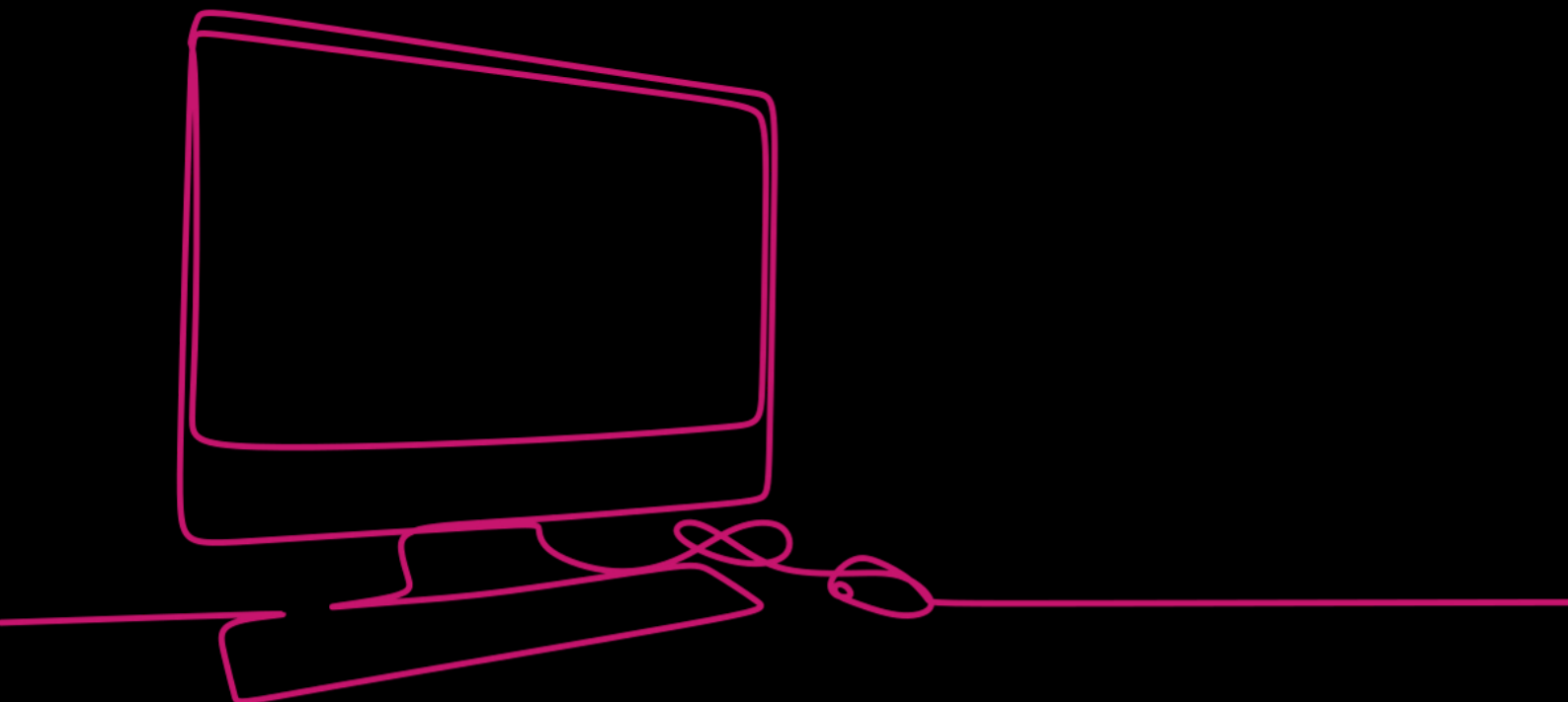


**stobbs**

Intangible Asset  
Management

# Trade Marks in Ireland

Your brand is valuable. We've created this guide to help you maximise and protect your highest value asset.



# Why protect your brand?

If you sell a product or provide a service, you'll know that your customers recognise and identify your brand by reference to one or more distinguishing features. These might include your company name, product name, logo, slogan, or visual clues in your packaging and signage. These identifying features are known as 'trade marks'.

Having these identifying features allows you to create a brand identity and brand value. They give you a competitive edge in today's crowded marketplace as they help your customers instantly identify your brand. Intangible assets are worth >60% company value in the majority of industry sectors\*.

Brand owners want to have clear ownership of their trade marks and be able to protect their brand from anyone who tries to create copycat or lookalike products that dilute and take advantage of their brand value.

If you want to secure exclusivity in your name, logo or any other valuable symbols belonging to your brand, it could be time to think about registering a trade mark.

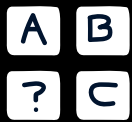
In a nutshell, a trade mark registration can give you a legal right to the exclusive use of the sign as applied for, in the chosen territory, in relation to the goods and services covered.

\*Brand Finance 2021

Why?

# What can be registered as a trade mark?

A trade mark can be...



Words



Pictures



A combination of words and pictures



Other symbols such as sounds, holograms and multimedia files

and should be...

- 1** Distinctive enough to identify the goods and services originating from your business from those of any other business
- 2** Clearly different from any other mark which is already owned by somebody else (especially for similar goods or services)
- 3** Not deceptive or misleading to consumers or contrary to other rules of law

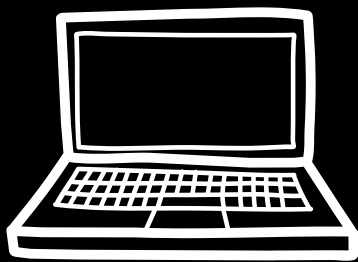
It's common sense that everyday language should be free to all to use, and that terms that are customary within a trade should not be monopolized by any one business. Therefore, trade marks cannot be legally registered if they are common words that are descriptive of the goods or services that they refer to.

For example:

“The Bakery” could not be registered in respect of a bakery business. However, “The Red Dog Bakery” could be eligible, since the name ‘Red Dog’ is distinctive.

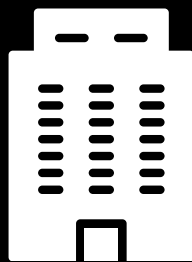
# When should I register my trade mark?

Both new businesses and established companies can benefit from registering trade marks.



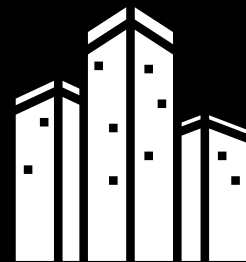
**New businesses**

If you are thinking about launching a new business or a new product or service, it is a good idea to ensure you are free to use the name you prefer. Registering your trade mark will help keep that identity clear by making public the record of your ownership.



**Businesses already trading**

If your brand is copied you may find the infringer causes damage to your business. Trade mark registration makes it easier, faster, and less costly, to take swift action against copycats.



**Established businesses**

Even if you have been using a name successfully for years, it would be worth registering your trade mark. Any reputation or goodwill already attached to the name will translate into capital, for example if you sell the business and its intellectual property rights.

Unfortunately, all too often, companies who do not register their trade mark find it becomes a serious problem when some other trader creates an identity which causes confusion. It is much more difficult, and much more expensive, to try to take action if you don't have registered rights to prove you have legal ownership of your own brand.

# How long will my trade mark last?

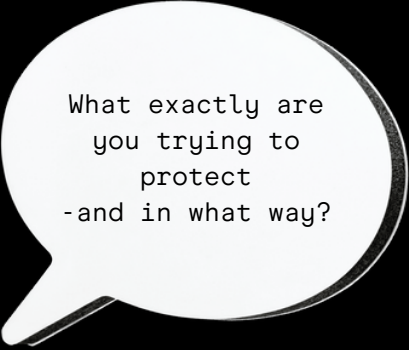
Trade marks can last indefinitely, subject to the payment of renewal fees at regular intervals.

These fall due every ten years in Ireland, the UK and at EU level. This means that an owner can protect their brand for as long as they would like.

Compared to other types of intellectual property rights, trade marks offer a very enduring way to protect your intellectual property's value.



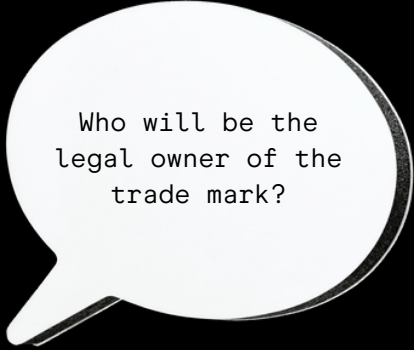
# Four questions before you register your trade mark...



What exactly are  
you trying to  
protect  
-and in what way?

A basic question, but one deserving of careful thought. Is it a name, or a particular stylised version of a name? Is it a name always used together with a logo? Exactly what you see on the trade mark application form is exactly what protection you will obtain.


Applications should be very specific, so that it is completely clear to both the Applicant and the Examiner precisely what is to be protected.



Who will be the  
legal owner of the  
trade mark?

The owner must put the mark to genuine commercial use to maintain its validity in the long run.


While ownership may be transferred, this involves some administration and the payment of supplementary fees.



What goods or  
services do you, or  
will  
you, offer?

Every trade mark registration lists the related goods and services to which protection is afforded. These must also be specified clearly in a trade mark application.

These goods and services must be categorised in accordance with a standard international classification system.



Where will you need  
protection?

Consider where you conduct business and where you intend to conduct business in the foreseeable future. Every territory has its own legal system and costs. Would a national mark in Ireland provide adequate protection? Would you require cover for the counties in Northern Ireland?

Your trade mark agent should be able to help you decide upon the best overall strategy for your business.

# Costs

Costs generally depend on the number of classes included in a trade mark application, as well as the territory or territories where protection is sought. We can advise you about what to protect and where based on your professional ambitions- so you don't over-pay or leave yourself at risk.

We want to properly understand your objectives and how you work and acknowledge that this approach will require a certain amount of time on our part for which we would not expect to charge. We believe that this is all part of creating the right kind of long-term relationship.

At Stobbs, we provide you with a clear understanding of what is covered along with a tailored quote for every trade mark application. As a guide to help Irish businesses understand the typical costs of a trade mark, we have prepared the following indicative table.

<b>Territory</b>	<b>Ireland</b> (Protection in the ROI)	<b>UK</b> (Protection in the UK including Northern Ireland)	<b>EU</b> (all EU member states)
One trade mark in one class*	€647*	€620*	€1,620*

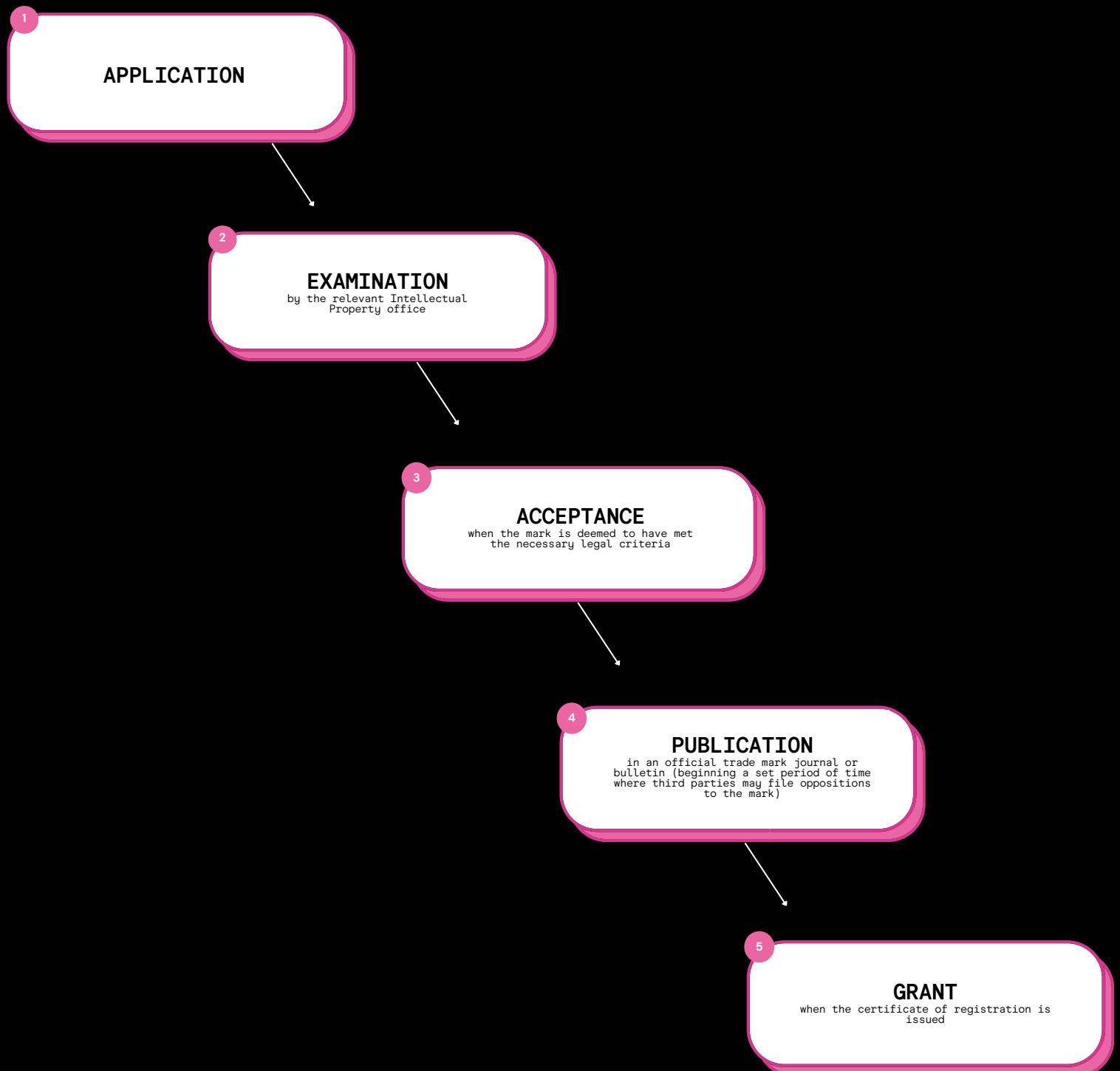
- Additional fees apply for second and subsequent classes of goods and services.
- The costs above do not include VAT.
- Fees are correct as of January 2023.

The quoted services also include checking and reporting the official publication, checking and completing registration formalities and acting as an address for service during the first ten years of the trade mark. If no official and/or third party oppositions are encountered, these would be the only costs incurred during the initial ten year period.

It is important to note that if there are objections or oppositions, tackling these will incur additional costs. It is also important to note that once an application is submitted, it may not be amended and the costs are not refundable.

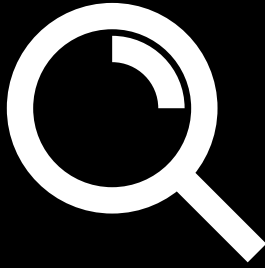
# What's the process?

The typical time frame from application to registration, if there are no objections, is approximately 5-6 months, but this can vary from country to country. There are five main stages in the trade mark registration process.





# The benefits of...

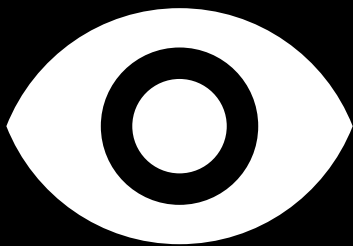


## Clearance services

before you apply for  
a trade mark

Earlier trade marks or other rights, owned by another entity, may pose a legal obstacle to successful registration of your chosen mark.

We can perform clearance searches to locate similar trade marks, business names and domains and assess the legal and commercial risks they might pose before you file. Clearance searches are priced depending on factors including the type of mark (whether your mark is a word, image or combination), the goods and services for which protection is being sought, and the geographical scope of the search.



## Watching services and enforcement advice

after registration

After a trade mark is registered, it is important that brand owners maintain a proactive stance on enforcement as most intellectual property offices do not routinely prevent the registration of similar marks.

We can assist by providing watching services to monitor for the publication of new marks which bear resemblances to yours, and we can provide you with opinions on how to take action if your trade mark is being infringed.

# Our Team



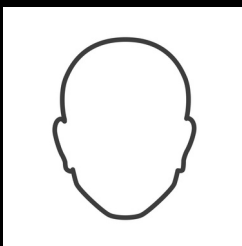
**Mary White**  
Operations Manager,  
Ireland



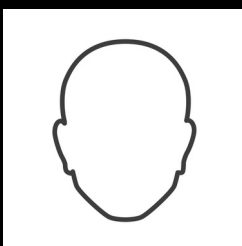
**Tasneem Madani**  
IA Executive



**Gretha Cachia**  
IA Executive



**Nicola Scott**  
IA Paralegal



**Mollie Gaffey**  
IA Paralegal

We advise strategically and holistically based on our unmatched breadth of expertise that makes up IAM.

We take a commercially-savvy approach based on thorough understanding. We provide commercial, practical and proactive advice – as standard. There are no surprises – scope, budget and timings are all agreed up front.

We take a virtual in-house approach – we are an extension of your team. We believe in cultivating strong, long lasting relationships. The more we understand, the more we can help.

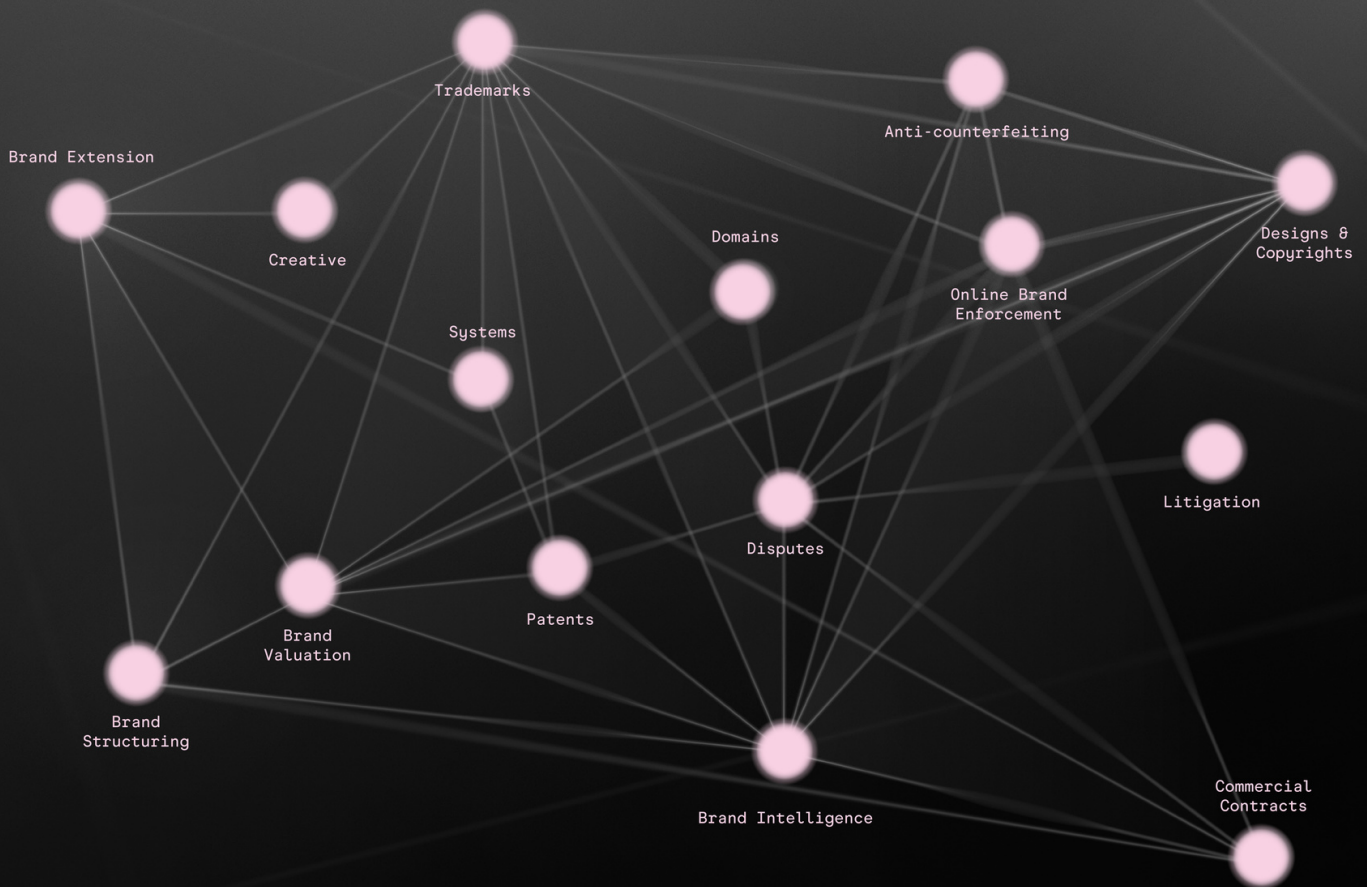
We bring commitment, flexibility and value. We go above and beyond. We have competitive and flexible fees and offer a range of different charging models.

We are on a mission to become the best brand advisory firm in the world- and that includes Ireland.

# Our full range of services

## Intangible Asset Management:

the best interests of brands require  
expertise across a breadth of capabilities.



# More detail on some services that are relevant to you (part one)

## Brand development.

We help clients build robust brands from the outset. We work with:

- start-ups
  - companies who are launching new brands or new products
  - companies who are renaming or rebranding
  - design agencies who are assisting with brand development
- to build a brand development brief that will ensure your design is as legally robust as it is aesthetically pleasing and commercially sound.

## Conflict searching.

Searching helps identify inherent legal risks before starting the process of protecting your brand. Our in-house searching capability covers 100+ countries, using the best technology to search comprehensively and accurately. Where there are potential concerns, we deep-dive to assess both the legal and the commercial risks. Your trade mark attorney prepares a clear, easy to read summary, and we help you incorporate the knowledge acquired into your business. With the right strategy, you can confidently invest in your brand.

## Trade mark applications and prosecution.

Stobbs is one of the most prolific filers of trade marks in the EU. We can directly file trade mark and design applications nationally in Ireland, in the UK, and in the EU. We also file International (Madrid) trade mark applications and we work closely with our network of trusted associates when local expertise is required. We can help you to grow your brand, right around the world.

## Watching.

Our watching services cover everything from trade marks and domain names through to keywords, social media and web content.

# More detail on some services that are relevant to you (part two)

## Litigation.

Our litigation team - based in the UK - consists of experienced solicitors. We do not rely on litigation to generate fees so we are in a better position to use it as it should be used - as a tool to achieve the right commercial result. We have experience of acting in the High Court and Intellectual Property Enterprise Court (IPEC). We can cover IPEC cases for a fixed cost.

## Domain name management.

We operate our own domain management service. This lets our clients manage their domains and trade mark portfolios from one place. Our client area platform provides full functionality and pricing information, including the technical management of domains.

## Brand extension.

We offer unparalleled assistance in brand licensing. Dealing with brands every day means that we look beyond the deal to the overall brand strategy, health and value of the brand. We have deep expertise in sourcing, structuring, negotiating, executing, and administering brand licensing deals in diverse industries in over 40+ jurisdictions. We have encountered - and solved - the full gamut of challenges in establishing and running profitable and commercially-savvy brand licensing programs.

## Brand intelligence.

We have our own in-house intelligence agency consisting of a team of highly capable experts with years of relevant experience. We operate from the depths of the dark web to the high streets of the UK and EU, and beyond.

## Anti-counterfeiting.

We take a holistic approach to enforcement both online and in the real world. We devise strategies that provide a good deal of standardisation on low level matters, but also provides input on commercially more important issues so that the real underlying issues can be addressed.

# Let's connect.

Choosing the right legal advisor is important.

Get in touch with a member of our team for a free consultation at our office, online or by telephone - so you can see for yourself if our approach will suit you.

Contact us at (01) 9103260 or [ireland@iamstobbs.com](mailto:ireland@iamstobbs.com).