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# **Protection and Examination of Non-Traditional Trademarks**

## **The Irish Experience**

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# Ireland in the world of Intellectual Property



OIFIG NA bPAITINNÍ  
IRISH PATENTS OFFICE

## Party to...

**Paris Union Convention**

**TRIPS Agreement**

**EU Trade Mark & Design Systems**

**Madrid Agreement and Protocol**

**Lisbon Agreement (Appellations of Origin)**

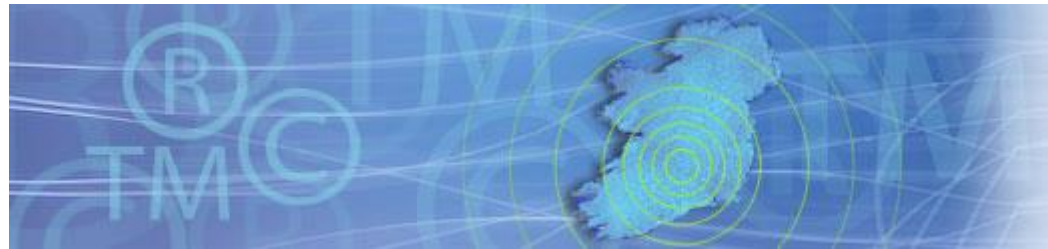
**European Patent Convention**

**Patent Cooperation Treaty**

**Berne Convention (Copyright)**

(...)





- Agency of the Department of Business, Enterprise & Innovation
- Central Mission is to provide an efficient and effective system of industrial property protection that will encourage technological progress and promote enterprise
- Responsible for the protection of intellectual property rights in the fields of patents, trade marks and designs and the dissemination of relevant information in relation to these.
- Team of 48 employees



## **Mission**

- grant protection to Industrial Property (IP) rights
- define specific policies relating to IP
- promote IP among academic, scientific and business community
- provide training on IP
- ensure treatment, access and dissemination of information and documentation of IP
- co-operate with other national and international organisations



# Non-Traditional Trademarks



## Legal Basis

- Trade Mark Directive (EU) 2015/2436 of the European Parliament and of the Council of 16 December 2015
- Provisions further aligning the laws of the Member States relating to trade marks with regard to both substantive and procedural matters
- Requirement for Member States to transpose the Directive within agreed deadline of 14 January 2019



## Key Changes

- Previously a trade mark was any sign capable of being represented graphically which was capable of distinguishing the goods or services of one undertaking from those of other undertakings
- Elimination of the graphic representation from the definition of both EU and National Trade Marks allows for the possibility of accepting new types of trade marks filed in formats not previously provided for
- Now a trade mark may, in particular, consist of words or designs, letters, numerals, colours, the shape of goods or the packaging of goods, or sounds, provided that such signs are capable of being represented on the Register in a manner which enables the determination of precise subject matter of the protection afforded to its proprietor



## Type of mark





## Challenges

- The TM Directive did not include detailed definitions of trade mark types or specific representation requirements
- Resultant risk of different types and representation requirements being accepted by the various EU National Offices
- Major changes required to our e-filing and administration systems to cater for the new mark types
- Training and communication solutions required to support examiners and users



## Solutions

- New EUIPO led project launched to Support the Transposition of the Directive
- Legal support provided to National Offices to help with the implementation process
- Technical assistance provided to help with the adaption of our systems to cater for the new mark types
- Helped by the fact that more than 92% of Irish applications are made through e-filing



## Common Communication

- Key part of the Transposition of the Directive Project
- Aim to ensure that the provisions of the Directive are implemented in a harmonised and consistent manner across the EUIPN
- Emphasis on the definitions and representation requirements for the new mark types
- Acceptable electronic file formats for non-traditional trade marks



## Outcome of Common Communication

- Agreement reached on types of marks, definitions and representation
- Acceptance of electronic file formats to be used for sound, motion , multimedia and hologram marks as shown while acknowledging that future formats arising from technological developments may be acceptable then

Type of trade mark	Electronic file format
Sound	JPEG
	MP3
Motion	JPEG
	MP4
Multimedia	MP4
Hologram	JPEG
	MP4



## Other Considerations

The Irish Office conducts examinations on relative as well as absolute grounds

- Key question is not the type of mark but whether a Likelihood of Confusion exists with an earlier application regardless of type
- New Vienna type codes introduced to help Search process

### 98 - SPATIAL MARKS

9801 - SMELL MARK

9802 - SOUND MARK

9803 - OTHER MARK

9804 - 3D SHAPE

9805 - Hologram

9806 - Motion

9807 - Multimedia

9808 - Pattern

9809 - Position

9810 - Colour per se

## Remaining Issues

- EUIPO Convergence Project launched (CP11)
- Aim to promote agreement between Offices on the examination of formal requirements and grounds for refusal on absolute grounds, (WS1), and relative grounds, (WS2), for the new mark types
- Focused on harmonising practices from the outset, in order to prevent misalignments, multiplicity of practices and legal uncertainty as a consequence of different solutions being found
- Application of the legal standard Sieckmann criteria (a sign must be clear, precise, self-contained, easily accessible, intelligible, durable and objective)



## Further Points to Note

- Very small number of applications of new mark types so far
- Anticipated grounds for refusal include length and complexity of marks, lack of distinctive or memorable elements, not deviating significantly from norm, direct reference to goods or services, similarity with earlier traditional marks
- Management of Priority Claims
- Sound Marks played on different instruments
- Future adoption by WIPO- possible amendment to Rule 9 of the Common Regulations of the Madrid Protocol?



**THANK YOUR FOR YOUR ATTENTION!**

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