COMPANY LAW REVIEW GROUP

REPORT ON COMPANY NAMES AND REGISTERED TRADE MARK RIGHTS

MAY 2024

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Chairperson's Letter to the Minister for Enterprise, Trade and Employment

Mr Peter Burke T.D.,
Minister for Enterprise, Trade and Employment
23 Kildare Street
Dublin 2
D02 TD30

Mr Dara Calleary, T.D.
Minister of State for Trade Promotion, Digital and Company Regulation
23 Kildare Street
Dublin 2
D02 TD30

30 May 2024

Dear Ministers,

I am pleased to present to you a Report of the Company Law Review Group on Company Names and Registered Trade Mark Rights.

The Report Recommends an amendment to the Companies Act and to the Rules of the Superior Courts, in order to facilitate a fast-track application procedure for trade mark proprietors who wish to challenge company names that infringe their trade mark. The Review Group considers the recommendation to be a measured and appropriate course of action to address the issue.

I would like to extend my sincere thanks to the members of the CLRG's Corporate Governance Committee and in particular Committee Chairperson Salvador Nash for their engagement and input in examining these issues.

I would also like to thank the Department of Enterprise, Trade and Employment for their support, including the Secretariat to the Review Group, former CLRG Secretary Deirdre Morgan, current CLRG Secretary Paul Thompson, and Dan O'Neill.

Yours sincerely,

Paul Egan SC
Chairperson
Company Law Review Group

1. Introduction

1.1. The Company Law Review Group

The Company Law Review Group (**CLRG**) is an expert advisory body charged with advising the Minister for Enterprise, Trade and Employment (**the Minister**) on the review and development of company law in Ireland. It was accorded statutory advisory status by the Company Law Enforcement Act 2001, which was continued under Section 958 of the Companies Act 2014. The CLRG operates on a two- year work programme which is determined by the Minister in consultation with the CLRG.

The CLRG consists of members who have expertise and an interest in the development of company law, including practitioners (the legal profession and accountants), users (business and trade unions), regulators (implementation and enforcement bodies) and representatives from Government Departments and Agencies including the Department of Enterprise, Trade and Employment (**the Department**) and the Revenue Commissioners. The Secretariat to the CLRG is provided by the Company Law Review Unit of the Department. Full lists of members of the Company Law Review Group and of the Corporate Governance Committee are set out in Section 2.

1.2. The Role of the CLRG

The CLRG is established to monitor, review and advise the Minister on matters pertaining to company law. In so doing, it is required to "seek to promote enterprise, facilitate commerce, simplify the operation of the Act, enhance corporate governance and encourage commercial probity" as per section 959(2) of the Companies Act 2014.

1.3. Policy Development

The CLRG submits its recommendations on matters in its work programme to the Minister. The Minister, in turn, reviews the recommendations and determines the policy direction to be adopted.

1.4. Contact information

The CLRG maintains a website at www.clrg.org. In line with the requirements of the Regulation on Lobbying Act and accompanying Transparency Code, all CLRG reports and the minutes of its meetings are routinely published on the website. It also lists the members and the current work programme.

The CLRG's Secretariat receives queries relating to the work of the CLRG and is happy to assist members of the public. Contact may be made either through the website or directly to:

Paul Thompson
Secretary to the Company Law Review Group
Department of Enterprise, Trade and Employment
Earlsfort Centre
Lower Hatch Street
Dublin 2
D02 PW01
Email: clrg@enterprise.gov.ie

2. The Company Law Review Group Membership

2.1. Membership of the Company Law Review Group

The membership of the Company Law Review Group at the date of this Report is set out in this table.

Paul Egan SC	Chairperson (Mason Hayes & Curran LLP)
Prof Deirdre Ahern	Ministerial Nominee (School of Law, Trinity College Dublin)
Alan Carey	The Revenue Commissioners
Barry Conway	Ministerial Nominee (William Fry LLP)
Dr Margaret Cullen	Institute of Directors in Ireland
Richard Curran	Ministerial Nominee (LK Shields LLP)
Emma Doherty	Ministerial Nominee (Matheson)
Ian Drennan	Corporate Enforcement Authority
Bernice Evoy	Banking and Payments Federation Ireland CLG
James Finn	The Courts Service
Anne Fitzpatrick	Office of the Attorney General
Michael Halpenny	Irish Congress of Trade Unions (ICTU)
Tanya Holly	Ministerial Nominee (DETE)
Neil Keenan	Law Society of Ireland (Beauchamps LLP)
Eamonn Kennedy	Irish Business and Employers' Confederation (IBEC)
Gillian Leeson	Euronext Dublin (The Irish Stock Exchange PLC)
Prof Irene Lynch Fannon	Ministerial Nominee (Matheson)
Kathryn Maybury	Small Firms Association LTD (KomSec LTD)
Neil McDonnell	Irish Small and Medium Enterprises Association CLG (ISME)
Dr David McFadden	Ministerial Nominee (Companies Registration Office)
Salvador Nash	The Chartered Governance Institute (KPMG Law)
Fiona O'Dea	Ministerial Nominee (DETE)
Gillian O'Shaughnessy	Ministerial Nominee (ByrneWallace LLP)
Maureen O'Sullivan	Ministerial Nominee (Registrar of Companies)
Kevin Prendergast	Irish Auditing and Accounting Supervisory Authority
Eadaoin Rock	Central Bank of Ireland

Niamh Ryan	Irish Funds Industry Association CLG (Dechert LLP)
Cathy Smith	Bar Council of Ireland
Doug Smith	Restructuring & Insolvency Ireland (Addleshaw Goddard Ireland LLP)
Tracey Sullivan	Consultative Committee of Accountancy Bodies-Ireland (CCAB-I) (Grant Thornton Ireland)

2.2. Corporate Governance Committee

The membership of the Review Group's Corporate Governance Committee is set out in this table.

Salvador Nash	Chairperson
Deirdre Ahern	CLRG member
Aisling Byrne	DETE Nominee
Jill Colquhoun	DETE Nominee
Barry Conway	CLRG member
Dr Margaret Cullen	CLRG Member
Richard Curran	CLRG member
Michael Dillon	Corporate Enforcement Authority
Emma Doherty	CLRG member
Paul Egan SC	CLRG member
Michael Halpenny	CLRG member
David Hegarty	Corporate Enforcement Authority
Tanya Holly	CLRG member
Eamonn Kennedy	CLRG member
Dr David McFadden	CLRG member
John McGorry	Revenue Commissioners
Kathryn Maybury	CLRG member
Susan Monaghan	Irish Auditing and Accounting Supervisory Authority
John Nolan	Intellectual Property Office of Ireland (IPOI)
Gillian O'Shaughnessy	CLRG member
Niamh Ryan	CLRG member
Tracey Sullivan	CLRG Member

3. The Work Programme

3.1. Introduction to the Work Programme

In exercise of the powers under section 961(1) of the Companies Act 2014, the Minister, in consultation with the CLRG, determines the programme of work to be undertaken by the CLRG over the ensuing two-year period. The Minister may also add items of work to the programme as matters arise. The current work programme began in November 2022 and runs until mid-2024. The work programme is focused on continuing to refine and modernise Irish company law.

3.2. Company Law Review Group Work Programme 2022-2024

There are three standing items within the Work Programmes of the Review Group which allows emerging issues and topics to be added to the Work Programme. One of these standing items relates to examining company law in the context of recent case law and submissions received regarding the Companies Act. In this instance, the Law Society Intellectual Property and Data Protection Law Committee made a submission to the CLRG requesting a review of an issue that arises in practice that concerns the registration of company names that infringe registered trade marks, often believed to have been done intentionally to extort money in order to change the company name.

3.3. Decision-making process of the Company Law Review Group

The CLRG meets in plenary session to discuss the progression of the work programme and to formally adopt its recommendations.

3.4. Committees of the Company Law Review Group

The work of the CLRG is largely progressed by the work of its Committees. The Committees consider not only items determined by the work programme, but issues arising from the administration of the Companies Act 2014, matters arising such as court judgements in relation to company law and developments at EU level.

This Report is the product of work undertaken by the Corporate Governance Committee which is chaired by Mr Salvador Nash. The Committee met three times (both in person and using video conferencing facilities) and circulated draft versions of this Report in its analysis of this issue and consideration of possible remedies.

4. Background to the Report

4.1. Introduction

The Chair of the Intellectual Property and Data Protection Law Committee of the Law Society of Ireland wrote to the CLRG on 4 March 2021 and 25 January 2022 expressing the Law Society Committee's concerns regarding, *inter alia*, the registration of company names in the context of intellectual property and trade mark rights and the protection of same. The concerns relate to the practice of registering a company name that infringes a registered trade mark, the limited circumstances in which the Registrar of Companies can order a name change, and the absence of a cost-effective remedy to obtain redress for Trade Mark right infringement in this scenario. This infrastructure, the Law Society claimed, undermines Ireland's reputation as a jurisdiction that actively protects intellectual property rights. Further details of the concerns were raised at a meeting with representatives of the Law Society in 2023 and are set out under Section 4.3 of this Report.

4.2. Defined terms

In this Report, the following defined terms and expressions are used:

1996 Act: means the Trade Marks Act 1996.

2014 Act or **Companies Act**: means the Companies Act 2014.

CLG: means a company limited by guarantee.

CLRG or **Review Group:** means the Company Law Review Group.

CNT: means the UK Company Names Tribunal, which is part of the UK Intellectual Property Office, that deals with complaints concerning the registration of a company name for the primary purpose of preventing someone else with legitimate interest from registering it, or demanding payment from them to release it.

Committee: means the Corporate Governance Committee of the Review Group.

Committee Member: means a member of the Corporate Governance Committee.

Controller: means the Controller of Patents, Designs and Trade Marks.[1]

CRO: means the Companies Registration Office.

DAC: means a designated activity company.

DCR: means the District Court Rules.

DNS: means a domain name system. The domain name system is a global address system and is the way that domain names are located and translated into IP addresses (a series of characters and numbers).

EUIPO: means the European Union Intellectual Property Office.

IP: means intellectual property.

[1] Trade Marks Act 1996, section 2

IPOI: means the Intellectual Property Office of Ireland which is the official Irish government body responsible for intellectual property rights including patents, designs, trade marks and copyright.

Journal: means the Intellectual Property Office of Ireland Official Journal that is published fortnightly and contains: information on IP applications filed, published and granted; information on Irish IP rights that have ceased or expired; and information on other legal patent proceedings.

Law Society Committee: means the Intellectual Property and Data Protection Law Committee of the Law Society of Ireland.

LTD: means a private company limited by shares.

opportunistic registration: means when someone registers one or more variations of the name of a well-known company in order to get the latter company to buy the registration(s), or "where someone knows that a merger is about to take place between two companies and so registers one or more variations of the name that the newly formed commercial entity is likely to require". [2]

PLC: means a public limited company.

Registered Trade Mark: means a property right obtained by the registration of the trade mark under the Trade Marks Act 1996 and the proprietor of a registered trade mark shall have the rights and remedies provided by this Act.[3]

RSC: means Rules of the Superior Courts.

trade mark: means any sign capable of being represented graphically which is capable of distinguishing goods or services of one undertaking from those of other undertakings.[4] A trade mark may, in particular, consist of words (including personal names), designs, letters, numerals or the shape of goods or of their packaging.[5]

Trade Mark Squatting: means the registration or use of a generally well-known trade mark that is not registered in the country or is invalid as a result of non-use.[6]

UK 2006 Act: means the Companies Act 2006 (United Kingdom).

In this Report

- references to any enactment is to that enactment as amended to date;
- references to sections, Chapters, Parts and Schedules where no enactment is identified, are to sections, Chapters and Parts of and Schedules to the 2014 Act.

[2] Montagon and O'Loughlin, *The Company Names Tribunal* (Company Secretary's Review, July 2009, 33 CSR 7,54 22)
[3] Trade Marks Act 1996, section 7(1)
[4] Trade Marks Act 1996, section 6(1)
[5] Trade Marks Act 1996, section 6(2)
[6] Lakshmikumaran & Sridharan, *Trade mark squatting - Jurisdictional perspectives* (Global – India 18 August 2022)

4.3. Submission of the Law Society of Ireland

The Intellectual Property and Data Protection Law Committee of the Law Society of Ireland submitted its concerns relating to issues in practice concerning IP rights, particularly trade marks, and the registration of company names with the CRO. The Law Society Committee noted that there is no interaction between the processes of registering a trade mark and registering a company name. This can give rise to a situation whereby a company can register a company with the CRO with a name that may infringe a registered trade mark (with the IPOI) or which may permit Trade Mark Squatting with company names.

Section 30 of the 2014 Act entitles the Registrar of Companies to direct a company to change its name where s/he is of the opinion that is it too like the name by which a company in existence is already registered. Section 30 makes no reference to IP rights. At a meeting of the Corporate Governance Committee, representatives from the Law Society presented to the Committee on this topic and expressed concern at situations where the Registrar has refused to order a name change notwithstanding that the companies in question were using as part of their name an iconic international branch or a well-known Irish brand. When the CRO considers requests for name changes it does so solely in relation to the similarity with other companies on the CRO register, as provided for in section 30 of the 2014 Act. The CRO is not permitted therefore to take into account whether or not the proposed company name is similar to a particular brand.

The representatives from the Law Society stated that in cases where the Registrar of Companies has not ordered a name change due to the criteria of section 30 not having been met, the only remedy available to these brands is to institute Court proceedings for trade mark infringement and/or passing off. While the Court can be an effective option to prevent Trade Mark Squatting with company names, it is a costly avenue to simply secure use of a company name. Consequently, Court proceedings might not be financially possible or sensible for SMEs and indeed larger corporates due to the associated costs.

Some anonymised and generic examples were provided by the Law Society:

1. An international brand that previously did not operate through an Irish registered entity may find that someone has registered a company consisting of or including its trade mark brand and it is then prevented from registering its own Irish subsidiary with the brand because of the pre-existing entity.

2. The owner of an Irish cosmetic brand might seek to prevent the registration of a company name incorporating its brand where the registrant intends to operate as a beauty salon or a hairdresser.

3. A famous brand may find a company name registrant in a completely different industry e.g. tractors who registered a company name which incorporates the famous brand's name.

Registering a company with the CRO may give the impression of a connection or association with the brand owner where the brand owner's brand is used by the company in its name. Generally, the brand owner will be concerned to prevent a company being registered with a name designed to confuse the brand owner's customers or the public more generally.

The Law Society representatives contended that this lacuna raises practical concerns for companies who are not registered in Ireland, but who wish to do so. Bad faith registrations or Trade Mark Squatting

with company names are seen as opportunistic and many of the registrants will seek payment in exchange for the company name. Potential solutions were proffered by the Law Society Committee and were subsequently considered by the Committee.

5. Relevant Company and Trade Mark Legislation

5.1. Company Legislation

Company Names

Regardless of the type of company seeking to be incorporated, every company must choose and state a name in its constitution. This is often referred to as the "name clause" in a company's constitution or memorandum of association, as appropriate.

Section 19(1) of the 2014 Act provides that an LTD's constitution must include the company's name, complying with the requirements stipulated in section 26 i.e. it shall end with "limited" or "teoranta" which may be abbreviated to "ltd" or "teo".

The principles are broadly similar in respect of each type of company.

- In the case of a DAC, section 967 (2)(a) stipulates that its memorandum of association must state its name. and s 969 requires that the name ends with 'designated activity company' or DAC or their Irish language equivalents.
- In the case of a PLC, section 1006(2)(a) requires the memorandum of association to state its name per and s 1008(1) requires that the name ends with 'public limited company' or PLC or their Irish language equivalents.
- In the case of a CLG, 1176(1)(a) requires the constitution to include the company name and that the name of the name ends with "company limited by guarantee" or CLG or their Irish language equivalents.
- A similar name clause requirement exists in relation to an unlimited company in section 1237. Such company must have the words "unlimited company" or UC or their Irish language equivalents at the end.

In light of the requirements in a company's constitution/memorandum of association to have a name clause, it follows that a name must be chosen by a company. This is subject to some restrictions. In order to register the company name, application must be made to the CRO.

In a its information leaflet[7] on the topic, the CRO states that it may refuse a name if:

- it is identical to or too similar to a name already appearing on the register of companies;
- it is offensive;
- it suggests state sponsorship.

Some other guidelines and/or restrictions provided by the CRO are:

- Include extra words in the name so as to create a sufficient distinction between names.
- Similar descriptive elements e.g. press/printing, or the inclusion of only general or weak qualification e.g. holding, group, system etc may not be regarded as a sufficient distinction between company names.

[7] Company Name and Change of Company Name, Information Leaflet No 8 (April 2019) < https://www.cro.ie/Portals/0/Leaflets/Info%20Leaflet%208.pdf >

- Names which are phonetically or visually similar will be refused. This includes where there is a slight variation in spelling which does not create a significant difference.
- The use of a year to differentiate between two companies of otherwise the same name is prohibited.
- Names containing certain words cannot be used unless approved by the relevant body e.g. Bank may only be used with the permission of the Central Bank of Ireland etc. Other such words include, amongst others, "society", "co-op", "University" etc.

Section 28 of the 2014 Act provides that a company may apply to the CRO to reserve a specified name either for the purposes of incorporating a company under than name, or for a company to change its name to that name. Upon receipt of such application, the Registrar may determine that the name shall be reserved for a specified period, not exceeding 28 days. Application can be made for an extension before the expiry of the 28 day period.

Changing of Company Name

A company may change its name pursuant to section 30 of the 2014 Act, set out in Appendix A below. Section 30(1) empowers a company, by special resolution and with the approval of the Registrar, signified in writing, to change its name.

Section 30(2) applies if through inadvertence or otherwise, a company is registered by a name (whether on its first registration, or on its registration by a new name) which, in the opinion of the Registrar is too like the name by which a company in existence is already registered. Where section 30(2) applies, the first mentioned company, with the approval of the Registrar, may change its name or if, within 6 months after the date of its being registered, the Registrar directs it to do so, the company shall change its name.

Where a company changes its name under section 30, the Registrar shall enter the new name in the register in place of the former name, and shall issue a certificate of incorporation altered to meet the circumstance of the case.[8] A change of name by a company under this section shall not affect any rights or obligations of the company, render defective any legal proceedings by or against the company, and any legal proceedings which might have been continued or commenced against it by its former name may be continued or commenced against it by its new name.[9] Section 30(7) deals with company names specified by statute.[10] If a company fails to comply with a direction under section 30(3)(b) of the 2014 Act within the specified time period, the company and any officer of it who is in default shall be guilty of a category 4 offence.[11]

Business Names

Where a company carries on business under a name other than its registered name, it must register that name as a 'business name' with the Registrar under section 26(4) of the 2014 Act . A business name is statutorily defined as the "name or style under which any business is carried on, and, in relation to a

[8] Section 30(5) of the 2014 Act
[9] Section 30(6) of the 2014 Act;
[10] Section 30(7) of the 2014 Act provides: "*A company which was registered by a name specified by statute, may, notwithstanding anything contained in that statute, change its name in accordance with subsection (1), but, if the Registrar is of the opinion that any Minister of the Government is concerned in the administration of the statute which specified the name of the company, the Registrar shall not approve of the change of name save after consultation with that Minister of the Government.*"
[11] Section 30(8) of the 2014 Act.

newspaper, includes the title of the newspaper." The CRO does not check proposed business names against names on the registers of companies, business names or trade marks. Persons wishing to register a business name are advised to investigate so as to ensure that the proposed business name does not conflict with a pre-existing company name or trade mark – this is because relevant natural or legal persons could take an infringement action or a passing off action to defend their interest in the name.

5.2. Trade Mark Legislation

The 1996 Act provides, *inter alia*, the definition, registration process, the rights associated with and infringement of a registered trade mark, the management of a registered trade mark. The 1996 Act has been amended from time to time to include reference to European trade mark law. The administrative provisions, which relate to the Register of Trade Marks and the power of the Controller, are set out in Part IV.

Section 6(1) of the 1996 Act defines a trade mark as "*any sign which is capable of distinguishing the goods or services of one undertaking from those of other undertakings and is capable of being represented on the register*". A trade mark may consist of words, including personal names, designs, logos, letters, numerals or the shape of goods or of their packaging, or sounds, provided that such signs are capable of being represented on the register in a manner which enables the Controller and the public to determine the clear and precise subject matter of the protections afforded to its proprietor.[12]

Trade marks are territorial rights. The IPOI is responsible for the registration of Irish national applications. Once the Trade Mark is registered, it lasts for a 10 year period. This period can be extended indefinitely on payment of a renewal fee every 10 years. European and international application systems also exist. The EUIPO offers a unitary Trade Mark right granting protection across the 27 countries of the European Union. International trade mark applications can be made through the "Madrid System" administered by the World Intellectual Property Organization, which provides a mechanism for registering a trade mark in several countries by means of a single application. EU and Irish law recognise that a trade mark will be infringed where there is a likelihood of confusion on the part of the public or where the trade mark in question has a reputation, and without due cause, the use of that mark by the defendant takes unfair advantage of, or is detrimental to, the distinctive character or reputation of the mark.

The Committee was presented with additional information concerning the benefits of registering a trade mark and the associated application process which is carried out by the IPOI. This information is provided at Appendix B below.

Administrative Processes for Trade Mark Protection by Application to the Controller

Section 10 of the 1996 Act allows for certain rights of opposition to be invoked pre-registration of a trade mark pursuant to section 43 of the 1996 Act. This section allows for pending marks to be opposed. A successful opposition will result in the Controller refusing to register the offending mark. The cost for instigating an opposition action is €60.

Section 51 of the 1996 Act provides for revocation. The proprietor of a trade mark right (registered or unregistered) can challenge an offending trade mark "post registration" by way of a revocation action under section 51 of the Act, providing the offending mark has been registered for a period of at least 5

[12] Section 6(2) of the 1996 Act, as amended.

years. A successful revocation action will result in the Controller, in effect, cancelling the registration of the offending mark. The costs associated with a revocation action is €125.

Section 52 of the 1996 Act provides that a proprietor of a trade mark right (registered or unregistered) can challenge an offending trade mark "post registration" by way of an invalidation action. A successful invalidation action will result in the Controller invalidating the registration of the offending mark which will, in effect, mean that the mark was never registered in the first place. The costs associated with an invalidation action is €125.

Judicial Processes for Trade Mark Protection by Application to the Court

Section 18 of the 1996 Act provides for court actions for infringement. This section provides a means by which the proprietor of a registered trade mark may seek relief before the courts by way of damages, injunctions or accounts or by any other means available in respect of any other property right.

Section 24 of the 1996 Act provides a remedy for groundless threats of infringement proceedings. This section provides a means by which any party unjustifiably threatened with infringement proceedings in respect of a trade mark may defend themselves against such groundless threats, and may seek an injunction against the continuance of such threats and/or seek damages in respect of and loss sustained by said threats.

6. Options Considered by the Committee

Several possible remedies were proposed by the Committee members for further review in addition to the suggested remedies included in the Law Society Committee's letters. Each option was debated thoroughly to determine the feasibility and desirability of each and whether it addressed the alleged mischief.

A primary concern of many Committee members concerning each of the options considered was the absence of cogent data and evidence available to substantiate the scope and prevalence of the problem outlined. The Committee also considered that any proposal for substantial legislative change or resourcing would require a robust business case with evidence of the problem and a full analysis of how the proposed solution would address the deficiency. The Secretariat made a number of attempts to source additional data on the matter to support the Committee's deliberations but was unable to locate any meaningful information.

Statistics on company registrations and name changes under section 30 were provided by the CRO for the Committee's consideration. There are approximately 288,000 companies on the Register in Ireland and over 21,000 new companies are incorporated each year. There are approximately 2,000 company name changes each year for reasons including mergers, buy-outs, and image change amongst others. In the years 2020 and 2021, there were 10 objections to company names in each year. Two were outside the permitted time period, and five objections were upheld. It was noted that this issue of Trade Mark Squatting with company names does not generally come to the attention of the CRO.

1. Establish a Company Names Tribunal
2. Expand the powers of the Intellectual Property Office of Ireland
3. Amend CRO forms to include a tick-the-box confirmation
4. Add a CRO administrative process with an appeal by way of Originating Notice of Motion
5. Permit objections by way of Originating Notice of Motion
6. Allow applications to the District Court to direct a change of company name
7. Amend the Trade Marks Act

6.1. Establish a Company Names Tribunal

One of the solutions proposed by the Law Society Committee representatives included establishing a body similar to the CNT in the UK. The CNT was established on 1 October 2008 pursuant to section 69 of the UK 2006 Act. The aim of the CNT is to provide brand owners with a cost-effective method of enforcing their trade marks against the registration of similar company names.[13] The CNT is limited to applications in respect of opportunistic registrations.

Relevant Legislation

Pursuant to section 69 of the UK 2006 Act, a person, known as the applicant, may object to a company's registered name on the ground (a) that it is the same as a name associated with the applicant in which

[13] JA Kemp LLP, Company Names and Trade mark Infringements – The UK Company Names Tribunal (4 October 2018)

he has goodwill, or (b) that it is sufficiently similar to such a name that its use in the United Kingdom would be likely to mislead by suggesting a connection between the company and the applicant. The objection must be made by the applicant to the company names adjudicator.[14] Section 69(4) of the UK 2006 Act provides that if the applicant establishes the matters at (a) and (b), it is for the respondent to show:

> *"(a) that the name was registered before the commencement of the activities on which the applicant relies to show goodwill; or …*
>
> *(c) that the name was registered in the ordinary course of a company formation business and the company is available for sale to the applicant on the standard terms of that business; or*
>
> *(d) that the name was adopted in good faith; or*
>
> *(e) that the interests of the applicant are not adversely affected to any significant extent."*

If none of the foregoing are shown, the objection is to be upheld. Section 69(5) provides for so called opportunistic registrations. It provides that if the facts mentioned in (a), (b) or (c) are established:

> *"the objection shall nevertheless be upheld if the applicant shows that the main purpose of the respondents (or any of them) in registering the name was to obtain money (or other consideration) from the applicant or prevent him from registering the name."*

Part 5, Chapter 3 of the UK 2006 Act deals with similarity to other names. Section 67 provides a power to the Secretary of State to direct a change of name in case of similarity to existing names. This is similar to section 30 in the 2014 Act. For completeness, section 67 provides:

> *"(1) The Secretary of State may direct a company to change its name if it has been registered in a name that is the same as or, in the opinion of the Secretary of State, too like—*
>
> *(a) a name appearing at the time of the registration in the registrar's index of company names, or*
>
> *(b) a name that should have appeared in that index at that time.*
>
> *(2) The Secretary of State may make provision by regulations supplementing this section.*
>
> *(3) The regulations may make provision—*
>
> *(a) as to matters that are to be disregarded, and*
>
> *(b) as to words, expressions, signs or symbols that are, or are not, to be regarded as the same,*
>
> *for the purposes of this section.*
>
> *(4) The regulations may provide—*
>
> *(a) that no direction is to be given under this section in respect of a name—*
>
> *(i) in specified circumstances, or*
>
> *(ii) if specified consent is given, and*
>
> *(b) that a subsequent change of circumstances or withdrawal of consent does not give rise to grounds for a direction under this section.*
>
> *(5) Regulations under this section are subject to negative resolution procedure.*
>
> *(6) In this section "specified" means specified in the regulations."*

[14] The UK 2006 Act, 69(2)

Overview of the CNT Process

Application can be made to the CNT by completing an application form which costs £400. If a defence is filed, a notice of defence can be delivered at a cost of £150. This is followed by a notice of giving evidence (£150); request for a hearing to be appointed (£100). There is also a request for an extension of time application (£100) and a request for security for costs (£150). All forms are publicly available on www.gov.uk.

Where no defence is filed, the Company Names Adjudicator will make a written decision on the basis of the complaint as filed. If the application is allowed, one month is usually permitted to allow the company to change its name or to appeal the decision. Once a decision is made, a Company Names Adjudicator must within 90 days of the determination under section 69, make her or his decision and reasons available to the public.[15] These are usually posted on the website.

An appeal lies to the Court from any decision of a Company Names Adjudicator to uphold or dismiss an application.[16] The appeal lies to the High Court of England and Wales, the High Court of Northern Ireland or the Court of Session in Scotland.

No set timeline is provided for a hearing before the CNT, however the CNT website states:

> "*Much depends upon the parties themselves e.g. whether an application is defended, whether the parties adhere to the timescales set by the adjudicator or whether they ask for more time to file evidence and whether the parties appeal against the adjudicator's decision to the court*."

The priorities for 2014 to 2015 were to issue 75% of decisions within 15 months of the counterstatement being filed. This, however, is for the application before the Company Names Tribunal. If an appeal is lodged, the parties are then at the will of the Courts.

Between October 2008 and September 2018, 958 cases were decided by CNT. 870 applications were undefended and the applicant was successful. The remaining 88 cases were defended and 56 of 88 were decided in favour of the applicant.

6.1.1. Committee Deliberations

The Committee reviewed the statistics of the CNT and extrapolated from that data to give a 'best guess' figure as to the number of applications concerning opportunistic registrations that could potentially be brought to such a tribunal if it were established in Ireland. This came to 22 cases a year. Using this number, the Committee agreed that it was not feasible to set up such an independent tribunal in Ireland. There is insufficient evidence of this problem to justify the resources required to set up such an organisation, even on a much smaller scale than the UK. The differences between Ireland and the United Kingdom relating to the establishment of quasi-judicial bodies were also highlighted, meaning any tribunal in Ireland would also have to meet the constitutional standards which could incur significant costs in both establishment and operation. The Committee did not consider this suggestion a viable solution.

6.1.2. Review Group Recommendation

In light of the Committee's conclusions, the Review Group does not recommend a names tribunal akin to the CNT

[15] Companies Act 2006 (UK), section 72
[16] Companies Act 2006 (UK), section 74

6.2. Expand the Powers of the Intellectual Property Office of Ireland

The Committee considered as a possible remedy extending the powers of the IPOI to broaden the remit of the office to include a role in the assessment of name change requests made under section 30 of the 2014 Act, given the IPOI has the required skillset to review possible instances of trade mark infringement.

The IPOI is the national intellectual property agency, under the auspice of the Department of Enterprise, Trade and Employment, that is responsible for the administration of IP rights in Ireland. Its functions are designated under the Trade Marks Act 1996 (as amended), the Industrial Designs Act 2001, the Copyright and Related Rights Act 2000, the Patents Act 1992 (as amended), the various Statutory Rules and Regulations made under these Acts; and the European Communities (Supplementary Protection Certificate) Regulations. The Intellectual Property Office of Ireland Annual Report 2021[17] provides that in addition to its functions under the aforementioned legislation concerned with the processing of application for IP rights and others, the IPOI performs a number of operation and regulatory functions including:

1. Administering proceedings before the Controller in relation to IP rights including hearings on oppositions to trade mark registrations.
2. Maintaining the registers of patent and trade mark attorneys authorised to operate in the State.
3. Administering the registration and compliance reporting by copyright licensing bodies/collective management organisations as well as the resolution of disputes regarding royalty amounts payable to those bodies arising mainly in the area of public performance of sound recordings.
4. Contributing to policy and legislative development on IP rights.
5. Providing assistance and information on intellectual property rights.

6.2.1. Committee Deliberations

The Committee did not believe this solution was desirable for several reasons. First, it may cause delays with incorporations by virtue of the fact that the protection of trade marks is open to question, appeal, and taking action before the Controller and the Courts. Second, there were concerns over how the two discrete areas of law would interact and if that interaction would lead to provisions in one Act being prioritised or overruling provisions in the other Act. The issue of additional resourcing for the IPOI was also raised as a problem given the lack of evidence to support any such request. Consequently, the Committee did not consider this a suitable option.

6.2.2. Review Group Recommendation

In light of the Committee's conclusions, the Review Group does not recommend the involvement of the IPOI in the incorporation process

6.3. Amend CRO forms to include a tick-the-box confirmation

Another suggestion considered by the Committee was to amend certain CRO forms relating to incorporation and a company name change. When a company is incorporated a Form A1 must be completed. If a company wishes to change its name, a Form G1Q must be completed. This option suggested the insertion of a tick box onto these forms which would place the onus on the person seeking to register/change the name to ensure that all appropriate checks were made to ensure that

[17] https://www.ipoi.gov.ie/en/about-us/ipoi-publications/annual-reports/ipoi-annual-report-english-2021.pdf

the name is not similar to another company name or registered trade mark. A phrase similar to the below was suggested:

> *"I am not knowingly interfering with another's company name and/or Trade Mark and I have taken all prudent steps to ensure this."*

The intention behind this option was to remove the onus from the CRO when the name is registered and place the onus on the company seeking to register the name.

6.3.1. Committee Deliberations

The Committee considered whether this would provide any remedy for a company whose trade mark is infringed, if this box was included on the relevant form and ticked. It was generally accepted that while it may act as a deterrent in some cases, it would not be an effective overall deterrent or remedy for Trade Mark Squatting with company names. Court proceedings would still have to be instituted to ensure that any infringement ceases. The Committee also discussed whether a "*tick box*" would be more appropriate on the business name forms, but that was not seen as a viable solution. The Committee agreed that registration of a company with a name, which is the cornerstone of company law, should remain a straightforward process. It was also noted that company law does not look at the motivation of a person who is registering a company with a name. Overall the Committee agreed that the company registration process should not be contaminated. Consequently, the Committee did not believe this option would be an effective remedy.

6.3.2. Review Group Recommendation

In light of the Committee's conclusions, the Review Group does not recommend the addition of a tick-the-box confirmation on CRO forms.

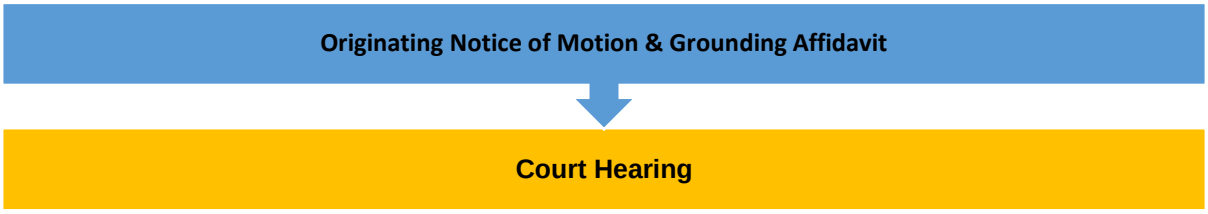
6.4. Add a CRO administrative process with an appeal by way of Originating Notice of Motion

The Committee reviewed the Court process currently available to companies in instances where alleged trade mark infringement has occurred through company incorporation.[18] The options currently available to aggrieved companies include instituting and conducting proceedings in the Circuit Court, High Court or the Commercial Division of the High Court. The Committee sought to identify if the current system could allow for speedier access to the courts in such cases, or if a simpler court process would be permitted similar to that available when restoring companies to the register.

Originating Notice of Motion

Under the Companies Act 2014 and the RSC, some company law applications are permissible by way of Originating Notice of Motion, grounded on affidavit. By way of example, one such application is an application to restore a company to the Company Register. [19] Such applications are made to the "*Court*" which is defined as either the Circuit Court or the High Court.[20]

[18] Information made available to the Committee is set out at Appendix 3
[19] Section 738(1) Companies Act 2014 and Order 74A Rules of the Superior Courts
[20] Section 743(1), Companies Act 2014



The above diagram represents an uncontested application of this nature.

Section 738 provides that the Court may order that a company that has been struck off the register be restored to the register if (a) the striking off of the company has disadvantaged the applicant; (b) the application is made within the period of 20 years after the date of dissolution of the company; and (c) it is just and equitable to do so.[21]

The application must be made on notice to the Registrar of Companies, the Minister for Public Expenditure, and the Revenue Commissioners. Generally, the Registrar and one or more of the other notice parties will furnish a letter of no objection.[22] If the application is made by a creditor of the dissolved company, section 739(2) provides that other members or officers of the company at the date of dissolution, which are known, should be notified of the application.

These are once-off applications and generally will not trouble the Court for any extended period of time. The return date given on the Originating Notice of Motion is approximately six weeks from the date of issue and it is capable of being heard on the first return date. However, there are situations where objections are filed, particularly if the application is made by a creditor. In these circumstances, the application can be adjourned to allow for affidavits to be exchanged between the parties. If this occurs, and subject to the Court's list, the application could take between 6 to 18 months to complete.

Proposed amendments to the Companies Act and the Rules of the Superior Courts

The Committee considered a proposed amendment to the 2014 Act which inserted a new section 30A to amend company law to allow such applications be heard by way of Originating Notice of Motion in the High Court. This option would provide an administrative process whereby a proprietor of the registered trade mark could apply to the Registrar of Companies for a direction that a company change its name. If the Registrar of Companies declined to give such a direction - in cases where the company registered a notice of objection - the proprietor could apply to the Court for an order directing the company to change its name. The draft amendment to the Companies Act and a subsequent amendment to the RSC which were considered by the Committee are set out below.

Draft amendment to the 2014 Act

30A. Change of company name including third party registered trade marks

(1) Where:

(a) a company is at any time registered by a name (whether on its first registration, or on its registration by a new name) which includes words or numerals which are identical with, similar to or likely to be mistaken for[23] a registered trade mark, within the meaning section 6 of the Trade Marks Act 1996 or a registered EU trade mark, within the meaning

[21] Section 738(1), Companies Act 2014
[22] https://www.cro.ie/Portals/0/Leaflets/Info%20Leaflet%2011.pdf
[23] Wording "identical with, similar to or likely to be mistaken for" taken from Trade Marks Act 1996, section 2(2).

of article 1(1) of Regulation (EU) 2017/1001 of the European Parliament and of the Council of 14 June 2017[24] *(in either case in this section, "**the registered mark**");*[25]

(b) the registered mark is at that time registered as a trade mark or EU trade mark and was so registered before the date of delivery to the Registrar of the constitution of the company and other items as provided by section 21;[26]

(c) at that time:

*(i) the proprietor of the registered mark (in this section, "**the proprietor**") is not a member or director of the company and, where the proprietor is a body corporate, the company is not a member of the proprietor;*

(ii) where the proprietor is a body corporate:

(A) the company is not a subsidiary of the proprietor and the proprietor is not a subsidiary of the company;

(B) there is no person who holds office as both a director of the company and a director of or member of the governing body of the proprietor;[27]

(d) the information in the documents of the company which have been received and recorded by the Registrar in pursuance of this Act does not appear to indicate that the company is carrying on a bona fide activity in the State;[28] *and*

(e) the proprietor has not less than one month before that time notified the company and the Registrar of its intention to make an application under this section;[29]

the proprietor may apply to the Registrar in the prescribed form[30] *for a direction that the company shall change its name.*

(2) Upon receipt of an application under subsection (1):

[24] O.J. L 154 16 June 2017, p1.

[25] Paragraph (a) uses language similar to that in CA 2014 section 30(2): "if … a company is registered by a name (whether on its first registration, or on its registration by a new name) which, in the opinion of the Registrar, is too like the name by which a company in existence is already registered."

[26] Paragraph (b) states a requirement that, for a trade mark proprietor to object to a registered company's name, the date of registration of its trade mark must precede the date of delivery to the CRO of the registration documentation of the company.

[27] Paragraph (c) states a requirement that the proprietor must be unconnected with the company.

[28] Paragraph (d) states a requirement that the company's registered documentation must point to its not having a bona fide activity in the State. Wording "any document which has been received and recorded by the Registrar in pursuance of this Act" taken from CA 2014 section 891(1)(a). Wording "bona fide activity in the state" reflecting CA 2014 section 18(1): "A company shall not be formed or registered unless it appears to the Registrar that the company, when registered, will carry on an activity in the State."

[29] Paragraph (e) states a requirement that the proprietor must give at least one month's notice to the company of its intention to apply for a Registrar's direction to change the company name.

[30] The requirement for the application to be in a prescribed form enables the fleshing out of the information to be provided in the form, e.g., particulars of the trade mark registration, the proprietor being the registered proprietor, the absence of any filed document on the company file e.g. a return of allotments indicating a raising of capital, financial statements indicating turnover, a registered office at a real business premises rather than an accommodation address.

(a) where the company has not, prior to the delivery by the proprietor of the application under subsection (1), delivered to the Registrar a notice of objection to the application in the prescribed form[31], the Registrar shall give the direction;[32]

(b) where the company prior to the delivery of the proprietor of the application under subsection (1) delivers to the Registrar a notice of objection to the application, the registrar shall decline to give the direction.[33]

(3) Where the registrar gives a direction:

(a) the company may, within a period of six weeks after the date of its being given, apply to the Court for an order cancelling the Registrar's direction; and

(b) the Court may give a direction to the affirming or cancelling the Registrar's direction and such other orders as it considers fit. [34]

(4) A direction under subsection (2)(a) shall be complied with:

(a) where the company has not applied under subsection (3)(a) for cancellation of the direction, within a period of 6 weeks after the date of its being given or such longer period as the Registrar may think fit to allow;

(b) where the company has applied under subsection (3)(a) for cancellation of the direction and the Court has affirmed the direction, within a period of 6 weeks after the date of the Court's order affirming the direction being given or such longer period as the Court may think fit to allow.[35]

(5) Where the Registrar declines to give a direction within one month of the application under subsection (1):

(a) the proprietor may apply to the Court for an order directing the company to change its name; and

(b) the Court may give or decline to give a direction to the company and the Registrar to change the name of the company and such other orders as it considers fit.[36]

(6) Where the Court gives a direction under subsection (5)(b), it shall be complied with within a period of 6 weeks after the date of its being given or such longer period as the Court may think fit to allow.[37]

*(7) Where a direction under subsection (2)(a) or subsection (4)(c) has not been complied with within the period of 6 weeks or such longer period as the Registrar or Court, as the case may be, may have allowed (in this section, "**the designated date**"), the name of the company shall be changed on the designated date to "Company x Limited", where "x" is the registered number of the company. [38]*

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[31] The company must file a notice of objection in a prescribed form, which would include e.g., a statement of the activity in the state that the company is carrying on and a denial that it is name-squatting

[32] The Registrar would give the direction only where first, she will have satisfied herself that the application by the trade mark proprietor under subsection (1) has been made in the prescribed form and secondly, no notice of objection has been received by her from the company.

[33] The Registrar need do nothing where a notice of objection is received.

[34] Subsection (3) allows the company a second opportunity to contest the application by applying to Court.

[35] Subsection (4) is modelled on CA 2014 section 30(4).

[36] Subsection (5) states the discretion of the Court.

[37] Subsection (6) is modelled on CA 2014 section 30(4).

[38] Subsection (7) provides for a default change of name of, e.g. "Acme Products Limited" to "Company 765432 Limited" where the company does not change its name.

(8) Where the name of a company is changed under this section, the Registrar shall enter the new name in the register in place of the former name, and shall issue a certificate of incorporation altered to meet the circumstances of the case.[39]

(9) A change of name by a company under this section shall not affect any rights or obligations of the company, or render defective any legal proceedings by or against the company, and any legal proceedings which might have been continued or commenced against it by its former name may be continued or commenced against it by its new name.[40]

(10) If a company fails to comply with a direction under subsection (2)(a) or subsection (4)(c) within the period provided under subsection (3) or (5), as the case may be, the company and any officer of it who is in default shall be guilty of a category 4 offence.[41]

Draft amended Rule 16 in Order 75 of the Rules of the Superior Courts[42]

VII. ~~Appeal against refusal to register a name~~ Appeals and applications with respect to company names

16. (1) An appeal under section 26 of the Act against the refusal to register a name of company shall be brought within 21 days after the applicant for such registration has received notice of such refusal but the Court may extend the time within which such appeal may be brought upon such terms (if any) as the Court may direct.

(2) An application under section 30A(3)(a) of the Act for the cancellation of a direction of the Registrar of Companies to a company to change its name shall be brought within 21 days after the expiry of one month after the company has received notice of such direction, but the Court may extend the time within which such application may be brought upon such terms (if any) as the Court may direct.

(3) An application under section 30A(5)(a) of the Act to direct a company to change its name shall be brought within 21 days after the expiry of one month after the delivery of its application to the Registrar of Companies under section 30A(1), but the Court may extend the time within which such application may be brought upon such terms (if any) as the Court may direct.

(4) A copy of the originating notice of motion shall in any such case be served on the Registrar of Companies within four days after it has been filed in the Central Office~~.~~

6.4.1. Committee Deliberations

Additional information was provided by some Committee Members on applications for passing off and/or reliefs under the 1996 Act, highlighting that these are complex by nature. These applications are unlikely to be heard on affidavit and are properly suited to a plenary action (which allows for oral evidence). The purpose of pleadings (which are essentially absent in the Originating Notice of Motion procedure) is to simplify, narrow and define the issues of the parties before the trial of the action.

Currently, applications by Originating Notice of Motion are largely uncontested. Affidavits with the necessary proofs and consents are sworn and filed in advance. The relief sought is relatively straightforward. To allow applications for passing off and/or reliefs under the 1996 Act be brought by way of Originating Notice of Motion instead of Plenary Summons may not simplify or condense the

[39] Subsection (8) is identical to CA 2014 section 30(5).
[40] Subsection (9) is substantially the same as CA 2014 section 30(6).
[41] Subsection (10) is substantially the same as CA 2014 section 30(8).
[42] Rule 16 is expanded to deal with the proposed a 30A as well as section 26.

complexity of such cases. The Committee was cognisant that this option, while potentially quicker at the outset, could ultimately lead to a lengthier process, which could forego proper case management, narrowing of issues between the parties, and a full trial of the action. This is directly contrary to the aims sought to be achieved.

The Committee thus focussed its discussion on situations that could be said to be obvious cases of opportunistic registration or Trade Mark Squatting with company names, based on certain criteria that either side must fulfil.

The Committee agreed that the draft amendment presented limits the scope of application to simple cases, as only uncontested cases that fulfilled certain criteria would be permitted to remain in the administrative process applicable to the Registrar of Companies, and any contested cases would automatically be a matter for the Court. However, concerns were raised regarding the likelihood of the Registrar of Companies being drawn into more complex cases which would require that office to become a decision maker. It would place a greater onus on the Registrar of Companies to compare company names with registered trade marks. Concern was also expressed that this option would see the Registrar of Companies decide on private law rights between parties, while there are ample Court options available. Furthermore, this option was expanding the role of the Registrar of Companies to include considerations under Trade Mark Law as well as Company Law. It was suggested that if decision making role of the Registrar of Companies could be reduced in this option and the decision left the Court, then when the Registrar of Companies is presented with a court order directed a change of name, this could be undertaken.

For these reasons, the Committee ruled out this option as initially proposed.

6.4.2. Review Group Recommendation

In light of the Committee's conclusions, the Review Group does not recommend the introduction of an added administrative process and accompanying appeal procedure.

6.5. Permit objections by way of Originating Notice of Motion

While the Committee did not support the previous option, it further explored an variation of it, which removed the role of the Registrar of Companies and instead proposed a 'fast-track' procedure direct to the Courts for non-complex, obvious cases of Trade Mark Squatting with company names or opportunistic registrations. The same qualifying criteria would apply. Draft text for the proposed amendment to the Companies Act and corresponding change to the Court Rules was provided for the Committee's review, and is included below.

Draft amendment to the 2014 Act

30A. Change of company name including third party registered trade marks

(1) Where the following conditions are met:

(a) a company is at any time registered under a name (whether on its first registration, or on its registration by a new name) which includes words or numerals which are identical with, similar to or likely to be mistaken for[43] *a registered trade mark, within the meaning of section 6 of the Trade Marks Act 1996 or a registered EU trade mark, within the*

[43] Wording "identical with, similar to or likely to be mistaken for" taken from Trade Marks Act 1996, section 2(2),

*meaning of article 1(1) of Regulation (EU) 2017/1001 of the European Parliament and of the Council of 14 June 2017[44] (in either case in this section, "**the registered mark**");[45]*

(b) the registered mark is at that time registered as a trade mark or EU trade mark and was so registered before the date of delivery to the Registrar of the constitution of the company and other items as provided by section 21;[46]

(c) at that time:

*(i) the proprietor of the registered mark (in this section, "**the proprietor**") is not a member or director of the company and, where the proprietor is a body corporate, the company is not a member of the proprietor;*

(ii) where the proprietor is a body corporate:

(A) the company is not a subsidiary of the proprietor and the proprietor is not a subsidiary of the company;

(B) there is no person who holds office as both a director of the company and a director of or member of the governing body of the proprietor;[47]

the proprietor may apply to the Court for an order directing the company to change its name.

(2) Where a proprietor makes an application pursuant to subsection (1):

(a) the Court may give or decline to give a direction to the company and the Registrar to change the name of the company and such other orders as it considers fit;[48]

(b) where the Court gives a direction under paragraph (a), it shall be complied with within a period of 6 weeks after the date of its being given or such longer period as the Court may think fit to allow;[49]

*(3) Where a direction under subsection (2)(a) has not been complied with within the period of 6 weeks or such longer period as the Court may have allowed (in this subsection, "**the designated date**"), the name of the company shall be changed on the designated date to "Company x Limited", where "x" is the registered number of the company.[50]*

(4) Where the name of a company is changed under this section, the Registrar shall enter the new name in the register in place of the former name, and shall issue a certificate of incorporation altered to meet the circumstances of the case.[51]

(5) A change of name by a company under this section shall not affect any rights or obligations of the company, or render defective any legal proceedings by or against the company, and any legal proceedings which might have been continued or commenced against it by its former name may be continued or commenced against it by its new name.[52]

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[44] O.J. L 154 16 June 2017, p1.

[45] Paragraph (a) uses language similar to that in CA 2014 section 30(2): "if … a company is registered by a name (whether on its first registration, or on its registration by a new name) which, in the opinion of the Registrar, is too like the name by which a company in existence is already registered."

[46] Paragraph (b) states a requirement that, for a trade mark proprietor to object to a registered company's name, the date of registration of its trade mark must precede the date of delivery to the CRO of the registration documentation of the company.

[47] Paragraph (c) states a requirement that the proprietor must be unconnected with the company.

[48] Subsection (2)(a) states the discretion of the Court.

[49] Subsection (2)(b) is modelled on CA 2014 section 30(4).

[50] Subsection (3) provides for a default change of name of, e.g. "Acme Products Limited" to "Company 765432 Limited" where the company does not change its name.

[51] Subsection (4) is identical to CA 2014 section 30(5).

[52] Subsection (5) is substantially the same as CA 2014 section 30(6),

(6) If a company fails to comply with a direction under subsection (2)(a) within the period provided under subsection (3), the company and any officer of it who is in default shall be guilty of a category 4 offence.[53]

Draft amended Rule 16 in Order 75 of the Rules of the Superior Courts

VII. ~~Appeal against refusal to register a name~~ [54]
Appeals and applications with respect to company names

16. (1) An appeal under section 26 of the Act against the refusal to register a name of company shall be brought within 21 days after the applicant for such registration has received notice of such refusal but the Court may extend the time within which such appeal may be brought upon such terms (if any) as the Court may direct.

(2) An application under section 30A(1) of the Act for a direction to a company to change its name shall be brought within 21 days after the expiry of one month after the company has received notice of the application of such direction, but the Court may extend the time within which such application may be brought upon such terms (if any) as the Court may direct.

(3) A copy of the originating notice of motion shall be served on the Registrar of Companies within four days after it has been filed in the Central Office.

(4) A copy of the originating notice of motion shall in any such case be served on the Registrar of Companies within four days after it has been filed in the Central Office.

6.5.1. Committee Deliberations

The Committee concluded that using existing structures was preferable and agreed that this option appeared to provide a feasible remedy for obvious cases of Trade Mark Squatting with company names. It also noted that should an obvious case become complex, the case is already in the Court system and can resume the normal process for more complex cases of passing off.

The Committee agreed that this option is a feasible and cost-efficient remedy and should be put forward as a recommendation to the Minister.

The Committee observed, with respect to business names, the inclusion of this remedy in the proposed General Scheme to replace the Registration of Business Names Act 1963 should also be considered.

6.5.2. Review Group Recommendation

The Review Group recommends the amendment of the Companies Act and the RSC so as to facilitate a fast-track application by a trade mark proprietor substantially as set out in this section 6.5.

6.6. Allow applications to the District Court to direct a change of company name

The Law Society representatives noted that, under the section 30 limited circumstances in which the Registrar of Companies can refuse to register a company name or order a company to change its name often means that the only option open to a company facing this issue is to issue proceedings in the High Court, which often incurs significant legal costs.

The Committee considered an amendment to section 30 to give jurisdiction to the District Court to deal with specific applications relating to this issue. At present, the District Court does not have jurisdiction to deal with such cases, and consequently the DCR are silent on the procedure.

[53] Subsection (6) is substantially the same as CA 2014 section 30(8).
[54] Rule 16 is expanded to deal with the proposed a 30A as well as section 26.

The District Court

The District Court is established under section 5 of the Courts (Establishment and Constitution) Act 1961. Section 33 of the Courts (Supplemental Provisions) Act 1961 confers jurisdiction on the District Court. The District Court is a court of summary jurisdiction and its jurisdiction in civil cases is limited to €15,000. Parties may consent to unlimited jurisdiction in the District Court, thus enabling the District Court to award damages in excess of its jurisdictional limits. It is generally held that the District Court has jurisdiction to deal with actions arising out of claims in tort once the value of the claim does not exceed its monetary jurisdiction.

The procedure in the District Court is similar to that described for the High Court (outlined in Appendix C). The initiating document, the claim notice, differs in name but is similar in nature. Order 40 rule 4(1) DCR provides that, subject to the provisions of the DCR which apply to particular categories of claims or cases, a civil proceeding must be commenced by the filing for issue and service of a claim notice. A *claim notice* is defined as a document issued initiating civil proceedings in the District Court in which damages or other relief are claimed against a respondent, and where the context so requires, includes a personal injuries summons, and any reference in an enactment to a "civil summons" must, unless the context otherwise requires, for the purposes of the DCR be taken to be a reference to a claim notice.

An appearance and defence follows.[55] A defence to a claim must state which of the facts stated in the statement of claim are admitted; denied; or not admitted. Following delivery of the claim notice and defence, there is scope for particulars and discovery which may arise. Once all pre-trial matters are concluded, the trial of the action can proceed.

Some company law applications are dealt with in the District Court. One of the most common applications is a section 343 application to extend the time for filing of annual returns. Both the District Court and the High Court have jurisdiction to deal with this, but they are routinely dealt with by the District Court.[56]

The process for such application is set out in Order 93B DCR[57]. The application is made by "notice of application", as opposed to a claim notice, and is accompanied by an affidavit which details and exhibits the relevant evidence and documentation the Court will require to hear and determine the application. These applications are heard on affidavit, which means there is no *viva voce* evidence in Court.

For section 343 applications (and many others), the DCR provides forms in the schedules to the rules. These forms prescribe the form of the document(s) together with a guide towards the substance of the document(s) required for the application.

Potential -amendments to the Companies Act and District Court Rules

A proposed amendment to section 30 of the Companies Act 2014 and a draft rule for inclusion in the DCR (set out below) were considered by the Committee. The amendment confines the District Court to applications relating to Trade Mark Squatting with company names or opportunistic registrations. For

[55] Order 42, rule 1 DCR
[56] Section 343(7) of the 2014 Act.
[57] https://www.courts.ie/rules/applications-extend-time-delivery-annual-return-under-section-343-companies-act-2014-si-no-256

this reason, the amendment is very similar to section 69 of the UK 2006 Act which established the CNT. The draft rule is modelled on Order 93B[58].

[58] https://www.courts.ie/rules/applications-extend-time-delivery-annual-return-under-section-343-companies-act-2014-si-no-256

Draft amendment to section 30

30. Change of name

(1) A company may, by special resolution and with the approval of the Registrar, signified in writing, change its name.

(2) Subsection (3) applies if, through inadvertence or otherwise, a company is registered by a name (whether on its first registration, or on its registration by a new name) which, in the opinion of the Registrar, is too like the name by which a company in existence is already registered.

(3) Where this subsection applies the first-mentioned company in subsection (2)—

(a) with the approval of the Registrar, may change its name; or

(b) if, within 6 months after the date of its being registered by the first-mentioned name in subsection (2), the Registrar directs it to do so, shall change its name.

(4) A direction under subsection (3)(b) shall be complied with within a period of 6 weeks after the date of its being given or such longer period as the Registrar may think fit to allow.

(5) Where:

(a) subsection (3) does not apply; and

(b) the company name:

(i) is the same as a name associated with a company or in which the company has goodwill, or

(ii) is sufficiently similar to such a name that its use in Ireland (or elsewhere) would be likely to mislead members of the public in Ireland (or elsewhere) by suggesting a connection between the company name and another unrelated company, or

(iii) the main purpose of registering the company name was to obtain money (or other consideration) from the company or to prevent the company from registering the name.

*application may be made to the Court by the company (in this section, "**the applicant**") for an order directing a company to change its name (in this section, "**the respondent**").*[59]

(6) The court for the purposes of subsection (5) shall be the District Court for the District Court district where the registered office of the company is located or the High Court.[60]

(7) if the grounds specified at subsection (5)(b) are established, it is for the respondent to show:

(a) that the name was registered before the commencement of the activities on which the applicant relies to show goodwill; or

(b) that the company:

(i) is operating under the name, or

(ii) is proposing to do so and has incurred substantial start-up costs in preparation, or

(iii) was formerly operating under the name and is now dormant.

(c) that the name was registered in the ordinary course of a company formation business and the company is available for sale to the applicant on the standard terms of that business; or

(d) that the name was adopted in good faith; or

(e) that the interests of the applicant are not adversely affected to any significant extent.[61]

[59] This is the same as section 69 of the UK 2006 Act for the CNT.

[60] This is the same as section 343(7) of the 2014 Act which relates to an extension of time for filing annual returns. Both the District Court and the High Court have jurisdiction to deal with this, but they are routinely dealt with by the District Court.

[61] Identical to section 69 of the UK Act

(8) If the respondent does not show any of the grounds in subsection (6), the Court shall direct the respondent to change its name within a period of 6 weeks or within such period as the Court may allow.

(9) The applicant shall deliver a certified copy of the order of the court to the Registrar within 6 weeks of the date of the making of the order.

*(10) Where a direction under subsection (3) or subsection (8) has not been complied with within the period of 6 weeks or such longer period as the Registrar or Court, as the case may be, may have allowed (in this section, "**the designated date**"), the name of the company shall be changed on the designated date to "Company x Limited", where "x" is the registered number of the company.*

(11) ~~(5)~~ Where a company changes its name under this section, the Registrar shall enter the new name in the register in place of the former name, and shall issue a certificate of incorporation altered to meet the circumstances of the case.

(12) ~~(6)~~ A change of name by a company under this section shall not affect any rights or obligations of the company, or render defective any legal proceedings by or against the company, and any legal proceedings which might have been continued or commenced against it by its former name may be continued or commenced against it by its new name.

(13) ~~(7)~~ A company which was registered by a name specified by statute, may, notwithstanding anything contained in that statute, change its name in accordance with subsection (1), but, if the Registrar is of the opinion that any Minister of the Government is concerned in the administration of the statute which specified the name of the company, the Registrar shall not approve of the change of name save after consultation with that Minister of the Government.

(14) ~~(8)~~ If a company fails to comply with a direction under subsection (3)(b) within the period provided under subsection (4), the company and any officer of it who is in default shall be guilty of a category 4 offence.

Draft order for inclusion in the District Court Rules

Order X – Applications to direct a company to change its name

1. In this Order, the "Act" means the Companies Act 2014 (No. 38 of 2014); the "Registrar" means the Registrar of Companies.

2.(1) An application to the Court for an order under section 30(5) of the Act for an order directing a company to change its name, may be heard and determined on affidavit in the Form [INSERT] of Schedule [INSERT], modified to the circumstances of the case.[62]

(2) A notice of application shall be issued by the applicant to the respondent and the Registrar in the Form [INSERT] of Schedule [INSERT], modified to the circumstances of the case.

(3) The notice of application shall include-

(i) the name, registered number and location of the registered office of the applicant (and that the registered office is within the court district in which the application is made)

(ii) the name of the respondent, including the number and location of the registered office of the respondent

(iii) the relevant subsection under section 30(5)(b) upon which the applicant relies[63]

(iv) [INSERT any other relevant information]

(4) An affidavit relied on in an application under this Order shall be sworn by a director or secretary of the company and shall-

[62] Most applications to the DC have an appropriate form which the document should take.
[63] This is based off the draft amendment to section 30 of the 2014 Act

(i) *Verify the facts set out in the notice of application;*

(ii) *[INSERT any other relevant information]*

3. *The applicant shall serve on the Respondent a copy of the notice of application and copies of any affidavit and exhibits relied on not later than 21 days before the date fixed for hearing the application.*
4. *An order directing a change of name in accordance with section 30(8)*[64] *shall be in the Form [INSERT] of Schedule [INSERT], and the applicant shall cause certified copy of the order to be served upon the Registrar in accordance with section 30(9) of the Act, and on any other person whom the Court directs should be served with a copy of the order.*
5. *An application under this Order may be brought, heard and determined at any sitting of the court for the court district wherein the registered office of the applicant company is situated.*[65]

6.6.1. Committee Deliberations

The Committee Members noted the possible benefits of this option, namely that the infrastructure already exists which is preferable to establishing a new body and that as a general principle, fees in the District Court tend to be lower than the Superior Courts. However, a number of Committee members who had experience in District Court operations raised concerns about the appropriateness of the above.

It was posited that this type of application which seeks passing off and/or reliefs under the 1996 Act may not be appropriate for the District Court. The District Court provides an excellent function for high-volume low-complexity applications, but cases of this nature would involve adjudication on complex legal issues. It is likely that these matters would not conclude in an ordinary Court list, and may require a separate date and time to be heard and further delays would be incurred in this instance in order to find a judge with available time and expertise to deal with these applications.

The Committee was aware of the lengthy delays that District Court proceedings can face due to a lack of resourcing. Reference was made to the Family Courts Bill 2022, which proposes a Family District Court as a division within the existing court structure and to transfer judicial separation and divorce from the Circuit Court to the District Court. This proposal has faced strong criticism.[66] It could be argued that an application could be heard earlier in the District Court than the Circuit or High Court and legal costs could be lower, but this has to be balanced with credible access to justice.

Overall the Committee did not consider that this would be a viable option.

6.6.2. Review Group Recommendation

In light of the Committee's conclusions, the Review Group does not recommend the introduction of a District Court procedure to address the issue.

6.7. Amend the Trade Marks Act

The final option considered by the Committee was an amendment to the 1996 Act to permit more passive cases of opportunistic registration or Trade Mark Squatting with company names to be brought before the Court.

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[64] This is based off the draft amendment to section 30 of the 2014 Act

[65] Paras 4 and 5 are almost identical to Order 93B, rules 5 and 6 DCR.

[66] Keith Walsh SC, "*Towards a better reform of the Family Justice System*", The Parchment, Winter 2023, Issue 98 https://issuu.com/256media/docs/parchment_winter_2023-flipbook?e=16581915/97855617

Section 14 of the 1996 Act deals with infringement of a registered trade mark. Section 14(1) provides that a person shall "*infringe a registered trade mark if that person* ***uses in the course of trade*** *a sign which is identical with the trade mark in relation to goods or services which are identical with those for which it is registered*."[67] (emphasis added)

Infringement of a trade mark will also occur if a person "*uses in the course of trade*" a sign where (a) the sign is identical with the trade mark and used in relation to goods or services similar to those for which the trade mark is registered; or (b) the sign is similar to the trade mark and is used in relation to goods or services identical with or similar to those for which the trade mark is registered and there exists a likelihood of confusion on the part of the public, which includes the likelihood of association of the sign with the trade mark.[68]

A registered trade mark shall be infringed if that person "*uses in the course of trade*" a sign which (a) is identical with or similar to the trade mark, and (b) is used in relation to goods or services which are not similar to those for which the trade mark is registered, where the trade mark has a reputation in the State and the use of the sign, being without due cause, takes unfair advantage of, or is detrimental to, the distinctive character or the reputation of the trade mark.[69]

A key issue in determining the scope of section 14 of the 1996 Act is the concept of "*use in the course of trade*".

Trade is defined in section 2 of the 1996 Act as including "any business or profession". Section 2(2) states: "*References in this Act to use (or any particular description of use) of a trade mark, or of a sign identical with, similar to, or likely to be mistaken for a trade mark, include use (or that description of use) otherwise than by means of a graphic representation.*"

The Court of Justice has stated that "*use*" in certain German, English, French, Italian, Dutch and Hungarian versions of the Trade Mark Directive involves "*active behaviour and direct or indirect control of the act constituting the use*."[70]

Section 14(4) of the 1996 Act provides a non-exhaustive list of use of a sign, which includes:

(a) affixing it to goods or the packaging thereof;

(b) offering or exposing goods for sale, putting them on the market or stocking them for those purposes under the sign, or offering or supplying services under the sign;

(c) importing or exporting goods under the [sign;]

(d) using the sign on business papers or in advertising;

(e) using the sign as a trade or company name or part of a trade or company name; or

(f) using the sign in comparative advertising in a manner that is contrary to the European Communities (Misleading and Comparative Marketing Communications) Regulations 2007 (S.I. No. 774 of 2007).

Section 14(4)(e) was inserted by the European Union (Trade Marks) Regulations 2018 (S.I. No 561 of 2018) and implements Article 10 of Directive (EU) 2015/2436 headed "*Rights conferred by a trade mark*", which states:

[67] Section 14(1) Trade Marks Act 1996
[68] Section 14(2) Trade Marks Act 1996
[69] Section 14(3) Trade Marks Act 1996
[70] AG v Együd Garage C-179/15, [2016] ETMR 27 at para 39.

1. *The registration of a trade mark shall confer on the proprietor exclusive rights therein.*
2. *Without prejudice to the rights of proprietors acquired before the filing date or the priority date of the registered trade mark, the proprietor of that registered trade mark shall be entitled to prevent all third parties not having his consent from using in the course of trade, in relation to goods or services, any sign where:*
   (a) the sign is identical with the trade mark and is used in relation to goods or services which are identical with those for which the trade mark is registered;
   (b) the sign is identical with, or similar to, the trade mark and is used in relation to goods or services which are identical with, or similar to, the goods or services for which the trade mark is registered, if there exists a likelihood of confusion on the part of the public; the likelihood of confusion includes the likelihood of association between the sign and the trade mark;
   (c) the sign is identical with, or similar to, the trade mark irrespective of whether it is used in relation to goods or services which are identical with, similar to, or not similar to, those for which the trade mark is registered, where the latter has a reputation in the Member State and where use of that sign without due cause takes unfair advantage of, or is detrimental to, the distinctive character or the repute of the trade mark.
3. *The following, in particular, may be prohibited under paragraph 2: …*
   (d) using the sign as a trade or company name or part of a trade or company name.

'Use in the course of trade' - case law

The phrase 'use in the course of trade' has been considered at length. In *Arsenal Football Club plc v Reed*[71], the defendant sold merchandise bearing signs which were identical to the registered trade marks of the plaintiff, and these goods were offered for sale outside Arsenal's stadium grounds. The merchandise clearly stated that it was unofficial. In the UK High Court, Laddie J held that the use of the plaintiff's trade marks would not be perceived by consumers as indicating the origin of the goods and that there was no infringing use of the plaintiff's marks as they were used as 'a badge of support, loyalty or affiliation'. The matter was referred to the ECJ who had to clarify whether use of a mark was necessary to establish infringement.

The ECJ said:

> *"'where a third party uses in the course of trade a sign which is identical to a validly registered trade mark on goods which are identical to those for which it is registered, the trade mark proprietor is entitled, in circumstances such as those in the present case, to rely on Article 5(1)(a) of the (then) Community Trade Mark Directive to prevent that use."*

The Court found that although the defendant stated that the goods were unofficial, he had infringed the plaintiff's registered trade marks. When the matter came back before Laddie J, he dismissed the plaintiff's claim. The matter ended up in the Court of Appeal. That court held that the defendant used the plaintiff's marks to create the impression of a link between his goods and those of the plaintiff and such use jeopardised the ability of the plaintiffs' trade marks to guarantee origin.

[71] [2003] EWCA Civ 696

In *International Business Machines Corporation & Ors v Web-Sphere Ltd*[72], the plaintiffs were the proprietors of a registered Community Trade Mark for WEBSPHERE, covering goods and services in Classes 9, 38 and 42, which had been in use since 1998 for a software application. The defendant was established in 1997, changed its name in 1999 to Web-Sphere Limited and, that same year, registered three domain names: www.web-sphere.com; www.web-sphere.net and www.web-sphere.org. The defendant offered internet-related computer services under the Web-Sphere brand since 2000 and, in 2002, announced his intention to launch software under the Web-Sphere brand.

The plaintiffs brought a claim for trade mark infringement. The defendant asserted, inter alia, that the plaintiffs' mark should never have proceeded to registration in the first place, that its mark (Web-Sphere) was different from WEBSPHERE, that it did not use the mark in relation to the goods of the plaintiffs and that there was no evidence of confusion.

The court assessed the marks under the double identity provision. In comparing the marks, the court noted that the only difference between them was the hyphen in the defendant's mark. The defendant argued that the hyphen was important and that internet users would 'appreciate the necessity of absolute accuracy in typing an internet address'. The court found that this argument presupposed that the user remembered that the mark did, or did not, have a hyphen.

When the marks were compared side by side, the court found that they were identical. As the goods were both software-related, the marks were deemed identical. The plaintiffs' claim of double identity was established, and the court directed the defendant to change its name and to either cease use of the domain names or to assign them to IBM.

In *Supreme Petfoods Limited v Henry Bell & Co (Grantham) Limited*[73], the plaintiff owned a UK registration for SUPREME (word) and several UK and EUTMs for figurative versions thereof, all related to foodstuffs for animals and related goods in Class 31. The plaintiff traded since the 1980s and first sold canned dog food in the 1990s. It launched a rabbit food, which became its main product, and which was sold under the name 'Russel Rabbit'. The words SUPREME PETFOODS and SUPREME were used on the packaging. The food range was extended to serve several small animals, including hamsters, gerbils, rats, and ferrets and each was given a character name (such as Harry Hamster and Reggie Rat).

Subsequent changes of packaging over the years saw the SUPREME element reduced in size until, in the early 2000s, any reference to SUPREME was removed from the front of the packaging, although the company name, Supreme Petfoods Limited, appeared on the back. In 2007, the word SUPREME was reinstated on the plaintiff's packaging and the back referred to 'Supreme Original Complete Muesli' and 'Supreme original Russel Rabbit'. The packaging also referred to 'SUPREME QUALITY' and 'Supreme Petfoods' thereon and the side of the packaging bore the plaintiff's website, www.supremepetfoods.com.

The defendant was established in the early 1820s and it manufactured cereals and foods for wildlife and small animals. In 2009 it acquired another pet food business that traded as 'Mr Johnsons'. The defendant's new packaging, in 2012, contained the words 'SUPREME RABBIT MIX' thereon, a term it had used since 1994.

[72] [2004] EWHC 529
[73] [2015] EWHC 256 (Ch).

The plaintiff issued trade mark infringement proceedings. The Court noted that the CJEU had established six conditions which a trade mark proprietor must meet to succeed in a double identity claim, as follows:

i. there must be use of a sign by a third party within the relevant territory;

ii. the use must be in the course of trade;

iii. it must be without the consent of the proprietor of the trade mark;

iv. it must be of a sign which is identical to the trade mark;

v. it must be in relation to goods or services which are identical to those for which the trade mark is registered; and

vi. it must affect, or be liable to affect, one of the functions of the trade mark.

vii. He found that the first four conditions had been met.

The Court noted that a likelihood of confusion was to be presumed where there is use, in the course of trade, of a sign identical to the trade mark in relation to goods identical to those for which the trade mark was registered. However, he noted that the defendant used the term 'SUPREME RABBIT MIX' for over 20 years with no evidence of confusion and he concluded that this use did not adversely affect the functions of the trade mark. Although the marks and goods were identical, Judge Arnold found that there was no likelihood of confusion because the use by the defendant of the common element 'SUPREME' was insufficient for a finding of confusion and the defendant also used 'Mr Johnsons' trade mark which negated any likelihood of confusion. The court found several of the plaintiff's marks to be invalid and the claim failed.

6.7.1. Committee Deliberations

The Committee accepted that Ireland has a robust IP framework which provides legal certainty over IP rights both domestically and across the European Union. A Committee Member highlighted that to delete "*in the course of trade*" would be to delete reference to Directive (EU) 2015/ 2436**.** This cannot be done as it would lead to Ireland diverging from EU law and Irish case law. The Committee, in considering these factors, agreed that this option would not be feasible.

6.7.2. Review Group Recommendation

In light of the Committee's conclusions, the Review Group does not recommend amendments to the Trade Marks Act to address the issue.

6.8. Summary and Recommendation

The Review Group has considered the issue identified by the Law Society's Intellectual Property and Data Protection Law Committee concerning Trade Mark Squatting with company names. This is the bad faith registration or use of a generally well-known company name that may infringe on a registered trade mark, often with the sole motive to sell the company name to the brand owner for a profit at a later stage.

The Law Society submitted that brand owners are often forced to settle with these "squatters" as there is no cost-effective option available to tackle this problem other than to take a case to the High Court or the Commercial Court.

When reviewing the options, the Committee was very mindful of the lack of information available on the prevalence of this problem, which is hard to determine given it is often settled privately outside of court. However, there was an appreciation among the Committee that bad faith registrations or Trade Mark Squatting with company names does occur albeit it is not clear how often the issue arises in practice.

The Review Group was not asked to consider an alternative to the existing options to pursue a trade mark infringement. Rather, it was being asked to consider the limited circumstances in which a brand owner can object to a company name that contains references to or can be mistaken for a trade mark registered by a brand owner.

Given the foregoing factors, any recommendation has to meet the dual objectives of providing a remedy and in a cost-efficient manner. In that regard, by way of example, one of the Law Society's suggestions of establishing a body in Ireland similar to the Company Names Tribunal in the UK would simply not be justified in the context of the estimated number of cases in Ireland in a given year.

The Review Group's task, after acknowledging that an issue exists, albeit unknown as to its extent, is to recommend a remedy that is feasible, cost efficient and reflective of a modern company law regime.

The Review Group therefore recommends the course of action described at section 6.5 of this Report, which will facilitate a court process to permit applications by way of Originating Notice of Motion.

This recommendation relies on existing and established procedures while at the same time facilitating, should the need arise, the escalation of complex cases to a full court hearing.

Appendix A Section 30, Companies Act 2014

Section 30 of the 2014 Act provides:

(1) A company may, by special resolution and with the approval of the Registrar, signified in writing, change its name.

(2) Subsection (3) applies if, through inadvertence or otherwise, a company is registered by a name (whether on its first registration, or on its registration by a new name) which, in the opinion of the Registrar, is too like the name by which a company in existence is already registered.

(3) Where this subsection applies the first-mentioned company in subsection (2)—

(a) with the approval of the Registrar — may change its name; or

(b) if, within 6 months after the date of its being registered by the first-mentioned name in subsection (2), the Registrar directs it to do so — shall change its name.

(4) A direction under subsection (3)(b) shall be complied with within a period of 6 weeks after the date of its being given or such longer period as the Registrar may think fit to allow.

(5) Where a company changes its name under this section, the Registrar shall enter the new name in the register in place of the former name, and shall issue a certificate of incorporation altered to meet the circumstances of the case.

(6) A change of name by a company under this section shall not affect any rights or obligations of the company, or render defective any legal proceedings by or against the company, and any legal proceedings which might have been continued or commenced against it by its former name may be continued or commenced against it by its new name.

(7) A company which was registered by a name specified by statute, may, notwithstanding anything contained in that statute, change its name in accordance with subsection (1), but, if the Registrar is of the opinion that any Minister of the Government is concerned in the administration of the statute which specified the name of the company, the Registrar shall not approve of the change of name save after consultation with that Minister of the Government.

(8) If a company fails to comply with a direction under subsection (3)(b) within the period provided under subsection (4), the company and any officer of it who is in default shall be guilty of a category 4 offence.

Appendix B Relevant information on the Registration of Trade Marks

Benefits of registering a trade mark: Registering a trade mark creates an official record of the rights as owner of a particular Trade Mark. It is one of the strongest ways to defend a brand as registration grants a statutory right, subject to certain conditions, to prevent others from using the trade mark without the registered proprietor's permission. The proprietor of the Registered Trade Mark may take infringement proceedings before the court to prevent others from benefiting from the reputation established by the use of a trade mark. Registration also confers an exclusive right to authorise others by means of licensing to use the trade mark for the goods and /or services for which the trade mark is registered.

If a trade mark is not registered, another company may do so and acquire those rights to distinguish their goods and services.

Trade Mark Search Tools: Before applying for a new trade mark, the IPOI states that it is essential for an applicant to make sure that they are free to use it in so far as it is not similar or identical to any trade mark already existing (registered) or the subject of an existing pending application for registration of a mark in the same classes of goods or services. It is also important to regularly consult trade mark databases and the Journal to check if similar or identical trade marks to the proprietor of the registered trade mark are being registered. The proprietor may be interested in taking legal action against someone else's Trade Mark application or registration.

The Application Process to Register a trade mark: application must be made to the IPOI. As part of that process, an **examination** is carried out including a search of the National and the European Union Trade Mark Databases to see if there is a similar or identical trade mark registered or pending with an earlier filing date. If there is, the IPOI will write to the applicant, setting out their options and give time in which to respond.

If a Trade Mark application is accepted by the IPOI, it is **published** in the Journal which is available to view on the website.[74] There is a three month period within which parties may file observations or an opposition to its registration. If opposition is not filed against the trade mark application, the applicant will be requested to pay the registration fee of €177 to complete registration of the Trade Mark.

If there is **opposition**, a third party may formally object to an application for a registration of a trade mark.[75]

[74] IPOI Journals, https://www.ipoi.gov.ie/en/ip-search-tools/search-the-journal/download-journals/ipoi-journals.html

[75] 10 Trade Marks Act 1996, s 43(2); see further, https://www.ipoi.gov.ie/en/types-of-ip/trade-marks/after-you-apply/opposition/#:~:text=accept%20YouTube%20cookies-,Filing%20Opposition,which%20the%20opposition%20is%20based

Appendix C Current Court Processes Available in cases of Trade Mark Infringement

If a company believes that their trade mark or business is being used unlawfully, they may issue proceedings in the Irish Courts. Such actions will usually seek protection under the common law tort of passing off[76] or pursuant to statute including, but not limited to, (i) the 1996 Act: (ii) the Copyright and Related Rights Act 2000; (iii) the Industrial Designs Act 2001.

Proceedings are normally instituted in the High Court and can follow the traditional route, or application can be made to admit the proceedings to the Commercial List of the High Court.[77] The Circuit Court has jurisdiction to hear and determine such applications, however this is rarely utilised.

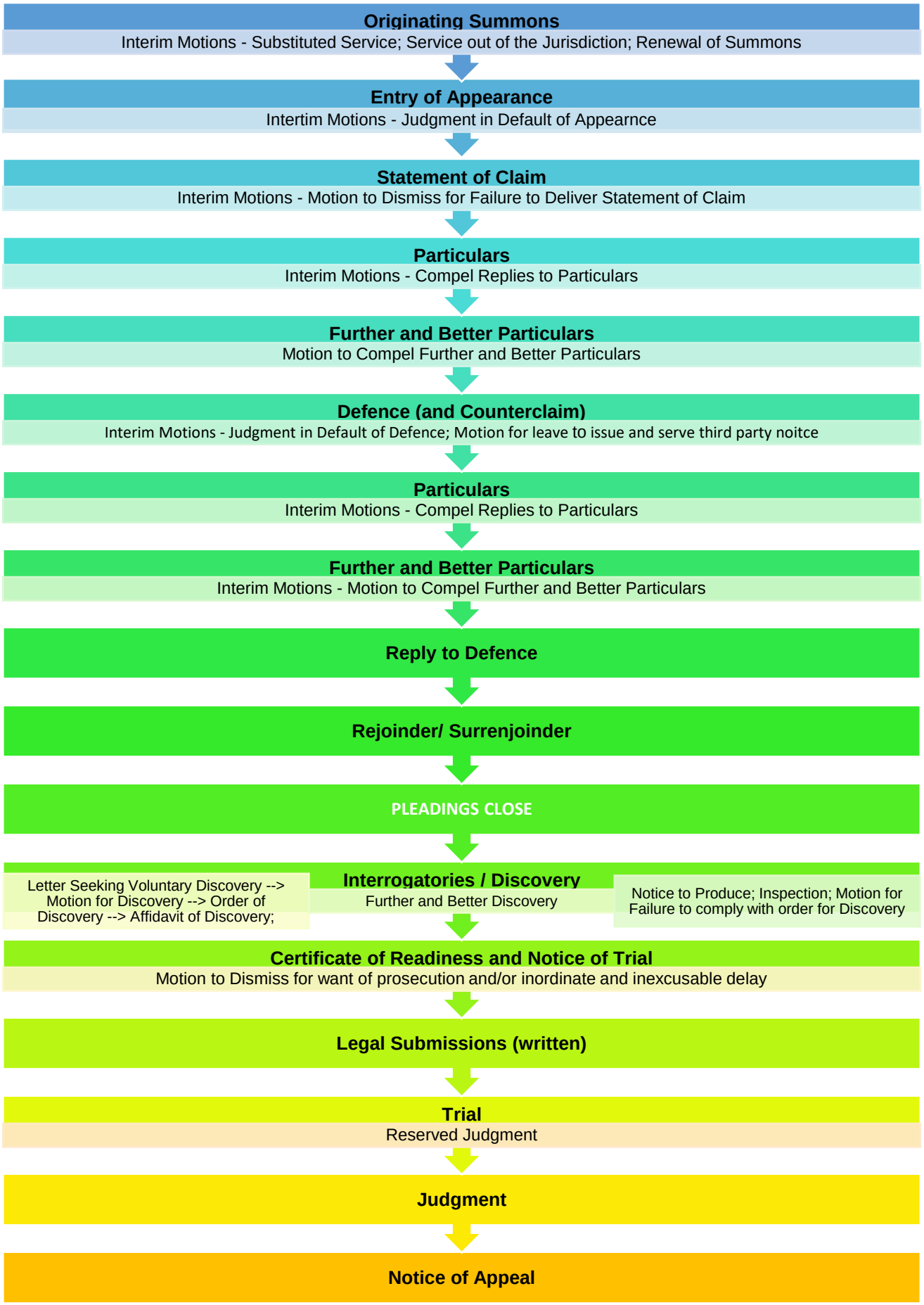
High Court Proceedings

The expected path of High Court proceedings is set out below for reference. Every case is different and brings its own complexity. The emboldened heading is the main pleading/step in the proceedings and the smaller text underneath each represents an additional extra step which may occur. For example, a Summons may be served by the Plaintiff on a Defendant. The Defendant might not enter an appearance to the Summons in the Central Office of the High Court, as required, and therefore, the Plaintiff may bring a motion for judgment in default of appearance.

Every effort has been made to include the various steps in Court proceedings, however there are many more applications and/or steps which may occur in court proceedings including for instance an application for an injunction at the outset of the proceedings and attempts at alternative dispute resolution . The Rules of the Superior Courts sets out timelines for each step, however they are often honoured in the breach.

[76] The key elements of the tort are:
1. The claimant has goodwill in its business that has been built up through the use of a mark attaching to the business or its relevant goods or services.
2.There is a misrepresentation leading to confusion between what is alleged to be the offending business or its products/ services and the claimant's business or its products/services.
3.The claimant has, or will, suffer damage by reason of the misrepresentation.

[77] Order 63A of the Rules of the Superior Courts


Originating Summons
Interim Motions - Substituted Service; Service out of the Jurisdiction; Renewal of Summons
Entry of Appearance
Intertim Motions - Judgment in Default of Appearnce
Statement of Claim
Interim Motions - Motion to Dismiss for Failure to Deliver Statement of Claim
Particulars
Interim Motions - Compel Replies to Particulars
Further and Better Particulars
Motion to Compel Further and Better Particulars
Defence (and Counterclaim)
Interim Motions - Judgment in Default of Defence; Motion for leave to issue and serve third party noitce
Particulars
Interim Motions - Compel Replies to Particulars
Further and Better Particulars
Interim Motions - Motion to Compel Further and Better Particulars
Reply to Defence
Rejoinder/ Surrenjoinder
PLEADINGS CLOSE
Letter Seeking Voluntary Discovery --> Motion for Discovery --> Order of Discovery --> Affidavit of Discovery;
Interrogatories / Discovery
Further and Better Discovery
Notice to Produce; Inspection; Motion for Failure to comply with order for Discovery
Certificate of Readiness and Notice of Trial
Motion to Dismiss for want of prosecution and/or inordinate and inexcusable delay
Legal Submissions (written)
Trial
Reserved Judgment
Judgment
Notice of Appeal

Commercial Court Proceedings

The Commercial Court is a division of the High Court which deals solely with significant commercial cases. Proceedings start in the same manner with the issue of a Summons, however on the application of either the Plaintiff or the Defendant, application can be made to the Judge in Charge of the Commercial List for an order entering the proceedings into the Commercial List (the "**entry application**"). The procedure is contained in Order 63A of the RSC.

Order 63, rule 1(a)(e) and (f) defines commercial proceedings as:

> *"(e) any proceedings instituted, application made or appeal lodged under:*
>
> *(i) the Trade Marks Act 1996;*
>
> *(ii) the Copyright and Related Rights Act 2000;*
>
> *(iii) the Industrial Designs Act 2001;*
>
> *(f) any proceedings instituted for relief in respect of passing off."*

Proceedings before the Commercial Court follow the same life as regular High Court proceedings but are expedited. The entry application, if successful, will generally be treated as the first directions hearing and the court will fix strict timelines for the progression of the case. Non-compliance with the directions is not tolerated and the Court retains a discretion to remove any cases from the commercial list.

There are significantly higher costs involved given the value of the case, the expedited nature of the proceedings and the resources, including lawyers, required to get a case to hearing before the Commercial Court. By way of example, a party seeking entry into the commercial list must pay €5,000 stamp duty on the entry application. This is in comparison to the €190 stamp duty on a Summons.[78]

[78] https://www.courts.ie/content/fees-payable-central-office-and-examiners-office