

**DECISION OF THE CONTROLLER OF PATENTS, DESIGNS AND TRADE MARKS IN
PROCEEDINGS UNDER THE TRADE MARKS ACT, 1996**

between

SAVANAGH SECURITIES LIMITED t/a T-REX CLOTHING (Applicant for Invalidity)

and

CUMANN LÚTHCHLEAS GAEL (Proprietor)

concerning Trade Mark No. 239459

The registered trade mark

1. CUMANN LÚTHCHLEAS GAEL (hereinafter “the GAA”, which is how the Proprietor is commonly referred to, based on the English translation meaning “Gaelic Athletic Association”), of Páirc An Chrócaigh, Baile Átha Cliath 3, Ireland is the registered proprietor of the trade mark GAA (“the said mark”), which is registered in respect of the follow goods and services:

Class	Goods/Services
9	Screensavers; holographic images; physical representations of images stored electronically for electronic transfer; audio and video recordings; computer games; discs and tapes bearing audio and/or video recordings; computer programs; downloadable electronic publications; encoded credit cards; encoded phone cards; protective clothing.
14	Goods in precious metals or coated therewith included in Class 14; jewellery, precious stones, horological and chronometric instruments; key rings of precious metal.
16	Paper, cardboard and goods made from these materials, included in Class 16; printed matter; photographs; stationery; instructional and teaching material (except apparatus); plastic materials for packaging included in Class 16; flags made of paper.
18	Goods made of leather and imitations of leather included in Class 18; trunks (luggage) and travelling bags; umbrellas, parasols and walking sticks; fobs incorporating key rings.
21	Household or kitchen utensils and containers (not of precious metal or coated therewith); combs and sponges; unworked or semi-worked glass (except glass used in building); glassware, porcelain and earthenware included in Class 21; ceramic mugs.
24	Textiles and textile goods, not included in other classes; bed and table covers; flags not made of paper.
25	Clothing; footwear; headgear.
28	Games and playthings; gymnastic and sporting articles included in Class 28; decorations for Christmas trees; playing cards; gaelic footballs and sliotars.

The application for registration of the mark was filed on 27 November, 2007 and by virtue of Section 45(3) of the Act the mark is registered as of that date. The application was published for opposition purposes in Journal No. 2107 dated 17 September, 2008 and the registration of the trade mark was published in Journal No. 2118 on 18 February, 2009.

Application for declaration of invalidity

2. On 6 February 2016 Savanagh Securities Limited (hereinafter “the Applicant”), of Pine Lodge, Castlebar, Co. Mayo, Ireland made an application under Section 52 of the Trade Marks Act, 1996 (“the Act”) for a Declaration of Invalidity of the said mark and included with the application a statement of the grounds on which it was made. On 24 May 2016 the Proprietor filed a Counter Statement and evidence was, in due course, filed by the parties under Rules 20, 21 and 22 of the Trade Marks Rules, 1996 (“the Rules”).
3. Both parties elected to attend a hearing in the matter. Acting for the Controller, I decided to reject the application for invalidity on the grounds that the registration of the said mark did not offend against the Act. The parties were informed of my decision by way of letter dated 12 December, 2017. I now state the grounds of my decision and the materials used in arriving thereat in response to a request by the Applicant in that regard pursuant to Rule 27(2) of the Trade Mark Rules 1996, filed on 21 December, 2017.

Grounds of the Application

4. The Applicant attacks the registration of the mark on two fronts. Firstly, that Section 7 of the Act stipulates that a registered trade mark is a property right obtained by registration of the trade mark and the proprietor of a registered trade mark shall have rights and remedies provided by the Act. However, it is a well-recognised principle of Irish law that unincorporated associations have no legal personality of their own and cannot own property or enter into contracts in their own right. The GAA is an unincorporated association, and is therefore incapable of owning property, including registered trade marks. Accordingly, the Applicant claims the registration is in breach of Section 8(3)(a) of the Act which provides that a trade mark shall not be registered if “*it is contrary to public policy or to accepted principles of morality*” - in this case contrary to the public policy that prohibits unincorporated associations from owning property.

5. Secondly, that the mark should be invalidated under Section 52(1) of the Act on the grounds it was registered in breach of Section 8(3)(b) of the Act which provides that a trade mark shall not be registered if “*it is of such a nature as to deceive the public, for instance as to the nature, quality or geographical origin of the goods or services*”. The Applicant’s claim in this regard is that the registration of a trade mark in the name of an unincorporated association deceives the public into believing that the GAA is legally entitled to be registered as the proprietor of the mark GAA, when in fact it is not.
6. The Applicant goes on to say that, while it is customary for trustees to hold property for the benefit of unincorporated associations, it is to be noted that Section 30(1) of the Act stipulates that no notice of any trust (express, implied or constructive) shall be entered on the Register; and that the Controller shall not be affected by any such notice. Accordingly, it is not permissible for notice of any existing trust, for the benefit of the GAA, to be entered on the register. Having regard to the provisions of Section 30(1), the Register must only contain the name of the legal owner of the mark. It is a principle of Irish Trust Law that a trustee is the legal owner of property held in trust for a beneficiary. Thus, where it is intended that a trade mark is to be held in trust for a beneficiary, the legal owner (the trustee), rather than the beneficial owner (the person for whom the property is held), should be listed as the applicant.
7. The Applicant attaches two annexes to its Statement of Grounds, the first of which contains an extract from the WHOIS database pertaining to the domain www.gaa.ie, which confirms the GAA is an unincorporated association; and the second an extract from the GAA’s Official Guide which stipulates that all property owned by “Units” of the GAA shall be vested in Trustees.

Counter Statement

8. In its Counter Statement the Proprietor does nothing other than deny all the grounds mentioned in the Applicant’s Statement of Grounds.

Rule 20 Evidence

9. Evidence submitted by the Applicant under Rule 20 consists of a Statutory Declaration, dated 2 August 2016, of Niall Henry Tierney, Registered Trade Mark Agent, of Castle Street, Dalkey, Co. Dublin which serves to enter ten exhibits (marked “NHT1” to “NHT10”) into evidence.

10. I would summarise the Exhibits as follows:

NHT1 is a printout from the Companies Registration Office attesting to the incorporation of the Applicant and its trading name.

NHT2 contains an extract from a translation service showing that CUMANN LÚTHCHLEAS GAEL translates into English as “Gaelic Athletic Association”.

NHT3 is an extract from the WHOIS database which confirms the GAA is an unincorporated association.

NHT4 consists of a legal definition of an unincorporated association as defined in *Conservative and Unionist Central Office v Burrell*¹.

NHT5 contains a copy of the Law Reform Commission of Ireland Consultation Paper on the “Legal Structures for Charities”, which outlines the current state of Irish law on unincorporated associations.

NHT6 consists of a copy of the “Charity Law, A Case for Reform” report from the Law Society of Ireland Law Reform Committee which contains a section titled “Unincorporated Associations”.

NHT7 is a copy of an article by the law firm A&L Goodbody titled “How to structure your sports club/organisation” wherein it advises clubs to appoint trustees if the club wishes to hold property.

NHT8 consists of an extract from the United Kingdom Intellectual Property Office’s (UKIPO) ‘Manual of Trade Mark Practice’ regarding the practice the UKIPO adopts in regard to unincorporated bodies.

NHT9 is an extract from the UK Trade Marks Act, 1994 which outlines the provisions of Section 26 of that Act.

NHT10 contains an extract of the GAA Official Guide 2015, wherein under Clause 5.3 ‘Vesting’ it is stated that vesting of all property owned by units of the Association shall be held in trust.

Rule 21 Evidence

11. Evidence submitted by the Proprietor under Rule 21 of the Rules consisted of a Statutory Declaration dated 2 May 2017, of Paul Kelly, Trade Mark Attorney of FRKelly and 3 accompanying exhibits marked “PK1” to “PK3”.

¹ [1982] 1 WLR 522

12. Mr. Kelly provides a brief background to the Proprietor and attaches at Exhibit PK1 an extract from the Proprietor's website setting out its historical context and activities. He also provides background to the present application which arises from a request sent by the Proprietor to the Applicant to urge the Applicant to cease using certain intellectual property of the Proprietor as the use was without authorisation or consent.
13. Mr. Kelly says the Proprietor has rules that set down the conditions relating to ownership and control of property. Exhibit PK2 is a list of the contents of the Proprietor's 2016 Official Guide (which comprises the Constitution and Rules of the Association) and Exhibit PK3 is an extract of Chapter 5 of the Guide that deals with ownership of property. Mr. Kelly points to Exhibit NHT5 attached to Mr. Tierney's Statutory Declaration which confirms that the assets of every charitable association are to be treated as being held on trust, whether express or implied. Mr. Kelly states that Chapter 5 of the Proprietor's Constitution and Rules expressly sets down how property of the Proprietor will be held in trust, and provides for the appointment of trustees in accordance with the rules. He says all that is required is for there to be a mechanism or condition in place that allows for the ownership of property to be held in trust and this is the case in respect of the Proprietor as evidenced by the rules, particularly Chapter 5.

Rule 22 Evidence

14. The Applicant filed evidence in reply under Rule 22, which consists of a second Statutory Declaration of Niall Henry Tierney, dated 12 June 2017, and 3 exhibit which comprise an extract from the Trade Marks Act, 1996 and two Irish Court decisions; one the decision of the Supreme Court in *Hickey v McGowan & ors.* ([2017] IESC 6) and the other the decision of the High Court in *McArdle v O'Donohoe* ([1999] IEHC 176).

The Hearing

15. At the Hearing the Applicant was represented by Mr. Niall Tierney and the Proprietor by Mr. Paul Kelly. Both gentlemen restated their positions as outlined in the evidence they filed under Rules 20 to 22. It was common case that trade marks are an item of property and fall under the relevant Irish law governing the ownership of property. It was also common case that these proceedings were put in train to address an action by the GAA to prevent the Applicant from continuing its illegal use (in the eyes of the Proprietor) of the GAA trade mark.

Section 8(3)

16. Turning now to the grounds of the application centred on Section 8(3) of the Act, which reads as follows:

8(3) A trade mark shall not be registered if—

(a) it is contrary to public policy or to accepted principles of morality; or

(b) it is of such a nature as to deceive the public, for instance as to the nature, quality or geographical origin of the goods or service.

17. In terms of Section 8(3)(a) Mr. Tierney focused his argument on the “contrary to public policy” provision not the “principles of morality” part. He argued that property law in Ireland is absolutely clear and it does not allow unincorporated associations to own property. The GAA is an unincorporated association and is recorded as the registered Proprietor of the disputed mark. This, he argues, flies in the face of the public policy which prohibits such organisations from owning property.

18. This is a misguided and unsustainable argument as the “public policy” provisions in Section 8(3)(a) concern the content of the mark itself. It prohibits the registration of marks that consist of or contain material which is illegal or would be a cause for concern in terms of public safety. For example, an image of a hypodermic syringe accompanied by the phrase “Enjoy Heroin Sensibly” (illegal matter) or the registration of a well-known confectionary trade mark for a third-party’s disinfectant or toxic substance (public safety consideration). I find the mark GAA does not contain a reference to or an indication of anything that is contrary to public policy. Accordingly, I must reject the application for invalidity on this ground.

19. Turning now to Section 8(3)(b). Mr. Tierney argued that in claiming the ownership of a property right, which it was not legally entitled to own, the registered proprietor was deceiving the public. Mr. Kelly suggested that this was nonsense and that there was no intention to deceive anyone. He argued the GAA has rights for years in the term GAA and has used and defended those rights for years.

20. Here again, the Applicant has misconstrued the provision of this Section, which bars from registration marks which consist of or contain material that is of such a nature that it is likely to deceive the public. Like Section 8(3)(a) this provision applies solely to the mark itself and does not allow for the mark to be linked with other provisions in law. Therefore, the question

of the Proprietor's right to own property is not an issue in terms of invalidating the registration of a trade mark under Section 8(3)(b). There is nothing in the mark GAA that is in any way deceptive. The Proprietor has not sought to deceive and is not deceiving anyone by its use of the letters GAA. The general Irish public is well aware of the Gaelic Athletic Association, its history, role and functions and is not being deceived by the Association's use of the acronym GAA.

21. Mr. Tierney also claimed the registration of the deceptive mark in the name of the registered Proprietor contravened the Consumer Protection Act 2007, as it is an offence under that act to engage in misleading or prohibited commercial practices. This was the first mention of the Consumers Protection Act and ordinarily I would not entertain an expansion of the grounds of an application for a Declaration of Invalidity at the Hearing. But as Mr. Kelly did not object and because it may have some educational benefit I shall address it.

22. Misleading practices in consumer protection law include those likely to cause the average consumer to confuse a competitor's product with the trader's product or trade marks, where the practices are likely to lead to the consumer making a transactional decision which he or she would not otherwise make. Mr. Tierney did not identify any trader that the Proprietor is attempting to steal business from by using the trade mark GAA. Nor did Mr. Tierney provide any example of the type of transaction a consumer would make as a result of being confused by the Proprietor's use of the trade mark GAA or explain how the Proprietor is attempting to mislead consumers as to the commercial origin of any of the goods or services it supplies. The case in respect of the Consumer Protection Act 2007 is purely based on the claim the Proprietor is not entitled to own property. However, I am unaware of any provision in the Consumer Protection Act 2007 that prohibits trade by an unincorporated association or restricts the right to trade to individuals or bodies corporate, who have the legal right to own property. In any event, in my opinion, the Proprietor, in using the trade mark GAA, is not engaging in misleading or prohibited commercial practices. I find the registration of the trade mark GAA is not of such a nature to deceive the public either under the Trade Marks Act 1996 or the Consumer Protection Act 2007. Therefore, I reject the application on these grounds also.

The Right to Own Property

23. The thrust of the Applicant's case is grounded on the claimed lack of entitlement of the registered proprietor to own property by virtue of its legal status as an unincorporated association. It is common case that the GAA is an unincorporated association and as such it

cannot own or hold property its own name. However, the GAA is entered on the Register as the Proprietor of the trade mark at issue.

24. Section 26 of the Act states: “*A registered trade mark is personal property*” and Mr. Tierney argued that the GAA should not have been recorded as the Proprietor of such property. I agree. The questing is: is that sufficient grounds for invalidating a trade mark that has resided on the Register since 2007?
25. Mr. Tierney correctly pointed out the UKIPO advertises that, where there appears to be some doubt as to an applicant’s legal status, it reserves the right to ask for confirmation that the applicant has the necessary standing to hold property. But this is not the case here because the Controller has always taken a good faith approach regarding proprietorship. In the case of an application in the name of an individual there are no checks to establish the existence, authenticity, accuracy or the identity of the name entered on an application form. Likewise, in the case of applications filed in the name of an entity other than an individual, the office does not carry out any checks to establish that the name entered on the application form is entitled to own property.
26. The Controller is concerned with the proper examination of applications in accordance with the prevailing legislation, namely the Trade Mark Act 1996, as amended. There are no provisions in the Act or Rules to refuse an application or to invalidate a registration on the grounds of the lack of a legal entitlement to own property. Should the Controller register a mark in the name of an entity that is not entitled to own property, then there is a danger that the rights afforded by that registration may not be enforceable. That is not strictly a matter for the Controller, but a matter to be determined in the Courts where the registered proprietor may be seeking to enforce or protect its rights.
27. Even taking the UKIPO approach, I am satisfied that there was nothing in the original application (filed in the name of the GAA) to raise any doubt as to the legal standing of the GAA to own property. The GAA is a renowned organisation that the Controller, and everyone else in Ireland, knows owns property, including the biggest sporting arena in the country - Croke Park, and other major sporting venues. Clearly the GAA has structures in place to ensure its properties are legally held for the benefit of the Association and its members. Evidence provided by the Applicant clearly shows that the Applicant understands this to be the case, as the Applicant itself exhibited at “NHT10” an extract from the GAA’s Official

Guide which defines how all its property “*shall be vested in a GAA Corporate Trustee and/or a number of Full Members as Trustees who shall hold such property upon Trust...*”.

28. I am satisfied in this case that the application was entirely bona fide and that the property rights acquired on foot of the registration of the trade mark GAA are properly held by the GAA in a manner that is in accordance with all its other properties. In my opinion the entering of the name GAA as the Applicant instead of what should legally have been “*The trustees for the time being of the GAA*” is no more than an administrative oversight. This oversight cannot, in equity, condemn the Proprietor to the loss of the property right, the invalidation of the trade mark, or provide cover for a third party to use the GAA name in the course of trade with impunity. The oversight should, nonetheless, be rectified and the GAA should formally apply to the Controller to put the registration of the mark in the ownership of its trustees, in accordance with its own rules.

29. However, at the Hearing Mr. Tierney argued that, under Section 30(a) of the Act, no notice of any trust (express, implied or constructive) shall be entered in the register. I took this to mean that he was arguing that the mark could not be entered on the Register either in the name of the GAA, or in the name of the Trustees of the GAA. I reject his argument as that is not the intention of that Section. The provisions of Section 30(a) are to ensure that only the legal owner of the trade mark may be recorded as the proprietor on the Register. It does not mean that trustees cannot be the legal owners of trade marks. There are dozens of marks on the Register in the proprietorship of the trustees of various unincorporated associations, including sporting bodies and charities. What it does mean is that the Proprietor of a trade mark, for example Sean Soap, cannot be recorded on the Register as “Held in trust by Joe Soap, on behalf of Sean Soap”, because in this example Joe Soap is not the legal owner of the trade mark.

30. Having duly considered all the evidence, legal arguments and referenced case law, I have decided to reject the application for a Declaration of Invalidity and to allow the mark to remain on the Register.

Dermot Doyle

Acting for the Controller

14th March, 2018