from those of another business (e.g. the hash (#) symbol);
- does not have any distinctive character (e.g. We Make Clothes for clothing);
- Consists exclusively of signs or indications that designate essential characteristics of goods or services, namely, their quality, intended purpose, or geographical origin (e.g. Great Irish Beef);
- consists exclusively of signs or indications which are customary in the language in the trade (e.g. Hot Yoga);
- consists exclusively of the shape, arising from the goods themselves (e.g. the common shape of a chocolate bar), 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, (e.g. extremely vulgar, explicit or blasphemous terms);
- is likely to deceive the public, e.g. as to the nature, quality, or geographical origin of the goods or services (e.g. SAFECOAL which may lead to the erroneous believe that the coal is not dangerous to touch);
- is applied for in bad faith (e.g. where the intention is solely to block another from registering the mark); or
- is identical or similar to a trade mark that is already on the Register in respect of identical or similar goods.

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.

05

Use of State Emblems

Any person who wishes to obtain registration of a trade mark containing a State Emblem (the State harp or shamrock) or to use either of these State emblems 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 for the 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 in writing or by e-mail to:

Intellectual Property Unit, Department of Enterprise, Trade and Employment, 23 Kildare Street, Dublin 2, D02 TD30.

Telephone Number: 01 631 2121

Fax: 01 6312561

Email: ipu@enterprise.gov.ie

There is no formal application form.

NOTE: Consent for use of marks containing the State Harp is confined to Government Departments and Agencies. Further information is available from the Department of Enterprise, Trade & Employment’s website:

<https://www.enterprise.gov.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 and other emblems of all States, and abbreviations and names of international intergovernmental organisations that are party to the Paris Convention. Trade marks containing these flags, armorial bearings, official hallmarks and emblems of states and international organisations are usually excluded from registration, but they may be registered if the appropriate permission for their use is acquired. Please see paragraph 7 for details on how to identify these protected emblems.

Classification of goods and services

An application for registration of a trade mark must include a list of the goods and/or services for which the mark is to be used.

The Nice Classification, which Ireland uses, is the internationally recognised classification system of goods and services in respect of trade marks.

Under the Nice Classification, goods and services are categorised into classes each of which relate to a particular field of commercial activity, for example, clothing, pharmaceuticals, financial services.

When a trade mark is registered, it may be registered in respect of goods and/or services within one or more classes. The list of goods and/or services defines the extent of the protection afforded by the 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 applicants to search for and classify the goods and/or services (terms) needed to apply for trade mark protection. Further information is available in the Classification of Goods and Services section of the IPOI website www.ipoi.gov.ie/en/types-of-ip/trade-marks/understanding-trade-marks/classifying-your-goods-or-services/

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 IPOI.

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.

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 applied for in respect of the same/similar goods or services. This can be done by the following means:

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

The following databases are available for searching:

The **IPOI 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 participating trade mark offices in a single place.

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 IPOI 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 IPOI website.

08

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. For example, trade marks for clothing (which is proper to Class 25) may need to be compared to trade marks for retail services in respect of clothing (which is proper to Class 35).

09

Classification of Figurative Trade Marks

A trade mark, which contains a picture/logo/design is 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 IPOI website.

10

How to Apply for Registration

A trade mark, which contains a picture/logo/design is 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 IPOI website.

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 IPOI website www.ipoi.gov.ie/en/manage-ip/apply/apply-for-a-trade-mark/. This e-filing facility is easy to use and navigate and facilitates the electronic payment of the relevant

application fees by credit or debit card. Alternatively, the application can be made on the official paper application form (Form No. 1), which can be obtained from the IPOI or downloaded from the Office's website.

A guide to completing the application form is also available on-line or on request from the IPOI. The completed application form should then be lodged at the Intellectual Property Office of Ireland.

Fees for Application & 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. When availing of the online application facility the application fee must be paid with the application. The fees for paper-filed applications must be made **within one month** of the date of filing. If this deadline is not met the application will be deemed to have been abandoned.

When the examination process is completed and the Office is satisfied the application is worthy of registration, the Office will publish its intention to register the application. This publication puts other parties on notice of the Office's intention and allows anyone, who believes the mark should not be registered, three-month in which to oppose its registration. When the opposition period expires without the notice of opposition being received or where notice of opposition is received and the opposition if unsuccessful, the mark will be allowed to proceed to registration, and a registration fee of €177 will be requested by the Office.

Renewal of trade mark registration

Trade marks can remain on the Register for as long as its proprietor continues to pay registration renewal fees. Payment of the renewal fee allows the mark to remain on the Register for another period of 10 years. The first renewal is due on the 10th anniversary of the date of application, following which registration may be renewed for further period(s) of 10 years.

The renewal fee is €250 in respect of one class and €125 for each additional class of goods/services.

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

A copy of the schedule of fees relating to trade marks is available online at www.ipoi.gov.ie or on request from the Intellectual Property Office of Ireland.

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.ipoi.gov.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 ipinfo@ipoi.gov.ie for more details.

Please quote your application or registration number on all correspondence when making a 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 owns the mark, from those of other traders. The following are examples of collective trade marks from the trade mark register.



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 cannot be registered by an applicant who carries on a business involving the supply of goods or services of the kind to be certified. The following are examples of certification trade marks from the trade mark register.



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. A guide to understanding a trade mark series can be found on IPOI website at Types of Trade Marks - IPOI. The following are examples of valid series of three trade marks:

WINDINDEX



THE COUNTY
SLIGO GOLF
CLUB



WindIndex



COUNTY
SLIGO GOLF
CLUB



Wind Index

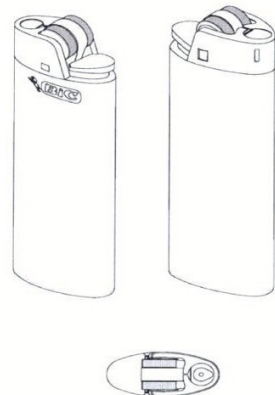
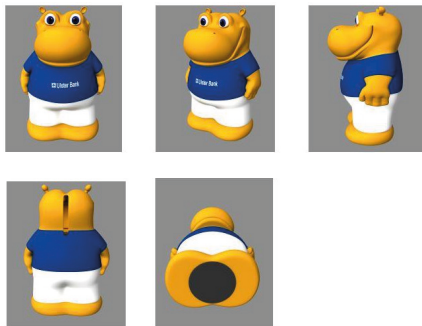


CO. SLIGO
GOLF CLUB



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. The following are examples of valid 3-dimensional trade marks:



11

What are the requirements for a filing date?

In order for an application to be valid it must be submitted on the official paper form, or filed electronically using the e-form, and it must contain, at a minimum, the following information in order to be allocated a filing date and an application number:

- The name and address of the person requesting the registration,
- A representation of the trade mark,
- An address for service within the European Economic Area (i.e. any EU Member State or Iceland, Norway or Liechtenstein)
- A 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 the registration of the same trade mark for 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 IPOI 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 a certified copy of the Irish trade mark application from the IPOI 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 registrability having regard to the provisions of the Trade Marks Act, 1996 and the Trade Marks Rules 1996. As part of the examination process the IPOI will carry out a search of the Irish and European Union 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 Office Journal which is available on the Intellectual Property Office of Ireland 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 oppositions to the registration of marks. 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 IPOI 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.

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 by third parties 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 IPOI website www.ipoi.gov.ie

17

Licensing of Trade Marks

The proprietor of the 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 IPOI website www.ipoi.gov.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.

Protection Abroad

It should be noted that trade mark registration is territorial, i.e. a registration resulting from an application filed at the IPOI is only valid in Ireland. If trade mark protection is required beyond Ireland, 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 & Designs)
Avenida de Europa, 4
E-03080 Alicante, Spain

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 a EUTM registration is valid everywhere in the European Community and gives proprietors exclusive rights enabling them to prohibit any third parties from using the sign in their 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, a 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 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 the EUIPO, within one month from the date of receipt of the application at the EUIPO or the Intellectual Property Office of Ireland.

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 or by post/courier service. Applications sent by post should be addressed to:

European Union Intellectual Property Office
(Trade Marks & Designs)
Receiving Unit
Avenida de Europa 4
E-03080 Alicante, Spain

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

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

If you request it when filing your application, EUIPO will carry out a search

in the EU trade mark database (<https://euipo.europa.eu/eSearch/>) for identical and/or similar marks. The results are sent to you before your trade mark application is published. Owners of previously registered trade marks or trade mark applications quoted in the report are informed — by letter — about your trade mark application. This is called a 'surveillance letter'. The results of both search reports and surveillance letters are for information only.

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 available by searching the EUIPO eSearch Plus database on 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:

Application Fees (e-filed)			
EUTM – Individual Mark	Basic Fee	EUTM – 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

Renewal Fees (e-filed)			
EUTM – Individual Mark	Basic Fee	EUTM – 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

The Cost of a European Union Trade Mark Registration

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

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

Bank	Santander	CaixaBank
Address	Alicante, Spain	Alicante, Spain
BIC code*	BSCHEMMXXX	CAIXESBBXXX
IBAN	ES08 0049 6659 0121 1622 4792	ES03 2100 2353 0107 0000 0888
Bank charges**	>OUR	>OUR

* Some computer programmes do not accept the last three digits XXX of the BIC code. Should this be the case, please kindly indicate CAIXESBB or BSCHEMM.

** It is important to indicate the term 'OUR' when making the transfer, to ensure that you assume any bank charges and EUIPO receives the full amount due. However, if you are making a SEPA payment, the default SEPA specification 'SHA' is required. SEPA is a new common European payments system, used by most banks in the EU Member States and in four European non-EU countries.

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

<https://euipo.europa.eu/ohimportal/en/fees-and-payments>

Representation before the 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 trademark 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 the EUIPO, can act as representatives in matters before the 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 IPOI website (www.ipoi.gov.ie/en/law-practice/).

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 IPOI are 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 IPOI does not provide copies of the form and applicants are advised to download 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 IPOI 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), be for 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 Intellectual Property Office of Ireland 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 IPOI 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

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. Therefore, depending on the nature of the issues raised, it may be desirable, but never mandatory, for applicants to consult with 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 IPOI website www.ipoi.gov.ie/en/law-practice. However, the IPOI cannot advise applicants as to what agent to approach.

22

The IPOI Journal

The Office publishes the IPOI 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 IPOI 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. In such cases an application should be made to the Companies Registration Office in respect of the business name registration, and a separate application made to the IPOI 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 at www.weare.ie.

.IE is the registry for .ie Internet domain names and maintains the .ie database. .IE is an organisation that have been managing the .ie country code Top Level Domain (ccTLD) namespace since 2000. The .IE 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

EUIPO European Union Intellectual property Office www.euipo.europa.eu

World Intellectual Property Organisation www.wipo.org

UK Intellectual Property Office www.gov.uk

US Patent & Trade Mark Office www.uspto.gov

ANNEX 1—Nice Classification (CURRENT) EDITION

ANNEX 2—Cross Class Search List

25

Contact Details

The Intellectual Property Office of Ireland
Government Offices, Hebron Road,
Kilkenny, R95 H4XC, Ireland

Tel: 056 - 7720111

Fax: 056 - 7720100

E- mail: ipinfo@ipoi.gov.ie

Website: www.ipoi.gov.ie

For Office opening hours please check the "Contact Us" webpage.

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.
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
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 (nontextile).
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			
Class No.	Conflicting Class(es)	Class No.	Conflicting Class(es)
01	4; 17	19	6; 17
02	16	20	6; 21
03	5; 21	21	3; 8; 11; 14; 20
04	1; 17	22	18; 23; 24

05	3; 10	23	22; 24; 26
06	17; 19; 20; 37	24	22; 23
07	8; 11; 12	25	18; 28
08	7; 21	26	23
09	16; 28; 38; 42	28	9; 16; 18; 25
10	5	29	30; 31
11	7; 21	30	29; 31
12	7; 37	31	29; 30
14	21; 34	32	33
16	2; 9; 28	33	32
17	1; 4; 6; 19; 37	34	14
18	22; 25; 28		

Service Classes

Class No.	Conflicting Class(es)
35	36; 41; 42 (and potential conflicts – classes 1 to 34 inclusive)
36	35; 42
37	6; 12; 17
38	9; 41; 42
39	42; 43
40	42
41	35; 38; 42; 43
42	9; 35; 36; 38; 39; 40; 41; 43; 44; 45
43	39; 41; 42
44	42
45	42

