

DOCKERY SOLICITORS

&

REGISTERED TRADE MARK AGENTS



WHY REGISTER TRADE MARKS?

Have you ever considered registering a trade mark? Do you know what is involved?

Are you aware of the compelling reasons why you should register your trade mark?

If you have ever asked yourself these and other questions, the following may be of interest to you.

WHY REGISTER TRADE MARKS?

Even a brief consideration of modern business practice discloses the extent to which businesses and companies choose to identify and market their products and services through the development and use of registered trade marks.

By enabling companies to distinguish their products from those of market competitors, trade marks can play a vital role in the branding and marketing strategies of business concerns. Trade marks can contribute to the development of the image, reputation and goodwill of a business and its range of products and/or services. It is certainly fair to say that in many cases a carefully developed, promoted and enforced trade mark can be an extremely valuable asset; it may even become the most valued asset of a business.

The value of a trade mark can be found in the link that it creates in the mind of the consumer with a product or service. A trade mark is, therefore, often the most effective way to create this link and to distinguish a product from the product of a competitor. If used and marketed effectively, a trade mark can substantially develop customer loyalty in an often crowded, multi-choice market; these are important considerations for any business.

WHAT EXACTLY IS A TRADE MARK?

A trade mark is most commonly a visual logo applied to goods to enable consumers to identify a product or service so as to distinguish it from other identical or similar products. Some of the best examples of trade marks include names and/or logos such as Kodak, Coca-Cola, Pedigree Chum, Wranglers, Pepsi and McDonald's.

The definition of a trade mark is found in section 6 of the Trade Marks Act, 1996. That section states that a trade mark is "any sign capable of being represented graphically which is capable of distinguishing the goods or services of one undertaking from those of other undertakings".

This is a very broad definition and it makes possible the registration of many types of 'sign' as a trade mark. Trade marks can, accordingly, consist of drawings, symbols, three-dimensional signs such as the shape and packaging of goods and even audible signs such as music or vocal sounds. It is also possible to register as a trade mark fragrances or colours which are used as distinguishing features. Prior to the 1996 Act marks of this type could not have been registered.



WHAT DOES REGISTRATION INVOLVE?

The procedure involved in the registration of a trade mark is quite straightforward. The application for registration can be confined to Ireland alone. Alternatively, application can be made for what is known as a Community trade mark ("CTM"). A CTM is registered in respect of the whole of the European Union ("EU") and it is the equivalent of a series of national registrations in each of the states of the EU. Such a trade mark would be of particular interest to a business concern whose activities are carried out throughout the EU or part of it. It is also possible to register a trade mark in many states outside the EU, for example, the United States of America, Canada and Australia, to name but a few.

In each case a properly completed application form must be sent with a representation of the proposed mark to the relevant trade mark office. Official fees must be paid to the receiving office at the time that the application is made. In Ireland the appropriate office is the Patents Office. In the case of a CTM application, the Office for Harmonisation of the Internal Market, which is located in Alicante, Spain, deals with all such applications. If there are no queries by the relevant office upon receipt of the application, and there are no third party objections (for example, from the owners of other previously registered trade marks), the application will proceed and the trade mark will ultimately be registered.

ARE THERE ADVANTAGES TO REGISTRATION?

1. Registration grants the exclusive right to the use of the trade mark. It is only the registered owner who is entitled to use the trade mark, and it cannot be used by third parties in bad faith to market their goods/services.
2. Once a trade mark is registered, the owner receives a Certificate of Registration. This amounts to prima facie evidence of the ownership of the mark. The registration lasts for a period of ten years and can be renewed indefinitely, provided the trade mark is properly used and does not become generic. For example, 'Escalator' was originally a trade mark but has since become a generic term for the product it originally described. The same can be said of 'Vaseline'.
3. It is much more straightforward to prevent trade mark infringement by a third party when a trade mark has been registered. This means that there is usually no difficulty in establishing the existence of an intellectual property right in the holder of the Certificate of Registration. Accordingly, it is not necessary to establish matters such as (a) the link that the public have made between you and your product (which often requires extensive market analysis), (b) damage or likelihood of damage to goodwill in the product and (c) intention to injure business or goodwill. These are often requirements in the remedy of passing off and they are far more troublesome and difficult to establish successfully.



FOR FURTHER INFORMATION:

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