Protection and Examination of Non-Traditional Trademarks

The Irish Experience

Bangkok, Thailand | 15.10.2019
Ireland in the world of Intellectual Property

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)

(...
The Irish Patents Office (IEIPO)

- 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


- 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

- Word only mark
- Figurative only mark
- Combined Word & Figurative Mark
- 3D Shape mark
- Colour only mark
- Sound mark
- Hologram mark
- Position mark
- Pattern mark
- Motion mark
- Multimedia 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

<table>
<thead>
<tr>
<th>Type of trade mark</th>
<th>Electronic file format</th>
</tr>
</thead>
<tbody>
<tr>
<td>Sound</td>
<td>JPEG, MP3</td>
</tr>
<tr>
<td>Motion</td>
<td>JPEG, MP4</td>
</tr>
<tr>
<td>Multimedia</td>
<td>MP4</td>
</tr>
<tr>
<td>Hologram</td>
<td>JPEG, MP4</td>
</tr>
</tbody>
</table>
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 YOU FOR YOUR ATTENTION!

johnp.nolan@patentsoffice.ie