

Protection of Country Names in the field of Registration of Trademarks in Ireland

1) Legal basis of protection (whether trademark or non-trademark law):

- Trade Marks Act 1996
- Trade Marks Rules 1996

2) The applicable procedures (pre-registration, post-registration, other)

Pre-Registration

The scope of protection according to country names in the field of registration of trademarks (the sign applied for registration as a trademark is a country name, or the country name forms part of the sign)

- Under Section 8(1)(b) of the Trade Marks Act 1996, state names would be excluded from registration as a trademark for goods or services if they otherwise lack any distinctive character.
- Under Section 8(1)(c) of the Trade Marks Act 1996, state names would be excluded from registration as trademarks for goods or services if they could be considered descriptive of the origin of the goods in respect of which registration is sought.
- Under Section 8(3)(b) of the Trade Marks Act 1996, state names would be excluded from registration as a trademark for goods or services if the use of the name of a state could be considered to be misleading as to the origin of the goods in respect of which registration is sought or if they can be considered incorrect as to the origin of the products for which registration is sought.

Post-Acceptance/Pre-Registration

Under Section 43 of the Trade Marks Act 1996, there are provisions whereby an application which is post acceptance but pre-registration may be subject to publication, opposition proceedings and observations as follows:

- Section 43.—(1) When an application for registration has been accepted, the Controller shall cause the application to be published in the Journal.
- Section 43.—(2) Any person may, within the prescribed time from the date of the publication of the application in the Journal, give notice to the Controller of opposition to the registration; and any such notice shall be given in writing in the prescribed manner, and shall include a statement of the grounds of opposition.
- Section 43.—(3) Where an application has been published in the Journal, any person may, at any time before the registration of the trade mark, make observations in writing to the Controller as to whether the trade mark should be registered; and the Controller shall inform the applicant of any such observations.

- Section 43.—(4) A person who makes observations as mentioned in subsection (3) shall not thereby become a party to the proceedings on the application.

Post-Registration

Under Section 52 of the Trade Marks Act 1996, a registered mark, irrespective of its composition, *inter alia*, the inclusion of a state name, may be declared invalid as follows:

Section 52.—(1) The registration of a trade mark may be declared invalid on the ground that the trade mark was registered in breach of section 8 or any of the provisions referred to in that section; but where a trade mark was registered in breach of subsection (1) (b), (c) or (d) of that section, it shall not be declared invalid if, in consequence of the use which has been made of it, it has after registration acquired a distinctive character in relation to the goods or services for which it is registered.

Section 52.— (2) The registration of a trade mark may be declared invalid on the grounds—

- (a) that there is an earlier trade mark in relation to which any of the conditions set out in subsections (1) to (3) of section 10 obtains, or
- (b) that there is an earlier right in relation to which the condition set out in paragraph (a) or (b) of subsection (4) of that section is satisfied, unless the proprietor of that earlier trade mark or earlier right has consented to the registration.

Section 52.— (3) An application for a declaration of invalidity may be made by any person, and may be made either to the Controller or to the Court, except that—

- (a) if proceedings concerning the trade mark in question are pending in the Court, the application must be made to the Court; and
- (b) if in any other case the application is made to the Controller, the Controller may at any stage of the proceedings refer the application to the Court.

Section 52.— (4) In the case of bad faith in the registration of a trade mark, the Controller may apply to the Court for a declaration of the invalidity of the registration.

Section 52.— (5) Where the grounds of invalidity exist in respect of only some of the goods or services for which the trade mark is registered, the trade mark shall be declared invalid as regards those goods or services only.

Section 52.— (6) Where the registration of a trade mark is declared invalid to any extent, the registration shall to that extent be deemed never to have been made, provided that this shall not affect transactions past and closed.

3) Protection is granted for the official name of the country and/or for variations of those names, such as common names, adjectives or abbreviations subject to the applicable provisions of the Trade Marks Act 1996.