The Brief

The Official Journal of the Irish Institute of Legal Executives
2022/23 Issue

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THE BRIEF 2022/23

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As part of this objective, The Brief will act as an authoritative source of information on Institute activities and policies. From time to time The Brief may cover controversial issues. The editorial team shall have the final decision on matters of editorial policy or content but always strive to preserve and to enhance the good name of the Irish Institute of Legal Executives and its members.

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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,

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Congratulations and well done all.

The Irish Institute of Legal Executives

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President's Address

Dear Members,

I hope this finds you all safe and well. Each one of us have faced challenges over the last few years be it personal or professional.

We are confident that the Institute will continue to grow in strength and numbers. The Board of Directors of Irish Institute of Legal Executives continue to work representing the interests of members and progressing the role of the Legal Executive in Ireland.

The Board continues to conduct Board Meetings via Zoom which has been very successful. We continue to sit representing Legal Executives on the Customer Focus Group for the Property Registration Authority which has formed part of Tailte Eireann. We also continue to liaise closely with Griffith College to assist in their expansion and adaptation to a larger eLearning facility for our members and future members thus providing Legal Executive Graduates of the highest calibre. Congratulations to all Students who graduated during this year and the Institute looks forward to these Graduates becoming full members in the future. I would like to acknowledge the tireless work behind the scenes that my fellow Directors and Administration Staff put in during this and every year, volunteering their time to IILEx, sincerely thank you!

We welcome any suggestions/ideas you may want to share with the Board. We can be contacted at info@iilex.ie and we can also be found on LinkedIn and Facebook through our home page at www.iilex.ie.

I would ask Members to encourage their colleagues who may fill the Irish Institute of Legal Executives required criteria to become Members. We also encourage our members to give us feedback and share ideas enabling us to continue growing and being an integral part of the Legal profession in Ireland.

Finally, I would like to take this opportunity on behalf of the Board of Directors to thank you our Members for your continued support as we look forward to 2023.

Kind regards,

Deirdre Butler
President
Irish Institute of Legal Executives

All fully paid-up Members of the

IRISH INSTITUTE OF LEGAL EXECUTIVES

are invited to **IILEX'S AGM:**

on Saturday 2nd September 2023

at 11.30 a.m.

in **HYATT CENTRIC HOTEL**,

Dean Street, The Liberties,

Dublin 8, D08 W3X7

Speaker: To be confirmed

Please enquire by Email: info@iilex.ie or Tel: 01-8904278

Mary B. O'Dwyer (1943-2022)

The death occurred of Mary B. O'Dwyer, fellow and director of PR Communications with Irish Institute of Legal Executives on January 7th 2022 in the loving care of the staff at our Lady's Hospice, Harolds Cross, Dublin.

Formerly of Roxton, Corofin, Co. Clare, she was the only daughter of the late John and Josie O'Dwyer and devoted sister of the late Pat.

Educated at the Hall in Corofin School, Coláiste Mhuire Boarding School Ennis. Mary went on to work in the Public Service - Irish Land Commission - (Examiners' Registrar Branches as well as Court Clerk to Registrar of Judicial Commissioner of the ILC the late Ms. Justice Mella Carroll, High Court Judge) and laterally worked in the Department of Justice Equality & Law Reform, to name but a few of the Departments she worked in over her term of service until her retirement.

Mary held a B.A. Degree in Public Management, and post retirement went on to complete the Diploma in Legal Studies at Griffith College Dublin.

She joined the Irish Institute of Legal Executives, became Director of PR/Communications and received her Fellowship in 2012. She was dedicated to her role and took particular interest in the official journal of the Institute 'The Brief'. She was commended for her expert editorial work sourcing articles and photographs for The Brief, not to mention the many interesting articles she contributed herself! including those on the Burren Law School and the Brehon Law in Ireland.

Her mind was always a "tome" of information and she loved quoting Latin phrases, Obiter Dictum of all sorts would crop up. an intelligent interesting conversationalist of a rare kind, she would speak about far ranging topics from local history in Clare of the Bindon-Blood's and the artist Sir Frederic William Burton to some latest court case she was following in the USA!

She spoke so highly of her cousins, relatives, friends, neighbours, colleagues and all who cared for her during her illness. Their kindness to her throughout the years and when her dear brother died on February 1st 2019.

It was a pleasure to have known Mary B O'Dwyer. She was great fun but always a lady. We all miss her so much. the many tributes paid to Mary B. since her death are a testament to the respect in which she was held in the legal community and by her colleagues and friends.

solas mhic dé ar a-anam.

MF.

CLARE MY HEART MY HOME

Song by Tim Collins PHD

Tonight, dear friends I'll sing a song, a toasting glass I'll raise
To a place that means the world to me, on the Wild Atlantic Way
A land where blessed feet once tread, where kings and princes roamed
A place of beauty and renown, Clare, my heart, my home.

So, raise your voices one and all, sing out, let it be known
The Banner's flying high tonight, in Clare, my heart, my home

Liscannor Bay and Moher's Cliffs greet white Atlantic foam
And Burren's beauty uncompared, majestic land of stone
The rolling hills of Tulla, Inchichronan, Craggaunowen
All jewels in the crown that is, Clare, my heart, my home

So, raise your voices one and all, sing out, let it be known
The Banner's flying high tonight, in Clare, my heart, my home

Across this land are ancient ruins, once built by holy hands
From Scattery to Corcomroe, from Killaloe to Quin
Kilfenora of the Crosses, seven carved from Burren stone
Standing tall as sentinels of faith in Clare, my heart, my home

So, raise your voices one and all, sing out, let it be known
The Banner's flying high tonight, in Clare, my heart, my home

And now it's time to bid farewell, this night must come to end
But I wish you peace and god's blessings until we meet again
If ever you return again of this, you can be sure
You'll be welcome here with open arms, in Clare, my heart, my home

So, raise your voices one and all, sing out, let it be known
The Banner's flying high tonight, in Clare, my heart, my home

So, raise your voices one and all, sing out, let it be known
The Banner's flying high tonight, in Clare, my heart, my home

Barry Brady
Winner Legal Executive of the Year at the Irish Law Awards 2021

Claire Rafferty
Legal Executive of the Year 2022 at the Dye & Durham Irish Law Awards

Navigating the World of Sanctions

INTRODUCTION

The Russian invasion of Ukraine has led to a range of sanctions by the European Union on Russian companies and individuals. The sanctions imposed on Russia by the EU are not the first sanctions of the EU. For example, prior to any of the latest sanctions on Russia, the EU had sanctioned entities such as the Islamic State. Not many Irish businesses have dealings with the Islamic State, however, whereas the size and importance of the Russian economy has meant that the Russian sanctions have a real and immediate impact for many Irish businesses and professionals. Of course, the EU and its member states are not the only countries that impose sanctions and any solicitors advising their clients on compliance with sanctions have to keep in mind not only the EU and Irish sanctions regimes but the regimes of other countries, in particular that of the United States.

WHAT ARE SANCTIONS

In the words of the European Commission, EU sanctions may target governments of non-EU countries, as well as companies, groups, organisations, or individuals through arms embargoes, travel bans, asset freezes or other economic measures such as restrictions on imports and exports. Member states, including Ireland, are responsible for the implementation and enforcement of EU sanctions, as well as for identifying breaches and imposing penalties.

Of course, the EU is not the only world power to use sanctions nor, indeed, is it the first or the largest imposer of sanctions. That honour must fall to the United States where sanctions have been used as a foreign policy tool for decades and where, following the collapse of the Soviet Union in 1989, an event which left the United States with comparatively huge economic power, their use by the United States expanded greatly. The post September 11th period saw the United States expand its sanctions regime further to exploit its control of the world's reserve currency, the US dollar, to create what are known as secondary sanctions.

PRIMARY AND SECONDARY SANCTIONS

The EU limits itself to primary sanctions which prohibit parties in Europe engaging in transactions with sanctioned entities. The United States has expanded its sanctions regime beyond primary sanctions to secondary sanctions. These are much more extensive and act to prohibit parties in the United States engaging in transactions with third parties anywhere in the world that engage in transactions with sanctioned entities. Many entities based in the EU will have numerous contacts with the US and will need to retain access to the US market and the US financial system and to maintain an ability to conduct business in US dollars. Secondary sanctions put all these requirements at risk since they prevent any US entity from engaging in business with an EU entity who does business in breach of US sanctions. Secondary sanctions effectively present companies based in the EU with the choice of continuing to deal with the sanctioned entity or maintaining access to the US market and dollar denominated system. Faced with this choice, companies will almost inevitably choose the US.

SANCTIONS ON IRAN

At the moment, the US and the EU are relatively closely aligned on the sanctions applicable to Russia. But they are not always so closely aligned and, in fact, in the recent past, the EU and the US have adopted contrary positions on certain sanctions, most particularly in relation to Iran. In 2015 the EU and the US agreed with Iran to lift sanctions in return for nuclear disarmament. With the election of Donald Trump to the US presidency, however, the US reneged on its agreement and re-imposed sanctions, including secondary sanctions, on Iran. This action, in addition to severely undermining the agreement with Iran, exposed the relative weakness of the EU in the face of US sanctions. No sooner had the US imposed secondary sanctions than EU companies, notwithstanding EU support for economic engagement with Iran to bolster the nuclear disarmament agreement, quickly shied away from any dealings with Iran. The French oil giant Total abandoned its investment in Iran's oil fields and the Belgian Society for Worldwide Interbank Financial Telecommunication cut off Iranian access.

The European Commission has stated that the American action in imposing secondary sanctions is 'contrary to international law, that it threatens the integrity of the Single Market and the EU's financial systems, reduces the effectiveness of the EU's foreign policy and puts strain on legitimate trade and investment in violation of basic principles of international law.' The EU response to what amounted to a de facto challenge to foreign policy independent of the United States was largely two-fold. Firstly, the EU established a Special Purpose Vehicle named INSTEX designed to process payments between Iran and its international trading partners and thereby facilitate trade that would otherwise be inhibited by American sanctions. The EU also revived the 1990s-era Blocking Statute (European Council Regulation 2271/96) that prohibits compliance with the US sanctions. The Blocking Statute aims to protect EU operators by nullifying the effect within the EU of any foreign decision, including court rulings, based on the foreign sanctions annexed to the statute. The statute prohibits EU persons from complying with such sanctions and allows affected EU persons recover damages caused by the sanctions (though not, of course, from the US government, which benefits from State sovereignty). The law also allows parties to seek derogations from the European Commission from the obligation to comply with the statute and requires EU persons and companies to inform the Commission if the targeted sanctions affect their economic or financial interests.

BANK MELLI IRAN CASE

The Court of Justice has ruled on one case concerning the Blocking Statute, namely the case of Bank Melli Iran v Telekom Deutschland GmbH (C-124/20). The facts are that following the reintroduction of sanctions against Iran by President Trump, Bank Melli Iran, an Iranian bank with a branch in Germany whose main business was to settle foreign trade transactions with Iran, was made subject to US primary sanctions on the 5th November 2018. At the time, the bank had a contract with Telekom Deutschland GmbH for the provision of telecommunication services. The contract itself was on insignificant value, about €2,000 per month, but Telekom Deutschland is a subsidiary of Deutsche Telekom, a company with a significant presence in the United States market where it generates over 50% of its turnover. On the 16th of November Telekom Deutschland terminated its contract with the bank and on the 28th November the bank sued Telekom for breach of the Blocking Statute claiming that the termination of the contract was motivated solely by the desire to comply with US secondary sanctions annexed to the Blocking Statute. Initially, the bank secured an injunction from the Regional Court in Hamburg requiring Telekom to continue to provide services until the end of the contractual notice period and then sought a further order compelling Telekom to continue to provide the service even after the termination date. This request was refused by the Regional Court and appealed by the bank to Hanseatic Higher Regional Court in Hamburg which referred a number of questions concerning the Blocking Statute to the Court of Justice.

In responding to the questions raised, the court agreed with Advocate General Hogan that the Blocking Statute applies not only where the United States' authorities compel or direct a European entity to comply with its sanctions but also to spontaneous decisions by such an entity to comply, as in the Telekom case. The court also broadly agreed with the Advocate General on the question of giving reasons for termination and held that where all the evidence indicates prima facie that thereason was to comply with secondary sanctions then the regulation requires that the burden of proving otherwise is put on the terminating party.

On the final question of the appropriate sanction for breach of the Blocking Statute, the Advocate General felt compelled to go so far as to say that because the Blocking Statute created rights for persons subject to primary sanctions (Bank Melli in this case) and in order to ensure consistent and effective enforcement of the Blocking Statute, any decision to terminate a contract simply to comply with sanctions should be regarded as invalid and ineffective and the national courts must order the party to continue the contractual relationship in question. On the question whether this outcome was a proportionate restriction on the freedom of enterprise under Article 16 of the Charter of Fundamental Rights, the Advocate General felt that the option to apply for a derogation under the statute is sufficient to ensure that any prohibition does not infringe a substantive freedom. The court, on the other hand, gave some scope to avoid the drastic consequences that could flow from the Advocate General's view and held that it was for the national courts to strike a balance between the requirement to pursue the objectives of the Blocking Statute (which would favour continuing the contract) and the economic losses a party would incur by doing so and whether those would result in disproportionate effects. The court did note, however, that Telekom Deutschland did not apply for a derogation under the Blocking Statute, a fact which it suggested was relevant in assessing proportionality.

COMMISSION CONSULTATION

In early 2021 the European Commission announced that it was considering amending the Blocking Statute to make it more effective in deterring and counteracting the application of secondary sanctions on EU operators. The Commission's subsequent public consultation confirmed that, overall, the Blocking Statute had not been successful in protecting European entities from the consequences of secondary sanctions. The consultation indicated that the Blocking Statute suffers from a lack of awareness and enforcement among the judiciary and its effectiveness was compromised by complexity and expense. Respondents to the consultation suggested strengthening the effectiveness of the Blocking Statute through restrictions on access to the EU market and punitive damages targeted at specific sectors or specific operators, as well as exploring resolutions through diplomacy and international organisations.

THE FUTURE

The reaction to Russia's invasion of Ukraine shows how prominent a part sanctions may play in the future and while the US and the EU may be aligned on Russian sanctions they are not aligned (indeed, are directly opposed) on other sanctions and are unlikely to be aligned on all sanctions in the future. To make the situation even more complicated, the Commission's consultation noted how China has exploited its predominance in technology to introduce secondary sanction similar to America's. With the Commission considering expanding the Blocking Statute, economic conflict seems likely.

For Ireland, an EU member state with an open economy and deep economic ties to the United States and growing ties to China, the conflicting sanctions regimes of these three major economic powers and the possibility that the conflict between them will intensify could come to present a particularly difficult challenge. Irish solicitors will be at the forefront of negotiating the delicate path through these conflicting and powerful interests on behalf of their clients.

Brian McMahon is a solicitor and Head of Contentious Matters in An Post. This article is written in a personal capacity.

Assisted Dying –

A debate spanning centuries, with no end in sight

"It is wrong to force a person to live in circumstances of unendurable and irremediable suffering and …the wishes of capable patients should be respected within legal limits, especially in such an intimate matter as how they choose to die. Persons, in other words, have a right to life, not a duty to live…"

Zlotnik Shaul et al (2018)

Coming from the Greek words meaning "good" and "death" (happy death) euthanasia has come to mean the deliberate and intended painless acceleration of a person's death, in a willed termination of human life. Indeed, Donnelly believes that the way we die is a fundamental part of our life story, even if, most of the time we prefer not to think too much about it.

THE ASSISTED DYING DEBATE

The debate surrounding assisted dying (euthanasia) has existed for more than three thousand years and dates back to early Greek and Roman times. With Samuel Williams first proposing the use of anaesthetics and morphine to intentionally end a patient's life as early as 1870. Moreover, while the dilemma posed by assisted dying continues to divide proponents and opponents of the right to die and is debated not only in medical, legal, philosophical and theological literature but also across society, the debate has intensified over the past five decades.

The assisted dying debate centres on the clash of two core values, the right to respect for individual autonomy and respect for life. Particularly when bearing in mind that ending the life of another or allowing another person to die and depriving that person of their life is a crime in many societies.

While opponents of assisted dying argue that vulnerable members of society do not have the capacity to choose assisted dying and that at its core assisted dying is a violation of the inalienable right to life that we all have. Proponents will argue that we should all have the right to die in the most humane and dignified way possible as in an advanced and developed society assisted dying is a civilised option and people should be given the choice between life and death if a well-established system of checks and balances are in place.

However, what proponents and opponents of euthanasia generally agree on is the importance of making every possible effort to offer patients the best attainable quality of life, including the best possible quality for the end of their lives when they consider their lives unbearable.

Because of debate at both national and international level and the call for recognition of the right to die as a human right, many countries have now started the conversation about assisted dying. Moreover, it is because of these conversations that assisted dying is now legal in a number of countries.

DEFINING ASSISTED DYING

Many varying definitions exist on the meaning of the terms assisted dying, assisted suicide, physician assisted suicide and euthanasia. The term assisted dying being used in circumstances where terminally ill patients (with capacity) make the decision to die and takes the medication themselves; it is also often used as an umbrella term.

Whereas assisted suicide is, where a person makes the decision to die (by completing suicide) and assistance is provided by a third party, which may be a physician (i.e. physician-assisted suicide).

While euthanasia is in the norm the intentional ending of one person's life by another (for example, where a physician administers the medication to the patient) motivated solely by the best interest of the patient, and excludes non-voluntary death (for example, a neonate or a coma patient who are not actively involved in the decision making process).

The debate regarding assisted dying also includes, active and passive assisted dying, voluntary, involuntary and non-voluntary assisted dying and the difference between euthanasia and physician assisted suicide.

Active v. passive assisted dying

Assisted dying can either be an intentional positive act that results in the death of the patient, referred to as 'active' or where measures which could prolong the life of the patient (for example, the use of a ventilator) are no longer employed, which is referred to as 'passive', and also known as antidysthanasia (Hayes Brown and Truitt, 1976).

When referring to an intentional positive act ('active') resulting in the death of the patient, assisted dying, assisted suicide and euthanasia are often used interchangeably, albeit each has in fact a different meaning with a clear distinction outlined in the Euthanasia Report of the Social, Health and Family Affairs Committee of the Council of Europe, 2003.

In cases of an intentional positive act ('active euthanasia), a third party undertakes a lethal action to help someone die. This could be by administering an injection with a lethal medicine or the provision of a prescription for a fatal dose of a lethal medication.

Whereas, when the act is seen as passive this implies that 'nothing' is done, for example, this would be in a situation where treatment of the patient ceases, where for example, artificial respiration of the patient is terminated. While passive assisted dying is often more readily acceptable, as people find it harder to accept or comprehend a lethal injection ending someone's life rather than the stopping of a ventilator, it is difficult to label death by this means as absolutely 'passive', as an action must still be undertaken in order to hasten the death of the patient for example, turning off the ventilator. This has resulted in passive assisted dying being a contested concept, particularly in relation to intent (Brassington 2020), as there is significant disagreement that the withdrawal of life sustaining treatment in an end-of-life scenario in any way equates to deliberate killing, either by direct or indirect participation.

From an ethical perspective, however, there is no difference between active and passive assisted dying (Hopkins, 1997), as in both instances, the objective is for the patient to die in the most humane way. Therefore, while the intention is the same, the only difference is the approach adopted, which is often based on the patient's medical condition.

Voluntary, involuntary and non-voluntary assisted dying
Another distinction that arises is the difference between voluntary, involuntary and non-voluntary assisted dying.

Voluntary assisted dying is where the person has explicitly asked to die. Whereas, non-voluntary assisted dying is when the explicit consent of the individual concerned is unavailable, for example, a coma patient. While involuntary assisted dying is where assisted dying is carried out against the will of the patient.

Euthanasia v. physician-assisted suicide
Euthanasia in the strict sense refers to the situation where a third party carries out a positive lethal action which results in the death of their patient, for example, an injection with lethal medication.

Physician-assisted suicide, however, is where suicide by a patient is facilitated by a physician who is aware of their patient's intention to complete suicide, such as a drug prescription for a lethal dosage.

It is worth noting that the European Court on Human Rights have not to-date differentiated between euthanasia and physician-assisted suicide in their decisions (Koch v. Germany, 497/09 and Pretty v. UK, 2346/02).

The variances in what is permissible are best evidenced in the laws introduced across a number of countries that have legalised assisted dying.

THE CURRENT POSITION FOR ADULTS

Assisted dying for adults is legal in an ever growing number of countries, including the Netherlands, Spain, Belgium, Luxembourg, Germany Switzerland, Colombia, Canada, and the US states of Washington, Oregon, Colorado, Hawaii, Vermont, Montana, Washington DC, New Jersey and California and the Australian state of Victoria.

The Netherlands became the first country in the world to legalise euthanasia and assisted suicide in April 2001 with the 'Law for the Termination of Life on Request and Assisted Suicide, 2002' that came into effect in April 2002.

Shortly afterwards Belgium legalised euthanasia for terminally ill adults (citizens over eighteen years of age or in rare instances a category of individual called "emancipated minors") in 2002.

While Luxembourg became the third European country to decriminalise assisted dying (subject to appropriate medical approval) in March 2009 when parliament passed Mémorial A n 46 de 2009 – Legilux.

In May 2014, the Federal Constitutional Court in Germany legalised passive euthanasia by means of the withdrawal of life support to patients who request euthanasia. However, in November 2015, the German Parliament passed a bill criminalising assisted suicide if done in a business-like manner, but in February 2020, Germany's highest court overturned the ban on medically assisted suicide, allowing terminally and gravely ill patients to seek assistance in ending their lives without leaving Germany.

Under Article 115 of the Swiss Penal Code (effective since 1942) life ending drugs may be prescribed to recipients who can themselves take an active role in the drug administration and considers assisting suicide a crime only if the motive of the person assisting the suicide is for what are deemed selfish reasons.

Euthanasia and assisted suicide is currently illegal in Ireland. In October 2020, the Dáil voted to pass the "Dying with Dignity Bill 2020". The proposed legislation would permit physician assisted suicide in limited circumstances, allowing some terminally ill patients to choose end their own lives. Currently the practice or act of euthanasia, insofar as it involves assisted suicide, is illegal in Ireland and it is an offence, under section 2(2) of the Criminal Law (Suicide) Act 1993, to assist another person in completing suicide.

CONCLUSION

Addressing the technicalities of assisted dying alone requires significant agreement in terms of the distinction between for example, assisted suicide, physician-assisted suicide and euthanasia, not to mention concerns regarding active, involuntary and non-voluntary assisted dying. Let alone concerns regarding capacity and the right to respect for autonomy.

While there appears to be little doubt that assisted dying would allow relevant patients to take control over the timing and manner of their death, the implications for patients, physicians and society appear set to remain the cause of much debate for the foreseeable future.

Karen Sutton, M.A.HE, LL.M, MSc.HEL

While an extensive review of assisted dying and related matters is beyond the confines of this article, the aim is to provide the reader with an introductory overview of the debate surrounding assisted dying.

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Donovan, C.B.,STL (Licentiate of Sacred Theology) (March 2019). 'End of Life Decisions: Ordinary versus Extraordinary Means'. Available at https://www.ewtn.com/catholicism/library/end-of-life-decisions-ordinary-versus-extraordinary-means-12733.

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Succession Law – Some Eu And Irish Aspects

It is not uncommon for individuals residing in one member state of the EU to hold assets in another member state or other member states. In such a case the question of succession law will inevitably arise as each state will have its own such law.

For each member state in which an individual holds an asset he or she may have to deal with a different succession regime. A stark example of this is the fact that in France the assets of a deceased pass directly to the relevant beneficiary or beneficiaries without the involvement of any intermediary. In Ireland, on the other hand, the assets first pass to the deceased's executor/executrix or administrator/administratrix.

To address the potential difficulties posed by a multitude of different nation rules on succession the EU introduced a Regulation in 2012 entitled the EU Succession Regulation (650/2012) which took effect on the 17th August 2015.

The Regulation allowed Ireland, the UK and Denmark not to adopt it but permitted all or any of them to do so in the future. (This now only applies to Ireland and Denmark as the UK has left the EU)

One of the apparent reasons for Ireland not adopting the Regulation was the concept of enforced Inheritance which is applicable in EU member states such as Germany and France. This means that, irrespective of the wishes of the deceased, his or her estate will be distributed in a particular way. Another reason is that in France, for example, beneficiaries must account for the assets and liabilities of the deceased not only at the time of death but also during his or her lifetime. This is in contrast to an Irish legal personal representative's obligation (generally speaking) to account the assets of the deceased at the time of death.

Among the stated purposes of the Regulation are to endeavour to ensure:

1. A succession is treated coherently under a single law and by one single authority

2. Citizens are entitled to choose whether the law applicable to their succession should be that of their habitual residence or that of their nationality, with parallel proceedings and conflicting decisions being avoided for participating EU Member States and

3. Mutual recognition of decisions relating to succession within the European Union.

There are a number of exceptions to the applicability of the Regulation. For example, a member state which is composed of a number of parts each of which has its own succession law is not obliged to apply the Regulation to conflict of laws. From a practical point of view and more likely to be far more relevant to individuals wishing to plan for the future of their estates is the fact that the Regulation does not apply to transfers of property other than on death. Consequently, gifts fall outside its scope as do forms of ownership which result in title passing to the surviving owner(s) on the death of one of them

As a general rule, the Regulation provides that the law applicable to a particular individual's succession shall be his or her "habitual place of residence" at the time of death. However, such an individual may choose the law of the member state of which he or she is a national either at the time of making the choice or at the time of death . If a person holds multiple nationalities, he or she may select the law of any of the states of which he or she is a national at the time of choice or at death.

A person's habitual place of residence determines the member state whose courts shall have jurisdiction. If, however, a person chooses the law of a (member) state of which he or she is a national to govern his or her succession, the parties may agree to the laws of such state being applied.

Going back to the objectives of the Regulation referred to above, it is quite obvious that some means of determining the "single law" and "single authority" under which a succession is to be treated must be established. This has been achieved by what is known as "The European Succession Certificate" and created by the Regulation. This is a certificate issued by the competent authority of a member state and which sets out, inter alia, the name of the issuing authority, the elements on the basis of which the issuing authority considers itself competent to issue the Certificate and the date of issue. The Certificate also provides other information such as details of the applicant (for the Certificate), details of the deceased and details of each beneficiary. All such information is mandatory under the provisions of the Regulation as is the format of the Certificate.

A Certificate issued by an authority in one member state is recognised by all other (adopting) member states and is deemed to be accurate as to its contents . As a rule it is valid for six months from the date of issue.

It may be useful at this stage to give some more consideration as to how the Regulation would or could affect the succession, for example, of a French national or a person whose habitual place of residence is France and who owns a property in Ireland. Were the Regulation adopted by Ireland, the applicable succession law would, in such a case, be that of France thereby over-riding Irish inheritance rules.

French inheritance law, unlike that of Ireland, is heavily weighed in favour of the children of the deceased whereas the Succession Act 1965, both in the case of testacy and of intestacy, favours a surviving spouse (or civil partner). For example, the surviving spouse (or civil partner) of a deceased testator is entitled to a one half share of the deceased's estate if there are no children and a one third share if there are. Under French law. In France children of a deceased are entitled to a fixed share of the estate to be divided equally between them. Irish law does not have any similar provision in the case of a testacy. If a deceased dies intestate leaving a spouse/civil partner and no children the spouse/civil partner inherits the entire estate; if there are children, the spouse/civil partner takes two thirds and the child or children the remaining one third.

As Ireland did not adopt the Regulation, the provisions of the Succession Act apply. This would of course change in the event of adoption of the Regulation.

Another scenario which might be considered is one where an Irish national owns a property in a member state of the EU which has adopted the Regulation. Such a person may wish to have Irish law govern the entirety of his succession irrespective of the location of his or her assets and provide for family members in a way which is inconsistent with the laws of the member state in question. He or she can, of course, make a gift of the property to the individual(s) he or she wishes to acquire it or create the equivalent of a joint tenancy in the property.

It is also possible to make an Irish will in which the testator or testatrix stipulates that he or she wishes Irish law to govern the entirety of the succession. This will necessitate, if it has not already been done, the making of a will in the member state where the property is located prior to the making of the Irish will.

The Irish will ought to provide that it applies to all property of the testator or testatrix except that located in the member state where the property is located and set out the reason(s) why he or she considers it appropriate that Irish law should apply to the entirety of his succession.

I have deliberately refrained from advising on or suggesting the wording which should be used in the Irish will but hope that this article will be of some use and has given readers an idea of the issues and complexities which arise when advising clients on estate and succession planning when they have assets located in other EU Member States.

George McGrath, Solicitor

Gender-based violence in the Irish Courts system – an overview

By Sarah Cleary

The United Nations defines gender-based violence as any of violence against women and girls based on their gender. An act which is likely to result in physical, sexual or mental harm to women including threats of such acts, coercion or arbitrary deprivation of liberty occurring both in public and/or private life. Current worldwide statistics tell us that one in every three women will be physically, sexually or otherwise abused in her lifetime. Let's look within the Irish courts and see what approach is taken.

It is difficult to fully gauge how effective the justice system really is when it comes to gender-based violence as much of this violence goes unreported. Typically, the criminal law system is designed to deal with offences that are described as once-off incidents. The fact with gender-based violence is that many situations are not 'once-off'. The violence is repetitive. More then twenty years ago, Susan Edwards wrote;

> *"Domestic violence until the 1970s was regarded as a rare phenomenon. Criminal law was rarely, if ever, invoked to prosecute aggressors… A far wider range of remedies is now available. But stereotypical attitudes and expectations of women and men persist, these inform the law and militate against the justice and protection victims receive. The law, whilst it makes claims to offer remedies and protection to victims, is replete with obstacles and difficulties for the applicant or complainant seeking safety and protection."*

Unfortunately, these words appear to be still true today as recent statistics have shown that the number of Domestic Violence Applications and Court Order breaches have significantly increased, especially in light of the current health pandemic.

Statistics from the Courts Services Annual Report 2020 tell us that applications in the District Court increased by 12% in 2020.

The Oireachtas reports that from the beginning of 2021 until the 9 September 2021, 24,686 incidents of domestic abuse were reported to an Garda Síochána.

The annual An Garda Síochána report tells us that Gardaí received approximately 43,500 calls to respond to domestic abuse incidents.

The Domestic Violence Act 2018 was landmark legislation which came into law on the 1 January 2019. This legislation brought many progressive changes and options available to victims suffering from domestic abuse in every context.

Firstly, this legislation brought about an extension of those who can apply for Safety and Protection Orders. It has been extended to those who are, or who have been, in an intimate relationship.

The 2018 legislation introduced Emergency Barring Order's. This is a new relief which gives protection to a person who cannot satisfy the 'property' test. This Order allows an applicant time to find alternative accommodation when they may need financial assistance.

The most progressive aspect of this Act is that, Coercive Control is now a criminal offence. Coercive Control is defined as consistent behaviour which is controlling or coercive. In November 2020 at a Dublin Criminal Circuit Court sitting, the first conviction by a jury for the offence of Coercive Control was given. This lady was highly commended for her bravery and courage.

Women's aid is a leading national organisation that has been working in Ireland to stop domestic violence against women and children since 1974.

Another interesting addition that is somewhat related to the 2018 Act is the introduction of a new statutory definition of 'consent' to help in the prosecution of rape cases.

Women's Aid statistics from 2020 tell us that there were;

- 29,717 contacts with Women's Aid
- 26,400 contacts to the Women's Aid 24hr National Freephone Helpline
- 290,856 visits to the Women's Aid website
- 30,841 disclosures of abuse (24,894 against women & 5,948 against children)

Women's aid run a successful Court Accompaniment service which provides support for women availing of legal options or involved in a criminal trial. Applicants and/or victims are attend alongside a keyworker for support and to clarify any legal terminology. This offers support to women that may be very well needed.

Under plans recently brought to the Cabinet, a new statutory agency is set to be established to oversee the State's response to domestic, sexual and gender-based violence in by the Minister for Justice, Ms Helen McEntee. This follows the completion of a report by Tusla into the provision of accommodation for victims of domestic violence and the lack of refugee spaces for the needs of the population.

Any changes within the justice system have been hard won by brave women who have spoken out about their experiences and situations as victims and survivors. Only in recent years we have seen the first sexual assault victim wave her anonymity and tell her story.

This individuals name is Lavinia Kerwick and she told her story in 1993. She told Gerry Ryan on RTÉ 2FM how the man who violently assaulted her when she was 19 walked free. She campaigned for the introduction of victim impact statements but during her campaign she says that she was always made to feel like she was "doing the wrong thing". She urged others who had been sexually assaulted to come forward and seek justice.

Without any doubt, gender-based violence remains an issue fraught with difficulty, fear and suffering. With the recent horrific events of young women being brutally murdered, these developments are simply not sufficient and urgent reform is needed.

Sarah Cleary AIILEX

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Recipients of the Frank Crummey Cup

Linda Leahy for Best Academic Achievement in the 2020 Diploma in Legal Studies at Griffith College

Alisha Larkin for Best Academic Achievement in the 2021 Diploma in Legal Studies at Griffith College

Taxation of Polish and Irish Pensions by the Polish Revenue Administration

At some point in time many Polish nationals living and working in Ireland will be eligible to apply for an Irish State Pension. An Irish State pension can be either Contributory or Non-contributory *(Emerytura Składkowa lub Nieskładkowa).* As a citizen of the European Union, a Polish national may have accumulated rights to apply for more than one pension due to his/her work in more than one European State.[1] This article outlines the issues of the limbo period caused by the difference between the retirement age in Ireland and Poland, and the issue of taxation of both pensions.

Before proceeding, the age of retirement in each country needs to be outlined. In Poland the earliest retirement age as of 2020 is 65 years for men and 60 years for women. This age bracket is applicable to any applicant born after the 31st December 1948.[2] The current retirement age for men and women in Ireland is 66 (the proposed new retirement age in Ireland of 67 (2021) was deferred by the State, probably delaying the proposed age of 68 which was previously set for 2028).[3] Such a difference in retirement age becomes an issue when a Polish national wishes to retire while still working and residing in Ireland. For the purpose of this article let us use the current retirement age of 66 for men in Ireland, and the retirement age for men in Poland, 65. An applicant should keep in mind that the law in Poland may change, and there might be no need to work an extra year (or more) in Ireland to claim two pensions.

In Poland, when an applicant turns 60 (women) or 65 (men) years of age, the Social Insurance Institution *(Zakład Ubezpieczeń Społecznych)*, commonly known as ZUS, deems an applicant eligible for a Polish pension. However, if an applicant is working in Ireland, the following issues arise:

(a) An applicant is unable to retire in Ireland as s/he will not qualify for an Irish pension due to not reaching the required age.

(b) Taxation of the Irish income (while claiming a Polish pension).

In light of the above-mentioned issues, an applicant faces the dilemma between being fully retired in Poland but ending up in limbo for a period of 12 months in Ireland – in short, eligible to retire in Poland but not eligible to retire in Ireland. In this situation the best option is to apply for a pension in Poland and when one is approved (for the years worked in Poland only), it should be put on hold and remain unclaimed for a period of 12 months (to allow an applicant to reach the age of 66). Such an arrangement is currently possible to reach with ZUS *(Zakład Ubezpieczeń Społecznych).* Then, three months before his/her 66th birthday, an applicant should make an application for the Irish State Pension.[4] Unfortunately, at the moment, the limbo period for women is five years according to the 2020 law. An application for an Irish pension must include details of the applicant's past employment in Poland. This will require the applicant to have his/her documents in order prior to making an application (e.g., translated Birth Certificate plus the original; translated Marriage Certificate plus the original; translated and original Certificates of Employment *(Świadectwa Pracy)* from Poland, etc.). It must be noted here that the Irish authorities will contact the Polish authorities before approving the Irish pension. This exchange of information is governed by international agreements. An applicant will receive a letter to his/her address in Ireland from both Polish and Irish authorities. If everything goes well, an applicant will – in many cases – receive two pensions: a pension for his/her work in Poland and a pension for his/her work in Ireland.

When an Irish pension is approved, along with the already approved Polish one, an applicant is left with a second obstacle, namely the dilemma of taxation. Poland and Ireland have a Double Taxation Treaty (DTT) *(Umowa o unikaniu podwójnego opodatkowania)* which is available in English [5] and Polish.[6] An applicant should be aware that the Polish authorities may offer 'assistance' to handle an applicant's Irish money regarding the transfer of the euro currency to the applicant's Polish bank account – this should be avoided at all costs. It is recommended to keep any Irish payments away from the Polish authorities. Preferably, the Irish pension should be sent to the Irish bank account and the Polish pension should be sent to the Polish bank account.

Tax residency: it is important to mention here that the Polish pension will be taxed.[7] The amounts may vary between, for example 15% and 18% or higher.[8] Practical problems regarding double taxation have been also addressed by the Polish Financial Ombudsman in 2012 *(Rzecznik Finansowy).*[9] Therefore, if a Polish national chooses to be taxed under the Polish tax system, s/he will be taxed on both pensions. This means that ZUS will convert the euro currency to Polish złoty and tax this amount – the tax will be substantial taking into consideration the average 1:4 exchange rate. However, the Irish tax system may be of some assistance here by way of using the DTT. The Revenue currently operates the following categories of tax residency in Ireland:

domicile, resident and ordinarily resident. An applicant's Irish citizenship, if acquired, may be beneficial if s/he plans to reside between Ireland and Poland.

At this stage, an applicant should seek professional advice on tax matters and calculations – for instance, would it be financially advantageous to pay all taxes in Ireland? It is important to remember that a basic Irish pension is not taxed in Ireland and only additional income would be taxable. Taking into consideration the average exchange rate of the Polish złoty to euro (4:1), the tax on the Polish pension in Ireland should be lower than the tax on the Irish pension in Poland. Therefore, using Article 4 (or any other relevant articles) of the Treaty, an applicant should communicate through the medium of writing to ZUS and/or to the relevant office of the National Revenue Administration in Poland *(Urząd Skarbowy)* that s/he is domiciled (or resident and ordinarily resident) in Ireland and is choosing to be fully tax compliant in Ireland by nominating Ireland as the primary place of residence. This means that an applicant will be taxed on his/her worldwide income (for the purpose of this article both pensions) by the Revenue only and not by the Polish Revenue Administration.

It is important that an applicant contacts his/her ZUS office in Poland prior to making an application for the Polish pension to discuss his/her situation.[10] Unfortunately, it is not possible to predict the exact details of taxation, rules/regulations, etc. applicable to Polish pensions. This is due to the uncertain political situation in Poland regarding quite frequent and rapid amendments of various laws. An applicant should also gather any necessary original documents (including certified translations) required by the Irish authorities in advance. Any person eligible to apply for an Irish pension should familiarise oneself with the application process well is advance. An applicant is also advised to ensure that s/he is eligible to be taxed in Ireland under the Revenue guidelines.[11] It is worth mentioning that the Irish tax system allows, for example, to be tax resident in Ireland while spending a minimum of 183 days per year in Ireland, and also to be tax resident in Ireland for a period of three years after leaving Ireland.[12] The Revenue also offers joint or separate spousal tax assessments for applicants.

In summary, if a Polish national accumulates 520 full-rate PRSI (Pay Related Social Insurance) contributions (10 years' contributions) in Ireland, then s/he would qualify for a minimum State pension. Various pension rates depend on additional contributions.[13] In addition to the Irish pension, s/he would be in receipt of a Polish pension (applicable for the purpose of this article). This person has a choice to elect either a Polish or an Irish tax residency. By electing the Irish one, s/he would financially benefit from taxation of both pensions in comparison with another person who elects a Polish tax residency where a different tax regime is applicable and both pensions would be taxable on a higher rate along with an unsympathetic currency exchange rate. Both factors significantly decrease the net value of both pensions. Also, it might be possible to retire in Ireland at the age of 65 if certain conditions are satisfied.[14] Potential applicants are advised to contact their local office of the Department of Social Protection (DSP). If one qualifies for retirement at that age, it might allow an applicant to also retire in Poland at the same time.

Finally, it is advised that any potential applicants familiarise themselves with the Treaty (in which various Articles may be applicable to different groups of people, circumstances, etc.), and residency requirements to maximise their financial benefits. It is paramount to remember that if a Polish national leaves Ireland, his/her tax residency would have to be re-declared, either in Poland or Ireland, after spending three years outside Ireland. In this situation, the applicant could return to Ireland (to continue his/her tax compliance) or become tax compliant in Poland. However, it is possible to enquire with the Revenue in Ireland regarding a possible option of being taxed in Ireland depending on the personal circumstances of that individual. It is advisable to consider different taxation options of two incomes in Ireland and/or Poland after the expiry of the three year-tax Irish residency while residing outside Ireland.

It is worth mentioning that a married person can accumulate higher tax credits and reduce their tax bill in Ireland, e.g.: personal tax credit and age tax credit (when reaching 65).[15] Personal tax credit for a married person is higher than one applicable to a single person but is subjected to the residency requirement. This tax interpretation was upheld by the High Court in *McConnellogue v. Fennessy.*[16] Before making any tax decisions, a knowledgeable tax advisor should be consulted with a view of discussing various options.

The information contained in this article is correct at the time of going to press and is subject to change.

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The role of IT in a modern-day legal practice

Photo by Sora Shimazaki: Source Pexel

Computing and **IT** is now an essential part of every profession and in many cases, has radically altered the client business relationship. It also offers new ways to solve old problems.

The legal profession has not been exempted from this change. With the new ground rules that IT has created, comes new responsibilities to ensure the IT in your legal practice works for and not against you.

In this article, I'll take you through the changes IT has brought to the legal profession and the impact they have had.

PAPER REDUCTION

Firstly, we have seen the opportunities it has presented in potentially reducing the amount of paper used in a practice. Let us take the example of electronic case management. Gone in most cases are files and folders.

In their place, we have searchable databases of case content allowing a legal executive to track cases by date or by name and subject.

Also, by typing in the name of an executive, you can see which case belongs to which lawyer. Thus allowing you to communicate case progress to a client or to the solicitor in charge.

Photo by Porapak Apichodilok: Source Pexel

LOCATION IS NO LONGER AN IMPEDIMENT

Information technology now means that your location is no longer an impediment when it comes to doing business.

An executive can log in from anywhere to access their work and collaborate with other team members.

Outside the practice, it is now possible to file documents with courts electronically and have them reviewed relatively quickly.

Also, if a mistake is made to a file, then an edit can be made instantaneously and the document refiled. This was in contrast to the older ways of working where you would have to wait for the document to come back in the post from the court before it could be resubmitted again.

IT infrastructure has also allowed practices to expand their business. Legal firms are no longer limited by geography within a specific county or country. Because of the Internet, all a potential customer has to do is search using specific legal keywords to locate a legal firm that offers them the services they are searching for.

To get in front of these searchers many legal firms often use Google Ads to achieve top billing on Google's search pages or SERP's.

thedesignpool.ie offers Google Ads as a service to legal companies. Call us on 01 230 3645 or email me at *pat@thehostingpool.com*. We specialise in creating, hosting, and promoting websites for solicitors and legal practices.

WEBSITES - THE IMPORTANCE OF YOUR ONLINE PRESENCE

The communication between clients and legal firms has improved greatly with the widespread adoption of **websites** and **email**. Clients now expect an instant response to queries. The speed at which you respond could be one of the metrics potential clients will judge your customer service by.

Websites have also taken away some of the confusion as to what a company is about, who the staff are, and what are their legal specialisms.

Is a potential customer looking for a lawyer that is well-versed in company law, family law, or conveyancing? The great thing about a website is you can list all your services clearly for all to see.

This type of clear communication and layout can help build trust between your firm and the potential customer.

In many cases, your company website will be the first point of contact with potential customers. Thus, it needs to be easy to navigate providing all the information the user requires.

Remember, attention spans online are notoriously short and you do not want a potential client clicking away from your website if they can find something more quickly elsewhere.

When developing a new website you will also want to ensure your website is quick loading. Web searchers will not hang around. You should also note that Google classifies speed as one of its key metrics when it comes to Search Engine Optimisation (SEO).

SEO essentially means preparing your website so that it meets a set of best practice criteria laid out by Google.
Getting SEO right, along with a well-optimised Google Ads campaign, gives your website the best possible chance of being seen first on Google.

BASIC RULES OF WEBSITE DESIGN
If you want your **website** to provide an enjoyable user experience for your visitors then you should ensure everything is easy to find.

Work on the principle of no more than 2 clicks to access all your important information. For example, your phone number should be clearly visible in either the footer or header of your website.

Your firm's name, address, and phone number should be in the footer as well as on your contact page.

Your contact page should also contain a contact form to allow the visitor to type a more detailed enquiry and send it to you. Finally, on this page, you should have a map of your location thus providing the website with greater authenticity but also allowing your location to be picked up by Google maps. This will also make it easier for visitors to view your details on their mobile phones.

You should also have some form of analytics tracking software on your website. This will allow you to check what is and isn't working with your online marketing efforts. For example, which of your web pages receive the most traffic, which are the least popular, how long users stay on the website, and so on.

Source pixabay

DATA AND CYBERSECURITY BEST PRACTICE FOR A LEGAL COMPANY.
The legal **data** firms now possess is the actual lifeblood of their business. If the data is compromised it will cause damage to be done to the reputation of the firm as well as compromise the personal information of their clients

Data security should be a selling point of your legal practice, a way to provide the practice with a competitive advantage over the competition.

In terms of security, the following procedures should be the bare minimum that your firm has implemented.

- Keep all your software up to date by accepting patches from the **know** suppliers of your antivirus software.
- Also, if you are running a WordPress website you should ensure that all the plugins which are the tiny pieces of software that run in the backend of the site are updated. This is a service thedesignpool.ie offer to all our clients.
- Ensure there is a firewall protecting your Internet connection as a double sense of security.
- Make sure every electronic device in the company is protected by antivirus software.
- Encrypt all mobile devices and install a system that can wipe data from them if they become compromised.
- Do not forget to back up your information on a regular basis.
- Ensure there is one person only who is in control of the admin accounts for the systems. You do not want passwords to be circulating amongst too many people increasing the chances of passwords being compromised.

Putting procedures in place is one thing but what you should really do is trial a scenario that mimics a real attack to assess how robust your systems really are.

- For example, make sure the staff knows how to follow all procedures in the event of a cyber attack.
- Create secure passwords for networks that follow best practices. For example, ensure the passwords are of a good length and contain a mix of numbers, special characters, and different casing.
- Understand and recognise common IT scams such as phishing attacks.
- Have procedures in place where staff who work away from the office can connect securely using VPNs to prevent data from being intercepted.
- Ensure staff do not open email attachments without knowing where they come from.
- Do not allow data sticks or personal devices to be connected to your company network.
- Exclude unsafe apps from being downloaded and shared on your network.

My name is Pat Hughes and I am a Digital Marketing/IT Specialist at a web agency called the thedesignpool and our sister company thehostingpool.

We specialise in creating, hosting, and promoting websites for solicitors and legal practices.

I hope you have found this article useful. If you would like further information or help to create and promote and secure your company website, then please call us on:

01 230 3645

or email me at

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Revocation in Trademark Law and the concept of "Use it or Lose it"

A commercial undertaking who owns a registered trademark (®) or owns a portfolio of registered trademarks on official registers in individual countries administrating and regulating such trademarks (for example an IPOI registration in Ireland) or if the commercial undertaking owns international registrations administered by the World Intellectual Property Office / Madrid Protocol system (administered by WIPO in Geneva, Switzerland) or owns a European Union Trademark registration ("EUTM"), the commercial undertaking enjoys monopoly property rights relating to the commercial use and exploitation of such trademarks.

An owner of an earlier registered trademark, or indeed any person, may consider, pursuant to Section 51 (1) of the Trademarks Act, 1996 ("TMA 1996"), an application known as revocation to either the Controller of the Intellectual Property Office of Ireland ("IPOI") or to the Court, to seek a declaration or an Order, to revoke the trademark registration.

Readers should be aware the TMA 1996 has on several occasions been up-dated since it was first enacted on 16 March 1996. Readers should note that the amending laws are not officially consolidated into a single document.

Readers should refer, in addition to the TMA 1996, to the Copyright and Other Intellectual Property Law Provisions Act, 2019 and to statutory instrument – SI 561 / 2018 European Union (Trademarks) Regulations 2018.

Readers need to be aware of EU law when it comes to trademark law issues and concerning the issue of "revocation" should refer to Article 58 (1) of Regulation (EU) 2017 / 1001 of the European Parliament and of the Council on the European Union trademark, applicable since 14 June 2017 ("EUTMR").

When it comes to the issue of revocation and the non-use topic, readers should be aware of Article 17 of the EU revised Trademark Directive 2015 / 2436 and to the EUTMR.

For example, arising from Article 17 of the EU revised Trademark Directive 2015 / 2436 and the EUTMR, sections 16A (1) to (4) were inserted into the original section 16 of TMA 1996 ("Exhaustion of rights conferred by registered trademark") and sections 18A (1) & (2) were inserted into the original section 18 TMA 1996 ("Action for Infringement").

EUTMR has identical legislative provisions to the Trademarks Act, 1996, specifically Chapter II, Section 3 at Article 18 which deals with *"use of an EU Trademark"* and in terms of contentious disputes at Chapter VI Section 2 at Article 58 *"Grounds for revocation of EU Trademark".*

The purpose of this article is to explain what revocation is and to provide a summary of the relevant Court case law. Readers should note that revocation applications may arise as a counterclaim to invalidity proceedings or to infringement proceedings.

To understand "revocation" readers should understand that "use of a trademark" is very important as well as understand the "classification of goods and services" (see Section 39 (1) of the Trademarks Act, 1996).

NICE CLASSIFICATION
("CLASSIFICATION OF GOODS AND SERVICES")

When an applicant trademark owner applies to register their trademark as a registered trademark, they must identify the NICE classification of goods or services, to which the application will apply. The NICE Agreement concluded during 1957 at Nice, France and its subsequent editions establish an international classification system for the purposes of registering trademarks and service marks. 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.

The NICE classification system is important when it comes to the revocation issue.

Section 51 (5) of TMA 1996 states *"where grounds for revocation exist in respect of only some of the goods or services for which the trademark is registered, revocation shall relate to those goods or services only".*

Case law illustrates that when revocation occurs, depending on the circumstances of a particular case, revocation is partial and may not apply to the full NICE specification within the registration.

Relevant extracts from the official version of the Trademarks Act, 1996 (Number 6 of 1996) and Trademarks Act, 1996 (as amended), the unofficial consolidated version are set out below:

Section 51 (1) of TMA 1996 (Revocation of Registration) reads:

"The registration of a trademark may be revoked on any of the following grounds –

a) that, within the period of five years following the date of publication of the registration, the trademark has not been put to genuine use in the State, by or with the consent of the proprietor, in relation to the goods or services for which it is registered, and there are no proper reasons for non-use;

b) that such use has been suspended for an uninterrupted period of five years, and there are no proper reasons for non-use.

c) that, in consequence of acts or inactivity of the proprietor, it has become the common name in the trade for a product or service for which it is registered.

d) that, in consequence of the use made of it by or with the consent of the proprietor in the relation to the goods services for which it is registered, it is liable to mislead the public, particularly as the nature, quality or geographical origin of those goods or services".

Section 51 (2) of TMA 1996 reads:
"For the purposes of subsection (1), use of a trademark includes use in a form differing in elements, which do not alter the distinctive character of the mark, in the form in which it was registered, regardless of whether or not the trademark in the form as used is also registered in the name of the proprietor, and use in the State includes affixing the trademark to goods or to the packaging of the goods in the State solely for export purposes". (The original wording for this section of TMA 96 was amended by SI 561 of 2018 – European Union Trademark Regulations 2018).

In terms of Section 51 (2) of TMA 1996, an IPOI decision on 29 December 2021 by John Nolan, acting for the Controller in the matter of an application to revoke the "GLANDEX" trademark registration (IR No. 1045463) in the case of Vetnique Labs LLC (Applicant) and HASCO TM spólka ograniczona odpowiedzialnoscia spólka komandytowa (Proprietor), illustrates how this section applies.

Section 51 (3) of TMA 1996 reads:
"The registration of a trademark shall not be revoked on the ground mentioned in paragraph (a) or (b) of subsection (1) if such use as is referred to in that paragraph is commenced or resumed after the expiry of the five year period and before the application for revocation is made; but, for this purpose, any such commencement or resumption of use occurring after the expiry of the five year period and within the period of three months before the making of the application shall be disregarded unless preparations for the commencement or resumption began before the proprietor became aware that the application might be made".

Given the contents of the Section 51 (1) subsections (a) to (d) of TMA 1996, an application for revocation not only regulates "non-use of a Trademark" it also deals with cases wherein a trademark has become a generic word (see subsection (c)).

Essentially, section 51 (1) (c) of TMA 1996 legislates for a situation wherein a registered trademark because of its commercial success becomes a commonly used noun or adjective in everyday language. A proprietor of a very successful registered trademark must accept this issue as a downside to maintaining its trademark registration.

Readers may be aware the former Bayer AG registered trademark "ASPIRIN" was revoked on the basis it had become the common word used for over-the-counter pain medication tablets.

Other examples where this scenario occurred is the "ESCALATOR" trademark owned by the Otis lift company. In the Irish and UK markets the registered trademark "HOOVER" became indistinguishable with vacuum cleaning so much so that it earned an entry into the Oxford English Dictionary.

Readers are no doubt aware of expressions such as *"I will Google it"* or *"Google it"* for internet searches. So far, Alphabet Inc. (a Delaware – United States of America holding company which owns Google Inc.) is successful in defending Court cases claiming the word "Google" is a generic word. It appears that "GOOGLE" is similar to the other iconic trademark such as "COCA-COLA" in avoiding genericide.

Due to the rarity of "generic" contested cases and given Irish and EU case law mainly deals with disputes concerning "use versus non-use", this article in terms of case summaries considers the "use versus non-use" issue only.

IPOI and EUIPO adjudicators for the Irish or European Courts when considering "use versus non-use" cases must first determine if "use" of the registered trademark post five years of publication of the registration occurred.

Second if such "use" occurred, determine whether the use applies to all the goods and services the respondent / trademark owner's mark is registered for.

This is a reason why a careful wording selection is required for the NICE classification section when applying for a registered trademark.

If the answer to these two questions is affirmative, the Court or Intellectual Property office examiner must then test and establish if such "use" is "genuine use".

Regular readers of IPOI and Irish Court case law will appreciate that the wording from Section 51 (1) (a) of TMA 1996 *"…not been put to genuine use in the State."* is not defined by the Act.

EU and Irish Court case law decisions elucidate what is *"genuine use".*

Ansul BV v Ajax Brandeveilliging BV (Case No. C-40/01).
This is a case concerning a reference by the Supreme Court of the Netherlands to the European Court for a preliminary ruling under Article 234 EC to determine two questions on the interpretation of Article 12 (1) of the First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trademarks.

The European Court of Justice in its judgment cited the Community legislative background and in particular Article 10 (1) to (3) of the Directive (which the Trademarks Act, 1996 under Section 51 (1) has similar wording) namely:

"If, within a period of five years following the date of the completion of the registration procedure, the proprietor has not put the trademark to genuine use in the Member State in connection with the goods or services in respect of which it is registered…".

The dispute between the parties concerned the trademark "MINIMAX" for a fire protection product. Ansul BV ("Ansul") and Ajax Brandeveilliging BV ("Ajax") are both legal entities incorporated according to Netherlands law with both entities carrying on business in the fire protection product / service sector. Ajax was a subsidiary of a German company Minimax GmbH.

The Opinion of the Advocate General (delivered on 2 July 2002) indicates that the *"word mark "Minimax" and related rights were, until the Second World War, owned by a German company with a sales office in the Netherlands. Those assets were expropriated after the war as enemy property. The rights in the sign were thus split. In the Netherlands they were acquired by Ansul's predecessor and in Germany they passed to Minimax GmbH".*

The ECJ judgment on its interpretation of *"genuine use"* in the "Ansul" v "Ajax" case opined that: -

"…there is 'genuine use' of a trademark where the mark is used in accordance with its essential function, which is to guarantee the identity of the origin of the goods or services for which it is registered, in order to create or preserve an outlet for those goods or services; genuine use does not include token use for the sole purpose of preserving the rights conferred by the mark. When assessing whether use of the trademark is genuine, regard must be had to all the facts and circumstances relevant to establishing whether the commercial exploitation of the mark is real, particularly whether such use is viewed as warranted in the economic section concerned to maintain or create a share in the mark for the goods or services protected by the mark, the nature of those goods or services, the characteristics of the market and the scale and frequency of use of the mark".

The legal reasoning in this case and other similar EU cases such as La Mer Technology Inc v Laboratories Goemar SA (C-359/02) [2004] E.C.R 1-1159 and Sunrider v Office of Harmonisation in the Internal Market (C-416/04 P) [2006] E.C.R 1-4237 are regularly referenced by the IPOI examiners when deciding "use versus non-use" disputes.

Compagnie Gervais Danone v Glanbia Foods Society Limited [2010] IESC 36 – docket number – (S.C No. 141 of 2007).

This is a case concerning an appeal to the Supreme Court from a High Court judgment of Ms Justice Finlay Geoghegan S.C delivered on 20 April 2007. The Supreme Court judgment was delivered by Ms. Justice Fidelma Macken S.C.

Ms Justice Macken commenced her distinguished and impressive legal career as a Barrister at Law working as a legal advisor with Ireland's largest Patent & Trademark Agent practice and given her stint as Ireland's appointee on the European Court of Justice (ECJ), her delivery of the judgment in this case is seminal.

The Supreme Court judgment in this appeal is also important as Justice Macken, when a Judge of the ECJ, had presided in the influential *Ansul BV v Ajax Brandeveilliging BV* case.

The Plaintiff company in the High Court proceedings [2007] IEHC 126 - Compagnie Gervais Danone ("Danone") - was the owner of an Intellectual Property Office of Ireland registered trademark "ESSENSIS" in respect of a number of NICE classes to include class 29 (for milk, powder milk, milk products and in particular yogurts and yogurts to drink).

The Defendant company in the proceedings, Glanbia Foods Society Limited ("Glanbia"), launched in the Irish market a range of fermented milk products under the YOPLAIT registered trademark which bore a particular representation of the word "Essence".

The YOPLAIT registered trademark is owned by Yoplait Marques in France, wherein Glanbia manufacture and market the product in Ireland by way of a licence agreement (Licence No. 4474 previously held by Waterford Foods Ireland Limited, of which GLANBIA is a successor).

Danone in the High Court proceedings argued that the use made by Glanbia of the sign "Essence" in respect of its fermented milk products was an infringement of its "ESSENSIS" registered trademark.

Glanbia in its defence and counterclaim denied infringement of the trademark "ESSENSIS" and sought to attack Danone's registration by:

(i) seeking revocation pursuant to section 51 (1) (a) of TMA 96 on the grounds that, within the period of five years following the date of publication of its registration, "ESSENSIS" had not been put into genuine use in the State in relation to the goods for which it was registered; and

(ii) It seeks a declaration of invalidity pursuant to section 52 (1) of TMA 96 on the basis that "ESSENSIS" was registered in bad faith contrary to Section 8 (4) (b) of TMA 96 as Danone never had any *bona fide* intention of putting "ESSENSIS" to use in the State.

Clearly, if an attack by way of a revocation application/counterclaim is successful there is no necessity to examine an alleged infringement of the registered trademark.

The issue of bad faith in trademark law is a subject on its own and while it is outside the scope of this article, readers should be aware that a plea by a plaintiff of "bad faith" against a defendant is difficult to get over the line.

The plaintiff company ("Danone") registration of the "ESSENSIS" trademark was published on 12 July 2000. There was no real dispute between the parties concerning the actual use by Danone of its trademark. The core dispute between the parties was the classification of such use.

Danone, between 2000 to 2002, sold its yogurt products bearing the name "DANONE" in a representation which is a trademark together with the name "BIO ACTIVIA" in a representation which is also a registered trademark. On the front of its packaging underneath the words "DANONE" and "BIO ACTIVIA" were the words "with BIFIDUS ESSENSIS cultures" and after the word "ESSENSIS" was the well-known designation circle "r" symbol - ® to identify the words as registered trademarks.

The High Court in its judgment examined in detail the promotion and marketing materials used by Danone.

Danone's marketing manager when giving her evidence to the Court explained that Bifidus ESSENSIS was the brand name for its unique pro-biotic culture *Bifidobacterium animalis* DN173 010, which was identified by Danone food scientists for its benefits to digestive health. Danone's marketing manager indicated that Bifidus ESSENSIS was not found in any other yogurt and was unique to Danone. Danone marketing manager's evidence to the Court was that this culture was protected by Danone by means of registration of the trademark "ESSENSIS" which was then combined with the generic word "Bifidus" to create the brand name "Bifidus ESSENSIS".

The High Court having heard Danone's evidence made a number of findings of fact in relation to the use made by Danone of its trademark "ESSENSIS" namely:

1. *The trademark used by Danone by putting same on packaging, marketing and advertising materials for its yogurt sold successively under the brand names "BIO ACTIVA" or "ACTIVIA" but always in conjunction with the word "Bifidus" and always as the name of an ingredient of the yogurt, namely a pro-biotic culture.*

2. *The trademark ESSENSIS either on its own or in conjunction with Bifidus was never used to designate the yogurt. At all times it was used to designate an ingredient of the yogurt.*

3. *The pro-biotic culture called "Bifidus ESSENSIS" was unique to Danone.*

4. *The existence of the unique culture called Bifidus ESSENSIS and its claimed health benefits was part of the marketing and promotional strategy of Danone to distinguish the Bio Activia or Activia yogurt from its competitors.*

The Court further found that the goods for which ESSENSIS was registered did not include a culture. There was no dispute that NICE Classification – Class 1 allows registration of a trademark for *"cultures of micro-organisms other than for medical and veterinary use"*. The Court found yogurt as the only relevant good or product for which ESSENSIS was registered.

The High Court had to determine whether the use made by Danone of its "ESSENSIS" trademark was genuine use of the mark in relation to yogurt within the meaning of section 51(1) of TMA 1996. Counsel for Danone obviously argued there was genuine use and relied on a number of ECJ judgments.

Counsel for Glanbia argued that the only goods *"in relation to which"* there has been genuine use of the trademark within the meaning of Section 51 (1) of TMA 1996 is a pro-biotic culture and there was no such use in relation to yogurt.

The Court having examined case law and various EU judgments was not satisfied that the use made of the trademark ESSENSIS is use as a trademark in relation to yogurt. The Court found use was unequivocally confined to referring to an identified ingredient of the yogurt as distinct from the yogurt itself. The Court made an Order in accordance with an element of Glanbia's counterclaim that was

"An order pursuant to Section 51 (1) (a) of TMA 1996 for revocation of the Irish registered trademark no. 2111092, ESSENSIS".

Danone obtained a stay of the Order of the High Court and appealed to the Supreme Court.

Justice Macken, when delivering the judgment of the Supreme Court (*see www.courts.ie* at judgments section for a full written judgment of the case and in particular pages 8 /9) indicated that:

"*…the product to which the trademark ESSENSIS is physically applied is the yogurt product of the appellant sold under the primary mark DANONE, a house mark of the appellant, and / or ACTIVIA, a primary product trademark of the appellant. The mark is never used in respect of a culture product sold independently of the appellant's yogurt products. It is not entirely surprising that, in the absence of any intention to trade in cultures, there is no trademark registration in respect of cultures in Class 1 of the International Classification of Goods and Services adopted to the NICE classification. The trademark is used extensively, according to the findings of fact of the learned High Court Judge, in advertising and promotional materials, all in respect of the appellant's yogurt products and, as she found, to distinguish those goods from those of other manufacturers. From a trademark law point of view, I have found that since the trademark does not infringe the provisions of s.8 (1) (c) of the Act of 1996, or of the Directive, it had the capacity upon registration to fulfill its essential function."*

The Supreme Court found for the plaintiff / appellant ("Danone") and held that based on the trial Judge's findings of fact and on a correct interpretation of the ECJ decision in *Ansul BV v Ajax Brandeveilliging BV* (case no. C-40/01), Danone had made a genuine use of the ESSENSIS mark in relation to yogurt.

The Supreme Court held that:

- the trial Judge had placed an unduly restrictive interpretation on the Ansul principles; and

- the ESSENSIS mark had been used in accordance with its essential function that is to guarantee the identity of origin of the goods and services for which the mark was registered in order to create or preserve an outlet for those goods or services.

EUIPO Cancellation Division case no. 14 787 C (Revocation) – Supermac's (Holdings) Limited of Ballybrit Business Park, Galway, Ireland (Applicant) against McDonald's International Property Company Limited of Carpenter Street, Chicago, Illinois, United States of America (EUTM proprietor).

This case concerned an application by SUPERMACs (the successful and well known West of Ireland chain of fast food restaurants and motor way forecourt retailer) to the EUIPO Cancellation Division, pursuant to Article 58 (1) (a) EUTMR (European Union Trademark Regulation), to have McDONALDs European Union Trademark registration no. 10 392 835 "Mc" (WORD mark) revoked for the NICE classifications:

Class 29: Foods prepared from meat and poultry products (except for chicken nuggets), foods prepared from pork and fish products, preserved and cooked fruits and vegetables, eggs, cheese, milk, mil preparations, pickles.

Class 30: Biscuits, bread, cakes, cookies, chocolate, coffee, coffee substitutes, tea, mustard, oatmeal, pastries, sauces, seasonings, sugars, desserts.

Class 32: Non-alcoholic beverages, syrups and other preparations for making beverages.

Class 43: Restaurant services.

The EUIPO Cancellation Division highlighted that in revocation proceedings based on grounds of non-use, the burden of proof rests with the EUTM proprietor.

The applicant cannot be expected to prove a negative fact, namely that the disputed mark has not been used during a continuous period of five years. It is for the EUTM owner who must prove genuine use within the European Union, or provide proper reasons for non-use.

The proprietor in this case provided extensive evidence, including market research survey results from the Hungarian market to illustrate its use of the "Mc" trademark.

The Cancellation Division in its decision explained *"use as a trademark and use of the mark as registered"* and indicated that:

"nature of use requires, inter alia, that the contested EUTM is used as a trademark, that is, for identifying origin, thus making it possible for the relevant public to distinguish between goods and

services of different providers. Furthermore, 'nature of use' in the context of Rule 22 (3) Commission Regulation (EC) No. 2868/95 (in the version in force at the time of filing the application for revocation) requires evidence of use of the mark as registered, or of a variation thereof which, pursuant to Article 18 (1) (a) EUTMR, does not alter the distinctive character of the contested EUTM".

SUPERMACs criticised extensively McDONALDs evidence on the basis that it did not illustrate use of the EUTM as a trademark and that the use of the sign was in a form which altered its distinctive character in that it:

(i) the contested EUTM had not, nor had it ever been used a trademark to designate the goods and services of the proprietor. It was held as a defensive mark to prevent third parties from using trademarks encompassing the "Mc" term for the goods and services of the registration or for similar goods and services;

(ii) 'Mc' is a very common prefix for surnames through Ireland, the United Kingdom and elsewhere through the European Union. Use of the trademark "Mc" prefix with the additional words and elements which is the only evidence provided by the proprietor does not guarantee origin. There are a huge number of public houses, hotel, food items, beverages and restaurants which contain the prefix 'Mc' as part of a surname;

(iii) The mark as registered has a relative low degree of distinctiveness and the addition of elements has a serious effect in the distinctive character of the mark and

(iv) The proprietor does not and never has used 'Mc' in and of itself. The additions of the terms included are not separate and distinct from the combination with the 'Mc' element. It is not a 'Mc' chicken sandwich, it is a 'McChicken'® sandwich. It is not a 'Mc' Rib sandwich, it is a 'McRib'® sandwich. The 'Mc' element was never used separately…"

While McDONALDs contested the applicant's arguments in its evidence, the Cancellation Division agreed with the applicant in that there was no evidence of use of the contested EUTM alone, but only accompanied by further elements.

The Cancellation Division then had to determine whether the addition of these other verbal elements altered the distinctiveness of the contested EUTM or not.

Ultimately, the Cancellation Division held that the applicant's application for revocation was partially upheld allowing the proprietor's trademark to remain registered for the remaining goods, namely:

Class 29: Chicken nuggets.

Class 30: Edible sandwiches, meat sandwiches, pork sandwiches, fish sandwiches and chicken sandwiches.

EUIPO Cancellation Division case no. 14 788 C (Revocation) – Supermac's (Holdings) Limited of Ballybrit Business Park, Galway, Ireland (Applicant) against McDonald's International Property Company Limited of Carpenter Street, Chicago, Illinois, United States of America (EUTM proprietor).

This case concerns an application by SUPERMACs to the EUIPO Cancellation Division, pursuant to Article 58 (1) (a) EUTMR (European Union Trademark Regulation), to have McDONALDs European Union Trademark registration no. 62 638 for "BIG MAC" (a WORD mark) revoked on the grounds of non-use for NICE classifications set out below:

Class 29: Foods prepared from meat, pork, fish and poultry products, meat sandwiches, fish sandwiches, pork sandwiches, chicken sandwiches, preserved and cooked fruits and vegetables, eggs, cheese, milk, milk preparations, pickles, desserts.

Class 30: Edible sandwiches, meat sandwiches, pork sandwiches, fish sandwiches, chicken sandwiches, biscuits, bread, cakes, cookies, chocolate, coffee, coffee substitutes, tea, mustard, oatmeal, pastries, sauces, seasonings, sugar.

Class 42: Services rendered or associated with operating and franchising restaurants and other establishments or facilities engaged in providing food and drink prepared for consumption and for drive-through facilities; preparation of carry-out foods; the designing of such restaurants, establishments and facilities for others; construction planning and construction consulting for restaurants for others.

The EUTM for registration no. 62 638 for "BIG MAC" was first registered on 22 December 1998.

The Cancellation Division delivered its judgment on 11 January 2019 finding for the applicant with the result the EUTM proprietor's rights in respect of the EU trademark for "BIG MAC" are revoked in their entirety as from 11 April 2017.

The Cancellation Division delivered a relatively short judgment indicating that *in revocation proceedings based on the grounds of non-use, the burden of proof lies with the EUTM proprietor as the applicant cannot be expected to prove a negative fact, namely that the mark has not been used during a continuous period of five years.*

It is for the EUTM owner to prove genuine use within the European Union or provide proper reasons for non-use.

The writer's view of the judgment in this case is that despite the EUTM proprietor's long established promotion and as a result widely known mark "BIG MAC", the evidence submitted by McDonald's as proof of use was insufficient to satisfy the Cancellation Division.

McDonald's submitted evidence consisted of three Affidavits sworn by its executives, printouts of its own websites, examples of advertisements and packaging and a printout of its Wikipedia page.

Quoted extracts from the Cancellation Division are:

- *"Having examined the material listed above in its entirety, the Cancellation Division finds that the evidence is insufficient to establish genuine use of the trademark".*
- *"Although some of the evidence refers to the relevant time period (e.g., some of the brochures and printouts from websites) and to some of the Member States of the EU, and the EUTM is referred to in relation to at least some of the relevant goods (e.g., sandwiches), the EUTM proprietor fails to prove the extent of use of its mark".*

- *"It is noted that all of the remaining evidence (the affidavits have been already analysed above) originates from the EUTM proprietor itself…".*

- *"…although the submitted packaging materials and brochures depict the EUTM, there is no information provided about how these brochures, who they were offered to, and whether they have led to any potential or actual purchases. Moreover, there is no independent evidence submitted that could show many of the products for which the packaging was used (if that is the case) were actually offered for sale or sold".*

- *"The finding that genuine use has not been proven in the present case is not due to an excessively high standard of proof, but to the fact that the EUTM proprietor chose to restrict the evidence submitted."*

This Cancellation Division case is a lesson to EUTM proprietors when faced with revocation applications on the grounds of non-use, that they should as best they can, file independent evidence of "genuine use".

Interestingly, the EUTM proprietor in this case on 6 October 2017 filed a newer application for the WORD mark "BIG MAC" (registration no. 017305079) for NICE classes 29, 30 and 43, which was registered by the EUIPO on 11 April 2018, which application received no "Opposition" applications.

On 8 March 2019, the EUTM proprietor (McDonald's International Property Company Limited) filed an appeal to the EUIPO Board of Appeal ("BOA") against the Cancellation Division judgment (Case R 543/2019-4).

On 14 December 2022, the BOA partially overturned the decision of the Cancellation Division judgment and acknowledged that McDonald's International Property Company Limited evidenced genuine use of its "BIG MAC" mark for some of its original NICE classification and allowed the classification to be amended as follows:

Class 29: Foods prepared from meat and poultry products, meat sandwiches and chicken sandwiches.

Class 30: Edible sandwiches, meat sandwiches and chicken sandwiches.

Class 42: Services rendered or associated with operating restaurants and other establishments or facilities engaged in providing food and drink prepared for consumption and for drive-through facilities, preparation of carry-out foods.

While the BOA considered the appellant's initial evidence of "use / genuine use" at the Cancellation Division stage, it also considered the appellant's additional "genuine use" evidence (an additional 700 pages) to include, inter alia, market research consumer surveys, photographs of original packaging used in its "BIG MAC" products, various copies of cash till receipts and copies of advertisements.

This BOA decision is interesting for its conditions for accepting additional "late" evidence by an EUTM proprietor at the appeal stage. The BOA decision is also interesting in that it found the "BIG MAC" trademark was not only used to identify its product but also used to promote the appellant's overall business. The BOA also found a consumer cannot purchase the "BIG MAC" sandwich in any other fast food outlet than at a "McDONALD'S" retail outlet.

The applicant (Supermac's (Holding) Limited) on 9 February 2023 filed an appeal before the EU General Court (case T-58/23) against the BOA (Fourth Board) decision, so it appears there will be another opportunity to ascertain the fate of the EU registration for the "BIG MAC" trademark (000062638) and related suspended "Opposition" proceedings concerning the applicant's attempts to register EUTMs for its "SUPERMAC's" (WORD application no. 015442023) and SUPERMAC's red signature (figurative application no. 016583379) trademarks.

THE LEGAL EFFECT OF REVOCATION

In terms of Irish law, pursuant to section 51 (6) of TMA 96, "where the registered trademark is revoked to any extent, the rights of the proprietor shall be deemed to have ceased to that extent as from:

(a) The date of the application for revocation or

(b) If the Controller or the High Court, is satisfied that the grounds for revocation existed at an earlier date, that date."

In terms of EU law, article 62 (1) of EUTMR, to the extent that the rights of the proprietor have been revoked, the EUTMR will be deemed not to have the rights specified in the EUTMR as from the date of application for revocation.

CONCLUSION

Applicants should exercise care when submitting their NICE classification of goods and / or services wording when applying to register a trademark as a registered trademark (®).

Commercial use of a registered trademark (®) is very important. An owner's registered trademark (®) subsequent to five years from the date of publication of its registration may become liable to a revocation application, particularly if an owner initiates invalidity or infringement proceedings against a third party. A third party may attack the registered trademark owner's registration by way of a revocation action.

If a third party (applicant) is successful with its application, the registered trademark owner will lose its monopoly property rights to its mark either on a full NICE classification basis or on a partial NICE classification basis, remembering that the burden of proof of "use" and / or "genuine use" is for the registered trademark owner (respondent) to prove.

Author

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Rules of the Superior Courts

Sections 45 to 50 of the Courts and Courts Officers Act, 1995 and Statutory Instrument 391 of 1998 (known as SI 391 / 1998-Schedule of Witnesses, Expert Witnesses and Expert Reports) and a summary of relevant recent cases

The Superior Court Rules Committee in or around 19 December 1985 drafted the annexed Rules of Court. The Superior Court rules at that time, by way of Order 39, dealt with administrative matters relating to evidence issues, which order went up as far as rule 44. Order 39 at that time set out procedures for matters such as

(i) General issues

(ii) Examination of witnesses

(iii) Subpoenas

(iv) Perpetuating testimony

(v) Obtaining evidence for foreign tribunals

The Courts and Court Officers Act, 1995 at section 45 inserted *"Further powers of Superior Court Rules Committee and Circuit Court Rules Committee"* into the Superior Court rules known as rules 45 to 50 titled:

(vi) Disclosure of reports and statements.

Section 45 (1) defines "**action", "parties", "report"**

Relevant extracts to section 46 *"Disclosure of reports and statements"* which has 6 subsections are:

Section 46 (1) The Plaintiff in an action shall furnish to the other party or parties or their respective solicitors (as the case may be) a schedule listing all reports from expert witnesses intended to be called within one month of the service of the notice of trial in respect of the action or within such further time as may be agreed by the parties or permitted by the Court.

Within seven days of receipt of the plaintiff's schedule, the defendant of any other party or parties shall furnish to the plaintiff or any other party or parties a schedule listing all reports from expert witnesses intended to be called. Within seven days of the receipt of the schedule of the defendant or other party or parties shall exchange copies of the reports listed in the relevant schedule.

Section 46 (2) the parties in an action shall exchange with the other party or parties or their respective solicitors (as the case may be) the information and statements referred to in section 45 (1) (a) (iii), (iv) and (v) within one month of the service of the notice of trial or within such further time as may be agreed by the parties or permitted by the Court.

Section 46 (3) In any case where a party or his solicitor certifies in writing that no report exists which requires to be exchanged pursuant to sub-rule 1, any other party shall, on the expiry of the time fixed, agreed or permitted (as the case may be) deliver any report within the meaning of the section to all other parties to the proceedings.

Section 47 deals with motions for directions, section 48 deals with non-compliance with the rules, section 49 deals with actions transferred from the Circuit Court and section 50 deals with exceptions.

Section 51 states "*Rules 45 to 50 inclusive shall not apply to proceedings instituted before 1st day of September 1997 or to any report or statement coming into existence before that date for the purposes of any proceedings (whether instituted before or after that date)."*

On 14 October 1998, the Minister for Justice, Equality and Law Reform (at the time Mr. John O'Donoghue TD, who is a former practising Solicitor), concurred with the Superior Courts Rules Committee, in the making of Statutory Instrument No. 391 / 1998 – Rules of the Superior Courts (No. 6) (Disclosure of Reports and Statements), 1998 ("SI 391/1998 Schedule").

Essentially, the SI 391/1998 Schedule replicates the wording from the Courts and Court Officers Act, 1995, section 46 and its subsections.

The rules were deemed to have come into operation on 1 September 1997 and replaced Rules of the Superior Courts (No. 7) 1997 (S.I No. 348 of 1997) and Rules of the Superior Courts (No.8) (Disclosure and Admission of Reports and Statements (Amendment), 1997, (S.I No. 471 of 1997).

The SI 391/1998 Schedule rules apply wherein a Personal Injuries Summons (see section 10 (1) of the Civil Liability and Courts Act, 2004) is issued from the Central Office of the High Court and when a Notice of Trial is issued and served by one of the parties in such a case and when such a case is run at trial in a hearing before the High Court.

CASES

Murphy J in **Galvin v Murray [2001]** 1 IR 331 at page 336 stated *"the disclosure rules are designed to forewarn other parties' of expert evidence."*

A Supreme Court case regularly quoted in correspondence passing between personal injury litigation Solicitors and their opposing colleagues concerning SI 391/1998 issues is **Kincaid v Aer Lingus Teoranta [2003] 2 IR 314,** wherein it was stated that *"the 'exchange' of reports should be contemporaneous to avoid the danger that the rules can be abused to enable one party to gain an advantage over another".* Geoghegan J with McCracken J and McGuinness J concurring held: -

"The obligation under Order 39 rule 46 (1) is to 'exchange' scheduled reports. If a party's solicitor ensures that the 'exchange' is contemporaneous, there is no danger of the so called 'abuse' arising. If each party's solicitor ensures that an actual contemporaneous exchange of reports takes place, there is no danger that the procedure can be abused in the manner suggested by the plaintiff".

In **Paul Harrington v Cork City Council and Cork County Council [2015] IEHC 41**, the first defendant's Solicitors (RDJ LLP) delivered their client's disclosure schedule subsequent to the plaintiff's Solicitors (Ernest J Cantillion) delivering their client's SI 391/1998 disclosure schedule.

This case has given rise to an expression "*a Harrington undertaking*" when dealing with the SI 391/1998 issue.

The plaintiff's disclosure schedule listed his expert witnesses and expert reports which he intended to call at trial pursuant to his obligations under Order 39, rule 46.

RDJ LLP delivered their client's SI 391/1998 disclosure notice and listed witnesses it intended to be called at the hearing, but no expert witnesses nor expert reports were scheduled, with RDJ LLP reserving the right to call any expert evidence or produce expert reports pursuant to the proceedings *"as matters may arise".* RDJ LLP thereafter requested the plaintiff to furnish them with his scheduled expert reports.

The plaintiff refused to furnish RDJ LLP with his scheduled expert reports absent an undertaking from RDJ LLP that there would be no disclosure of the contents of the plaintiff's expert reports to any expert which RDJ LLP chose to commission in advance of the trial. RDJ LLP refused to constrain their client's defence in this way, resulting in the plaintiff refusing to deliver copies of his scheduled expert reports. The dispute between the plaintiff and RDJ LLP fell to the Court to determine.

The first defendant, relying upon the dicta of the Queen's Bench Division of the High Court in England and Wales in the case of **Kirkup v British Rail Engineering Limited [1983] 1 W.L.R 190** and relying on the judgment of Crestwell J in **National Justice Cia Naviera SA v Prudential Assurance Company Limited [1993 2 Lloyd's Reports 68]** made several interesting arguments such as:

1) The plaintiff's disclosure of his expert reports would not result in any unfairness.
2) There was no entitlement for a party to withhold a report merely because the other party does not have an expert.
3) There could be no prejudice to the plaintiff if any expert reports are commissioned by the first defendant, as he (the Plaintiff) would receive such reports and be afforded an opportunity to review such expert reports before the trial of the action.
4) RDJ LLP further submitted that no unfairness or prejudice would result from disclosure of the expert reports as experts have an independent duty to the Court. The first defendant argued that should it decide to commission an expert report at a late stage, the fact that their expert will have sight of the plaintiff's expert reports would not result in any unfairness or prejudice as their expert would owe a duty to the Court to produce an independent uninfluenced report of his or her own.

Notwithstanding a medical expert or other experts' fine intentions to be detached and objective and their obligation to the Court, there is an element that playing for the team may crop up, as outlined by Charleton J in the case of **James Elliott Construction Limited v Irish Asphalt Limited [2011] IEHC 269** (at para. 13)

"A Judge must bear in mind, notwithstanding that an expert may firmly declare a duty to the Court, it is a natural aspect of human nature that even a professional person retained on behalf of a plaintiff or defendant may feel themselves to be part of that side's team."

Readers should note though that any medical expert or other expert when producing his or her report, whoever commissions such reports, will likely quote in their report the line below: -

"I acknowledge that, in preparing this report, and by reference to Rule 57 (1) of the Rules of the Superior Courts (Conduct of Trials) 2016, my duty as an expert to assist the Court overrides any obligation to any party paying my fee".

The Court in its conclusion in Harrington indicated that "the requirements of fairness require a simultaneous exchange of expert reports and that requirement is not abrogated by the non-existence at this point in time of expert reports to the defendants"....

The Court held that *"as the first defendant has certified that no expert report exists on its behalf to be furnished in accordance with O.39, r 46 (3), the onus has fallen upon the plaintiff to furnish his expert reports on the defendants which he accepts. However, in accordance with the Supreme Court decision in Kincaid it is the order of this Court that the plaintiff's disclosure of his report in accordance with O.39, r.46 (3) be conditional upon the first defendant's undertaking that those reports will not be given, directly or indirectly, to any expert retained by the first defendant until after such expert has furnished his report".*

The SI 391/1998 Schedule issue arose in the case of **Aoibhe Naghten (a minor) suing by her mother and next friend Teresa Crowley v Cool Running Events Limited – Record No. 2016 / 4075P**, which judgment award the defendant / appellant appealed to the Court of Appeal. See neutral citation number [2021] IECA 17.

The correct and fair operations of the SI 398 / 1998 Schedule became part of the discussion in the Court of Appeal case.

The circumstances of the case are that the plaintiff (a minor) attended at the defendant's ice rink venue with her mother and older sister. When the plaintiff, described as a proficient 10-year-old skater, skated with other skaters towards the ice rink exit to leave it, she collided into a large gentleman who was holding onto the exit barrier and who had his back towards the ice rink. The large gentleman apparently moved at the last minute. When the plaintiff collided into him, she fell to the ground onto her outstretched hand and another skater immediately behind her inadvertently skated over her hand. The minor plaintiff suffered significant lacerations to the back of her hands. She luckily made a good recovery albeit she had some scarring remaining on her hands.

The defendant's Solicitors delivered a full Personal Injuries Defence. The plaintiff's Solicitors requested a joint engineering inspection but apparently for seasonal reasons a joint inspection did not occur. The first hearing of the case was listed for 3 May 2017 with the parties exchanging their SI 391/1998 Schedules prior to the trial.

The plaintiff's disclosure schedule listed her expert engineer and three factual witnesses being herself, her mother and sister. The defendant's disclosure document listed a medical expert witness but no expert engineer. A company director of the defendant company, a witness as to fact, was called at trial by Counsel, but he was not scheduled on its first SI 391 / 1998 Schedule.

The trial commenced before Hanna J on 3 May 2017 and proceeded for three days. The defendant's Solicitors, on the second day of trial (4 May 2017) prepared a new SI 391 / 1998 Schedule listing two additional witnesses. The defendant listed its expert engineer, as an expert witness, and the defendant's managing director and founder of the ice rink business, as a witness as to fact.

When the defendant's expert engineer ultimately came into Court to give his evidence, it transpired he was initially instructed on either 3 May 2017 or 4 May 2017, after the trial commenced. The defendant's expert engineer first report was dated 4 May 2017.

It appears the plaintiff's legal team were unaware until day three of the trial, when their own expert engineer had given his evidence in chief, that the defendant instructed an expert engineer. It was during cross examination by the defendant's Counsel that the plaintiff's legal team knew the defendant's expert engineer would be called to give his evidence.

The plaintiff's legal team objected to the defendant's late scheduling of its expert engineer report and its tactics in calling its expert engineer as an expert witness. The Court adjourned the case back into the list for a new trial date to be fixed and awarded the plaintiff all her costs for the May 2017 trial.

A third SI 391 /1998 Schedule was delivered on 18 October 2017 by the defendant's Solicitors listing the same witnesses and identifying its expert engineer and his report of 4 May 2017 and flagging that another expert report was awaited. A fourth SI 391 / 1998 Schedule was served by the defendant's Solicitors on 27 November 2017 which included the defendant's second expert engineer report, its engineer having inspected the ice rink.

The second trial was heard before O' Hanlon J on 26 April 2018 and ran for four days. The High Court (O'Hanlon J) delivered its judgment and found for the plaintiff, awarding her the sum of €65,000.00 for general damages. The defendant appealed against the judgment on both liability and quantum.

The Court of Appeal in its written judgment was critical of the defendant's belated instruction of its expert engineer and its approach to the issue of the workings of the SI 391/1998 Schedule.

Noonan J in delivering the Court of Appeal judgment stated a number of issues with the workings of SI 391 / 1998 namely:

"it was introduced to bring about a degree of transparency designed to avoid trial by ambush and as a consequence, in theory at least, to facilitate earlier resolution of personal injuries litigation".

"in the context of expert evidence where there was a perceived absence of equality of arms or, to use a more current expression, a level playing field".

"The requirement for simultaneous exchange of expert evidence meant that plaintiffs no longer labored under the disadvantage of having to call their expert evidence without knowing what the defendant's expert might say, or indeed if the defendant had an expert at all. This conferred litigious advantage on defendants which was rightly seen as unfair".

"…in both Kincaid and Harrington, the court identified the non-simultaneous exchange of expert reports as potentially amounting to an unfair litigious advantage."

"By its action in this case, the defendant sought to, and in fact, achieved an unfair litigious advantage of the kind identified by the Supreme Court in Kincaid as amounting to an abuse of process."

The Court of Appeal ultimately dismissed the Appellant's case.

Another case concerning the workings of SI 391/1998 Schedule is the Court of Appeal case of **Joan O'Flynn v Health Service Executive and Sonic Healthcare (Ireland) Limited and Medlab Pathology Limited and Clinical Pathology Laboratories Incorporated [2022] IECA 83.**

It was Mr Justice Noonan, similar to the Aoibhe Naghten (a minor) case, who delivered judgment on 1 April 2022. The Appeal in this case specifically concerns *"the proper implementation of the disclosure regime introduced in personal injuries litigation by S.I 391 of 1998".*

The plaintiff's case against the defendants is one of a large number of cases, taken by female plaintiffs impacted by failures within the "Cervical Check" scheme, a number of whom instructed the same legal representatives.

The first defendant had engaged different elements from the second, third and fourth defendants' businesses to examine and test cervical smear samples.

Counsel for the plaintiff at the commencement of the Appeal, informed the Court that in reality there was one participating defendant in the case, the fourth defendant, Clinical Pathology Laboratories Incorporated ("CPL"). Counsel for the fourth defendant did not contest this view.

Notwithstanding an element of medical negligence in these cases, the plaintiff in this particular case issued and served a Personal Injuries Summons. The Court of Appeal in its judgment remarked the Particulars of Negligence were drafted and pleaded in the normal way and were fairly generic. Besides alleging the defendants failed to properly interpret and report on the plaintiff's sample, a paucity of detail was given as to the particular acts or omissions on the part of the defendants, in reality CPL, that alleged negligence.

The Court of Appeal noted the key allegation for the purpose of the appeal was the misreading of the plaintiff's sample. The Court of Appeal noted at the time of issue of the proceedings, the plaintiff Solicitor had the benefit of one expert report dated 5 August 2018 from Professor John Sheppard, a Consultant Surgeon and Gynecological Oncologist.

During the course of the pleadings, Solicitors for CPL eventually served Notice for Particulars. The Court of Appeal noted *"no queries were raised to the particulars of negligence beyond seeking confirmation that those contained in the summons were final, and if not, that final particulars would be furnished".*

The Court further noted no particulars were sought as to the manner in which it was alleged CPL had misread the sample and the precise acts or omissions that were alleged to have constituted such negligence. The plaintiff when delivering her Replies asserted her right to amend and serve further particulars. Apart from delivering Further and Up-Dated Particulars of Injury, no Further and Up-Dated Particulars of Negligence were delivered.

When the plaintiff's Solicitor chased Solicitors for CPL to deliver its Defence, they indicated they had yet to receive the relevant pathology slide from the plaintiff's medical expert writing: -

"Our client is not in a position to deliver a Defence until an expert report has been obtained on its behalf following a review of cytology slide ZA376669".

Notwithstanding this assertion, CPL delivered its Defence, *"apparently without the benefit of such an expert report, and beyond putting negligence in issue, no particular complaint was advanced that the plaintiff's claim had not been properly pleaded or was inadequately particularised to a sufficient extent to enable CPL to know the case it had to meet."*

When it came to the service and issue of Notice of Trial and the scheduling and exchange of the parties' disclosure statements (SI 391/1998 Schedule), CPL indicated that *"its experts required to carry out what is known as a blind review of various slides, including those of this plaintiff,* in order to properly present its case". The removal of markings on the plaintiff's slides became a contested matter in the High Court
.
During the middle of July 2021, the plaintiff's Solicitor notified CPL Solicitors of an intention to apply to the Court for a specially fixed trial date. Solicitors for CPL argued this was premature in the absence of the plaintiff's SI 391/1998 schedule. The plaintiff's Solicitor subsequently delivered his client's disclosure schedule listing nine experts and their expert reports (nine).

On the day of the application to seek a specially fixed trial date, Solicitors for CPL wrote to the plaintiff's Solicitor enclosing their client's SI 391 / 1998 writing:

"…Our client confirms that as per the decision in Harrington v Cork County Council that your client's reports will not be given, directly or indirectly, to any expert retained by our client until after such expert has furnished his report",

and further wrote that failing to hear from them, they would take the liberty to mention the issue to the Court on Friday 30 July 2021 (the last day of Trinity Term 2021) wherein they would seek an Order directing that all reports in our respective clients' Schedules be exchanged by 5.00pm that day.

The plaintiff's Solicitor did not respond to the Solicitors for CPL. Solicitors for CPL then applied to the Court for liberty to issue a Motion to seek an Order to compel the plaintiff to disclose her scheduled expert reports. An Order to leave was granted to issue such a motion, which was issued on 13 September 2021 and returnable to 19 October 2021. Solicitors for CPL, three days prior to the issue of their client's Motion, served the plaintiff's Solicitors with an up-dated SI 391/1998 schedule adding two additional experts, a consultant in adult psychiatry and a nursing consultant.

CPL's application to the Court to seek an Order to compel the plaintiff to exchange her scheduled expert reports was ultimately heard on 5 November 2021 before Mr Justice Cross.

Cross J declined to make an Order compelling disclosure of the plaintiff's scheduled expert reports based merely on a Harrington undertaking and suggested as an alternative that if the defendants were prepared to have an undertaking to the effect that the reports would be disclosed only to CPL's legal team, but not CPL itself, he would then be prepared to allow the application succeed and allowed the parties to take instructions on his proposal. The plaintiff and the defendants found the proposal unworkable, and CPL's application was refused, which gave rise to the Court of Appeal case.

The Court outlined a history of the disclosure regime and a history of relevant cases, and explained sections 47 and 48 of the Act / Statute.

In relation to the appellant's case, the Court noted "*... the injustice identified by Murphy J* in the case of **Galvin v Murray and Cork County Council [2001] I IR 331**, *appears to be the possibility that the plaintiff would have to disclose his expert reports, but if the defendants had in-house experts and intended to call them to give evidence, they would be exempt from the requirement to provide their reports to the plaintiff, a clear unfairness".*

The Court in the Appellant's case further opined that *"although the formula adopted in Harrington has come into widespread use as a convenient template to facilitate disclosure by plaintiffs of their expert reports where no corresponding reports exist on the other side, a Harrington undertaking, as it is now known, is not something that can be foisted upon an unwilling plaintiff."*

The Court distinguished the Appellant's case from that of the Paul Harrington matter in that his case was not a professional negligence claim. The Court indicated that CPL intended to instruct experts on the key liability issue, equivalent to the plaintiff's expert and when before the High Court, it had not yet instructed such expert to prepare a report until it saw the plaintiff's reports given its argument that it did not know what case it had to meet. CPL's Counsel argued that if it did not see the plaintiff's reports, it would be taken by surprise at the trial and further argued that the plaintiff had at no stage updated the particulars of negligence. While the Court of Appeal had a sympathetic understanding of the CPL argument given the general and non-specific way the precise case against the defendants was pleaded, the Court rejected the argument.

Importantly, in terms of "pleadings" procedure the Court of Appeal stated, *"for whatever reason that CPL determined not to seek such particulars of negligence but rather await the plaintiff's expert reports to understand the case being made against it".*

Noonan J stated that this is not a permissible approach and remarked that *"Expert reports are evidence, not pleadings and if a defendant says it does not know the case it has to meet on the pleadings, it has a remedy. It is entitled to seek particulars and if it does not get them, apply to the Court to compel the plaintiff to furnish them."*

The Court further into its judgment again distinguished the appellant (CPL) as against the defendants in the Harrington case remarking *"it undoubtedly had available to it resources and expertise that will enable it to assess the strengths and weaknesses of the plaintiff's case once it sees her reports and react accordingly, while complying with the Harrington undertaking".*

The Court also indicated that *"Professional negligence cases are however different because by definition, the defendant itself will normally be expert in the area of controversy".*

The Court was of the view that notwithstanding such an undertaking, *"the illegitimate litigious advantage that contemporaneous exchange avoids would accrue to CPL were the plaintiff to be compelled to disclose her reports now and before any corresponding expert has been retained or has prepared a report on behalf of CPL. In my judgment, the disclosure regime, as it has evolved, would be significantly undermined, especially in professional negligence claims, if the approach by CPL herein were to be routinely adopted.*

Other commentators discussing this case headline the Court's conclusion that *"… there are significant shortcomings in the disclosure regime introduced by S.I. 391, as this case casts in stark relief. As the 25th anniversary of the disclosure rules approaches, they would, I think, benefit from recalibration to take account of the issues thrown up by this and previous cases which consider them, it may be necessary to revisit s. 45 itself."*

The Court in its judgment in this case suggested nine separate guidelines to ensure fairness between the parties but indicated *"other cases may of course require a different solution as unforeseen issues arise and what is suggested there is by no means intended to apply in every personal injury action, or even every such claim involving professional negligence."*

To achieve fairness between the parties, the Court suggested an adoption of the nine guidelines below:

(i) Each party's disclosure schedule should identity *the experts it intends to call to give evidence and their areas of expertise, whether they have a written a report or not;*

(ii) Exchange of expert reports should, where possible, occur on a simultaneous basis;

(iii) Where either party has not yet decided what, if any, experts they intend to call, or has so decided but not yet received a report, exchange of expert reports should be undertaken on a like for like basis as a reports become available;

(iv) Where genuine difficulty arises in identifying what amounts to like for like, resolution would be facilitated by each party indicating in a general way what issue or issues in the case the expert's evidence is directed toward;

(v) Where CPL confirms that it does not intend to call an expert to give evidence on a particular issue, the plaintiff should furnish her expert reports on that issue subject, if required, to a Harrington undertaking;

(vi) If, having seen any expert report of the plaintiff, CPL, decides that, contrary to an earlier indication, it now wishes to call an expert in relation to an issue disclosed in the plaintiff's report (s), it should satisfy the High Court that it is in the interests of justice that it be permitted to do so;

(vii) Any necessary application in that regard should be made, where possible, on foot of a motion on notice grounded on affidavit;

(viii) The stipulations at (v), (vi) and (vii) will apply mutatis mutandis to the plaintiff;

(ix) The parties must remain free to withdraw any expert from their schedule as they see fit.

The Court dismissed the Appellant's case.

CONCLUSION

Having worked for a period of twenty years as a personal injury litigation legal executive for both plaintiffs and defendants, I think a fair working of the SI 391 / 1998 Schedule of Witnesses, Expert Witnesses and Expert Reports in High Court personal injury litigation is a useful procedure to avoid litigious advantage by defendants to the detriment of plaintiffs.

A fair working of SI 391/1998 Schedule rules by practitioners when scheduled expert reports are exchanged by parties in a personal injury dispute aids "without prejudice" settlement of a particular case and saves Court time.

Some Solicitors attempt to apply a strict application of the rules wherein an SI 391 / 1998 Schedule is required to be delivered to the other side within one month from service of Notice of Trial. This does not generally occur in a majority of cases and a practice has developed between Solicitors to deliver SI 391/1998 Schedules, having had same settled by Senior Counsel, on the basis of *"or within such further time as may be agreed by the parties…"* with delivery of the Schedules occurring quite close to an actual trial / hearing date.

I disagree with the *"as matters may arise"* approach with some Solicitors belatedly delivering various amended SI 391 / 1998 Schedules even during the running of a case at trial before the High Court. I think parties to a High Court personal injuries dispute should be fixed with their final SI 391 / 1998 Schedule delivered up to the day of trial and no further SI 391/1998 Schedules should be entertained once a case is running before the Court.

Notwithstanding a *"Harrington undertaking"*, I agree with Justice Noonan's view in the Joan O'Flynn case when a plaintiff's Indorsement of Claim is drafted in a generic manner and defendants' Solicitors do not address this issue by way of delivering a detailed Notice for Further Information or by way of a Notice of Motion application to the Court, such defendant Solicitors should be precluded from using the SI 391 / 1998 Schedule to profit from such a scenario.

Finally, commentary on reform of the SI 391 / 1998 Schedule rules deal with the scheduling of expert witnesses and their reports, with such expert reports correctly being regarded as evidence.

Any suggested reform *("recalibration")* of the SI 391/1998 Schedule rules should also include stricter rules as to the identification of witnesses as to fact to include names, roles and / or occupation and their addresses and again no amended SI 391 / 1998 Schedules (to include additional witnesses as to fact) should be entertained when a case is running before the Court as this permits a litigious advantage to the detriment of the other party.

Arising from the judgment of Hogan J in the case of **Agnes Armstrong v Sean Moffatt and Others [2013] IEHC 148,** it is a practice of plaintiff Solicitors post March 2013, when dealing with defendants' Notice for Particulars and the issue of naming witnesses to an accident and a request for witness names and addresses by way of Replies, to decline providing such information, and given Justice Hogan's view in the Armstrong case that "evidence" issues should be dealt with in Court and not by way of Notice for Particulars / Replies, correct and full identification of witnesses and their address in a timely manner by way of the SI 391 / 1998 Schedule rules would aid "without prejudice" settlement of a particular case and save Court time.

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International Surrogacy and the Parental Rights of Irish Intending Parents

Shauna Colgan B.C.L., LL.M, BL

INTRODUCTION
The current regulatory regime in this jurisdiction, as it pertains to surrogacy, is non-existent. At the time of writing, the Health (Assisted Human Reproduction) Bill 2022 (hereinafter "the AHR Bill"), is currently before Dáil Éireann, Third Stage. Despite heralding much needed legal protections aimed at ensuring the health and safety of parents and children born of AHR, the legislation does not address the complicated issue of international surrogacy, leaving a significant lacuna in law.

TERMINOLOGY
Professor Conor O'Mahony, in his review of children's rights and best interests in the context of surrogacy, defines a surrogate as *"a woman who agrees to carry and give birth to a child as part of a surrogacy arrangement".* [1] For the purposes of this article, the terms 'surrogate mother' and 'intending parents' will be used to describe parties to a surrogacy agreement.

There are two 'types' of surrogacy, so described:

a) Traditional surrogacy, where the surrogate mother uses her own egg and therefore, has a genetic link to the child; [2]

b) Gestational surrogacy, where all genetic material is provided by the intending parents and/or by donors.[3] As such, there is no genetic link between the surrogate mother and the child.

Further distinctions may be made (e.g. between 'commercial' and 'altruistic' surrogacy arrangements). However, for the purposes of this article, the above terminology is sufficient.

THE LAW IN IRELAND
The Roman-law principle of *mater semper certa est* subsists in Irish law and is taken to mean that the woman who gives birth to a child is the mother of that child.

The State relied on this maxim in *M.R. and D.R. v An tArd Chláraitheoir* [4] to substantiate the rejection of an application made by a genetic mother to be registered as the legal mother on the birth certificates of her twin children. The applicant's sister had acted as surrogate in this case. In the High Court, Abbott J noted that traditionally, the maxim demanded that the very fact that a woman had given birth was determinative of maternity and no evidence could be introduced to rebut that fact. [5] The court held that the maxim did not survive the enactment of the Constitution insofar as it related to the situation post the emergence of AHR technology.[6] The court therefore granted a declaration that the genetic mother was the legal mother of the applicant twins.

The Supreme Court rejected the High Court's findings, however. Denham CJ held that the maxim was, *"a statement which recognised the medical and scientific fact that a birth mother was the mother of a child"* which did not specifically address the question of surrogacy.[7] Denham CJ stated that as neither the common law nor legislation provided for the registration of the genetic mother on the certificate of birth of a child born of surrogacy [8] , a gap existed in the law as to the maternal identity in such cases.[9] The Court called for urgent legislation regarding surrogacy. [10]

While the AHR Bill may, if enacted, go some way to answer the Supreme Court's call to action in relation to domestic surrogacy, it does not remedy the lacuna as it pertains to international surrogacy.

In the absence of regulation, *mater semper certa est* dictates that the international surrogate mother is the mother of the resultant child. This is so even in cases of gestational surrogacy, where there is no genetic link between the surrogate mother and child. If said surrogate mother is married to a man, her husband is presumed to be the child's legal father as per s. 46(1) of the Status of Children Act 1987. [11] Again, this remains the case even where the surrogate mother's husband has no genetic relationship to the child. If the surrogate mother is not married to a man, the man listed on the birth certificate will be presumed to be the legal father, pursuant to s. 46(3) of the 1987 Act, as amended.[12] These paternity presumptions are rebuttable.

Section 35(8) of the 1987 Act states that where, on application, it is established on the balance of probabilities, that a person named in the application is the father or mother of the applicant, the court shall make a Declaration of Parentage in their favour.[13] Dr. Lydia Bracken notes that the lack of legislative guidance as to surrogacy impacts in practice on the rights enjoyed by intending parents: *"at least one of the intended parents in a surrogacy arrangement (the non-*

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[1] Conor O' Mahony, *A Review of Children's Rights and Best Interests in the Context of Donor-Assisted Human Reproduction and Surrogacy in Irish Law (2020) 4.*
[2] O' Mahony, *A Review of Children's Rights and Best Interests in the Context of Donor-Assisted Human Reproduction and Surrogacy in Irish Law (2020) 4.*
[3] Geoffrey Shannon, *Child and Family Law,* (3rd edn, Round Hall 2020) 1181.
[4] *M.R. and D.R. v An tArd Chláraitheoir [2014] IESC 60.*
[5] *M.R. and D.R. v An tArd Chláraitheoir [2013] IEHC 91 [100].*
[6] *M.R. and D.R. v An tArd Chláraitheoir [2013] IEHC 91 [104].*
[7] *M.R. and D.R. v An tArd Chláraitheoir [2014] IESC 60 [88] (Denham CJ).*
[8] *M.R. and D.R. v An tArd Chláraitheoir [2014] IESC 60 [118] (Denham CJ).*
[9] *M.R. and D.R. v An tArd Chláraitheoir [2014] IESC 60 [116] (Denham CJ).*
[10] *M.R. and D.R. v An tArd Chláraitheoir [2014] IESC 60 [116] (Denham CJ).*
[11] Status of Children Act 1987, s. 46(1).
[12] Status of Children Act 1987, s. 46(3) as amended by Children and Family Relationships Act 2015, s.88(c).
[13] Status of Children Act 1987, s. 35(8) as amended by Children and Family Relationships Act 2015, s.80(e).

gestational intended mother or non-genetic intended father) might not have any legal connection to the child at birth". [14]

The Guardianship of Infants Act 1964, as amended, states that where the 'mother' of a child is not married to the child's father, she alone will be considered the guardian of the child.[15] As a result, in the case of international surrogacy, the surrogate mother is automatically considered to be the legal guardian of the resulting child. As discussed, if the surrogate mother is married to a man, there is a rebuttable presumption that her husband is the father of the resultant child. Under the 1964 Act, therefore, there is also a rebuttable presumption that said husband is the joint guardian of the child.[16]

The genetic father of the child can become a joint guardian by agreement, with the written consent of the surrogate mother.[17] The genetic father may also apply to the District Court for a Declaration of Guardianship under s.6A of 1964 Act as amended, which states: *"The court may, on an application to it by a person who, being a parent of the child, is not a guardian of the child, make an order appointing the person as guardian of the child".*[18] It follows from the text of this section that, guardianship may only be awarded to the genetic father once a Declaration of Parentage has been made by the courts.

The option of guardianship is available to those intending parents who do not enjoy recognised parental status and associated rights over their child.[19] Guardianship of a child may be granted to a person who is married to, is the civil partner of, or is the cohabitant of the legal parent, providing that he/she has shared responsibility for the child's day-to-day care for a period of at least two years for married or civil partners, and three years for cohabitants.[20]

It follows, therefore, that intending mothers or intending non-genetic fathers of children born to an international surrogate, cannot apply for guardianship of their child for several years after their birth.

O' Donnell J highlighted the day-to-day implications of this reality for many intending parents, in his judgment in M.R.. He stated that it was:

"surely most clearly and profoundly wrong from the point of children born through an unregulated process into a world where their status may be determined by happenstance and where simple events such as registration for schools, attendance at a doctor, consent to medical treatment, acquisition of a passport and even joining sports teams may involve complications, embarrassment and the necessity for prior consultation with lawyers". [21]

Further to these hardships is the fact that guardianship status ends when the child reaches the age of majority. This means that for many intending parents, all legal links to the child cease when the child reaches the age of 18 years.

FUTURE DEVELOPMENTS

As discussed, Health (Assisted Human Reproduction) Bill 2022 is currently before Dáil Éireann, Third Stage. The Bill provides for the recognition of surrogacy arrangements in Ireland, subject to certain restrictions, including: that the surrogacy must be gestational [22] , the child must have a genetic link to at least one parent [23] , the surrogacy must be altruistic [24] , and it must be approved by a regulatory authority established under the Bill.[25] Although the surrogate mother remains the legal mother upon the birth of a child, a Parental Order may be sought pursuant to the Bill by the intending parents with the consent of the surrogate mother.[26] While the Bill has been welcomed as placing surrogacy on legal footing, it has been lamented as only recognising domestic surrogacy agreements. [27]

In January 2022, the Irish Government established a Special Joint Oireachtas Committee on International Surrogacy.[28] The Committee was tasked to produce, within three months of its establishment, recommendations pertaining to the complex area of international surrogacy.

On the 6th of July, 2022 the Committee published its report on International Surrogacy. The report reflects the Committee's belief that amending the AHR Bill to include international surrogacy is the most appropriate way to regulate the area as opposed to legislating separately for it.

In the report, the Committee makes 32 recommendations. While a full examination of same is beyond the scope of this article, emphasis should be placed on those proposals which specifically address the parental rights of intending parents.

The Committee posits that where an international surrogacy agreement meets the criteria set out in the guidelines, the intending parents should be able to apply to the courts for a parental order in respect of both parties. [29] It is recommended that parental order shall declare both intending parents to be the parents of the child, equal in rights, regardless of biological connections and shall create an entitlement to all rights and an obligation to all duties under law for the parents and child.[30] The parental order shall name the surrogate, but declare severance of any parental relationship between the surrogate mother and child. [31]

The above recommendations, if adopted, would go some way towards ameliorating the inequality experienced by intending parents availing of international surrogacy going forward. The Minister for Health, Stephen Donnelly, has indicated that the report will need to be discussed at Cabinet level. At the time of writing, no amendments have been proposed to the AHR Bill on foot of the Final Report of the Joint Committee on International Surrogacy.

While an extensive review of international surrogacy and parental rights is beyond the scope of this article, the aim is to provide the reader with an introductory overview of the debate surrounding this topic.

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[14] Lydia Bracken, *Child Law in Ireland,* (Clarus Press, 2018) 64.
[15] Guardianship of Infants Act 1964, s. 6(4) as amended by Children Act 1997, s. 5.
[16] Guardianship of Infants Act 1964, s. 6(1) as amended by Marriage Act 2015, s. 16(a)(i).
[17] Guardianship of Infants Act 1964, s. 2(4), as amended by Children Act 1997, s. 4.
[18] Guardianship of Infants Act 1964, s. 6A, as amended by Children and Family Relationships Act 2015, s. 48.
[19] Guardianship of Infants Act 1964, s. 6C, as amended by Children and Family Relationships Act 2015, s. 49.
[20] Guardianship of Infants Act 1964, s. 6C, as amended by Children and Family Relationships Act 2015, s. 49.
[21] *M.R. and D.R. v An tArd Chláraitheoir* [2014] IESC 60 [6] (O' Donnell J).
[22] Health (Assisted Human Reproduction) Bill 2022, s. 2(1).
[23] Health (Assisted Human Reproduction) Bill 2022, s. 53(3)(a).
[24] Health (Assisted Human Reproduction) Bill 2022, s. 50(1)(c) and s. 54.
[25] Health (Assisted Human Reproduction) Bill 2022, s. 78(2)(i).
[26] Health (Assisted Human Reproduction) Bill 2022, s. 62.
[27] Health (Assisted Human Reproduction) Bill 2022, s. 49.
[28] Joint Committee on International Surrogacy, *Final Report of the Joint Committee on International Surrogacy* (33/JCIS/01-2022).
[29] Joint Committee on International Surrogacy, *Final Report of the Joint Committee on International Surrogacy* (33/JCIS/01-2022) 14.
[30] Joint Committee on International Surrogacy, *Final Report of the Joint Committee on International Surrogacy* (33/JCIS/01-2022) 14.
[31] Joint Committee on International Surrogacy, *Final Report of the Joint Committee on International Surrogacy* (33/JCIS/01-2022) 15.

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