

The Brief



The Official Journal of the Irish Institute of Legal Executives

2018 ISSUE



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Statutory Protection of Trade Marks
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Legislation Update**

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**Profile of Charlie Flanagan,
Minister for Justice and Equality
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EDITORIAL TEAM

We the Editorial team hereby extend many thanks to all of those who contributed articles as well as photographs for this Edition of the Official Journal of IILEX – "The Brief".

Your contribution and interest in being involved is much appreciated and makes all of the difference towards the production of a quality publication. All of our members and others should really enjoy reading the many interesting features and viewing the various exciting photographs kindly supplied by you,

If you have any social or current events coming up in the near future that you would like to see advertised or written about on the IILEX Website, or furthermore, maybe for inclusion in the next Edition of "The Brief", then please feel free to send information, photographs and other images to the following address:-

The Irish Institute of Legal Executives.

22/24 Lower Mount Street, Dublin 2 DX No. 15

Telephone: - (01) 890 4278 Email - info@iilex.ie www.iilex.ie

Congratulations and well done all.

Mary O'Dwyer, IILEX
Director of PR/Communications
Editor

President's Address

Dear Members,

It is a great honour and privilege to hold the position of President of the Irish Institute of Legal Executives for another year.

During the past year the Institute has been steadily moving forward. IILEx has been invited by the Property Registration Authority to be part of their Customer Focus Group. Our members were asked to take part in an online survey conducted by the PRA. Many thanks to all our members who took part in this survey. I would like to thank the PRA for inviting us to be part of this marvellous opportunity which we will continue to support.

On another positive note, IILEx has been invited to make submissions to the Legal Services Regulatory Authority (LSRA) in order to assist the LSRA to its statutory obligation to prepare a report into the education and training of legal practitioners in the State, i.e. Section 34 of the Legal Services Regulation Act 2015 and also public consultation on Section 6 Review of the LSR Act, 2015. Thank you to the LSRA for IILEx's inclusion in these submissions.

During the year the Directors and staff of IILEx have worked diligently to ensure that the Institute continues to reflect our Mission Statement: "IILEx promotes the practical efficient delivery of Legal Services in a quality ethical manner, incorporating the very best practices within the Legal Profession to the ultimate benefit of the Legal Consumer." We have attended various talks and meetings representing the best interest of Members and the Institute at all times.

I am very pleased that Griffith College Cork and Dublin continue to provide Legal Executive graduates. I would like to congratulate all of those students who graduated this year

and look forward to them becoming full members of the Irish Institute of Legal Executives in the future.

Please note that we can be contacted for information, to give assistance and help in any way that we can at info@iilex.ie. We can also be found on LinkedIn and Facebook through our home page www.iilex.ie. We encourage all our Members to give us feedback and share ideas as it is in sharing that we can continue to grow and learn from each other as we move forward as an Institute.

We have seen lapsed Members returning to membership, membership numbers have maintained a steady increase over the last year. I would also call upon current Members to encourage their colleagues who may fulfill IILEx's required criteria to become Members of the Institute.

I would like to take this opportunity to thank IILEx Directors and Staff on their hard work during the year, and, on behalf of the Board of Directors of IILEx, I would like to thank you our Members for your continued loyal support and look forward to another positive IILEx year!

Deirdre Littrean-Butler, FIILEX
President
Irish Institute of Legal Executives



Would you like to tip the scales in your favour?

If you are currently working in a legal environment you may be eligible to become a Legal Executive and obtain membership of the Irish Institute of Legal Executives - (IILEX) a corporate body formed in 1987, incorporated in 1992 whose Board of Directors consists of Legal Executives.

The primary aim of the Institute is to act as a regulatory body, which in conjunction with Griffith College based in Dublin and Cork provide a system of legal training and examination for the purpose of achievement of recognised professional qualification such as the current Diploma in Legal Studies and Practice (QQ1) for those engaged in legal work.

Applications for enrolment for membership must be made on the prescribed application form which is available from the Institute's registered office address:

The Irish Institute of Legal Executives
22/24 Lower Mount Street, Dublin 2
as well as the Institutes' Website at:
www.info@iilex.ie



All relevant information relating to the Irish Institute of Legal Executives – IILEX as well as membership is also available on the Website. The Irish Institute of Legal Executives would be delighted to hear from you in the near future.

You need us for direction; We need you for strength and resources

For an application form visit www.iilex.ie or contact 01 890 4278 or info@iilex.ie

Charlie Flanagan

Minister for Justice and Equality

– Profile –



Charlie Flanagan is the Minister for Justice and Equality. He was appointed to this role on 14 June 2017, having previously served as Minister for Foreign Affairs and Trade. He was Minister for Children and Youth Affairs for a period in 2014.

During his tenure as Minister for Foreign Affairs and Trade he represented the Irish Government in the Talks processes leading to the Stormont House Agreement (2014) and the Fresh Start Agreement (2015). Along with the Taoiseach he co-convened the All-Island Civic Dialogue on Brexit and played a senior role in advancing Ireland's strategic interests in the period leading up to the triggering of Article 50 and the establishment of the EU negotiating directives in respect of the UK's withdrawal from the EU.

Charlie Flanagan was first elected to represent Laois-Offaly (now the constituency of Laois) in Dáil Éireann in 1987 and was a member of Laois County Council from 1987 to 2004. His father, Oliver J. Flanagan TD, represented Laois-Offaly from 1943 to 1987 and served as Minister for Defence (1976-1977), Parliamentary Secretary to the Minister for Defence (1975-1976) and Parliamentary Secretary to the Minister for Agriculture (1954-1957).

Charlie Flanagan served as Chairperson of the Fine Gael Parliamentary Party 2011-2014 and was the leader of the Fine Gael group at the Constitutional

Convention. He served as Fine Gael Chief Whip 2000-2002 and was the Party's spokesperson in a diverse range of portfolios during his career as a TD including Health and Enterprise, Trade and Employment. During the 30th Dáil he was Fine Gael Front Bench Spokesperson on Children and Youth Affairs (2010-2011) and Justice, Equality and Defence (2007-2010), playing a very active role in contributing to legislation and Fine Gael policy.

He was Fine Gael Spokesperson on Northern Ireland from 1997-2000 and Vice-Chair of the British-Irish Parliamentary group from 1997 to 2000. He chaired, inter alia, the Oireachtas Sub-Committee on Legislation and Security (1994-1997) and served as Vice-Chair of the Oireachtas Joint Committee on Women's Rights (1995-1997).

A qualified solicitor who practised law for many years, he has published draft bills and amendments in a range of legislative areas including Competition Law, Corruption, White Collar Crime, Fraud and Bribery.

He was educated in Knockbeg College, University College Dublin (BA degree in History and Politics) and the Incorporated Law Society of Ireland.

Born and raised in Mountmellick, he now lives in Portlaoise with his wife Mary. He has two daughters, Olwyn and Sophie.

Administration of Justice in Public and the Gilchrist Decision

Administering justice in public is an imperative associated with Article 34.1 of the Constitution which provides that; "Justice shall be administered in courts established by law by judges appointed in the manner provided by this Constitution, and, save in such special and limited cases as may be prescribed by law, shall be administered in public."

Underpinning such a provision is the potential avoidance of corruption or prejudice which could be associated with proceedings in private, indeed seen an essential feature of a democratic society as observed by Keane J. (as he then was) in *Irish Times v. Ireland* [1998] 1 IR 359 at p.409:

"Justice must be administered in public, not in order to satisfy the merely prurient or mindlessly or inquisitive, but because, if it were not, an essential feature of a truly democratic society would be missing. Such a society could not tolerate the huge void that would be left if the public had to rely on what might be seen or heard by casual observers, rather than on a detailed daily commentary by press, radio and television. The most benign climate for the growth of corruption and abuse of powers, whether by the judiciary or members of the legal profession, is one of secrecy."

Furthermore, such a requirement speaks of a philosophical viewpoint that public proceedings not only protect us from such ill willed endeavours, but also from the invasion of liberty by the well meaning who act without sufficient understanding, per Brandeis J in *Olmstead v US* (1928) U.S. 433, at 479.

Article 34.1 presupposes that the court processes shall always take place in public save to the extent that the law allows otherwise. As an example of a legal provision dealing with proceedings otherwise than in public section 45 of the Courts (Supplemental) Provisions Act 1961, as follows:

"45.—(1) Justice may be administered otherwise than in public in any of the following cases:

- (a) applications of an urgent nature for relief by way of habeas corpus, bail, prohibition or injunction;
 - (b) matrimonial causes and matters;
 - (c) lunacy and minor matters;
 - (d) proceedings involving the disclosure of a secret manufacturing process;
- (2) The cases prescribed by subsection (1) of this section shall be in addition to any other cases prescribed by any Act of the Oireachtas.



- (3) Any provision contained in any statute of the Parliament of the former United Kingdom or of the Oireachtas of Saorstát Éireann which provided for the administration of justice otherwise than in public and which is not in force solely by reason of its being inconsistent with the provisions of the Constitution of Saorstát Éireann or the Constitution, as the case may be, shall have full force and effect."

These examples of cases which may be heard in private are supplemented by many other idiosyncratic legislative provisions dealing with cases with a particular subject matter which the legislature has determined merits consideration of the matter otherwise than in public.

From a judicial standpoint little consideration was evident in this area until the Supreme Court case of *In re R. Ltd.* [1989] I.R. 126. This case dealt with, the then, section 205 of the Companies Act 1963, which allowed for proceedings in respect of alleged oppression of a member of a company, and provided that if the proceedings would involve the disclosure of information the publication of which would be seriously prejudicial to the legitimate interests of the company, the court could order that the hearing of the proceedings or any part thereof shall be *in camera*.

The majority judgement in that case, exemplified by the judgment of Walsh J, held that whatever criteria had to be satisfied by a particular legal provision admitting an exception to the administration of justice in public amounted to a condition precedent to the exercise of a judicial discretion, and in addition a court must be of the opinion that the case proceeding in public would render it impossible for the court to do justice between the parties in the case.

He held that:

"that a public hearing of the whole or of that part of the proceedings which it is sought to have heard other than in public court would fall short of the doing of justice", at 137.

Additionally, he considered moreover that the Constitution of 1937 removed any judicial discretion to hear proceedings other than in public save where expressly conferred by statute. He also considered that it was well established that a phrase such as “save in such special and limited cases it may be prescribed by law” related only to a post-1937 law that is law as enacted or re-enacted or applied by the Oireachtas subsequent to the coming into force of the Constitution. He simply noted in passing the terms of sub-s. 3 of s. 45 of the Courts (Supplemental Provisions) Act, 1961 (although the reference might perhaps suggest some doubt over its validity).

In essence, *In re R. Ltd* established that while a legislative provision may set out criteria which if present would allow a court consider that the matter should proceed otherwise than in public, in this case that the publication of information could be seriously prejudicial to the interests of the company, the court before exercising such a discretion had to be satisfied that it would be impossible to do justice between the parties were such information published. Thus, in short, and with reference to that subject matter, the publication of information would be seriously prejudicial to the company, and it would be impossible to determine that oppression proceedings if the matter proceeded in public.

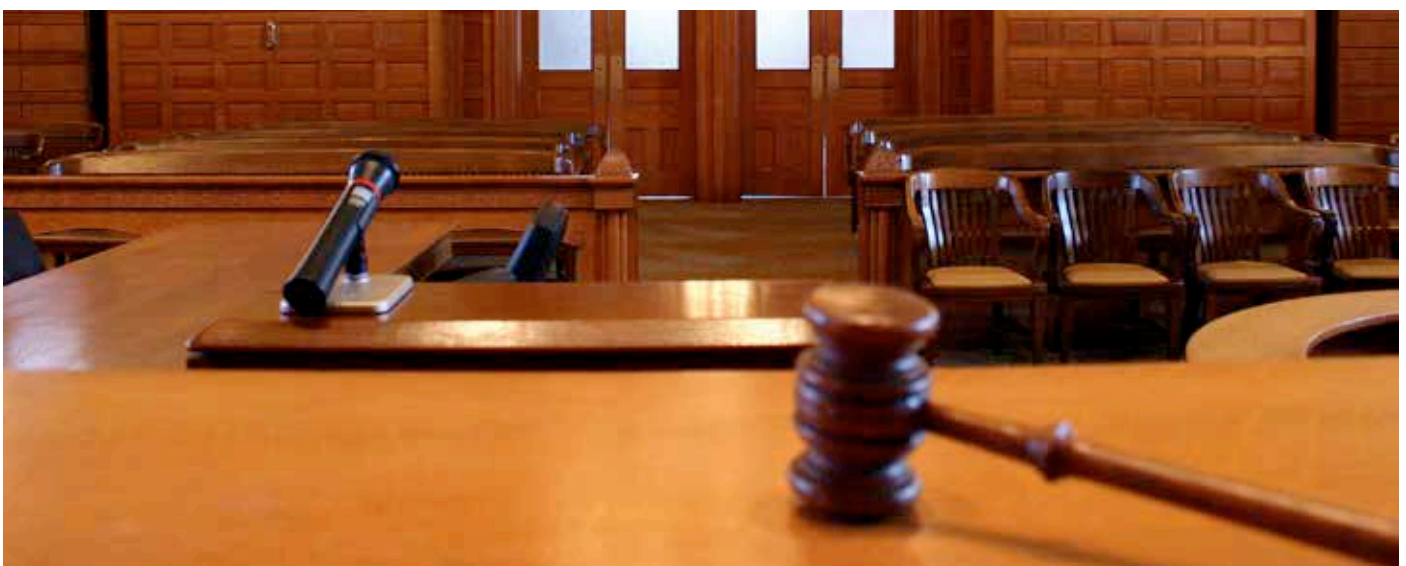
This represented a strict interpretation of the facility to legislate for proceedings other than in public, and indeed cast doubt on any provision which might seek to render such hearings mandatory, and thus oust the discretion of the court to determine the added limb as provided for in *In re R Ltd*. The correction, or clarification, of the situation has been described as both welcome, and at the same time perhaps an overcorrection of the situation, per O’Donnell J in *Sunday Newspapers Ltd v Gilchrist & Rogers* [2017] IESC 18, at 22.

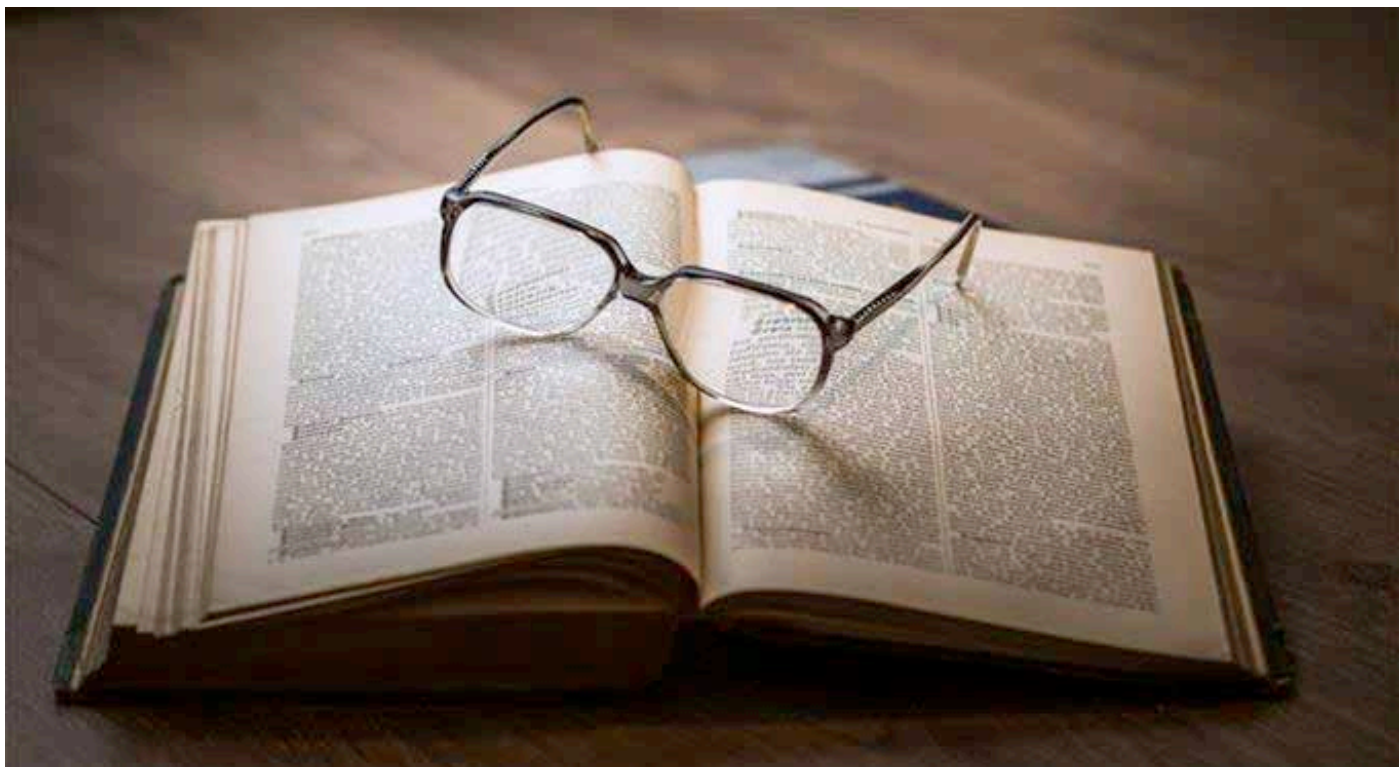
The position in *R* placed the effect on the administration of justice as the centrepiece, or determinative factor, in any analysis in this area. Notably, Article 6 of the ECHR deals with the right to, and imperative of, a public hearing in judicial proceedings. Therein, other interests are comprehended as potential exceptions to a public hearing, including the interests of morals, public order or national security in a democratic society, where the interests of juveniles or the

protection of the private life of the parties so require, or to the extent strictly necessary in the opinion of the court in special circumstances where publicity would prejudice the interests of justice. As such, and per O’Donnell J in *Gilchrist*, ...*There are other areas where it can be said that the exclusion of the public is justified, normally because publicity for proceedings or even access to them would offend important values, many of which are also protected by the Convention and Constitution...Looked at in another way perhaps, it might be said that the administration of justice should not require that serious damage should be done to interests which the Convention or the Constitution considers of significant value as the price of access to court, at 23.*

The matter was revisited by the Supreme Court in *Irish Times v. Ireland* [1998] 1 IR 359 which considered a criminal trial and an order for delayed reporting of criminal proceedings. The trial judge had ordered delayed reporting of criminal proceedings which was upheld on review by the High Court, a position which was overturned by the Supreme Court on the particular facts of the case. However, at the same time the Supreme Court upheld the reasoning of the lower courts in terms of the permissibility of a deviation from the imperative of public trial, and on this occasion relied on the common law ability of the courts to secure the effective administration of justice of their own motion in exceptional circumstances, without statutory intervention, through orders and associated contempt proceedings, which was a common law power carried over by Article 50, per Keane J at 410. On the competing constitutional rights at play in criminal cases Denham J observed, at 398-399, that:

...While there is no discretion in Article 34.1 to order a trial otherwise than in public Article 34.1 does not exist in a vacuum. There are competing constitutional rights, rights relating to other persons in addition the court has duties under the Constitution. The court has a duty and jurisdiction to protect constitutional rights and to make such orders as are necessary to that end. There were several rights for consideration at the trial before the Circuit Court. The accused had a right to trial in due course of law (Article 38.1) and to a trial with fair procedures (Article 40.3). The trial judge had a duty to uphold the Constitution and the law and to defend the rights of the accused. Balanced against that was the





community's right to access to the court, to information of the hearing, to the administration of justice in public (Article 34.1) That right is clearly circumscribed by the terms of Article 34.1. However, also in the balance was the freedom of expression of the community, a freedom of expression central to democratic government, to enable democracy to function. There was also the freedom of expression of the press. Thus consideration should have been given to Article 40.6.1 (i) which may include the publication of information: *Attorney General of England and Wales v. Brandon Book Publishers Ltd.* [1986] I.R. 597. The right to communicate (Article 40.3) was also part of the panoply of rights in the bundle of rights for consideration.

None of the rights in consideration are absolute. Where there are competing rights the courts should give a mutually harmonious application. If that is not possible the hierarchy of rights should be considered both as between the conflicting rights and the general welfare of society: *People v. Shaw* [1982] I.R. 1 at p.56.

The accused's right to a fair trial is superior to the other rights in the balance: *D v. Director of Public Prosecutions* [1994] 2 I.R. 465; *Z v. Director of Public Prosecutions* [1994] 2 I.R. 476. However, categorising the rights and placing them in the appropriate hierarchy does not dispose of the matter."

From a constitutional interpretation point of view excessive literalism is rejected with preference given to harmony, and if not possible then hierarchy. In so doing the Court recognised competing rights which may be at play in assessing the literal imperative associated with Article 34.1. The *Irish Times* case certainly opened the door to an extent, and the question which remained unanswered was as to whether the import of the *Irish Times* went so far as to only permit limited interference of the reporting of criminal trials, and indeed only in circumstances where it

was not possible to do justice between the parties in the terms of *In re R Ltd*, or whether a wider range of exceptions can be admitted to either limit or overbear the effect of Article 34.1.

These issues came to the attention of the Supreme Court again in *Sunday Newspapers Ltd v Gilchrist & Rogers* [2017] IESC 18 where O'Donnell J gave judgment for the Court. The facts related to alleged defamation of two persons whose work was associated with the Witness Security Programme (Witness Protection Programme). Articles appeared in a newspaper which were alleged to be defamatory of these two persons, and issues arose as to whether the action for defamation on their part could proceed in public. The factual matrix is somewhat complex, however, the plaintiffs who alleged defamation wished to litigate, and the respondent newspapers wished to defend the case. Neither sought an in camera hearing. However, the Garda Commissioner sought to join the proceedings and sought an in camera hearing on a number of grounds. The Court of Appeal granted the hearing in camera, with Ryan P holding that:

... the *Irish Times* jurisprudence and subsequent cases establish that it is possible to exercise the jurisdiction to depart from public hearings in civil actions and not just in criminal trials but the circumstances must be extreme and rare indeed and the evidence cogent... (9)

It seems to me that the principle is that Article 34.1 may be overborne in circumstances not provided by statute in the administration of justice, whether criminal or civil, but only in circumstances of such dire and exigent need in which major constitutional rights and interests are in issue and imperilled to a significant degree which is established by cogent evidence; where the protection of vital national and/or personal rights and interests can only be protected by in camera hearings or other ancillary orders and where the jurisdiction is confined



to rare and exceptional and extreme cases. I am also satisfied that this case is such an instance, being unique and of the highest degree of national and individual importance. As to the evidence, like Gilligan J, I am impressed by the material placed before the court in the affidavit of Detective Chief Superintendent O'Sullivan. I do not consider it to be too general in its nature. It is necessarily so and it would take little imagination to work out the specific nature of the dangers involved. (62)

Essentially the argument was between the Commissioner and the respondent newspaper, with the former arguing that threats to the lives of those associated with the Programme and a threat to State interests in maintaining the secrecy of the Programme justified an *in camera* hearing. The newspaper in turn argued around the primacy of Article 34.1 which in their mind did not admit to exceptions save in the circumstances of *In re R Ltd*. The plaintiffs, who alleged defamation, arising from pragmatism allied themselves to the Commissioner's viewpoint, as in the absence of a private hearing the Commissioner had indicated she would refuse permission to disclose information in relation to the Programme in evidence which in turn would be a breach of the Official Secrets Act, and if not disclosed would severely hamper or make impossible the action.

O'Donnell J surveyed the extant case law and in particular the *R* case and *Irish Times*. On whether the strict approach evident in *R* should be sustained, that is the administration of justice must be impossible without privacy, O'Donnell J preferred a less literal and more purposive approach to the understanding of Article 34.1. In this context he held that the word 'law' in Article 34.1 should be understood not singularly in the context of Article 15 which refers to the *Oireachtas*, but instead in a broader context and as understood when referring to equality per Article 40 and trials in the context of Article 38.1 where the concept of law embraces all sources of law. This approach, allied with the later *Irish Times* case thus opens the door to Court ordered deviations from privacy in the absence of legislative intervention.

On the relevant, and potentially competing, constitutional rights and values which can impinge on the public nature of proceedings, O'Donnell firstly recognises that there are a range of interests which may be at play, but in so

doing rejects any hierarchical approach to competing constitutional issues. Instead he considers the necessity for harmony instead of hierarchy, and the related obligation to have regard to, and give effect to, all constitutional rights.

Additionally, and in furtherance of the deviation from the 'rigid' approach in *R* he disagrees with the approach in that case in two material respects. First, he determines that the 'law' which may permit of an interference with a public hearing includes a continuing common law power to direct a trial *in camera* where it is required, and that such a course could be particularly justified when constitutional values are engaged. On a related point, such an exception is not limited to post-1937 statutes. Further, he determines, contrary to *R*, that the only exception is not that administration of justice is rendered impossible, and while this will remain a consideration which may justify a hearing *in private*, it is not the only reason.

On the inherent jurisdiction of the court, this is not one to be freely exercised and quite the contrary this is a discretion which *must be closely and jealously scrutinised*. Further:

It should be said that this approach is not radically different from that which has been applied hitherto, and most of not all cases would be decided in the same way. However, this approach has the benefit that any departure from the principle of open justice under Article 34.1 is and must be exceptional, and therefore be strictly construed and applied. There must be no other measure sufficient to protect the legitimate interest involved. One benefit of this approach may be that it will be necessary to consider steps short of a hearing *in camera* such as directing the requesting parties are not identified.

In the absence of legislation, the court should *only exercise an inherent jurisdiction to depart from a full hearing in public where it is shown that the interests involved are particularly important, and the necessity is truly compelling*.

As mentioned, while the Court turned against any hierarchical approach there is clear evidence of consideration of other constitutional rights and values which may weigh in any analysis as to whether a court should exercise its discretion, however narrowly construed, to deviate from a full public hearing:

In a case where justice cannot be done or cannot be done without damage to important constitutional values, it is appropriate to provide for the possibility of a hearing other than in public, albeit that it is a matter for the court to decide whether any departure from the standard of trial full trial in public is required and if so what measures are the minimum necessary.

By way of illustration, and referring to matters which are largely dealt with in private currently, the Court adverted to personal matters relating to family life, wardship proceedings and the associated concept of human dignity, all of which could potentially be dealt with and justice done for the parties via a public hearing, but in the course of which undue destruction would reign down on other constitutional values and rights which are deserving of protection and thus in an appropriate case admit of an exception to the imperative for a public hearing.

In a very useful summation of the case O'Donnell J stated:

However, the net issue presented for determination by this Court can be reduced to the question whether this trial **must** be conducted fully in public, or whether **any** departure from that principle may be permitted. In my view, the public interest in the functioning of the Witness Protection Programme and the consequent protection of the lives of participants in it and officers and staff mean that the court's power to control its own powers must extend to departing from a hearing in public in this case at least to some extent. While I have sought to analyse this in terms of Article 34.1, the same result could, and in most if not all cases would, be arrived at by application of the language of *In re R. Ltd.* or indeed *Irish Times v. Ireland*. Accordingly, I would summarise the principles as follows:

- (i) The Article 34.1 requirement of administration of justice in public is a fundamental constitutional value of great importance.
- (ii) Article 34.1 itself recognises however that there may be exceptions to that fundamental rule;
- (iii) Any such exception to the general rule must be strictly construed, both as to the subject matter, and the manner in which the procedures depart from the standard of a full hearing in public;
- (iv) Any such exception may be provided for by statute but also under the common law power of the court to regulate its own proceedings;
- (v) Where an exception from the principle of hearing in public is sought to be justified by reference only to the common law power and in the absence of legislation, then the interests involved must be very clear, and the circumstances pressing. Here that demanding test is capable of being met by the combination of the threat to the programme and the risk to lives of people in it or administering it. This is not a matter of speculation, but seems an unavoidable consequence of the existence of a witness protection programme.

(vi) While if it can be shown the justice cannot be done unless a hearing is conducted other than in public, that will plainly justify the exception from the rule established by Article 34.1, but that is not the only criterion. Where constitutional interests and values of considerable weight may be damaged or destroyed by a hearing in public, it may be appropriate for the legislature to provide for the possibility of the hearing other than in public, (as it has done) and for the court to exercise that power in a particular case if satisfied that it is a case which presents those features which justify a hearing other than in public.

(vii) The requirement of strict construction of any exception to the principle of trial in public means that a court must be satisfied that each departure from that general rule is no more than is required to protect the countervailing interest. It also means that court must be resolutely sceptical of any claim to depart from any aspect of a full hearing in public. Litigation is a robust business. The presence of the public is not just unavoidable but is necessary and welcome. In particular this will mean that even after concluding that case warrants a departure from that constitutional standard, the court must consider if any lesser steps are possible such as providing for witnesses not to be identified by name, or otherwise identified or for the provision of a redacted transcript for any portion of the hearing conducted in camera.

The essence of the position now is that the imperative for a public hearing remains strong, and any exceptions must be strictly construed. A court may of its own motion deviate from this imperative, in the absence of legislation, but the justification with reference to other constitutional interests must be very clear and pressing. However, legislation may provide for hearings otherwise than in public, but that the courts should still consider whether this is necessary with reference not only to whether justice can be done between the parties but as to whether the case presents those features which justify a hearing other than in public. Finally, there is an imperative to consider the least interfering mechanism with the imperative, such that the choice is not binary between public and private.

The effect of the judgment in *Gilchrist* is potentially significant and is already being grappled with in the context of privacy relating to court processes associated with sanction proceedings in the High Court following determinations by a professional regulatory tribunal as in *Medical Council v T.M.* [2017] IEHC548. Overall, the situation has now very much advanced since the *R* case and drawing on the clarification provided in *Irish Times*, *Gilchrist* generates a position which offers more general guidance while achieving welcome latitude associated with equally welcome restraint.

Dr Edward Mathews
RNID, LLB (1st), LLM (1st), BL, PhD
Lecturer in Law

Director of Regulation and Social Policy Irish Nurses and Midwives Organisation



An tÚdarás Clárúcháin Maoine Property Registration Authority

Introduction

The Property Registration Authority (PRA) is the State organisation responsible for the registration of property transactions in Ireland. The main function of the PRA is to manage and control the Land Registry and the Registry of Deeds and to promote and extend the registration of ownership of land.

It has been noted by the World Bank, that registered property rights are necessary to support investment, productivity and growth. With land and buildings accounting for between half and three-quarters of the wealth in most economies, having an up-to-date land information system clearly matters.



OUR SERVICES

Land Registry

The Land Registry maintains a register of legal interests in property, such as ownership and mortgages, which is conclusive evidence of title to property and is guaranteed by the State. Registered land parcels are recorded on a document known as a Folio. Since 2011, once a property is sold in Ireland, the title must be registered on the Land Register. The Land Register is fully computerised and all registered land parcels are digitised on an OSi map.

Registry of Deeds

The Registry of Deeds (ROD) records the existence of a document relating to unregistered property at a fixed point in time from which priority of one deed over another may be determined. The ROD records the existence of a deed, it does not guarantee the effectiveness of or interpret a deed. When an application is completed, the original deed is returned to the lodging party. Maps are not held as part of the registration record.



Registry of Deeds Genealogical Services

The ROD is custodian of a large, unique and very significant body of historical archives. For this reason, it provides research

facilities for genealogists, history researchers and the general public in its Henrietta Street location. These records date from 1708 and are of immense historical, cultural and genealogical importance to the Irish State.

Ground Rents Purchase Scheme

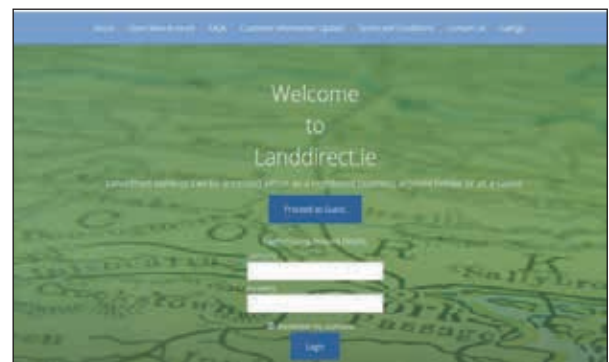
The PRA's Ground Rents Purchase Scheme allows leasehold owners to buy out their ground rent and become the outright owners of their property. Owning the freehold interest in a property means that you own the land and the building (if any) outright.

Online Services

The PRA's accessible online services are available to members of the public and professionals alike.

Landdirect is an online application offering easy access to the digital register from anywhere in the world 24/7, 365 days a year, at the touch of a button. At one time our online service was available only to business account holders such as solicitors and surveyors, acting on behalf of members of the public - landdirect now also caters for the occasional customer.

Visitors to the site can quickly and easily locate a property using intuitive map-based screens and can immediately obtain information such as ownership, mortgages or rights of way affecting that property or, indeed any registered property in the State. Certified documents can be ordered and paid for online.



eRegistration is the online channel provided by the PRA for the electronic registration of transactions affecting the Land Register. In addition to the eDischarges and eCharging Orders services, a new range of features have been launched that allow legal practitioners to:

- draft Deeds of Transfer and Deeds of Charge (for participating financial institutions)
- interact with the Land Register including the digital map
- circulate documents in a secure environment
- pay fees by direct debit and correspond electronically with the PRA.

RECENT DEVELOPMENTS

Electronic Funds Transfer

Since 10th April 2017, the fees due for an application can be paid electronically through landdirect. This new functionality

gives a choice between three methods of payment:

- Debit/Credit card - application fee is deducted immediately
- landdirect account - application fee is deducted immediately if sufficient funds are available in your account
- Direct Debit - the transaction occurs on receipt of the application documents for registration. Bank details must be sent to the PRA to avail of direct debit.

These payment methods relate to the payment for specific applications that have been created. A payment may be cancelled by the customer who made the payment if the application documents have not yet been lodged.

Further information on the use of EFT can be found on our website www.prai.ie.

Instructional Videos

In 2017, the PRA developed a suite of instructional videos to assist in the preparation and lodgement of applications and maps for registration.

Currently we find that on average over 15% of applications lodged for registration are rejected - these videos highlight some of the most common errors made in the preparation of applications and maps for registration with a view to reducing the occurrence of these errors.

Videos relating to the topics listed below have been designed in conjunction with a set of printable checklists which will further assist legal practitioners in the preparation of applications for registration. The videos/checklists are available on our website www.prai.ie under Application Guidelines.

- Transfer - Application for registration of a change of ownership
- Charge - Application for registration of a mortgage/loan
- Mapping Guidelines
- Form 1 - Application for First Registration of a freehold documentary title
- Form 2 - Application for First Registration of a leasehold documentary title
- Form 17 - Application lodgement form

- Form 3 - Application for First Registration of a Freehold or a Leasehold documentary title certified by a lodging solicitor.
- Rejection Policy



Social Media

As part of the ongoing need to continuously develop our digital services, the PRA has recently taken steps to enhance its social media presence as a means of providing information to a wider audience. Customers can now follow us on Twitter, Facebook and LinkedIn to receive regular news and updates from the PRA.

 @PRA_Ireland

 @PropertyRegistrationAuthority

 Property Registration Authority

Useful contact details:

Land Registry Enquiries: **info@prai.ie**
Registry of Deeds Enquiries: **registryofdeeds@prai.ie**
Ground Rents Enquiries: **groundrents@prai.ie**
IT/Landdirect Queries: **landdirect@prai.ie**
eRegistration Queries: **eRegistration@prai.ie**

If you would like to be added to our customer mailing list, please subscribe by contacting helpdesk-corporateservices@prai.ie. For more information on our mailing list, please visit www.prai.ie/data-protection

Griffith College Dublin's Diploma in Legal Studies and Practice - Testimonial

The Diploma in Legal Studies and Practice at Griffith College Dublin was the best step I took, in terms of my future career.

I knew I wanted to work in a legal field but didn't know how to begin my journey. I came across this diploma course and thought it was exactly what I wanted, little did I know that less than a year after completing the course I would be working as a legal assistant in one of Ireland's top law firms, with little legal or office experience. However, due to the Practical skills I learned throughout my time in the Diploma Course, with modules like Civil Litigation, and Professional ethics and skills for practice, I was given the opportunity to begin my career in the firm.

The friends I made during the course have also since began careers in the legal sector and became qualified as Legal Executives with ILEX.

I could not have completed this course without the help and guidance of the brilliant lecturers at Griffith College, all of whom work as Barristers or Solicitors themselves and do everything they can to aid you in beginning your career with their own personal insight into the legal profession.

I completed the Diploma in Legal Studies and Practice in Griffith College Dublin in 2017 and I am currently beginning my third year of the LLB Honours Programme at Griffith College.

Amy Lee
3rd Year LLB (Hons)
Programme Student 2018



Legislation Update

Making sense of Joint Tenancy

'My brother and I bought a property together during the boom, to get on the property ladder, but we are now ready to buy properties with our respective partners. If we keep our original property as an investment if something happens to me, does my partner get my share?'

'My wife and I would like to make our Wills, and I would like to leave my half of the family home to our son, while my wife will leave her half to our daughter. Is this ok?'

'My boyfriend is terminally ill, and I have lived in his home with him for the past 6 months looking after him, he says that he is going to look after me when he dies and leave me his half of the house which he owns with his previous girlfriend. Can he do that?'

If you own a property with someone else or are the intended beneficiary of a share in property currently owned by more than one person, it is important to know the title under which the property is held as this can affect a co-owners capacity to mortgage, rent, sell or transfer the property.

The two most common types of co-ownership of real property (real property being land and buildings) are tenancy in common and joint tenancy.

What is a Tenancy in Common?

With a tenancy in common all co-owners have a right to possession of the entire property, although they may not have equal shares. It is always worth remembering that there can be more than two co-owners of a tenancy in common. For example, one person may be entitled to two thirds of the property, while the other two owners own one sixth each.

What is a Joint Tenancy?

With a joint tenancy all co-owners own an equal share and the property passes by survivorship.

In order for a joint tenancy to exist it must comprise what are referred to as the four unities, which are interest, time, title and possession.

Put simply the unities are as follows;

- i. Unity of Interest means that, the same joint estate with the same joint rights and obligations are held by all co-owners of the property.
- ii. Unity of Time means that the interest of all co-owners must have vested in them at the same time.
- iii. Unity of Title normally means that the joint tenancy must originate from the same source, for example, a single conveyance transferred the property to all co-owners.
- iv. Unity of Possession means that each of the co-owners has an equal right to possession of the entire property.

How does a Tenancy in Common differ from a Joint Tenancy?

The most important distinction between tenancy in common and joint tenancy relates to survivorship, namely, what happens after one of the co-owners dies.

In the case of a joint tenancy, the surviving co-owner or co-owners automatically succeed to the share of a joint tenant who dies. It is a common mistake to think that property owned under joint tenancy can be bequeath to whoever is in the Will of the deceased or under the rules of intestacy.

Joint Tenancy – Scenario

If Simon and George own a house as joint tenants and if Simon dies, the property automatically passes to George, irrespective of whether Simon has made a will or not.

If Simon, Sarah and George own a house as joint tenants and if Simon dies, the property automatically passes to Sarah and George, irrespective of whether Simon has made a Will or not.

However, with a tenancy-in-common, a co-owner's share will pass under the terms of their Will or under the rules of intestacy.

Tenancy in Common – Scenario

If Simon and George own the house as tenants in common with Simon owning a 2/3rd share and George owning a 1/3rd share and Simon makes a will leaving his share of the house to his sister Abigail then Abigail would inherit Simon's 2/3rd share and George would continue to own his 1/3rd share.

While the common law prefers joint tenancies (to avoid the division of land), equity favours the tenancy in common as equity recognises that a joint tenancy could become a tenancy in common as the result of severance, following the elimination of any of the four unities.

The Land and Conveyancing Law Reform Act 2009

The Land and Conveyancing Law Reform Act 2009 (the 2009 Act) came into operation on 1st December 2009. The Act is divided into fourteen separate articles comprising one hundred and thirty three sections and three comprehensive schedules and repeals one hundred and fifty pre-1922 statutes together with certain provisions; in addition the 2009 Act provides useful comprehensive definitions including the definition of 'land' which previously has never had a single formal statutory definition.

Some of the amendments introduced by the 2009 Act include;

- i. Section 30 (1) of the 2009 Act states that a joint tenant is not entitled to convey land held in joint tenancy or acquire another interest in such land without first obtaining the consent of the other joint tenancy and any such conveyance is void at law and in equity. Consent as per Section 30 (2) means the prior consent in writing of the other joint tenant and if there is more than one, all of the other joint tenants.
- ii. Section 30 (3) of the Act also clarifies the position regarding registration of a judgment mortgage by providing that such registration against lands held in a joint tenancy no longer severs that joint tenancy. So, if a joint tenancy remains unsevered in such circumstances, the judgment mortgage is extinguished on the death of the judgment debtor.
- iii. Section 30 (4) of the Act specifically provides that these new provisions do not affect the powers of the courts to find that joint tenants, by mutual agreement, have severed their joint tenancy in equity. Further, these provisions have no effect on the powers of the courts under the family law acts pertaining to co-ownership (section 31 (5)).
- iv. Section 31 (1) of the 2009 Act, states that a trustee, mortgagee, secured creditor and a judgment mortgagee having an interest or estate in land which co-owned whether at law or equity can apply to the Court for an order. Orders include, an order for sale of the land and distribution of the proceeds of sale as the courts directs (as per section 31(2) (c)), and an order dispensing with consent to severance of a joint tenancy where such consent is being unreasonably withheld (as per section 31(2) (e)).
- v. Section 31 (6) of the Act provides that the equitable jurisdiction of the court to make partition orders at law or equity is abolished.

The Civil Liability (Amendment) (Prevention of Benefits from Homicide) Bill 2017

In 2011 Ms. Justice Mary Laffoy cited the need for new legislation in the area of joint tenancies and survivorship following the Cawley v Lillis case, this was echoed by Mr. Justice Nicholas Kearns, President of the High Court in the Nevin v Nevin case (2013) with a call for further legislation to clarify anomalies in the area. Irish succession law states that, a person may not inherit any part of the estate of

someone he or she has murdered, attempted to murder or killed by manslaughter, however, in co-ownership cases the property automatically passes to the surviving joint owner. This was the situation in the case of Eamonn Lillis, who was convicted of killing his wife Celine Cawley in December 2008.

Following the High Court decision that Ms. Cawley's share be held in trust for her daughter, the Law Reform Commission recommended a change in inheritance laws to prevent a co-owner from benefiting where there is a joint tenancy, and that legal title should not pass to the convicted killer.

The Commission believed the legislation should continue to apply to the three most recognised types of homicide: murder, attempted murder and manslaughter. It has also recommended the offender should not benefit financially through a life assurance policy or a pension from their spouse's death.

Ms. Justice Marie Baker, a member of the Law Reform Commission, described the proposed amendment to the law as "What we're suggesting is that there be a severance of the joint tenancy so that the survivorship right no longer exists. We're not recommending that the killer loses all of his or her own property rights but we're recommending that as a starting point that there be severance and that the shares be held equally."

Most recently Minister for Justice Charlie Flanagan indicated that he would not oppose, but amend, The Civil Liability (Amendment) (Prevention of Benefits from Homicide) Bill 2017 ('the Bill') that aims to stop those convicted of murder or manslaughter benefiting from their crimes.

Minister Flanagan has indicated his support for The Bill (known as 'Celine's Law') but indicates that the Government wishes to clarify and perhaps amend areas in respect the position of a person who aids, abets, counsels or procures the commission of an offence of murder, attempted murder or manslaughter.

It is clear from the above that the law, with regard to joint property, is not always straight forward and it is important to be mindful of this if you are the joint owner of property or intended beneficiary of property held under joint tenancy.

We await the final draft of Celine's Law and clarification of the position in respect joint tenancy and survivorship.

Karen Sutton BABL, MA H.Ed, LL.M
Head of Faculty of Law
Griffith College

Irish Law Awards 2018



Legal Executive of the year Jennifer Weafer



Griffith College Dublin

Graduation and Conferring Ceremony 2017

Diploma in Legal Studies and Practice - (QQI) HETAC Level 7 (Special Purpose Award) - 2017

The Graduation and Conferring Ceremony of graduates of the Diploma in Legal Studies and Practice - (QQI) HETAC Level 7 (Special Purpose Award) took place at the Conference Centre in Griffith College Dublin on Wednesday 10 November 2017. This Course is delivered by Griffith College Professional Law School and conducted in conjunction with the Irish Institute of Legal Executives - (IILEX).

The opening address of this event was made by Professor Diarmuid Hegarty, President of Griffith College who warmly welcomed to the Graduation and Conferring Ceremony all graduates and their families, friends, Directors of the Irish Institute of Legal Executives - (IILEX) as well as other invitees.

Directors' of the Irish Institute of Legal Executives - (IILEX) were delighted and honoured to receive the kind invitation to attend at this event and wish to sincerely extend thanks to Professor Diarmuid Hegarty, President of Griffith College for such and the hospitality shown. Directors in attendance representing the Irish Institute of Legal Executives - (IILEX) included Frank Crummey, Fintan Hudson and Mary B. O'Dwyer. It was most pleasant to meet up with and converse with various graduates, members

of the academic staff of Griffith College and other invited guests present.

A total of 31 students graduated with Diplomas in Legal Studies and Practice - (QQI) HETAC Level 7 (Special Purpose Award). Students were formally presented with their respective parchments by the President of Griffith College, Professor Diarmuid Hegarty who congratulated each on their great achievement as well as wishing them every success and happiness in their future careers and lives ahead. The Irish Institute of Legal Executives - (IILEX) also extend their good wishes to all graduates of this Diploma Course.

The Irish Institute of Legal Executives – (IILEX) was delighted once more to learn of and witness the high number of students graduating and thus acknowledging the sustained interest in the pursuance of the Diploma in Legal Studies and Practice (QQ1) HETAC Level 7 (Special Purpose Award). This is a marvellous success story and excellent outcome for both the Irish Institute of Legal Executives – (IILEX) in combination with Griffith College. Well done to all.

It was most special and a great honour to witness the Hon. Chief Justice Mr. Frank Clarke of the Supreme Court



being presented with a Distinguished Fellowship Award by Professor Diarmuid Hegarty on behalf of Griffith College. This award was made in acknowledgement of his tremendous contribution over many years to the legal profession. Chief Justice Clarke thanked Professor Hegarty and Griffith College for the very kind honour bestowed on him.

Congratulations and best wishes are extended to Rian Gallagher, who was presented with the Frank Crummey Perpetual Cup as an award for her great achievement as best student of the year 2017 in the Diploma in Legal Studies and Practice (QQL) HETAC Level 7 - (Special Purpose Award). Well done Rian and continued success.

Congratulations and best wishes are also extended to our esteemed Director of the Irish Institute of Legal Executives – (IILEX), Ita O’Gara who was awarded an LLM in International Law. Well done Ita and continued success.

In addition, sincere compliments are extended to all staff including staff of the Examinations’ Office of Griffith College - (GCD) who per usual worked very diligently and professionally displaying an enormous duty - of - care in organising the logistics in putting in place this entire most professional and memorable event. Well done to all involved.

Finally, Directors’ of the Irish Institute of Legal Executives – (IILEX), are at all times mindful and truly appreciative in being closely associated and engaged with Griffith College over many years. Continued success for the future is wished to Professor Diarmuid Hegarty President of Griffith College including wonderful academic staff and others in their much celebrated and excellent work .

Mary B.O’ Dwyer FIILEx.

Director of PR/Communications- IILEX

Editor of the Official Journal of IILEX - “ The Brief ”

Pictures by kind permission Lafayette Photography

THE FRANK CRUMMEY PERPETUAL CUP

The student who attains the highest mark on completion of **Stage 2 of the DLS&P** Programme will be awarded the Frank Crummey Perpetual Cup. This award is named in honour of Frank Crummey one of the founding members of the Institute and an active Council Member who has tirelessly given his time to the Institute down through the years.



Rian Gallagher best student of 2017 being presented with her award by Frank Crummey



Front Row Seated:-

Professor Diarmuid Hegarty, President of Griffith College, The Hon. Chief Justice of the Supreme Court, Mr. Frank Clarke, Karen Sutton Head of the Law Faculty and other Academic staff of GCD together with Directors of IILEX- Frank Crummey FIILEx (Hon. Life member of IILEX) , Fintan Hudson FIILEx, Mary B. O’ Dwyer FIILEx.

Second Row Standing:- Graduates of the DLS&P Programme 2017 including best student of the year Rian Gallagher.

#OMG

THE IMPORTANCE OF SOCIAL MEDIA POLICIES IN THE WORK PLACE



An interesting query that we often receive on the legal advice helpline relates to Facebook, Twitter or some other social media comments that are made by staff members that somehow relate to their employment. Employers must be careful in the way these comments are addressed and what action, if any, is taken by them in addressing same. In this article I

propose to highlight some examples of how employers have addressed such comments and the cases that have arisen as a result of same and the importance of a social media policy in existence to ensure that employers have the power to address any issues that arise.

What is a social media policy?

A social media policy can be broadly defined as a corporate code of conduct that provides guidelines for employees who post content on the internet, either as part of their employment or in a private capacity. A social media policy can be contained in an employee's handbook and can also be referred to in their contract of employment. All staff should sign to acknowledge receipt of a handbook to show that they have received, read and understood the contents of same. This ensures that the staff member cannot allege they were unaware of any governing policies that are in existence.

What should a social media policy contain?

- The purpose of the policy should be highlighted to ensure that all employees understand the reasoning for same i.e. why the company uses social media – exposure, advertisement, creating and expanding contacts in the business world.
- The policy should outline what are appropriate ways to use social media when referring to the business which should address issues of data protection, training on use of social media when being used in a professional capacity, a data base of all social media outlets that are used and who is control of this information.
- Clarification on who owns the information such as contacts made via a professional social media forum is very important.
- Guidance on private use of social media that can relate directly to the persons employment or employer or other employees of the business.
- The key element is that any breach of the policy can lead to disciplinary action being taken against the employee which may lead up to and include dismissal.

Points to consider when deciding to discipline.

An employer needs to approach any alleged breach of the social media policy in a professional manner and they must

at all times adhere to their disciplinary procedure and ensure that fair procedures are applied at all times. If there is an alleged breach of the social media policy then employers must consider the impact of the comments, statements etc. on the business and how much damage this has or could cause the company's reputation or brand. Another issue that the employer must consider is the duty that is owed to other employees to ensure that there is no potential bullying and harassment claims or constructive dismissal claims, potential personal injury or defamation claims as a result of any comments or posts made by other employees.

Case Examples

Sometimes the best way to illustrate the impact of the above policy not being in place is to highlight decisions that have been taken by the Employment Appeals Tribunal and courts. A key case that is often cited when discussing this topic is that of *Kiernan v A Wear* (UD643-2007). In this case the employee had commented on the social media forum Bebo. The comment related to one of her managers and was made to one of her friends, however as the pages were public this allowed any person linked to this employee to also see the comments – one of her contacts was in fact her employer and a customer who was also linked to the A wear page viewed the comments and reported same to the employer directly. As a result the employee was suspended and subsequently dismissed. The employee appealed this decision of dismissal via a solicitor. The appeal was heard and it was upheld by the operations manager of the company, even though they did not engage with the supervisor who the complaints/comments were made about, as it was outlined that there was not sufficient grounds to alter or reverse the dismissal. The Tribunal heard that the employee had worked for the company for a number of years with no previous disciplinary issues. The employee had expressed her remorse for the comments and apologised for same directly at the case. The employee also expressed that she was having a bad day and that the comments were to a friend's page and not on the company's page.

The Tribunal held that the dismissal was disproportionate and as a result awarded the applicant in this case €4000.00 as they outlined that she had contributed to her dismissal and that a sanction was required but that dismissal was too severe. This case also highlighted that the lack of a social media policy contributed to the fact that the company was liable to potential claims being taken against them.

A case which involved a successful dismissal is that of *O'Mahony v PJF Insurances* – in this case the employee made derogatory comments about her manager on Facebook which was visible to the public. In this case proper procedures were followed to invite the employee to a disciplinary meeting and to ultimately dismiss her for her comments as this related directly to the workplace. The employee applied to the Employment Appeals Tribunal and claimed that she had been unfairly dismissed but the Tribunal held that the dismissal was fair on the basis that the employee had breached the trust and confidence of her employer – the most important factor in this case is that procedures were followed.

- **Duty of care owed to other employees – case example**

A company must also ensure that proper steps are taken to address any issues that may arise in the workplace between employees – the reason for this is that an employer owes each of their employees a duty of care to ensure that they are not bullied and harassed by another colleague. An example of this matter is that case of Teggart v Teletech Uk Limited NIIT 00704/11 which was heard in Northern Ireland – in this case one employee made offensive comments on his Facebook page while he was outside of the workplace, about another staff member to allege that she was promiscuous. The comments were brought to the attention of the employer and an investigation was held as the female staff member alleged that she was feeling bullied and harassed. The employer decided that this did amount to bullying and harassment of the female employee and as a result this led to the dismissal of the employee who made the comments. The dismissal was appealed to the Tribunal and it was held to be fair as the

actions amounted to sexual harassment of one employee by another and albeit it did not bring the employer into disrepute it was still unacceptable. If an employer fails to address an issue such as this, then the effected employee could possibly pursue the employer for a constructive dismissal and perhaps a personal injury case.

Conclusion

As social media continues to grow for all aspects of personal and professional communities it is of the utmost importance that employers have policies in place to address same. Some of the case law used in this article illustrate that a policy is not in place or is not followed then this can result in costly awards being made against companies. Therefore some of the most beneficial advices that can be offered on this subject is prepare and take positive steps to introduce a policy and apply same to prevent potentially costly cases.

Vivienne Matthews O'Neill is a Barrister at Law at DAS Legal Expenses Insurance Company Limited.

Caught on Camera



Tim Dixon BL and George McGrath Solicitor - Speakers



Jennifer Weafer with Miriam O'Callaghan



IILEX Directors and Rose Whelan, Administrator attending AGM 2018 in Sligo

Double Whammy for Catherine Allison and Co. Solicitors

Catherine Allison & Co like to congratulate their long-standing member of staff, **Letitia Grace**, on becoming the only **Senior Legal Executive** in Ireland based on her practical experience and her Legal Executive qualifications. Letitia obtained a Diploma in Legal Studies with distinction in 2004. At that time she also qualified as a Legal Executive with the Irish Institute of Legal Executives and has held a practising certificate since 2004. In 2007 Letitia obtained a Diploma in Family Law accredited by the Law Society and recently in November 2017 she was appointed a Commissioner for Oaths for County Louth by the Supreme Court.

Letitia joined Catherine Allison & Co some seventeen years ago and almost exclusively practices in Family Law handling separation and divorce, which you can imagine, is a stressful time for the parties involved. Letitia treats her clients with the utmost respect, consideration and compassion, but most of all, practicality and aims to deal with matters as quickly and as amicably as possible, thereby enabling people to move on with their lives.

The second whammy is **Catherine Allison** is now also a qualified **Personal Insolvency Practitioner** and she has recently received a PIP licence in March 2018 from the Insolvency Service of Ireland. Catherine has been carrying out insolvency work for over twenty years, originally in London and in the last fifteen years in Ireland and Northern Ireland. Catherine also currently holds a diploma in Personal Insolvency Law awarded by the Law Society in December 2013. In September 2016, Catherine was appointed the duty solicitor at the Repossession Court under the new Government "Abhaile" Home Mortgage Arrears Legal Aid Scheme for Dundalk and Monaghan and handles large volumes of PIA Appeals to the Circuit Court where the insolvency arrangement involves the primary principal residence. Catherine goes above and beyond the call of duty to help distressed individual borrowers and business people to help debtors get back to solvency, and in particular, to save their family home and primary principal residence where possible. Catherine confirms that ongoing repossessions in County Louth are continuing at an alarming rate and there can be up to fifty cases in the court list at a time and there is no end in sight to the court lists as banks such as Permanent TSB and Ulster Bank now are reported to be selling more loans to the so-called "Vulture Funds". The government scheme, she feels, is a lifeline for people.

If your home is in negative equity, or you are drowning in debt, Catherine is renowned as the woman to sort you out and get your life back on track and back to solvency. If your home is valued at €100,000 and you have a mortgage of €200,000, we have a great chance to have it written down to market value (i.e. €100,000 knocked off the loan so it is affordable) in a Court Insolvency Arrangement under the new appeal system. Legal Aid is usually available for such PIA appeals. Catherine Allison & Company are this year celebrating 18 years of business in Dundalk. Since opening its doors in April 2000 with just Catherine and one secretary the practice has grown from strength to strength. We have an exceptionally strong and proven legal team who are backed by very experienced support staff including own, in house, fully qualified accountant. We undertake all areas of legal practice, excluding only Criminal Law. We are also the only practice in County Louth to practice in all the jurisdictions of Ireland, Northern Ireland, England and Wales, which helps to widen our client base.

Once again Catherine wishes to congratulate Letitia on her recent appointment as the only Senior Legal Executive in Ireland and wishes her continued success in her career with the company. Catherine has become one of the leading figures in the locality supporting many local businesses and charities. She would like to thank her clients for their continued support, trust and confidence over the last 18 years saying it's always a privilege to do business with the people of Dundalk and surrounding areas and says that she will continue to do all she can to ensure that whoever enters her office, for whatever reason, will be happy with the excellent, professional service.



Letitia Grace and Catherine Allison



Catherine Allison and team

CATHERINE ALLISON & CO. SOLICITORS

6 Roden Place, Dundalk
Ph: 042-9320854 • Web: www.callison.ie
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- # Bankruptcy & Insolvency Matters
- # Family Law - Divorce, Separation, Nullity, Maintenance & Access
- # Personal Injury & Accidents
- # Commercial & Residential Property
- # Employment Law

- # Wills & Probate
- # Landlord/Tenant Law - New Leases and Landlord & Tenant Litigation
- # Tax Advice Company/Corporate
- # Medical Negligence & Coroner's Inquests
- # Coroner's Inquest on Death

The Benefits and Impact of Case Progression in Family Law Proceedings

As a practising Legal Executive since 2004, I have seen many changes in Family Law and one of the most important changes was the introduction of Case Progression. Case Progression came into being through new Circuit Court Rules which commenced on 1st October 2008. The Statutory Instrument which brought about this change was SI 358 of 2008 Circuit Court Rules (Case Progression in Family Law Proceedings) 2008. Before Case Progression, the position for many couples was that the process of judicial separation/divorce proceedings was a tiring one, results of years of court attendances and Motion applications in an attempt to progress the case to a hearing date. Cases were not only stressful for couples but were also very costly, therefore in an effort to save costs, streamline and expedite cases through the Court, the Case Progression procedure was introduced. The benefit of Case Progression greatly reduces the length of time it takes to get a client's judicial separation/divorce to a hearing stage.

The normal procedure in Case Progression is that once the Respondent's solicitor files a Defence and Counterclaim with the Circuit Court Office a Case Progression Summons will issue and a date will be appointed and at that stage both parties' solicitors will complete a Form s37L. The Form s37L should be filed with the Circuit Court Office no later than seven days in advance of the Case Progression hearing date. At the first case progression hearing both solicitor and client will attend and the County Registrar will be informed at what stage the proceedings are currently at, e.g. what pleadings or vouching documents remain outstanding and whether or not any expert witnesses will be required. The client does not have to attend all case progression hearings; however, it is recommended that the client attend the first case progression hearing. All Case Progression hearings are heard "in camera".

Throughout the Case Progression procedure, the County Registrar can make various Orders. This is most beneficial in particular in relation to discovery as this can become a long drawn out process with protracted correspondence causing long delays. The County Registrar can decide what discovery documentation is to



be provided and make an Order in respect of same and a short adjournment is given to allow the documents to be exchanged. e.g. in relation to discovery. Once the County Registrar is satisfied that all documentation has been exchanged and the pleadings closed the case will be transferred to the next Callover list to fix dates.

Case Progression overall is an excellent method to ensure cases are not held up unduly. It is a very cost-effective procedure and I have found that it can reduce the time-frame of a judicial separation/divorce by approximately 6 – 12 months which is beneficial to any couple who are going through one of the most stressful experiences of their lives.

Letitia Grace S.I.I.L.Ex. Dip Family Law
Senior Legal Executive and Commissioner for Oaths

Catherine Allison & Co
Solicitors
6 Roden Place
Dundalk
County Louth A91 K265

Congratulations to Letitia Grace on becoming the first Senior legal Executive

*If you wish to apply to become a Senior Legal Executive
please revert to our website www.iilex.ie 'Levels of Membership' section 4
or refer to this year's Directory of Members Page 5*

Conferring and Graduation Ceremony 2017 at Griffith College Cork

The Conferring and Graduation Ceremony of Graduates of the Diploma in Legal Studies and Practice (QQI) HETAC Level 7 and on Friday 24th November 2017 in the Honan Chapel at Griffith College Cork Wellington Road Campus. This Course is run by Griffith College in conjunction with the Irish Institute of Legal Executives - IILEx.

On the kind invitation of Professor Diarmuid Hegarty, President of Griffith College, Deirdre Butler President, Irish Institute of Legal Executives - IILEx was in attendance. Also, in attendance was the Deputy Lord Mayor of Cork Cllr. Fergal Dennehy along with Griffith College Cork and Dublin Programme Directors and Faculty Lecturers and Griffith College staff as well as representatives of the validation bodies along with family and friends of Graduates.

College President Diarmuid Hegarty gave the conferring address, welcoming everyone to the ceremony at which National and International awards – Quality and Qualifications Ireland and the Institute of Commercial Management - were conferred on Graduates of the College and at the end of the Ceremony he congratulated Graduates on their achievements and wished them every success for the future.

Candidates who successfully completed the Diploma in Legal Studies and Practice (QQI Award, HETAC Level 7) were called to receive their parchments. Other candidates successfully completed the following programmes were called to receive their parchments were:

Law:

Diploma in Legal Studies and Practice (QQI)
LLB (Hons) in Irish Law (QQI)

Journalism and Media:

BA in Journalism (QQI)

Computing:

Higher Diploma in Science in Computing (QQI)

Institute of Commercial Management:

Diploma in Business Management (ICM)
Diploma in Human Resource Management (ICM)
Diploma in Marketing & Digital Strategy (ICM)
Certificate in Online Marketing & Digital Strategy (ICM)

Business:

BA (Hons) in Accounting and Finance (QQI)
BA in Business (QQI)
BA in Marketing (QQI)
BA (Hons) in Business Studies

It is exciting and encouraging for IILEx to see steadily increasing numbers of Graduates of the Diploma of Legal Studies & Practice and the LLB (Hons) in Irish Law and each year. After the required photographs were taken of the Graduates, Faculty Lecturers and friends and families were invited to light refreshments hosted by Griffith College Cork.

The Graduation was, as usual, successful and very well organised. Many thanks to Professor Diarmuid Hegarty President of Griffith College and Griffith College Staff for their kind invitation to this special occasion and for the hospitality extended to the Irish Institute of Legal Executives. As I am myself a graduate of Griffith College Cork it is always an honour to be invited to participate in this very special occasion.

On behalf of the Irish Institute of Legal Executives I would like to take this opportunity to wish Graduates every success going forward in their chosen profession and continuing success to Griffith College.

Deirdre Butler FIILEx

President

Irish Institute of Legal Executives

Picture by kind permission Lafayette Photography



*Seated Left to Right: - Tomás Mac Eochagáin, Director Griffith College, Noel Daly, Deputy Head, Griffith College Cork, Cllr. Fergal Dennehy
FF, Deputy Lord Mayor Cork, Professor Diarmuid Hegarty, President Griffith College,
Sian Langley, Head of Law Department Griffith College Cork and Deirdre Butler, President of IILEX
Standing: - Graduates of the 2017 DLS&P Programme Conferring Cork.*

The Tort of Passing Off and Statutory Protection of Registered Trade Marks

and a brief summary of recently decided Irish Patent Office and EU General Court “Public Policy” cases

A brand owner or marketer, in common law jurisdictions like Ireland, when a rival undertaking passes its goods off from those of a bona fide trader, may rely on common law remedies derived from the Tort of Passing Off. The Tort of Passing Off derives from the old common law Tort of Deceit. Such an action can only be initiated by one trader as against another. The action is unavailable as a remedy to the general public who may have been deceived into purchasing the goods of a rival trader.

The purpose of the Tort of Passing Off is not intended to protect a property right in the ownership of a trade mark, dress up or design per se, but it is an attempt to protect the business goodwill and reputation of an overall business. The essence of passing off is that the goods are in effect telling a falsehood about themselves. The goods indicate something about themselves which is calculated to misled (Draper v Trist, 1939). The main aspects of the tort are: -

1. The Plaintiff must have a commercial reputation associated with the particular aspect of the marketing in dispute.
2. The Defendant must make a misrepresentation to customers through use of the Plaintiff's reputation.
3. The misrepresentation and confusion of customers must have an adverse impact on the Plaintiff's trade.

Passing Off cases generally start by an application to the Court for an interlocutory injunction. The Plaintiff should make a good arguable case that the elements of the Tort exist and that the balance of convenience favours granting an injunction against the Defendant as a temporary measure until the full trial of the action. Most Passing Off cases tend to conclude at the interlocutory stage rather than proceed to a full trial. Lord Diplock suggested the essential elements of the Tort are: -

1. Goodwill and Reputation.
2. Misrepresentation.
3. By a Trader in the course of trade.
4. To consumers or ultimate consumers.
5. Calculated to injure / likelihood of damage.
6. Policy considerations.

Goodwill and reputation

Statutory protection is afforded to owners of Registered Trade Marks under the Trade Marks Act 1996 and the European Union Community Trade Mark Regulations. The primary obstacle for an owner of an unregistered trade mark, who seeks to protect and defend it, is that they must establish and prove goodwill in it. Goodwill

was defined in *Commissioners of Inland Revenue v Muller & Co's Margarine Limited* and quoted in *Independent Newspapers Limited v Irish Press Limited* as the “attractive force that brings in custom”. Goodwill develops from obtaining a reputation. The case of *Muckcross Park Hotel v Randle* highlighted that in Passing Off one may have a reputation without goodwill. Reputation on its own is generally insufficient to establish passing off. The English Courts over the past five decades have found the issue of where goodwill is located problematical. The issue is whether to protect the goodwill of a foreign business that has a reputation nationally but no actual business within the jurisdiction. The England and Wales Courts have tended to adopt a narrow approach to this issue. The Supreme Court of Ireland in the case of *C & A Modes v C & A (Waterford) Limited* rejected this approach.

The length of time required to obtain goodwill and how long it lasts is another issue to consider. The Defendant in the case of *Guinness Ireland Group v Kilkenny Brewing Co Limited* incorporated a company using the name KILKENNY® in connection with beer. The Plaintiff based its Passing Off action upon its prior use of the name when selling ale in Europe from 1987, in the United Kingdom from 1994 and in Ireland from July 1995. The Court held that given the reputation obtained from direct advertising in Ireland and the availability of the Plaintiff's products in Europe and the UK, the product was known to consumers in Irish public houses.

Misrepresentation

Misrepresentation in the Tort of Passing Off occurs in different ways. Most cases involve an implied rather



than an express misrepresentation. Misrepresentation occurs when a Defendant uses an aspect of the Plaintiff's marketing mix in a manner, which persuades the buyer to confuse the Defendant's goods or service with that of the Plaintiff. This may involve three elements, the first of which is the Defendant's adoption of an element, the second element is the Plaintiff's reputation with respect to that element and the third element is confusion caused by the Defendant's adoption of that element. Proof of deception is not required, merely a likelihood of it. The Defendant's intention to deceive is irrelevant. Some elements of an undertaking's marketing mix relevant to Passing Off are:

- a. Names
- b. Packaging
- c. Design
- d. Advertising

Names: A surname, geographical name, generic or a word descriptive of the type of good or service poses difficulties when it comes to establishing a reputation. The case of *Unitex Limited v Union Texturing Company Limited* illustrates that when a name is descriptive of a good or service the chances of success under a Passing Off action are slim. The Court of Appeal upheld the High Court's refusal to grant an injunction to the Plaintiff. The Plaintiff sold a range of goods to the building industry while the Defendant sold goods to the plastering sector.

Packaging: The way a good or service is presented is as crucial as the brand name. The Court granted interlocutory injunctions in *Polycell Products Limited v O'Carroll and Golden Vale Food Products Limited* when it held that the Defendants' product packaging in terms of colour and design would lead to confusion even though brand names were different to the Plaintiff. The Supreme Court of Ireland in the well-publicised case of *McCambridge Limited v Joseph Brennan Bakeries* agreed that consumers could be confused by the packaging of the two competing products. Evidence provided to the High Court illustrated that the manner of presentation of the product is an important issue when assessing whether the product is likely to mislead the public or whether there is confusion.

Design: Goods such as clothes are frequently sold without manufacturers' packaging. The Plaintiff was granted an interlocutory injunction in *Gabicki Plc v Dunnes Stores Limited* because of the significant likelihood of confusion arising from the Defendant's sale of jumpers being similar to their garment design. The Defendant retail business in this case was again a losing party in a later similar case, *Karen Millen Fashions Limited v Dunnes Stores and Dunnes Stores (Limerick) Limited* relating to the issue of an EU unregistered design pursuant to Community Regulation (EC) No.6 / 2002 of the 12 December 2001 (the Regulation).

Advertising: Some advertising methods may develop into an actionable misrepresentation when there is a sufficient association with the Plaintiff's goods or services. The Plaintiff succeeded in its action against the Defendant in the case of *Illustrated Newspapers*



Limited v Publicity Services (London) Limited, where the misrepresentation was the insertion of magazine supplements into the periodicals of another. The famous night-club owner as a Plaintiff in the case of *Stringfellow v McCain Foods* failed in his action against the Defendant when it used the Plaintiff's surname as its brand name for a range of oven chips with the Defendant running a TV campaign showing scenes from a dance floor.

By a Trader in the Course of Trade

The tort of passing off as a legal remedy is unavailable to the general public. Misrepresentation must occur by way of commercial activity. The Courts tend to adopt a flexible approach when it comes to deciding what is meant by a "trader" and the "in the course of trade". A defendant retailer was subject to an interlocutory injunction when he attempted to sell used GILLETTE® razor blades as new ones. The Court in *An Bord Trachtala v Waterford Foods Plc* held that the Plaintiff trade association representing the interests of its members, but not itself engaged in trade, could maintain a Passing Off action.

To Consumers or Ultimate Consumers

Misrepresentation occurs when the notional consumer or end user of the product or service is deceived or confused into purchasing the rival Defendant's product instead of the Plaintiff's, mistaking it for the Plaintiff's. In *Guinness Ireland Group v Kilkenney Brewing Co Limited*, the Court held that the Defendant's use of the title "Kilkenney Brewing Company" for a non-trading limited liability company, whose objects were to hold land for a micro-brewery premises, would lead consumers to assume that the Defendant's brewed the "KILKENNY" beer product owned by the Plaintiff or one of its companies.

Calculated to Injure / Likelihood of Damage

Lord Diplock in *Erven v Townsend & Sons (Hull) Limited* formulated the term "calculated to injure". This means a reasonably foreseeable prospect of an adverse impact on the Plaintiff which is measured by a likelihood of confusion or deception of consumers. This depends on the Plaintiff having a commercial reputation to which such confusion arises. If a Plaintiff does not have a commercial reputation there is nothing to confuse the consumer with and therefore nothing to damage. When a Plaintiff's reputation is in a different commercial sector from that

of a Defendant proving a likelihood of confusion and an adverse impact on its business will be difficult. The Court in *Granada Group Limited v Ford Motor Company Limited* refused an interlocutory injunction over the use of the word GRANADA®. The Plaintiff was engaged in a different business as a television producer than the Defendant's motor manufacturing and sales business.

Damage is a necessary element in Passing Off. Actual damage must be shown if the claim is for damage at common law, while a likelihood of damage is required when applying to the Court for an injunction. The Courts will infer damage in cases where fraudulent trading is established or where the Plaintiff can show a falling volume of sales. When a Plaintiff makes an application to the Court for an injunction there is no need to prove adverse economic consequences, the impact on goodwill is sufficient. The case of *Symonds Cider & English Wine Co v Schweppes (Ireland)* highlights that evidence from those in the trade such as wholesalers or market researchers may not be admissible given the element to prove is that it is customers who are likely to be deceived when making a purchase. It appears that a Judge's subjective view as a potential customer is preferred to a wholesaler or market researcher.

Policy Considerations

Lord Diplock in *Warnink v Townsend* opined that the essential elements of the Tort of Passing Off may not be definite when it comes to arriving at a particular decision in a case. It is suggested that policy considerations may also be considered. The case of *Falcon Travel Limited v Owners Abroad Group Plc* is an example where policy considerations extended the scope of the tort. The Plaintiff was a Dublin and Wicklow located retail travel agency who applied for an injunction over the use of the word "Falcon" against the Defendant, a large UK based wholesale tour operator. It appears that while the Plaintiff may have benefitted from the Defendant's advertising campaigns, the Court held there was sufficient damage to the Plaintiff's goodwill in the Dublin & Wicklow business reputation in that it was becoming submerged into the Defendant's. It was held that proof of adverse consequences flowing from the submergence was unnecessary with damages being awarded in lieu of an injunction.

Readers should note, as per the writer's introduction, that Lord Diplock's six elements may be shorted to

three tests which arise from the seminal Passing Off case of *Reckitt and Coleman Products Limited v Bordan Inc & Ors* (also known as the JIF lemon case), namely that there must be an existence of a reputation or goodwill in the claimant's product offering, there must be misrepresentation leading to confusion between what is alleged to be the offending product and the claimant's product and whether damage to the claimant's goodwill or reputation by virtue of any such confusion has been established. These tests were approved by Laffoy J in *Miss World Limited v Miss Ireland* [2004] 2 IR 394 and later by Clarke J in *Jacob Fruitfield Limited v United Biscuits (UK) Limited* [2007] IEHC 368.

STATUTORY PROTECTION FOR REGISTERED TRADE MARKS

The Paris Convention for the Protection of Industrial Property (1883) – ("The Paris Convention")

The Paris Convention applies to industrial property in the widest sense to include Patents, Trademarks, Service marks, Trade names, Industrial Designs and Utility Models (a "small scale patent" allowed by law in certain countries) and geographical indications (for example – PARMA ham) and the repression of unfair competition. The Convention has three categories: -

- a) National treatment: The Convention provides that, as regards the protection of industrial property, each Contracting State must grant the same protection to nationals of other Contracting states it grants to its own nationals. Nationals of non-Contracting States are also entitled to national treatment under the Convention if they are domiciled or have a real and effective industrial or commercial establishment in a Contracting State.
- b) The Convention provides for the **right of priority** in the case of patents, trademarks and industrial designs. This means that on the basis of a regular first application filed in one of the Contracting States, the applicant may within 6 months of the trademark application apply for protection in any of the other Contracting States. These subsequent applications (to the other Contracting States) will be regarded as if they had been filed on the same day as the first application. An advantage of this provision is that applicants seeking to protect in several countries are not required to present all of their applications at the same time but have 6 months to decide which countries they wish to seek protection.
- c) Repression of unfair competition: Each Contracting State must refuse registration and prohibit use of trademarks / marks that constitute a reproduction, imitation or translation, liable to create confusion, of a mark used for identical or similar goods and considered by the competent authority of that State to **be well known in that State** and to already belong to an entity entitled to the benefits of the Convention (known as Article 6bis of the Paris Convention).

The Madrid System (the Madrid Agreement) and (The Protocol)

The Madrid Agreement concluded in 1891 and was revised at various city locations, for example in Stockholm



in 1967. The Protocol relating to the Madrid Agreement concluded in 1989 and aims to make the Madrid System more flexible and more compatible with domestic legislation of certain countries or intergovernmental organisations that had not been able to accede to the Agreement.

The Madrid Agreement / Madrid Protocol system works on the basis that once the Trade Mark owner is domiciled or is a national or has a real commercial base in a Protocol country (Ireland) and its mark is the subject of an application or registration in the home country (Ireland for basic application) the Trade Mark owner may choose or “designate” which of the Protocol countries the registration (known as an International registration) is to take effect. Since 1 October 2004, the applicant may designate the EUTM system. Once the Controller of the Patent Office in Kilkenny has examined the application as to its formalities it is forwarded to the International Bureau of the World Intellectual Property Organisation (WIPO) in Geneva.

The Nice Classification system

The Nice Agreement concluded at Nice in 1957 and with subsequent revisions, amendments and up-dated editions establishes an international system for the classification of goods and services for the purposes of registering trademarks and service marks.

The current version is the 2018 version of the eleventh edition and it came into force on 1 January 2018. The Nice Classification has from 1 to 34 separate class headings to classify different goods and has from 35 to 45 separate class headings for different services.

Each numbered class has a Heading together an Explanatory note to indicate what goods or services are included and excluded from the particular class, as well as a code number for sub-classes of goods within the main class.

For example – the Class 8 Heading - relates to hand tools and implements, hand-operated; cutlery; side arms, except firearms; razors. The Explanatory Note indicates that the class includes mainly hand-operated tools and implements for performing tasks, such as drilling, shaping, cutting and piercing. The class includes, inter alia, table cutlery, such as knives, forks and spoons, including those made of precious metals. The class excludes, inter alia, surgical cutlery (Class 10) and fencing weapons (Class 28). The sub-heading class for table cutlery for knives, forks and spoons is 080059.

Ireland: - Trade Marks Act 1996, Trade Mark Rules and amendments

The Trade Marks Act 1996 (TMA 1996) came into force on 1 July 1996. Its enactment enabled the State to fulfil its obligations under European Union law.

Section 6 of TMA 1996 is based on Article 2 of the Harmonisation Directive. While the TMA 1996 repealed the previous Trade Marks Act 1963 (TMA 1963), transitional provisions suggest it still applies to the validity of existing registrations.



The TMA 1996 extends protection to service trademarks instead of just trademarks for goods only as under the TMA 1963. The TMA 1996 also allows for rights to a Trade Mark granted under the Community Trade Mark Regulation (CTM) to be effective registration in the Irish jurisdiction and provision is made for the recognition of the Madrid Agreement (Madrid Protocol). Section 60 of the TMA 1996 also gives effect to some provisions of the Paris Convention for the Protection of Industrial Property. Sections 6 and 7 of TMA 1996 deal with what is meant by “trademarks” and what is a registered trade mark.

Section 6 (1) defines a trademark as “*any sign capable of being represented graphically which is capable of distinguishing goods or services of one undertaking from those of other undertakings*”. The pertinent words to this section are sign, capable of being represented graphically and capable of distinguishing.

Section 6 (2) reads “without prejudice to subsection (1), a trade mark may, in particular, consist of words (including personal names), designs, letters, numerals or the shape of goods or of their packaging.

Section 6 (3) reads “references in this Act to a trade mark include, unless the context otherwise requires, references to a collective mark within the meaning of section 54 or a certification mark within the meaning of section 55”.

A collective trademark is a mark distinguishing the goods or services of members of the association which is the proprietor of the mark from other undertakings. A collective mark is a trademark owned by an organisation and utilised by its members to identify themselves with a level of quality or accuracy or geographical origin or other characteristics established by the organisation. The “ICSA” mark with the coat hanger symbol, belonging to the Irish Charity Shops Association, is an example of a collective trademark.

A certification trademark is a mark indicating that the goods or services in connection with which it is used are certified by the proprietor of the mark in respect of origin, material, mode of manufacture of goods or performance of services, quality, accuracy or other characteristics. An example of a well-known certification trade mark is the WOOLMARK symbol and word on clothing products. A certification mark guarantees specific characteristics of certain goods.

Section 7 (1) reads “a registered trade mark is a property right obtained by the registration of the trade mark under this Act and the proprietor of a registered trademark shall have the rights and remedies provided by the Act”. The pertinent word formulation is “is a property right”.

The cheapest option when a trademark owner proposes to market its trademark or brand solely in Ireland is to register it with the Controller of the Patents Office in Kilkenny (www.patentsoffice.ie). A trademark owner may apply in a single application to register its trademark in several classes of goods or services, as per the Nice Classification, by paying additional fees per additional class. A registered trademark is initially registered for ten years (from the date of filing the application) and may be renewed indefinitely for further 10-year periods subject to the payment of the statutory renewal fees.

As a registered trademark is a property right it may be sold or assigned by the proprietor pursuant to section 29 of TMA 1996. The trademark owner may licence the use of its trademark to others. Assignments and licences must be notified to the Controller of the Patent Office.

An Examiner in the Patents Office will examine an application to ensure it complies with the TMA 1996 and Rules and can refuse an application for registration if section 8 (a) to 8 (d) criteria are not met. These sections are known as the **Absolute Grounds for refusal of registration**. These section 8 (1) absolute grounds are:

- a) Signs which do not satisfy the requirements of section 6 (1).
- b) Trade marks devoid of any distinctive character.
- c) Trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of services, or other characteristics of goods or services;
- d) Trade marks which consist exclusively of signs or indications which have become customary in the current language or in the bona fide and established practices of the trade. (HOOVER to vacuum carpets is an example of a customary word).

A trade mark shall not be refused registration by virtue of paragraph (b), (c) or (d) if, before the date of application for registration, it has in fact acquired a distinctive character as a result of the use made of it. An application where this section applies is MARKETER OF THE YEAR™ owned by Michael Cullen, a publisher of Marketing.ie magazine who organises the nomination and awarding of this long-established individual business / marketing award.

The pertinent word to remember for both 8 (1) (c) and 8 (1) (d) is “exclusively”.

A trademark cannot be registered if it is contrary to public policy or accepted principles of morality or if it is of such



a nature so as to deceive the public, for instance as to the nature, quality or geographical origin of the goods or service.

Readers should be aware a feature of disputes which may be decided by the Patent Office in Kilkenny, the European Union Trade Mark Office (based in Alicante, Spain) and Registered Trade Mark contested cases is that an Applicant when faced with an action by a Registered Trade Mark owner may counter-claim or initiate an attack on the owner’s trademark registration by launching a Revocation or Invalidity claim.

A recent Irish Patents Office invalidity case, pursuant to section 52 of TMA 1996, wherein the issue of public policy was pleaded, is *Savanagh Securities Limited trading as T-Rex Clothing (applicant for invalidity) and Cumann Lúthchleas Gael (Proprietor)* (hereinafter – the GAA).

Dermot Doyle, acting for the Controller noted it was a common case that the applicant’s proceedings were put in train to address an action by the GAA to prohibit the applicant continuing its illegal use (according to the GAA) of the GAA registered trademark (Trade Mark No. 239459 published in Journal 2118 on 18.02.09).

The applicant (T-Rex Clothing) attacked the GAA trademark on the basis that section 7 of the TMA 1996 stipulates that a registered trademark is a property right. The applicant argued that it is a well-recognised principle of Irish law that unincorporated associations have no legal personality of their own and cannot own property or enter into contracts in their own right. The applicant relied on the seminal case of *Conservative and Unionist Central office v Burrell*.

The applicant further claimed the GAA trademark no. 239459 is in breach of section 8 (3) (a) of TMA 1996 which provides that a trademark should not be registered if “it is contrary to public policy or to accepted principles of morality”. The applicant also claimed the GAA trademark should be invalidated under Section 52 (1) of TMA 1996

on the basis it was in breach of section 8 (3) (b) of TMA 1996 which provides that a trademark shall not be registered if *“it is of such a nature as to deceive the public, for instance as to the nature, quality, geographical origin of the goods or services”*.

While Mr Doyle, acting for the Controller, decided to reject the application for a Declaration of Invalidity and to allow the GAA trademark remain on the Register, his decision pursuant to section 79 of TMA 1996, is under an Appeal to the High Court bearing High Court Record No. 2018/315SP.

An Examiner in the Patents Office will also examine an application by carrying out searches of the National and Community Trade Mark databases to ascertain if there is a similar or identical trademark registered or pending with an earlier filing date. These are known as the **Relative Grounds for Refusal of Registration** and occur when there are earlier trademark rights for which protection should be granted. Section 10 of TMA 1996 deals with earlier rights.

A trademark shall not be registered if because -

- it is identical with an earlier trademark and would be registered for goods or services similar to those for which the earlier trademark is protected or
- it is similar to an earlier trademark and would be registered for goods or services identical with or similar to those for which the earlier trademark is protected, there exists a likelihood of confusion on the part of the public, which includes the likelihood of association of the later trademark with the earlier trade mark.

A trademark which is identical with or similar to an earlier trademark, and is to be registered for goods or services which are not similar to those for which the earlier trademark is protected shall not be registered if, or to the extent that, the earlier trademark has a reputation in the State (or, in the case of a Community trademark, in the Community) and the use of the later trademark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or reputation of the earlier trademark. This section covers Ireland's obligations under the Paris Convention (known as Article 6bis of the Paris Convention).

A trademark may also be opposed by the owner of an earlier trademark if it can be proven that the use of the later trademark would be prevented under the law of Passing Off (protecting an unregistered trademark or

other sign used in the course of trade) or by invocation of another earlier right.

Section 11 of TMA 1996 provides that an “earlier trademark” means a registered trademark or one which is pending on either the Irish register, the EUTM register or on the International register, which has a date of application for registration earlier than that of the applicant trademark. This is where Priority of Application is an important issue. A trademark on the International register is one which had been registered with the International Bureau of the World Intellectual Property Organisation (WIPO) under the Protocol relating to the Madrid Agreement.

Section 14 of TMA 1996 deals with infringement. A registered trademark grants its owner exclusivity of rights given it is personal property. The proprietor, unlike under the Tort of Passing Off, is not required to prove a reputation or to show actual or likely damage. Section 13 (1) of TMA 1996 regulates the right as being limited to prevention of unauthorised use of the trademark. A registered trademark owner can only sue on foot of infringement within the State.

Section 15 of TMA 1996 regulates the various defences and exceptions to infringement.

Section 16 of TMA 1996 deals with the issue of exhaustion of rights conferred by a registered trademark.

Sections 18 to 23 of TMA 1996 deal with civil remedies in the event of infringement.

Section 51 of TMA regulates the revocation of a registered trademark and section 52 of TMA deals with grounds for invalidity of registration.

European Union Trade Mark (EUTM) – formerly known as a Community Trade Mark (CTM)

The Council of the European Union during late December 1993 issued Regulation 40/94. The Official Journal published it on 14 January 1994 and it came into force on 15 March 1994. The Regulation introduced a framework for a single European Union wide trademark known as a Community Trade Mark (CTM) and now known since 23 March 2016 as a European Union trademark (EUTM). On 23 March 2016, the European Parliament and the Council amended the Community Trademark Regulation with Regulation 2015/2424.

The EUTM system allows for a dual system for the registration of trademarks. A trademark application may be applied for at a national level in a particular EU country Patent Office or Intellectual Property Office or a trademark application may be applied for at the European Union Intellectual Property Office (EUIPO) located in Alicante, Spain. A EUTM application for a single trademark is valid for the entire European Union and it is impossible to hold a EUTM which excludes one or more EU member states. It is an “all or nothing” system.

The EUTM system is Opposition based. Applications obtain priority by virtue of their filing date and it is



important to note they are examined only on the basis on inherent registrability. The EUTM office does not examine the trademark as such, apart that is, to ensure it does not fall foul of the Absolute Grounds for Refusal category (Article 7). This is different to the Controller of the Patent Office in Kilkenny who will examine an application for both Absolute Grounds and Relative Grounds.

A EUTM is similar to a national registered trademark in that it grants exclusivity of use. A EUTM owner effectively acquires a monopoly on the use of its trademark registration. There is an examination, given the potential granting of an exclusive right, as to whether or not the trademark accomplishes the necessary requirement of being distinctive and therefore capable of distinguishing the goods or services of one undertaking from those of another undertaking.

It is impossible to file an Opposition to a EUTM application on any of the **Absolute Grounds for Refusal** (Article 7). Absolute grounds are similar to TMA 1996. It is possible, however, to file observations subsequent to publication. A trademark under these absolute grounds will be refused registration even it pertains to just one part of the European Community. Registration will be refused if a trademark contains a word, which may be descriptive in one EU language but not others. Article 7 recognises that acquired distinctiveness may nullify an objection so that use may be considered. Registration may be allowed if the trademark can be shown to be distinctive through use.

Upon an Opposition by the owner of an earlier trademark, the trademark applied for shall not be registered if it falls foul of the **Relative Grounds for Refusal** (Article 8). Relative grounds are similar to TMA 1996.

An earlier trademark is defined as a EUTM, a national registered trademark in an EU country or the Benelux and an International (Madrid Agreement or Madrid Protocol) trademark effective in an EU country.

Article 8 also provides for Opposition based on a trademark which is well known in an EU country under Article 6bis of the Paris Convention. An Opposition is also possible by the owner of an unregistered trademark used in the course of trade and of more than mere local significance.

The Italian government applied to the EUIPO under Article 59 (Absolute Grounds for Invalidity) to declare invalid the Spanish pizza chain (La Mafia) registration for its trademark LA MAFIA SE SIENTA A LA MESA with its red rose logo. The EUIPO declared invalid the trademark registration on the basis of the Italian government argued it cheapened the seriousness concerning the Mafia crime organisation. The Italian government argued that granting the trademark was “contrary to public policy and to accepted principles of morality”. The EUIPO Cancellation Division and its Board of Appeal upheld the Italian government argument and invalidated the trademark. The Spanish company appealed the decision to the General Court which appeal was also unsuccessful.

Summary

The tort of Passing Off is a common law remedy utilised to enforce unregistered trademark rights as compared to statutory rights used to enforce registered trademark rights which are essentially property rights to vindicate an exclusive right to use same. Passing Off allows for a remedy when there is no trademark registration protection by individuals or businesses or by trademark owners who allowed their registration to lapse or had it revoked or invalidated. A claim for Passing Off may be included in a claim for trademark infringement in the event the infringement claim is unsuccessful.

A Passing Off case may be taken where the subject matter has nothing to do with trademarks. A Passing Off action can only be initiated by one trader as against another. A Passing Off action is unavailable as a remedy by individuals who were deceived into purchasing a “passed off good or service” as compared to non-commercial third-party applicants in registered trademark disputes, such as the Italian government in the case of La Mafia Franchises SL v EUIPO. In a EUTM application anybody unconnected to the commercial product or service may file an observation.

A Plaintiff in a Passing Off dispute must be in a position to show goodwill and a reputation which is usually acquired in the course of trade over a period of time as compared to registered trademark statutory rights. In a Passing Off dispute the Defendant goods or services need not to be the same as the Plaintiff goods or services. In a registered trademark dispute the goods or services must be identical or similar with registration protecting certain categories of goods or services. Showing damage is a necessary element in a Passing Off dispute. If a registered trademark Plaintiff establishes the Third-Party trade mark is identical or deceptively similar no proof of likelihood of confusion is required.

Finally - a Passing Off action attempts to protect an overall business goodwill and reputation whereas a registered trademark enjoys statutory protection on its own. A registered trademark may be sold, assigned or licenced to others separate to an overall business. Readers may be aware of the famous business story concerning Vickers Plc and Rolls-Royce Plc and the sale of the Crewe motor-car manufacturing plant in England which made both ROLLS-ROYCE luxury and BENTLEY sports cars to the Volkswagen / Audi Group (VAG). The rights to the ROLLS ROYCE name were licenced by Rolls Royce Plc to BMW AG for GBP£40 million.

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Martin Tierney FIILEx is a Director of the Irish Institute of Legal Executives. Martin holds a BA (Hons) in Business Studies, a Diploma in Accounting & Finance (ACCA), an LL.B (Hons) in Irish Law and a Diploma in Intellectual Property and Information Technology Law (Law Society of Ireland). He is an Irish and European Union Registered Trade Mark Agent (Controller Patents Office, Kilkenny). Martin works as a litigation Legal Executive with LawPlus Solicitors.

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