

INTELLECTUAL PROPERTY

Law guide - Intellectual property

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Contents

Protecting your ideas	3
Passing off	6
Non-disclosure agreements	9
Confidentiality	11
Patents	14
Trade marks	16
Copyright	22
Performance rights	26
Moral rights	31
Design rights	35

Protecting your ideas

Overview

This section looks at how you can prevent someone from making unfair use either of your reputation or of your confidential information. The former is concerned with 'passing off' and the latter involves a consideration of how the law deals with issues of confidentiality and how you can take additional steps to protect yourself.

Passing off

'Passing off' is where a third party uses the goodwill (such as a mark or a logo) associated with your goods or services without authorisation which causes, or is likely to cause, the public to become confused between your goods and services and the goods and services, of a third party resulting in, or potentially resulting in, financial loss to you. For example, usually, passing off cases would involve the scenario of the infringer 'copying' the 'get-up' of your goods/services by copying your packaging and overall presentation as seen by the consumer. This could cause the consumer to purchase the 'infringer's' goods/services unintentionally, when they actually believe they are purchasing your goods/services, resulting in a loss of sales to you. Passing off is often used as an additional/alternative court action to registered trade mark infringement claims and may succeed even if the registered trade mark claim does not.

Passing off is based on the premise or idea that no one has the right to represent his goods/services as the goods/services of another. Passing off must be in relation to third party use of your goodwill in a commercial activity.

If you wanted to raise an action of passing off, the three elements that you must prove are 1) that you own goodwill or reputation in the mark 2) that the infringer's activities are likely to, or are causing, misrepresentation leading to confusion on the part of the public (i.e. that the goods/services are associated with yours) 3) that damage has been, or is likely to be caused, for example, a loss of profits.

Defences to passing off include:

- use of own name
- use other than in the course of trade
- that you have no goodwill or reputation in the mark
- your acquiescence
- no provable loss to you

If you can prove passing off, remedies include:

- an application for injunctive relief to prevent the use of the mark
- damages or an account of profits

- an order to change the way the offending product is packaged or presented
- an order for delivery up or destruction of the offending products
- declaration as to rights (Where, for example, two separate businesses have honestly acquired a reputation in a single mark or name, but in separate geographical areas, the court might make a declaration to specify that one business has the rights in the mark or name in one area, and the other business has the rights in the mark in the other area.)

Confidentiality

The broad principle under the law is that a person who has received information in confidence cannot take unfair advantage of it. That person must not make use of it to the detriment or disadvantage of the person who gave it without obtaining his consent.

For a breach of confidence claim to succeed, three criteria must be met:

1. The information must have the requisite quality of secrecy or confidence. For the information to be considered confidential, it must appear to have a confidential quality to it. A good indicator of whether information is confidential is whether it is labelled as such on the outside of a folder or if it contains a confidential watermark running through it. The consequences of the information being released into the public domain may also be relevant to the decision as to whether the information has the necessary confidential quality. For example, in areas such as patents or the registering of designs, certain information becoming public knowledge prior to the patent or design being registered would have huge consequences for the application. In a case such as this, the information would be treated clearly as confidential due to the nature of the outcome of that information being released into the public domain.

2. The information must have been disclosed in circumstances importing an obligation of confidence. When secret information is dealt with in a commercial setting it is usually the case that an obligation of confidence is created by an express contractual provision. These are called non-disclosure agreements and are a standard business practice across many different fields. If the obligation of confidence is not expressly provided then, in certain cases, there will be an implied duty of confidence. An example of where this would arise is in an employment setting, as employees are considered to owe an implied duty of confidence concerning trade secrets and such like to their employers.

3. There must be an unauthorised use of that information to the detriment of the party communicating it.

Whether information in a particular case is confidential, depends on all the circumstances. An express agreement (i.e. a non-disclosure agreement) about what is confidential information and what use may and may not be made of that information will avoid disputes arising. In addition, employment contracts will usually or should have a clause or covenant specifically detailing that all knowledge which an employee has gained in relation to the intellectual property of his employer during his tenure as an employee remains confidential. Similarly any breakthroughs made during the course of employment regarding the

improvement of any aspect of an employee's intellectual property (e.g. creating a new app for a smartphone or a writing a new computer programme) remain the property of the employer.

In addition, a non-disclosure agreement will:

- create certainty
- establish a contractual obligation
- facilitate enforcement and support a claim under the general law by creating the relationship of confidence that is the required basis of a claim
- set out in detail the conduct that the disclosing party expects from the recipient

In commercial negotiations, non-disclosure agreements can be vital.

The following types of information may need to be kept confidential:

- The detailed commercial information provided to the recipient in the course of negotiations. This can include everything that the recipient finds out from the disclosing party - from customer lists to manufacturing processes.
- The fact that negotiations are taking place and their status. A leak of this nature is particularly detrimental when a listed company is involved as it could force the parties to make an announcement or expose them to allegations of insider dealing. But private companies do not normally want their employees, customers, suppliers or lenders to know about a proposed deal until they are confident it will go through. This is particularly true in the case of an acquisition. One of the oldest tricks used by acquirers is to let everyone know that the target business is for sale, putting it into a state of uncertainty, possibly even affecting its value and giving the acquirer a stronger negotiating position.
- The existence of the agreement, its detailed terms and conditions. The disclosure of this information could also be detrimental to the discloser (assuming that no listed company is involved and therefore no obligation to announce under market rules) and cause uncertainty in that it would alert people to the fact that some major commercial transaction was imminent.

Passing off

Overview

If one business has distinguishing or easily recognisable features, another business cannot mimic them in an attempt to pass them off as their own. There are several possible remedies available if this happens as well as a number of defences in the event of a claim.

Reputation and goodwill of a business is something that is used to try to give an identity to a business and its goods/services that distinguishes them from those of their competitors.

If someone else uses this goodwill and reputation, the owner of the business can stop this by using the law against passing off. In order to succeed in a passing off action the claimant has to prove that:

- they possess a reputation or goodwill in their goods, name, mark, etc.
- there has been a misrepresentation by the defendant which has led to confusion
- this misrepresentation has caused damage to the claimant's reputation or goodwill in the claimant's goods, name, mark, etc.

Requirements for a claim

To succeed in a claim for passing off, the claimant must first prove that they have established a reputation in a mark by using it in business and that the use is associated with their name personally or their goods/services.

The claimant must also show that the mark distinguishes them and/or their goods/services from others. Marks can have many different forms, for example:

- style of packaging (e.g. the Smarties tube)
- colour (the gold foil in Ferrero Rocher chocolate)

The length of time required to establish goodwill is a matter of fact in all the circumstances and there is no hard and fast rule on this.

In order to succeed, the claimant must also prove that the infringing act has taken place within the geographical limits of their goodwill. It is not necessary for the owner to set up a business in the UK in order to show that they have established goodwill there.

Cases involving the geographical limits of goodwill are difficult to reconcile and the outcome depends on the facts of each case. Two cases can best explain this.

In 1967, the Crazy Horse Saloon of Paris (which had no UK base but was known there) was unable to stop the opening of a similarly named but otherwise unconnected club in the UK. In a further UK decision in 1964, however, the Sheraton Hotel Group (which at that time had no UK base but was known and took bookings for its overseas hotels from there) was able to

stop the opening of a similarly named hotel in the UK. Clearly, it is a judgment that a court will make based on the facts of an individual case.

In contrast in the Republic of Ireland the seminal case of *C & A Modes and C & A Ireland v C & A (Waterford) Ltd* (1975) is the early authority on the attitude of the Irish Courts towards passing off. This case concerned an Irish defendant company which registered in 1972, used the name 'C & A' and operated a clothing business. The UK plaintiff had used the symbol 'C & A' since 1953 and it succeeded in its application for an injunction restraining the defendant from using the name of C & A. The High Court held that it had been the defendant's intention to deceive the public.

It should be noted that registration of a company name will also be refused, or a company may be directed to change its name up to six months after its registration, where the Registrar considers that the company's name is identical or too similar to the name of a pre-existing company (CA 1963 s.23(2)). If the Registrar directs a change of name, the company must change its name within a period of six weeks from the date of the direction and failure to comply with the direction is a criminal offence (s.23(3)).

The long running passing off and trade mark infringement Budweiser litigation case between the Anheuser-Bush and the Budejovicky Budvar Organisation involving the US Corporation and a Czech company in respect of the use of the name "Budweiser" has led to proceedings being brought in 40 Countries since 1966. However, a case taken in the UK in the early 1970s failed because Budweiser did not enjoy any reputation or goodwill in the UK. Since then the landscape has dramatically changed with Budweiser being an instantly recognisable brand.

The requirement to prove actual damage seems to have been followed in the recent *B & S v Irish Auto Trader* case – the defendant in this case used the word "Autotrader" as a heading for its used car section. The application by the plaintiff was refused because the Court held that it was unlikely that car dealers would be deceived and if members of the public examined the defendant's magazine thinking that it was the plaintiff's magazine, they would quickly see that it was not the case.

Misrepresentation

The claimant must prove that in the course of trade, the defendant made a representation that was misleading. It does not matter if the representation is true as long the overall effect is to mislead. Moreover, there is no need for the representation to be made by the defendant with the intention that confusion will result.

The real issue is the effect on the customer. Will the customer believe that there is an association between the defendant's goods/services and the reputation of the claimant?

Confusion alone is not enough for an action for passing off. There must be also be actual and quantifiable loss to the claimant.

Damage to the claimant

To succeed in a passing off claim, the claimant has to show actual or likely business loss associated with the defendant's act. The loss need not be financial and the term 'business' is widely interpreted to include many things.

There can be loss to goodwill even before the claimant's business has begun if advance publicity and marketing has established goodwill. Similarly, there can also be damage to goodwill after the claimant's business has stopped.

Remedies

The claimant in a passing off action may claim any of the following remedies:

- an inquiry to establish loss
- damages or an account of the defendant's profits
- an order for the delivery up or destruction of the infringing articles
- injunctive relief

Defences

A defendant can start by denying that the necessary elements to establish a passing off action exist. Further, the following defences can be used:

- The claimant's mark is not distinctive.
- The claimant's mark is merely descriptive.
- The mark has ceased to be distinctive and has become generic.
- The claimant and the defendant have concurrent rights.
- The defendant is merely innocently using his own name.
- The claimant has given his or her consent.
- The claimant has delayed in issuing proceedings.
- The claimant has abandoned the mark.
- The claimant has exhausted his or her rights.

Often where someone believes that they have the benefit of an unregistered mark, they will seek to warn off others. They can do so by using the TM sign in order to preserve the mark.

Non-disclosure agreements

Overview

When information is given to third parties in confidence, it is necessary to ensure that it cannot be divulged to anyone else. Whilst the law provides some protection against this, it is often best to enter into a written non-disclosure agreement (NDA).

Where the information is formal and important enough to justify a full written confidentiality agreement, the following matters can be dealt with in the agreement:

- For whose benefit can the information be used?
- To whom can the information be disclosed and whether these third parties have to sign a confidentiality agreement?
- On what terms is the information to be used?
- How can the information be reproduced and stored?
- When does the obligation to pay for the information arise?
- What happens if the recipient claims he already possesses the confidential information?
- What happens if someone else later publishes the information?
- In what circumstances must the information be returned to the owner?

Alternatives to NDA

There are instances where, for example, an inventor sends confidential information concerning their invention to another person in order to discuss possible future co-operation.

In the absence of any agreement on confidentiality, it is possible for that other person to refuse to acknowledge that they cannot divulge the information passed to them. A non-disclosure agreement would offer the best protection to the inventor. Failure to agree terms of confidentiality could put the ability of the inventor to obtain a patent over the product in jeopardy.

However, it is not always practical to insist that a non-disclosure agreement be signed before negotiations. In such circumstances, it is best for the inventor to send the confidential information in a sealed envelope clearly marked 'confidential', not to be opened until the accompanying letter is read and its terms accepted.

As a back-up, the inventor can deposit a sealed copy of such letter with a third party (with the third party endorsing the date of receipt on the sealed envelope) or post a copy to themselves by recorded or registered delivery. This method has been endorsed by the Irish Courts particularly in relation to copyright but the pretext is the same. The envelope should of course remain sealed. The unopened envelope endorsed with the date of receipt can

provide evidence in any later litigation that the confidential information was in the possession of the owner at the relevant time. All registered packets can now be tracked with proof of delivery easily available whether from An Post or some other provider.

Covenants in restraint of trade

Apart from entering into a confidentiality agreement, the parties can agree on covenants in restraint of trade. A covenant is a contractual promise. These covenants can cover non-competition (for example, a promise by an employee not to set up or join a business that competes with the employer's business after the end of the employment), non-solicitation of customers (for example, a promise by one business not to poach customers from another business) as well as non-disclosure. They may be found in agreements with employees, franchises, distribution agreements and agency agreements.

For a covenant in restraint of trade of a former employee to be upheld, the covenant has to be reasonable both as to geographical area covered and the duration of the restriction. It has to be used only to the extent necessary to protect a legitimate interest.

A practice has grown up to ensure non-disclosure by key personnel through the inclusion of so-called 'garden leave' clauses in contracts of employment. This describes the practice whereby an employee who is leaving a job (having resigned or whose employment has otherwise been terminated) is instructed to stay away from work during their notice period, while still remaining on the payroll. This practice is often used to prevent employees from taking with them up-to-date (and perhaps sensitive) information when they leave their current employer, especially when they are leaving to join a competitor.

Employees continue to receive their normal pay during garden leave and are covered by any contractual duties, such as confidentiality agreements, until their notice period expires.

To be enforceable, the 'garden leave' clauses have to be reasonable.

Confidentiality

Confidentiality law

The law of confidentiality is useful in the commercial world as it recognises that certain information that has been divulged in circumstances imposing an obligation of confidence should be protected. The requirements are considered further below. The scale of confidentiality varies greatly and starts with trade secrets at one end, e.g. the recipe for a market-leading product. At the other end of the scale of importance comes the firm, which does not want its competitors to know how many customers it has or who these customers are. Breach of confidentiality does not depend on an express contract between the parties (although non-disclosure agreements are often used to ensure certainty) and it has the following three elements:

- The information must have a necessary quality of confidentiality itself. For the information to be considered confidential, it must appear to have a confidential quality to it. A good indicator of whether information is confidential is whether it is labelled as such on the outside of a folder or if it contains a confidential watermark running through it. The consequences of the information being released into the public domain may also be relevant to the decision as to whether the information has the necessary confidential quality. For example, in areas such as patents or the registering of designs, certain information becoming public knowledge prior to the patent or design being registered would have huge consequences for the application. In a case such as this, the information would be treated clearly as confidential due to the nature of the outcome of that information being released into the public domain.
- The information must have been imparted in circumstances importing an obligation of confidence. When secret information is dealt with in a commercial setting, it is usually the case that an obligation of confidence is created by an express contractual provision. These are called non-disclosure agreements and are a standard business practice across many different fields. If the obligation of confidence is not expressly provided then in certain cases there will be an implied duty of confidence. An example of where this would arise is in an employment setting, as employees are considered to owe an implied duty of confidence concerning trade secrets and such like to their employers.
- There must have been an unauthorised use of the information to the detriment of the party communicating it

Quality of confidentiality

For information to be of a confidential nature, it has to be sufficiently important and have involved some thought or effort on the part of the person who had the idea. It cannot just be a general concept. The test for this is as follows:

- The information must be such that the owner believes disclosure would be injurious to them or would be advantageous to their rivals or to others.
- The owner of the information must believe it to be confidential or secret and not already in the public domain.
- The owner's belief in the above must be reasonable.
- The information must be judged in the light of usages and practices of the particular trade or industry concerned.

Obligation of confidence

In the absence of an express contractual term imposing confidentiality, there are a number of circumstances that can give rise to an obligation of confidence. The most obvious ones are between solicitor and client, doctor and patient and between an employer and his or her employee during the course of employment.

In less obvious situations, the test used to determine whether the circumstances will give rise to an obligation of confidence is whether, at the time of receipt of the information, the circumstances were such that it would be obvious to a reasonable person that the information was confidential.

Although the original recipient of information may owe a duty to the owner of the information to keep that information confidential, the obligation of confidentiality will not necessarily extend to a third party who acquires the information from the original recipient. This is particularly true if the third party does not know that the information is confidential. In these circumstances, it is possible that the third party can use or disclose the information as they wish, even though the original recipient of the information breached the duty they owed to the owner by disclosing the information to the third party. However, if such third party acquires or receives information in circumstances in which he or she knows, or ought reasonably to know, such information is confidential, such third party may also be bound by the obligations of confidentiality until the relevant information becomes available to the general public.

Unauthorised use

Information that remains locked in the mind of the person who obtains it cannot cause a problem. It is only when there is unauthorised use of the information that the law of confidentiality steps in. For example, the information may have been supplied to another party in order for that party to do a specific task, for example, personal information may be passed to an employee of a company for the sole purpose of entering the data into the company computer system. If they were to do just that, it would constitute the authorised use of the information. If that person used the information for any other purpose such as disclosing it to others, then this would constitute an unauthorised use of the information.

Remedies

The remedies for breach of confidence consist of injunctive relief, damages, or an account of profits, and delivery up or destruction of documentation containing the relevant information.

Defences

There are several defences to a claim of breach of confidentiality available to the recipient of information. These include where the recipient can show that the information is no longer confidential because it is now public knowledge through no act of the recipient (the recipient cannot be allowed to benefit from his or her own wrongdoing).

In addition, there is the defence of public interest. The court will not respect an obligation of confidence if it is in the public interest that confidential information is made known to the public.

Conclusion

Suing for an alleged breach of an implied duty of confidence should be considered a last resort, primarily because you cannot know with certainty before you begin proceedings that the court will find that a duty of confidence can in fact be implied at all, or what the extent of that duty will be considered to be in your particular case. Imposing specific ways to protect confidential information on the recipient is of far more use than suing for breach of an implied duty of confidence. Practical steps include adopting a procedure for retention and destruction of documents, marking documents that are confidential, and entering into non-disclosure agreements.

Patents

Overview

The law relating to patents is governed by the Patent's Act, 1992, the Intellectual Property (Miscellaneous Provisions) Act, 1998 and the Patents (Amendment) Act, 2006. A patent confers upon its holder, for a limited period, the right to exclude others from exploiting (making, using, selling, importing) the patented invention, except with the consent of the owner of the patent.

A patent is obtainable for any patentable invention and will grant the owner protection for a maximum of twenty years. A short-term patent is also available in the Republic of Ireland, which is valid for a maximum of ten years.

Patentability

An invention is patentable if it is susceptible of industrial application, is new, and involves an inventive step. There is no definition in the 1992 Act of 'invention'. However the following shall not be regarded as an invention:

- (a) a discovery
- (b) a scientific theory
- (c) an aesthetic creation
- (d) a mathematical method
- (e) a computer programme
- (f) the presentation of information

An invention will be considered new if it is novel and does not form part of the state of the art. This means everything that is made available to the public before the date of filing of the patent application. The invention must have involved an inventive step and must be capable of being made or used in some kind of industry, including agriculture.

Grant of a patent

In order to obtain a patent a formal application must be made to the Patents office in Kilkenny. An application for a twenty-year patent must contain the following;

- (a) a request for a grant of a patent
- (b) a specification containing a description of the invention to which the application relates, one or more claims, and any drawing referred to in the description of the claim
- (c) an abstract

Every application must be accompanied by the correct filing fee and must clearly disclose the invention to which it relates. The claim or claims shall define the matter for which protection is sought, be clear and concise and be supported by the description.

Trade marks

Introduction to trade marks

A trade mark protects any sign or symbol that allows your customers to tell you apart from your competitors. You can register a name, numerals, logo, slogan, designs, letters, domain name, shape, smell or sound.

A trade mark must be:

- distinctive for the goods and services to which you wish to apply the trade mark
- not deceptive, contrary to public policy, law or morality or registered in bad faith

If your trade mark meets these requirements, you may want to consider applying for a registered trade mark. For further information on registering a trade mark, please visit The Irish Patents Office (www.patentsoffice.ie).

Your trade mark does not have to be registered, but an unregistered mark can only be protected by relying on the common law of passing off or (in some cases) copyright infringement. A registered trade mark is preferable as it gives you a statutory monopoly to use that mark (e.g. in the ROI then an ROI Mark) for the goods and services under which it is registered. It is much easier to pursue infringers under registered trade mark infringement as opposed to passing off.

If you have a registered trade mark, you must renew it every 10 years to keep it in force.

You can likewise apply for a European mark or a global mark. For further information please contact the Irish Patents Office.

General

Trade marks and the protection of trade marks are generally covered by the provisions of the Trade Mark Act 1996. Section 6(1) the Trade Mark Act defines a trade mark as being:

“any sign capable of being represented graphically which is capable of distinguishing goods or services of one undertaking from those of another undertaking”

An “undertaking” is understood to mean a commercial entity, a business or an individual acting in the course of business.

The sign must be distinctive to be a trade mark and ideally should be registered as soon as possible. The word “sign” incorporates a wide definition capable of covering, for example, words (including personal names), designs, letters, the shape of packaging of goods themselves, sounds, and even smells. Once registered, it becomes exclusive property of the registered proprietor in respect of the goods and services under which it is registered. This means that a third party cannot use the registered trade mark in relation to the same goods or services under which it is registered, or in exceptional circumstances, at all.

Trade mark protection is jurisdictional; therefore a trade mark which is only registered in the Republic of Ireland is only protected in the Republic of Ireland. However, registered trade marks can be obtained to include a European or an International trade mark to cover as many countries as is necessary for the proprietor. A trade mark which is registered only for the territory of the Republic of Ireland will enjoy protection for a period of ten year. Thereafter, an application for must be made and the renewal fee paid.

However, please note that under certain circumstances a trade mark can be revoked or invalidated.

Trade marks are registered in use classes and you should register the mark only in relation to the use classes which you intend to apply your goods or services to now or within the next five years. There are 45 use classes available: 34 classes of goods and 11 classes of services. The choice of use class is important since the mark is given monopoly rights in the relevant class(es) for goods/services registered.

A mark will not be registered:

- unless it has a distinctive character (for example, it is not possible to register the mark 'banana' for bananas)
- where the mark consists exclusively of signs or indications which simply designate the kind, quality, intended purpose, value, geographical origin, time of production or other characteristic of the goods or services, e.g. 'Cork trailers' for trailers made in Cork
- where the mark consists exclusively of signs or indications which have become customary in the current language or in the bona fide and established practices of the trade

In relation to these first three grounds for refusal there is, however, an exception that will still allow the mark to be registered if it can be shown that before the date of application for registration and following the use which has been made of it, that the mark has already acquired a distinctive character. Further grounds of refusal (which do not benefit from this exception) are:

- if the mark is contrary to public policy or accepted morals
- if the mark is likely to mislead the public as to the nature, origin or quality of the goods
- if the mark is prohibited under Republic of Ireland statute or EU law
- if the mark is a specially protected emblem such as a national flag or the national harp symbol – derivatives of this sign may be used but are subject to scrutiny and may be refused
- if the mark consists exclusively of the shape which results from the nature of the goods themselves or consists of a shape which is necessary to obtain a technical effect or a shape which gives substantial value to the goods

- if the application is made in bad faith. There is no definition of 'bad faith'. Whether an application was made in bad faith has to be determined based on the circumstances of the particular case. Some typical examples are where:
 - a distributor applies for the mark in his own name
 - the applicant has clearly copied another's well-known unregistered mark
 - there is no bona fide intention to use the mark. For example, an antiques dealer including in his specification 'beer' and providing no evidence of any connection with brewing when challenged.
 - an application is made for a mark for a range of goods 'confectionary, chocolate, biscuits, cakes etc.' whereas the intention was only to use the mark for a particular lollipop. This bad faith case was strengthened by evidence that the applicant knew the opponent planned to use the mark.

While the registering body will look at all circumstances of any particular case, it has been suggested that bad faith 'plainly includes dishonesty and ... also some dealings which fall short of the standards of acceptable commercial behaviour observed by reasonable and experienced men in the particular area being examined.'

In addition there are situations where the registering body may refuse registration. This may happen if the mark:

- is identical to an earlier mark and the application is in respect of identical goods or services
- is identical to an earlier mark and the application is in respect of similar goods or services
- is similar to an earlier mark and the application is in respect of identical goods or services
- is similar to an earlier mark and the application is in respect of similar goods or services and there exists a likelihood of confusion on the part of the public which includes the likelihood of association with the earlier trade mark
- is identical or similar to an earlier mark where the earlier mark has established a reputation and the latter mark would take unfair advantage of or be detrimental to that reputation
- is likely to be contrary to a rule of law protecting an unregistered trade mark, e.g. passing off or other intellectual property right (e.g. copyright, design right or registered design)

Procedures for application

It is usual and advisable to engage a trade mark agent or solicitor to assist in the drafting and pursuing registration of a trade mark. The first step is to search the register to find whether there are any conflicting marks in the use class(es) chosen by the applicant.

If the search indicates that there is no conflicting prior mark, an application form can be submitted to the Irish Patents Office for a Republic of Ireland mark). A charge is payable to

the Patents Office for lodging a trade mark application for the first class and also for each subsequent class. If the application is successful then the registration fee is also payable irrespective of how many classes the mark is intended to cover. The applicant has to submit details of the mark and its proposed use. The Trade Marks Examiner will examine the application to decide whether the mark meets the necessary requirements and search the register for possible conflict with earlier marks. If the mark does not meet the necessary requirements, the Trade Marks Examiner may object to the application. If it does meet the necessary requirements, but there is a possible conflict with earlier marks, the Trade Marks Examiner will notify you and ask you whether you still wish to proceed with the application. If you do proceed with the application, the proprietors of the earlier marks will be notified.

The Patents Office will then publish the mark in the next Official Journal which is published every two weeks. Anyone who wishes to raise an objection should send Notice of Opposition to the Patents Office along with the prescribed fee do so within three months. Thereafter the applicant and the objector will be given an opportunity to file papers to support either support for or objection to the registration. The final decision as to whether to register the mark or not in favour of the applicant rests with the Patents Office.

Trade mark infringement

A registered trade mark is a property right. It can be bought or sold or licensed, either entirely or partially. The owner's exclusive rights to a trade mark are infringed if, in the course of trade, a person does any of the following (even without specific knowledge of the registration and/or intent to deceive):

- uses a mark which is identical to a registered trade mark in relation to goods and services identical to those for which the mark is registered
- uses a mark which is identical to a registered trade mark in relation to goods and services similar to those for which the mark is registered and there is a likelihood of confusion in the public mind
- uses a mark which is similar to a registered trade mark in relation to goods and services identical to those for which the mark is registered and there is a likelihood of confusion in the public mind
- uses a mark which is similar to a registered trade mark in relation to goods and services similar to those for which the mark is registered and there is a likelihood of confusion in the public mind
- uses a mark which is identical or similar to the registered trade mark where the proprietor of the registered mark has established a reputation and such use, without due cause, would take unfair advantage of or be detrimental to the character or the repute of the earlier trade mark

'Use' of the mark includes putting it on business papers, goods or packaging, or offering, marketing, importing, advertising or stocking goods or supplying services under the mark.

Remedies

In an infringement action, the registered owner may claim any of the following remedies:

- damages or an account of profits
- an order for the offending sign to be erased, removed or obliterated from any infringing goods, material or articles. If this is not reasonably practicable, an order may be sought for the infringing party to destroy or deliver the infringing goods to a person in the court direct.
- injunctive relief

Defences

Comparative advertising occurs when one business refers to the mark of another when promoting its own goods and services as set out in the European Union Council Directive 97/55-EC. However, there will only be no infringement if the use is according to honest practice in industrial or commercial matters and is not detrimental to the other mark. While the issue has not been tested here to any great extent, it is not unreasonable to expect that the Irish Courts would follow the UK in this regard.

A registered trade mark is not infringed in the following circumstances, subject to such use being in accordance with honest practices:

- if the trade mark happens to be a person's own name or address
- if the trade mark is used to indicate the kind, quantity, quality, geographical origin and time of production of goods or other characteristic of the goods or services. An example would be a soft drink maker who tells customers of the branded sweetener in their product.
- if the use is necessary to indicate the intended purpose of goods and services. An example would be the sale of spare parts for third party products.
- In addition, a registered trade mark is not infringed:
 - by using an unregistered trade mark, which has been used continuously before registration or first use of the registered trade mark
 - by using a registered trade mark in relation to goods and services that are covered by that registered trade mark even if there is a similar registered trade mark belonging to someone else
 - by using, in the course of trade in a particularly locality, an earlier right (unregistered mark) which applies only in that locality

Losing a trade mark

Registration of a trade mark may be revoked if:

- a mark is not put to genuine use within five years from completion of registration and there is no proper reason for non-use
- use of the mark has been suspended for an uninterrupted period of five years and there is no proper reason for non-use
- the mark has been allowed by the owner to become a common name in the trade
- because of the use made by the owner or with their consent in relation to the goods or services for which it is registered, the mark becomes misleading to the public

An application for revocation can be made by anyone to the Registrar or to court, depending on the circumstances.

Surrender of registered trade mark

A registered trade mark may be surrendered by the proprietor in respect of some or all of the goods or services for which it is registered.

Invalidation of registered trade mark

The registration of a trade mark may be declared invalid on the grounds that it should not have been registered in the first place i.e. one of the absolute grounds of refusal (i.e. one of the situations described above where an application must be refused) can be met. It can also be made invalid if it was registered despite there being an earlier trade mark which is either identical or similar to your registered trade mark and in relation to identical or similar goods or services, subject to certain conditions being met. This would only apply where the proprietor of the earlier registered trade mark had not consented to your registration. An application for invalidity of a registered trade mark may be made to the Registrar or to the Court, depending on the circumstances.

Trade marks abroad

Although a Republic of Ireland registered trade mark is protected only in this country, it can be used as the basis of one or more international filings. The procedure for registering an international trade mark based on a Republic of Ireland registered trade mark is set out by the Madrid Protocol and is handled by the World Intellectual Property Office ('WIPO'). The contracting parties to the Protocol (called a Madrid Union) consist of the countries under which an international trade mark may potentially be covered; an international application is not necessarily worldwide. You would be required to choose which members of the Madrid Union you would like to register your mark under. For a list of the members of the Madrid Union, please visit [Members of the Madrid Union](#).

Copyright

Overview

Copyright is a right to stop others from copying one's works without permission and it arises automatically without the need for registration. Copyright protects original artistic, literary, dramatic or musical works.

Copyright can only exist in the expression of an idea in a tangible form. It is works, rather than ideas, that are protected. The distinction is difficult to draw, but an example may be useful to show what are protected under copyright law.

If a photographer takes a picture of a landscape, that picture will be copyright. The picture cannot be copied without the consent of the photographer. However, this does not prevent another photographer taking a similar picture of the same landscape. The second photograph, though using the idea of the first, would not be a reproduction of the first photograph; indeed a separate copyright would exist in that second photograph.

Copyright law protects only works that are 'original'. Original means that the works are not copies of another work. In other words, the works must originate from their author's own skill and judgment.

The following work types are capable of being protected by copyright:

- literary, dramatic, musical or artistic works
- sound recordings, films, broadcast or cable programs
- typographical arrangement of published editions

As already stated, The Copyright and Related Acts, 2000 (as amended in 2004) is the principal statute governing Republic of Ireland copyright law. The 2000 Act repealed much of the earlier governing copyright law but not all. The various statutes which are still applicable may be found in Section 10 of the 2000 Act. In addition the principal international conventions which protect copyright are the Berne Convention and the Universal Copyright Convention (the 'UCC'), which lay down minimum standards of protection for copyright owners in countries that have ratified the conventions.

Ownership of copyright

The basic rule is that copyright belongs to the author of the work concerned. If a work is created by two or more persons and it is not possible to identify their individual effort, they will be joint owners of the work. If an employee makes the work in the course of his employment, the employer is the owner of any copyright in the work, subject to contrary agreement.

Rights of the owner of the copyright

The owner of a copyright has exclusive rights in relation to the work in the Republic of Ireland to:

- copy it
- issue copies of it to the public or to rent or lend copies of the work to the public
- perform, show or play it in public, broadcast it or include it in a cable program service
- make an adaptation of it
- do any of the above in relation to an adaptation of it

'Adaptation' includes e.g. translation, conversion into a strip cartoon, as well as conversion of a literary into dramatic work and vice versa. For example, if a novel is converted into a silent film (there is no reproduction of the original work but reproduction of a dramatic adaptation).

Infringement

Primary infringement occurs if a person, without the copyright owner's licence, does any of the acts outlined above in relation to the whole, or a substantial part, of the work, either directly or indirectly. Copying need not be direct, and it need not be conscious or deliberate. All that is necessary for infringement is that the later work is somehow derived from the original.

Secondary infringement occurs when, in relation to an article which is, or which he knows or has reason to believe is an infringing copy of the work, a person:

- imports an infringing copy into the Republic of Ireland
- possesses an infringing copy in the course of business
- sells or hires or offers or exposes for sale or hire the infringing copy
- distributes or exhibits an infringing copy to the public in the course of business
- distributes an infringing copy (even if not in the course of business) to an extent which prejudicially affects the copyright owner
- without the licence of the copyright owner, makes, imports, possesses in the course of a business or sells or hires, or attempts to sell or hire, an article specially designed or adapted to make copies of an infringing copy knowing or having reason to believe that it is to be used to make infringing copies
- without the licence of the copyright owner transmits a copy of the work by means of a telecommunication system, knowing or having reason to believe that infringing copies of the work will be made as a result of receiving the transmission in the Republic of Ireland or elsewhere
- permits a performance of an infringing work in a place of public entertainment, unless when that person gave permission he believed on reasonable grounds that the performance would not infringe copyright

- supplies apparatus or any substantial part of it for the public performance of an infringing work, or allows such apparatus to be brought onto premises, if he knew or had reason to believe such apparatus would be used to infringe the copyright
- supplies a copy of a sound recording or film which he knew or had reason to believe such recording or film would be used to infringe copyright

In contrast to primary infringement, the state of the infringer's mind is relevant to secondary infringement. The infringer will only be liable if they knew or had reason to believe that they were dealing with an infringing copy or that an infringing copy or public performance would be made.

Defences

There are a number of specific exceptions to infringement. Listed below are the more commonly used defences:

- authority or consent from the copyright owner
- In case of secondary infringement, the infringer did not know or had no reason to believe that they were dealing with an infringing copy or that an infringing copy or public performance would be made.
- Fair dealing: This relates to the use of the work for the purpose of research, private study, for criticism, review and news reporting.
- Photographs of works in public places: There is no infringement for someone to paint, draw or photograph a building or a piece of sculpture or suchlike work that is permanently displayed in public.
- Public interest: Disclosure of the work was necessary because it was in the public interest.

Remedies

Remedies for infringement of copyright include the following:

- damages which are usually based on lost profits or licence fees
- account of profits
- delivery up of infringing copies
- seizure of infringing copies available for sale or hire in premises to which the public have access
- an injunction against the infringer to get them to stop

Examples

To have a better understanding of how copyright law works, we will turn to the different types of work that are protected by copyright law to see how long the protection lasts and what amounts to infringement.

Literary, dramatic, musical or artistic works

Generally, copyright in literary, dramatic, musical or artistic work ends after 70 years starting from the end of the calendar year in which the author (or if more than one, the last surviving author) dies. If the author is unknown, copyright ends either 70 years from the end of the calendar year in which the work was made or if made available to the public in that time, at the end of the period of 70 years from the end of the calendar year in which it was made available to the public.

In respect of computer-generated work, copyright ends 50 years from the end of the calendar year in which the work was made.

Sound recordings, films, broadcast or cable programs

Copyright in sound recording expires 50 years after its first release, or if it is not released, 50 years after it was made, or if within that period the recording is not published, but is made available to the public by being played in public or communicated to the public, 50 years from the end of the calendar year in which it was first made available. Released means when the film sound recordings are shown to the public or published, or broadcast or included in a cable service, except where this occurs without authorisation.

Copyright in a film expires 70 years from the end of the calendar year of the death of the last to die of the principal director, the screenplay author, the dialogue author or the composer of any music specially written for the film.

Copyright in broadcasts lasts for 50 years from the end of the calendar year in which the program was broadcast.

Typography of published books and music

There is a separate copyright in the typographical arrangements of published editions of literary, dramatic and musical works, distinct from the copyright in the works themselves.

The copyright belongs to the publisher and lasts for 50 years from publication.

Performance rights

Overview

The rights of performers, musicians, singers, and actors, amongst others, and those with whom they contract to control and exploit their performance are of particular importance to the entertainment industry. The performance is an integral part of the product that is exploited.'

Performance rights are the central concern of that part of the Copyright and Related Acts 2000 (as amended) devoted to related rights or neighbouring rights. These rights exist quite independently of copyright and moral rights in any works. Since the law of copyright in this area is extensive, this guide will only deal with performer's rights in a general way. Performers' rights are of particular importance to individuals who do not own the copyright in the works performed. The rights of performers and those with whom they have exclusive recording contracts to require their consent for the exploitation of a performance and creates offences in relation to dealing with or using illicit recordings and certain other related acts. A performance is a dramatic performance that includes dance and mime, musical performances, readings, recitations of a literary work, performances of a variety act, or any other similar presentation. The performance in question must be a live performance by one or more individuals and there is no need for the performers to be in front of an audience or for the performance to be particularly spectacular or original. It should be noted, however, that the definition of an audience is a wide one and a private presentation of a dramatic work to bank officials, after work for instance, has been held to be an audience and therefore copyright protection would attach itself to nature of the presentation.

If the performance in question is also the first fixation or recording of a new work (i.e. the first time that it is fixed in a tangible medium of expression; for example, the video recording of a dramatic performance), then the work may also qualify for copyright protection, but in some jurisdictions these rights do not extend to sportsmen, although special categories such as ice-skating may well qualify as a performance.

The protection is only given to qualifying individuals who are citizens or residents of the EC or where the performance takes place in a qualifying country (i.e. Republic of Ireland, member of the European Economic Community, etc.). A performer's right can be infringed if, without the consent of the performer or the exclusive licensee, a third party:

- makes a recording of or transmits live a qualifying performance
- makes, either directly or indirectly, a copy of a recorded performance
- exploits a recording by using it to show or play in public
- broadcasts it, or uses it in a cable programme service
- imports, possesses or deals with an illicit recording of a performance

A recording is defined as a film or sound recording which is made directly from the live performance or from a broadcast of the performance or directly or indirectly from another recording of the performance.

Exploitation

Most performers will, during the course of a professional career, sign a number of contracts. These can be of two main categories: standard terms or individual contracts.

Standard terms

The standard terms category accounts for most of the day-to-day dealings of performers and businesses. Certain professional units and guilds within the Republic of Ireland may agree rates of pay or collective terms prior to television broadcasts. The agreements provide for the payment of a basic fee for limited transmission rights. If further exploitation of a work is proposed then repeat fees may be payable together with fees for transmission overseas and for other exploitation of the performance such as video release. Performers enjoy statutory protection in the Republic of Ireland.

Individual contracts

Individual agreements are likely to be the subject of greater negotiations. Such agreements typically relate to longer term exclusive contracts such as for the services of a pop group or a well-known actor.

Performer's rights

Performance rights are divided into property rights and non-property rights. Property rights are those which can be transferred or sold to, and exercised by, a third party. Non-property rights are those which cannot be transferred or sold, and which can only be exercised by the performer.

Performer's property rights

A performer has three main property rights and these are:

- a reproduction right
- a distribution right
- a rental and lending right

The reproduction right is infringed when someone makes a copy of a recording of the whole, or a substantial part, of a performance otherwise than for their private or domestic use.

The distribution right is infringed when a person issues to the public copies of a recording of the whole, or a substantial part, of a performance.

The rental and lending right is infringed when copies of a recording of the performance are rented or lent to the public.

Performers may sell or make gifts of all or part of their property rights by way of assignment (legal transfer), or may make gifts of their rights in their Will, in the same way that they can deal with other property.

Performers' future property rights may also be assigned and it is also possible to grant an exclusive licence of a performer's property rights. An assignment must be in writing, as must an exclusive licence.

In agreements concerning film production between a performer and a film producer, unless the agreement provides to the contrary, the performer is assumed to transfer the rental rights in their performance to the film producer. Most agreements will deal with this point explicitly.

Although the rental right may be transferred, the performer retains the right to some remuneration for the rental of the film containing their performance. This is what is known as an equitable right and the performer may not assign this right to anybody except a collecting society, nor can this right be waived. An organisation such as the Phonographic Performance Ireland Limited (PPI) may perform this function by collecting money for actors and musicians. The amount paid as equitable remuneration is to be agreed by or on behalf of the person to whom it is payable.

Performer's non-property rights

A performer also has certain non-property rights. These are the right to:

- consent to the recording of live performances
- consent to the use of the recording

Where these rights are infringed by a person who without the performer's consent, imports into the UK, possesses or deals with, illicit recordings the performer has the right to raise an action for infringement.

These non-property rights are not assignable or transmissible. However, on death of a performer, these rights may be passed by a Will. For the purposes of these non-property rights, consent may be given either directly by the performer or by a person who has an exclusive licence with the performer.

Where a commercially published sound recording of the whole, or any substantial part, of a qualifying performance is played in public or included in a broadcast or cable programme service, the performer is entitled to remuneration from the owner of the copyright in the sound recording. This is known as an equitable right and this right cannot be excluded or restricted.

The question of whether or not consent has been given is fundamental to non-property rights. A singer may agree to perform live for a promoter. If that promoter records and subsequently sells the recording of the performance without the singer's knowledge, the singer's rights will have been infringed.

Assuming that the same performance is recorded, but this time the singer has been notified in advance of an intention to record the performance and agrees either by their conduct or because there is a written agreement consenting to the arrangement, then they cannot claim that the promoter is infringing their rights.

Consent may be inferred by conduct where a recording is made with the performer's knowledge. There may also be a question of the amount of any payment to be made in return for the consent.

Rights of persons with recording rights

Previously, it was only the performers who had enforceable rights in their performances; however, current legislation has created rights for those who have the benefit of exclusive recording contracts with the performers. It is therefore possible to infringe the rights of the owners of exclusive recording agreements e.g. record labels.

An exclusive recording contract is a contract between a performer and another person under which that person is entitled exclusively to make recordings of the artist's performance for commercial exploitation. Commercial exploitation means with a view to the recordings being sold or let for hire or shown or played in public.

Infringement of these rights will occur when a third party makes a recording of the licensed performance for commercial purposes; the recording is shown or played in public, broadcast or sent in a cable programme, imported into the Republic of Ireland other than for private or domestic use, sold or let for hire, or offered or exposed for sale.

A live broadcast is not an infringement of the rights of the person with an exclusive recording contract, although the broadcast of a recording will be an infringement of these rights. Recording rights may be assigned (legally transferred). However, a performer may exclude such a possibility in a recording contract.

As with moral rights, performers' rights last for 50 years from the end of the calendar year in which the performance took place or, if during that period a recording of the performance is released, 50 years from the end of the calendar year in which it is released. The principal remedies are those of injunction and damages. Additional remedies allow an application for the delivery up (handover) of illicit copies of a performance and the seizure of illicit copies, which are exposed or otherwise immediately offered for sale or hire. Criminal remedies also exist for making or dealing in illicit recordings which include imprisonment or a fine.

It is important that any consent given by the performer covers the method of exploitation proposed for the work in question. The terms of any consent contained in a contract should be carefully considered before use is made of the performance in any new or anticipated media.

Similar considerations apply as with the construction of copyright licences. The 2000 Act provides for a number of permitted acts that may be done in relation to a performer's rights. These are similar to the permitted acts that may be done in relation to copyright works. These broadly include the following:

- fair dealing for the purposes of criticism or review
- incidental inclusion of a performance or a recording
- various exceptions allowing the playing, showing and recording of works including performances for educational establishments
- research and private study
- provisions in relation to copying by librarians and archivists are also in the 2000 Act

Moral rights

Overview

Moral rights are rights that the creator of a work is automatically entitled to and which no one else can claim. The moral rights of a work can even remain with the creator after their death.

Moral rights exist alongside copyright in certain types of work. Generally, moral rights remain with the author of a work or pass to the author's estate on death. Unlike copyright, moral rights cannot be assigned (legally transferred). However, they are frequently waived.

Moral rights are divided into four categories as follows:

- the right to be identified as the author or director of a work, often known as paternity right
- the right to object to derogatory treatment of a work sometimes known as integrity right
- the right to privacy of certain photographs and films
- the right to object to false attribution of a work

The first three rights mentioned above exist for as long as copyright exists in a work i.e. life plus 70 years. The last right, that is to object to false attribution of a work, lasts until 20 years after a person's death.

The existence of moral rights raises an important additional element in the negotiation and drafting of certain agreements. Unfortunately, for many authors the transfer/licence of copyright is often accompanied by the insistence of the purchaser on the waiver of those moral rights.

Paternity rights

The author of a copyright literary, dramatic, musical or artistic work or the director of a copyright film has the right to be identified as the author or director of the work. If the author of the work uses a pseudonym, initials or other form of identification, then that form of identification will be used to identify the author of the work.

In order to be enforceable, this right needs to be asserted in writing either in the form of a statement on the text itself or by a letter written by the author to the person who will be dealing with the copyright in the work. In other words, if the right to be identified is not asserted in either of these ways, the person may deal with the copyright in the work without being obliged to identify the author. Once the right to be identified is asserted, various people will be bound by such an assertion.

If the assertion of the right to be identified is contained in an assignment of a copyright, the person to whom the copyright is assigned (the assignee) and anyone to whom any rights in

the copyright may have been given or passed by the assignee or on the assignee's death will be bound by the assertion of the right to be identified whether or not they have notice of it. An author's right of paternity may be asserted as follows:

'The author has asserted his/her moral right in accordance with Section 107 of the Copyright and Related Acts 2000.'

Authors and directors are well advised to insist upon this right in any dealings with their copyright works. In practice, if they are able to assert such a right, if the work is published commercially, performed in public, broadcast, or copies of the work are issued to the public, the author must be identified.

If a film is based upon a book then the author of the book must be identified or given a credit in the film. This right does not apply to computer programs, typefaces, or any computer generated works. It does not apply to work created by an employee whose employer is the first owner of the copyright in the work or the director of a film, where the director is not the author of the film for copyright purposes.

It is not infringed where any of the exceptions to infringement apply under Section 108 of the 2000 Act. For example, fair dealing with the work (this relates to the use of the work for the purpose of research, private study, for criticism, review and news reporting) or incidental inclusion of a work, for example:

- there is a fleeting or partial glimpse of some copyright work e.g. a snippet of a programme on a television screen in the background of shot
- a quick camera pan across a poster on a wall or a billboard on the street
- a brief or partial shot of a magazine cover, for example, in a doctor's waiting room where filming is taking place.
- where there is some background music playing where you are filming, e.g. in a lift or shop (and it has not been deliberately included e.g. added in the edit)

It does not apply to any work made for the purposes of reporting current events and does not apply in relation to publication in a newspaper, magazine or similar periodical, or an encyclopaedia.

Derogatory treatment

The author of a copyright, literary, dramatic, musical or artistic work and the director of a film have the right not to have their work subjected to derogatory treatment. The treatment of a work will be derogatory if it amounts to distortion or mutilation of the work or is otherwise prejudicial to the honour or reputation of the author or director. The right exists to prevent injury to the owner and protect the reputation of an artist.

Even if the author of a copyright work has assigned (legally transferred) or otherwise dealt with the rights in the work, this does not give the new owner of copyright a free rein to deal with the work in any manner they think fit.

Most commercial agreements that deal with the copyright in a work also contain waivers of the moral right to object to derogatory treatment of the work. There are certain exceptions e.g. this right does not apply to computer programs or computer generated works or to works made for the purpose of reporting current events or to publication of a work in a newspaper, magazine, periodical or other reference work where the work has been made for such a purpose or was used with the author's consent.

The right does not apply where work has been altered to avoid committing an offence or to comply with a duty imposed under the law or in the case of RTE, avoiding the inclusion in a programme broadcast of anything which might offend against good taste and decency or which is likely to encourage or incite crime or lead to disorder or be offensive to public feeling. In such a case a disclaimer should be included explaining that the author's or director's work has been altered in such a way.

There are no exceptions for fair dealing and accordingly, despite the fact that a defence of fair dealing may be available in an action for infringement of copyright, an author or director may still have a cause of action under this particular section for breach of moral rights.

Right to privacy of photos & films

A person who, for private and domestic purposes, commissions the taking of a photograph or the making of a film, where copyright subsists, has the right not to have copies of the work issued, exhibited or shown in public or broadcast in public. Anyone who does authorise the doing of any of those acts will infringe this right to privacy. Some exceptions to this right do exist and infringement will not occur when the inclusion of such a photograph or film is incidental.

This right to privacy is enforceable by the commissioner of the work and not the subjects of it (i.e. who the photograph is of) and the subjects may have other legal remedies under contract or tort law.

This right to privacy is of limited use to protect a member of the public whose photograph has been taken. The work must have been commissioned and must be for private or domestic purposes for this moral right to apply. Clearly, a newspaper wishing to publish wedding photographs which it obtains from the photographer at the wedding without the consent of the commissioner, which are likely to be the bride or groom's family, could be liable for an infringement of moral rights.

This is so, despite the fact that the position in copyright law as to ownership is clear. Naturally, no infringement occurs where the person entitled to the right has consented or waived their right.

False attribution

A person has a right not to have a literary, dramatic, musical, or artistic work falsely attributed to them as author and not to have a film falsely attributed to him as director. This right is infringed where copies of a work containing such a false attribution are issued to the public. The rights may be further infringed where such a falsely attributed work is

performed in public or broadcast where a person knows or has reason to believe that the attribution is false.

It is also an infringement where, in the course of business, a person deals with or possesses copies of the work knowing or having reason to believe that there is such an attribution and that it is false. This remedy is clearly useful where an author's name is attached to a work, which is not theirs. Such an attribution may also amount to a passing off.

A false attribution right exists until 20 years after the person's death. It is possible that when a work is adapted, perhaps in translation from a novel to a screen play, where the work changes so fundamentally, that attaching the author's name to the final film amounts to derogatory treatment as well as false attribution. Generally, the remedy for breach of moral rights is damages (usually money) and an injunction. Defences to such an action will include consent or waiver of the right.

There is no infringement of moral rights if consent is given. Any waiver of rights should be in writing signed by the person giving up the right. The waiver may be specific or general and may relate to existing or future works.

Design rights

Overview

Two different forms of design rights exist. The registered design system is for the visual appearance of designs. The unregistered design system is more for functional aspects of the design.

Registered design rights

In order to obtain a registered design, an application has to be made to the Irish Patents Office in Kilkenny (see www.patentsoffice.ie). An application can be made either under the Irish Industrial Designs Act, 2001 or under the Community Design Regulation 6/2002/EC. This guide will deal only with the provisions of the 2001 Act. The design right is then subjected to a process of examination during which the applicant can discuss any objections raised by the examiner. If the objections are overcome, the design right is registered.

In order to be registered, the design must be new, i.e. it has not been registered or published in the Republic of Ireland before the date of your application. The design must have individual character, i.e. must give the impression to the informed user of being different from any other design already available to the public. Lastly, a design will not be registrable if it is excluded from registration. The Industrial Designs Act 2001 states the following as excluded from registration:

(1) where the purported design does not fall within the definition of a design in the 2001 Act, which is 'the appearance of the whole or a part of a product resulting from the features of, in particular, the lines, contours, colours, shape, texture or materials of the product or its ornamentation'. This definition is therefore concerned with the overall visual appearance of a product. Internal, non-visible component parts of a product will not constitute a design for these purposes.

(2) where the design contains features or shapes or configuration dictated solely by function. Designs cannot be registered if everything is dictated solely by function. Objects such as furniture, table lamps and dinner plates are normally bought with aesthetic considerations in mind and will be registrable. The difficulty lies with articles which have had a design applied mainly to make them stand out on supermarket shelves.

(3) where the design is immoral or contrary to public policy

(4) where the design is in conflict with an earlier application or registration under the 1949 Act

Once registered by the Irish Patents Office, a registered design right gives the owner the right to make, offer, sell, import or export a product to which a design has been applied, often for their commercial benefit. The owner can also allow third parties to use the design in consideration for payment.

A registered design right gives the owner protection and therefore allows them to take legal action against the third party who uses the design without permission. Under the 2001 Act the test used to determine whether a design has indeed been infringed is whether a person without the permission of the registered proprietor has committed any of the acts which by virtue of Sections 51 to 54 of the 2001 Act are the exclusive right of the registered proprietor.

Infringement of the right

An infringement of a registered design right is committed by a person who without the licence of the registered proprietor does anything which is the exclusive right of the proprietor namely:

- when a person incorporates a design not substantially different from the registered design to make it available for commercial purposes
- to import for commercial purposes
- to sell
- to hire
- to offer, expose for sale or hire

Unlike trademarks, there are no 'classes' of goods for registered design rights. Separate applications are needed for each article to which the design is to be applied unless the articles belong to a set, e.g. a tea-set.

Duration of registered design rights

The maximum duration of a registered design is 25 years. More precisely, it is five 5-year terms with renewable fees payable after each fifth year.

Defences

Like defending a patent action, defences to an action for infringement of a registered design right include an attack on the validity of the registration, e.g. that the design was not new when registered. In addition, although technically not a defence, a party may avoid having to pay damages or an account of profits, where he or she can show that they neither knew nor had reasonable grounds for supposing that the design was registered. Simply marking the goods 'registered design' is not enough to constitute notice, unless accompanied by a registration number.

Remedies

The remedies for infringement include the following:

- damages (usually money)
- an account of profits

- an injunction against the infringer to get them to stop
- order for delivery-up or destruction of the infringing article

Unregistered design rights

Unregistered design rights are governed by The Community Design Regulations (Council Regulation 6/2002/EC) and seek to protect any designs made available to the public on or after 6 March 2002. This regulation enables the rights holder to prevent a third party from using the same or a similar design. Even though the period of protection afforded under the regulation is three years from the day the design first became available to public. Infringement can only occur by copying however a novelty requirement exists also. In addition, an unregistered design right cannot be asserted against an independently designed right

Exclusions

There are some items that are specifically excluded from protection as unregistered designs. These include the following:

- a method or principle of construction
- surface decoration, e.g. wallpaper, clothes etc.
- features of shape or configuration of an article which:
 - enable the articles to be connected to, or placed in, around or against, another article so that either article may perform its function
 - are dependent upon the appearance of another article of which the article is intended by the designer to form an integral part

Ownership of the right

Ownership of rights are set out in Sections 17 through 19 of the 2001 Act.

The creator of the design owns the unregistered design right unless it was produced as a result of accepting a paid commission or during the course of employment. In these circumstances, the commissioner or the employer in question will own the design. This should, however, be a condition of any contract of employment.

A design right can be transferred by its owner (whether by way of sale or gift) to other people. This must be done in writing and signed by or on behalf of the owner.

A design right only exists in a design if the designer, the commissioner of the design, the designer's employer or the person first marketing products incorporating the design are qualifying persons under the 2001 Act.

Duration of protection

The period of protection is the shorter of the following two periods:

- 15 years from the end of the calendar year in which the design was first recorded in a design document or an article made to that design
- 10 years from the end of the calendar year in which the articles were made available to the public

Infringement of the right

The 2001 generally provides that a design right is infringed by a person who without the licence of the design right owner does, or authorises another to do, anything which by virtue of the Act is the exclusive right of the design owner. Examples of the actions which would constitute design infringement include:

- copying the entirety of a design-protected article or a relevant portion of that article
- engineering a design-protected article to make another article
- engineering a design document for the purposes of making articles from it, etc.
- making articles exactly or substantially similar to the design

A secondary infringement occurs when a person who knowing, or reasonably believing, that the article is an infringing article, does any of the following:

- imports the article into the Republic of Ireland for commercial purposes
- has the article in their possession for commercial purposes
- sells the article, lets it for hire or offers the article for sale or hire in the course of business

Remedies

The remedies for infringement include the following:

- damages (usually money)
- an account of profits
- an injunction against the infringer to stop them
- order for delivery-up or destruction of the infringing article