



Relate

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Intellectual property

Intellectual property (IP) is the area of law that protects the use and exploitation of ideas, for example, a person's invention or novel. Intellectual property rights were introduced so that people could develop businesses or pursue artistic endeavours using their ideas without fear of others copying or "stealing" those ideas for their own use. Intellectual property encompasses two types of rights: industrial property, which includes inventions (patents), trade marks, industrial designs and models and designations of origin, and copyright, which includes artistic and literary property.

The Patents Office is responsible for providing an efficient and effective system of industrial property protection in Ireland that encourages technological progress and promotes enterprise through the implementation of the relevant legislation.

The Patents Office

The Patents Office operates under the management of the Controller of Patents, Designs and Trade Marks. The statutory functions of the Controller are set out in legislation including the Patents Act 1992, the Trade Marks Act 1996, the Intellectual Property (Miscellaneous Provisions) Act 1998, the Industrial Designs Act 2001, and the European Communities (Supplementary Protection Certificate) Regulations 1993. The Controller also has certain statutory functions under the Copyright and Related Rights Act 2000.

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Functions of the Patents Office

The Controller has many statutory functions including:

- The granting of patents
- The registration of trade marks and designs
- The administration and maintenance of registered industrial property rights
- Registration of copyright licensing bodies, references and applications relating to licensing schemes operated by those bodies, and the resolution of disputes regarding royalty amounts arising mainly in the area of public performance of sound recordings
- Promoting information about intellectual property

The Patents Office has produced a range of publications as general guides to the complex matter of the protection of intellectual property. These are available on its website patentsoffice.ie, as are examples of application documents. It also produces a fortnightly journal, the *Patents Office Journal*, which is also available online.

Types of intellectual property

There are different types of intellectual property rights.

- Patents are concerned with inventions producing a technical result – new and improved products, processes and uses that are capable of industrial application, for example, Dyson vacuum cleaners
- Trade marks are concerned with brand identity – principally of goods and services. They can be distinctive words, marks or other features, the purpose of which is to make a distinction in the mind of a customer between different traders, products and services, for example, the Coca-Cola and Apple logos. A geographical indication, or designation of origin, is a type of trade mark for goods that have a specific geographical origin and possess qualities or a reputation due to that place of origin, for example, Roquefort for cheese produced in that region in France.
- Industrial designs are concerned with the appearance of a product – that is, either the whole or a part of a product's features such as shape, configuration, contours, texture or materials not dictated by functional considerations, for example, the shape of a Mini Cooper
- Copyright is concerned with original literary works such as novels, poems and plays, musical and artistic works, sound recordings and television and radio broadcasts, software, multimedia films, drawings, maps, charts, plans, paintings, photographs, sculptures and works of architecture

There are also other types of intellectual property such as confidential information. This covers business information

such as customer or supplier lists, trade secrets, know-how that a business does not wish to share with its competitors, for example, the recipe for Coca-Cola. The protection of this information is often done by agreement between the parties, for example, confidentiality terms within employment contracts or non-disclosure agreements between inventors and manufacturer.

Patents

The Patents Act 1992 sets out the law on patents in Ireland. Chapter 2 contains the criteria for patentability. For an invention to be patentable it must be:

- New and not the same as anything that already exists
- Inventive and not obvious to a person already skilled in the relevant area of technology
- Capable of being made or used in some kind of industry

Under the Act, the following cannot be regarded as a patentable invention:

- Scientific discoveries and theories
- Aesthetic creations
- A scheme, rule or method of performing a mental act or a program for a computer
- The presentation of information

The following are excluded from patentability under the Act:

- Inventions that by their publication or exploitation would be immoral or against public order requirements
- Plant and animal varieties arising from some biological process

Software is not patentable by itself. Software comprises written computer code and is more usually protected by copyright (see page 7). However, if the software has a technical effect such as a specific control over an industrial process or in the internal functioning of a computer, then it may be patentable.

The benefits of registering a patent

You do not have to register a patent to produce or sell your invention. However, a patent will give you the best opportunity to profit from your invention by preventing others from copying it. There are several other reasons to consider filing a patent, such as:

- Patents allow inventors to raise investment or make other business arrangements while protecting their intellectual property rights

- The prospect of making profits from the exclusive use or sale of a patented invention encourages research activity
- Income derived from a patented invention developed in Ireland may be eligible for favourable tax treatment. Section 234 of the Taxes Consolidation Act 1997 provides that certain income derived from patent royalties is exempt from tax.

Registering a patent

Any person may make an application for a patent. If two or more people are responsible for an invention, they can make a joint application for the patent. If granted, all people who applied jointly will own the patent together.

The right to a patent belongs to the inventor. If an employee creates an invention in the course of their employment, the right to the patent usually belongs to the employer.

A patent application consists of:

- A request for the grant of a patent by completing the application form available from the Patents Office website patentsoffice.ie
- A specification containing a description of the invention, one or more claims (the claims set out the unique matter of your invention and form the basis of the patent protection) and any drawings referred to in the description
- An abstract containing a concise summary of the essential features of the invention. The abstract is for archiving and retrieval purposes assisting third parties in deciding whether the application as a whole might be of interest.
- The application fee

Once a patent application has been made, but before a final patent is granted, the patent is pending. Patent pending is a term often used on products to alert competitors that an application has been made to protect the invention.

A patent application is published in the *Patents Office Journal* as soon as possible after a period of 18 months has passed from the filing date, unless the application has been refused or withdrawn. It may be published earlier if requested by the applicant.

The patent will be granted if:

- No objections to the application are received from the public
- The Controller is satisfied that the application complies with the Patents Act 1992

A patent holder may assign, transfer or license their

patent rights to others in accordance to the rules and laws applicable to the ownership and devolution of personal property. It is a criminal offence for a person to falsely represent that a product sold by them is patented.

Patent agents

Patent law and practice, and the drafting of the specification describing an invention, is complex. Patent agents are specially qualified professionals who file patent applications on behalf of inventors. A list of registered patent agents is available from the Patents Office website. A patent agent can also arrange for patent applications to be filed abroad and can provide advice on making the most of your invention in the market.

Applicants who do not have their principal residence or principal place of business in the State must be represented by a patent agent. When an applicant is represented by a patent agent, all enquiries are directed to that agent and all official communications from the Patents Office are with the appointed agent.

Types of patent

There are two types of patent available in Ireland: full-term patents and short-term patents.

Full-term patents

For a full-term patent to be granted, the applicant must provide evidence of the invention's novelty. An invention is considered novel if it does not form part of the state of the art. The state of the art comprises everything made available to the public in any way, anywhere in the world, before the date of filing of the patent application. Full-term patents give the holder protection for up to 20 years from the date of filing the patent application. A holder may pay a renewal fee within a maximum period of six months from the end of the 20-year period. If the renewal fee is not paid in time, the patent will lapse. If a patent lapses, a holder can apply within two years of the lapse for the patent to be restored.

Short-term patents

Short-term patents give the holder protection for a maximum of 10 years. Short-term patents are intended for inventions where a shorter market life is expected, or inventions that are not technically complex. The application process is simpler and quicker. Short-term patents are usually granted within 12 months of the filing date. You can apply for both a short-term and a long-term patent at the same time in order to get the benefit of the short-term patent sooner

while you are waiting for the long-term patent application process to finish. The short-term patent will become void when the long-term patent is granted.

A short-term application may contain a maximum of five claims (see page 3). A full-term application may contain as many claims as you require.

Supplementary protection certificate

A supplementary protection certificate (SPC) can be obtained for inventions relating to medicinal and plant protection products. The certificate can extend the period of protection beyond the 20-year limit by a further five years. Such products may require rigorous testing and market authorisation before they can be sold commercially. So, in many cases, a patent will have been granted but the invention cannot be sold to the public for a number of years while it is undergoing testing. The SPC compensates the inventor for this loss of time. It does not extend the duration of the patent but only the protection for the specific product subject to market authorisation.

International patent registration

Patents are territorial in effect. For example, an Irish patent only offers protection in Ireland. If patent protection is required beyond the Irish jurisdiction, the following options are available:

- Application under the European Patent Convention – one application provides protection in the EU member states selected by the applicant
- Application under the Patent Co-operation Treaty – one application should provide protection in any countries selected by the applicant that have ratified the treaty. A list of countries that have ratified the treaty is available on wipo.int/pct/en/
- Application made to each national Patents Office or industrial property office of the country where protection is required

The InnovAccess website innovaccess.eu provides access to general information on intellectual property issues including grant and registration procedures and costs in other EU member states.

Patent infringement

If you hold a patent you have the right to prevent others from making, using, selling, or importing your patented invention without your consent. A patent holder may obtain an injunction from the courts to stop the infringement, demand the delivery or destruction of the offending items, and obtain compensation for the infringement or the transfer to the holder of any profits made from the infringement.

Trade marks

The Trade Marks Act 1996 sets out the law on trade marks in Ireland. It defines a trade mark as any sign capable of being represented graphically that is capable of distinguishing the goods or services of one business undertaking from those of another. A trade mark may include designs, letters, numbers and features of the product or its packaging.

The regulation of trade marks has developed to prevent the public from being deceived by a trader alleging they have an association with a certain brand when they do not, and to prevent traders from damaging the reputation of brands.

The benefits of registering a trade mark

Registering your trade mark creates an official record of your rights as the owner of a particular trade mark, and makes it easier for you to prevent others from using it. Trade mark registration is not compulsory but it is advisable as registration provides protection, particularly in the event of a conflict with an identical or similar trade mark. If a trade mark has been registered then it is easier for the owner to demonstrate its trade mark rights and enforce these rights before a court.

Criteria for trade marks

To register a trade mark it must be:

- Defined with sufficient precision to allow infringement to be assessed
- Capable of standing in place of the trade mark without the need for supporting samples
- Reasonably practical for people inspecting the register to understand from the graphical representation what the trade mark is

Not all trade marks can be registered. A trade mark will be refused registration if it:

- Is devoid of any distinctive character
- Consists exclusively of signs or indications that designate the quality, quantity, intended purpose, geographical origin, or other essential characteristics of goods or services
- Is contrary to public policy or principles of morality
- Consists of a state emblem of Ireland (without the consent of the Minister) or a representation of the national flag of the State and it appears the use of the trade mark would be misleading or offensive
- Is identical to an earlier trade mark and the intended

- goods or services are the same
- Is applied for in bad faith
- Is likely to deceive the public, for example, as to the nature or geographical origin of the goods

Trade mark classes

The Nice Classification, established under the Nice Agreement (1957), divides goods and services into various categories (known as 'classes'), for example, food and drink, paper products, financial services. When you apply to register a trade mark for a particular product or service, you must select the specific classes for which you intend to use the mark. It is important that when an application is made all the goods and or services for which the trade mark will be used are listed on the application form. Additional classes of goods and services cannot be added to the application after it has been filed at the Patents Office.

These classes define the extent of the protection your registration will have. For example, Apple registers its trade mark in the technology categories, but not in the food and drink categories. There are 34 classes of goods under the Nice Classification and 11 classes of services. Details of the Nice Classification and these classes are available on wipo.int/classifications/nice/en/.

Registering a trade mark

The Patents Office is responsible for the registration of trade marks. Before making an application to register a trade mark it is important to carry out a search of the existing registers, including the international registers, for any identical or similar trade marks. The registers are available on the Patents Office website patentsoffice.ie.

Once satisfied that your trade mark does not conflict with an existing mark (or at least does not conflict within the same classes), you can apply for registration. The application form is available on the Patents Office website and it can be completed online or submitted by post. There is an initial application fee of €70 and a further fee of €70 for each additional class. When the application process is completed by the Patents Office there is a final registration fee of €177.

Once a valid application is received, a filing date and application number will be assigned to the application and a filing receipt will be issued. This date is used for priority purposes. For example, if a subsequent application is made by someone else for registration of an identical or similar trade mark, you can claim priority and your application will take precedence over the other application.

When an application is completed, the Patents Office will search the relevant registers against the application, and the mark will be examined to ensure it does not conflict with requirements of the Trade Marks Act 1996.

Once the content of the application is accepted, a notice will be published in the *Patents Office Journal* seeking any objections. After three months, the objection period is closed and the Office will request the final registration fee before issuing a certificate of registration. Trade marks are treated like personal property and an owner of a trade mark can assign or transfer the use of that mark to another.

Trade mark agents

The registration of trade marks can be complex. Trade mark agents are specially qualified professionals who can assist with registering a trade mark. A register of trade mark agents in Ireland is available on the Patents Office website.

International trade mark protection

If you require trade mark protection beyond the Irish jurisdiction, the following options are available:

- Application to the European Union Intellectual Property Office for a European Union trade mark, which will provide registration in the 28 EU member states
- Application for international trade mark registration under the Madrid Protocol. The Madrid Protocol is an international system of registration that is administered by the International Bureau of the World Intellectual Property Organization (WIPO). This international system of registration gives a trade mark owner the option to apply to protect their trade mark in any of the countries that signed the treaty using a single application form in a single office with a single set of fees.
- Application made directly to the relevant national industrial property protection office of the country where protection is required

Duration of a trade mark registration

A trade mark will be registered for 10 years from the date of registration. Registration can be renewed for subsequent periods of 10 years. The current renewal fee is €250 and €125 for each additional class.

Trade mark infringement

If you own a registered trade mark you have exclusive rights to use that mark. A person infringes your trade mark if,

without your consent, they use an identical or similar mark, within the area of registration, for the same or similar types of goods and services so that a likelihood of confusion might occur among the public.

A registered trade mark owner may obtain an injunction from the courts to stop the infringement, demand the delivery or destruction of the offending items, and obtain compensation for the infringement or the transfer to the holder of any profits made from the infringement.

Passing off

Passing off occurs when others trading under a name, mark or description that is so similar to your trade mark it is likely to mislead or cause confusion among the public. In the case of *McCambridge Ltd v Joseph Brennan Bakeries* the Supreme Court deemed that the presentation or packaging of the product (bread) at the centre of the case, led, or was likely to lead the public to believe that another manufacturer made the product in question. The law against passing off applies even if the trade mark has not been registered.

Even where a person wishes to use their own name in the course of a trade, a person cannot do so in a way that is calculated to mislead the public to believe the goods or services are those of another. Unauthorised use of a registered trade mark 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.

A trader who has been the victim of passing off will be entitled to compensation from the person responsible for passing off if the act is likely to have caused damage to the reputation of the victim's business. A range of remedies are possible, including the award of damages, injunctions, or orders for seizure of goods.

Designs

The Industrial Designs Act 2001 sets out the law on design protection in Ireland. It defines a design as the appearance of the whole or a part of a product resulting from the features of, in particular, the lines, contours, colour, shape, texture or materials of the product itself or its ornamentation. In general, design refers to a product's overall form and function, for example, the shape of a Volkswagen Beetle. However, although the design of a product may have technical or functional features, industrial design, as a category of intellectual property law, refers only to the aesthetic nature of a finished product, and is distinct from any technical or functional aspects.

What is registerable?

Section 11 of the Industrial Designs Act 2001 provides that a design that is new and has individual character is registerable under the Act.

A design is considered to be new if no identical design has been made available to the public before the date of filing the application for registration or, where priority is claimed, the date of priority. The design must have individual character.

The Controller may refuse an application for the registration of the following:

- Designs incorporating protected official symbols or emblems
- Designs that are considered to be contrary to public order or morality
- Where the design constitutes an infringement of a copyright work under the Copyright and Related Rights Act 2000

A design can be registered with the Patents Office by a process similar to that of trade marks (see page 5). Once registered, the author of the design will be the owner of that design and may transfer the use of it to others. Registration of a design lasts for five years and may be renewed for four subsequent periods of five years each, for a total of 25 years.

A registered design owner may obtain an injunction from the courts to stop the infringement of their design rights, demand the delivery or destruction of the offending items, and obtain compensation for the infringement or the transfer to the holder of any profits made from the infringement.

Industrial design protection

An unregistered Community design is a right that automatically comes into existence by making the products incorporating the designs available to the public within the EU. This right is limited to three years but provides a useful short-term protection for items of short market duration such as clothing and footwear.

For design protection in the EU, an application can be to the European Union Intellectual Property Office for a registered Community design valid in all 28 EU member states. A registered Community design is protected for a period of five years. It can be then renewed four times giving a maximum of 25 years of protection.

Industrial design protection is obtainable on an international basis under the Hague Agreement administered by the World Intellectual Property Organization (WIPO). This provides for a single international registration with individual effect in each of the contracting parties of the Agreement.

Copyright

The Copyright and Related Rights Act 2000 sets out the law on copyright in Ireland.

Copyright protection covers works such as:

- Original literary, dramatic, musical or artistic works
- Sound recordings, films, broadcasts, television programmes
- The typographical arrangement of published editions
- Computer programs (within the meaning of Section 2 of the Copyright and Related Rights Act 2000)
- Original databases (a collection of independent works, arranged systematically)

The term "artistic works" refers to items such as photographs, paintings, prints, sculptures, works of architecture, craftsmanship. The term "literary works" refers to items such as plays, novels, lyrics and computer programs that are written using specialised language.

The owner of copyright is the author. The author is the person who creates a work, such as:

- The producer of a sound recording
- The producer and principal director of a film
- The person making a broadcast or, in the case of a broadcast which relays another broadcast by reception and immediate retransmission without alteration, the person making that other broadcast
- In the case of a cable programme, the person providing the cable programme service in which the programme is included
- In the case of a typographical arrangement of a published edition, the publisher
- In the case of a computer-generated work, the person who undertakes the arrangements necessary for the creation of the work
- In the case of an original database, the individual or group of individuals who made the database
- In the case of a photograph, the photographer

Copyright is a form of personal property and can be transferred by the author to another person or to a company. For example, a musician will transfer their copyright to their record label, which will distribute the music.

Where an employee in the course of their employment creates a work, the employer is the owner of the copyright in that work, unless an alternative agreement exists.

Copyright protection

Copyright is an automatic right that the author obtains as soon as their work is put into a physical form, for example, a book, recording, canvas. There is no registration system for copyright owners in Ireland. Essentially the act of creating the work creates the copyright.

No copyright protection is provided for ideas while the ideas are in a person's mind. Copyright law protects the form of expression of ideas, not the ideas themselves.

It is advisable to have some way of proving that you are the author of an original work and when the work, and consequential copyright, was created. One method is to post a copy of the work to yourself by registered post and then keep the sealed envelope showing the official postal date stamp.

It is important to show that copyright is claimed in a work. Works should be clearly marked to show who the copyright owner is and the date from which copyright is claimed. The internationally recognised symbol © is normally used to indicate that a work is protected by copyright. For example, © Copyright John Smith 2017.

The benefits of copyright protection

Copyright is a property right and the owner of a work can control the use of that work. For example, an owner has the exclusive right to prohibit or authorise others to:

- Copy the work
- Perform the work
- Make the work available to the public through broadcasting or recordings
- Make an adaptation of the work

These acts are known as 'acts restricted by copyright'.

Copyright protection provides an incentive to create intellectual works. It provides benefits in the form of economic rights which entitles creators to obtain an appropriate economic award. Without copyright protection such works could be exploited by others without paying any remuneration or royalties to the owner of the work. Copyright protection also gives moral rights to be identified as the creator or author of certain kinds of material and to object to the distortion and mutilation of it.

The Citizens Information Board provides independent information, advice and advocacy on public and social services through citizensinformation.ie, the Citizens Information Phone Service and the network of Citizens Information Services. It is responsible for the Money Advice and Budgeting Service and provides advocacy services for people with disabilities.

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Duration of copyright protection

Copyright lasts for different periods of time depending on the form of the work.

For example, copyright in:

- Literary, dramatic or artistic works lasts for 70 years after the death of the author
- Film lasts for 70 years after the last of the following people dies – the director, the author of the screenplay, the author of the dialogue and the author of the music specifically composed for use in the film or 70 years from the date the film is first made publicly available if that date is within 70 years of the death of the last of the above people
- Sound recording lasts for 50 years after the recording is made or the date the recording is first made publicly available if that date is within 50 years of the recording, or if either of those events occurs after 1 November 2013, the copyright lasts for 70 years
- Broadcast lasts for 50 years from the date of the first public broadcast
- Computer-generated works lasts for 70 years from the date the work is first made publicly available

Copyright infringement

Copyright infringement is a criminal offence. A person infringes the copyright of another when they, without the permission of the copyright owner, undertake any or all of the acts restricted by copyright (see page 7).

Secondary infringement occurs when a person does any of the following with a copy of a work, which they know or believe to be an infringing copy, without the permission of the copyright owner:

- Sell, rent or lend it, or offer or expose it for sale, rental or loan
- Import it into the State, otherwise than for their own private and domestic use
- In the course of a business, trade or profession, have it in their possession, custody or control, or make it available to the public
- Otherwise than in the course of a business, trade or profession, make it available to the public to such an extent as to prejudice the interests of the owner of the copyright

A copyright owner may obtain an injunction from the courts to stop the infringement, demand the delivery or destruction of the offending items, and obtain compensation for the

infringement or the transfer to the owner of any profits made from the infringement.

There are many exceptions to the law against copyright infringement. They mainly include "fair dealing" exceptions for the purposes of private research and study, criticism and review of works, and incidental inclusion of copyright material in another work. Exceptions also include educational and library or archival use. For example, the Act provides that prescribed libraries and archives are able to lend works without payment of royalties.

Regulation of copyright licensing bodies

Under the Copyright and Related Rights Act, 2000, the Controller of the Patents Office has certain statutory functions. These are concerned with the registration of copyright licensing bodies, references and applications relating to licensing schemes operated by licensing bodies, and the resolution of disputes regarding the payment of royalty amounts arising in the area of public performance of sound recordings.

The Controller maintains a Register of Copyright Licensing Bodies and a Register of Licensing Bodies for Performers' Property Rights.

The information in *Relate* is intended as a general guide only and is not a legal interpretation