

Study unit 7

Registration of a trade mark

Overview

In this study unit, we will discuss the conditions, limitations and other requirements which the registrar may impose before accepting an application for registration. You will find out about consents required in the case of marks comprising the names or representations of persons, geographical, colour and other limitations as well as disclaimers and associations. We will also deal with the effect of a trade mark registration, the maintenance of a registration as well as the duration and renewal of a registration.

Learning outcomes

After completion of this study unit, you should be able to —

- ☐ understand the conditions and limitations subject to which a trade mark may be registered and how they restrict the rights of the trade mark proprietor
- ☐ understand the effect of a trade mark registration and the rights acquired by the registration of a trade mark
- ☐ appreciate and be able to advise a trade mark proprietor what to do in order to maintain his registration
- ☐ determine the duration of and renew a trade mark registration

Discussion

Name or representation of person

Where application is made for the registration of a trade mark which consists of or includes the name or representation of a person, the registrar may require the applicant to furnish him with the consent of that person. In the event of the person concerned being deceased, the registrar may require the consent of the legal representative of the deceased person to

the appearance of the name or representation in the mark (see s 12).

Activity 7.1

- ☐ Thand' uses the mark THANDIBANDI as menu name for fried chicken wings. If she applies for registration of this mark, will consent be required because of the name Thandi, which appears in the mark?
- ☐ Thandi designs a package for her fast foods. It is old-fashioned in style, with a photograph of an elderly woman and script reading 'still made to Tannie Anna Bopokeng's original recipe'. Mrs Bopokeng was a neighbour of Thandi's who died recently. Will the registrar require consent in this instance and, if so, from whom?

Discussion

The Registrar may accept an application subject to amendments, modifications, conditions or limitations (s 16(2)(b); see s 13 of the UK Trade Marks Act 1994). Such limitations may include a limitation as to the mode of use, territorial restrictions within the South Africa and restrictions as to use for export (see *Sidewalk Cafes (Pty) Ltd v Diggers Steakhouse (Pty) Ltd* 1990 (1) SA 192 (T)).

A trade mark may be registered with or without a colour limitation. A trade mark registered without limitation as to colour is deemed to be registered for all colours (s 32(1)). It is preferable to obtain a registration without a colour limitation as the registered proprietor may then use it in any colour. Should a trade mark be registered in a certain colour or colours only, this could severely restrict the scope of the registered proprietor's infringement rights. Thus, in practice, only those marks which derive their capability of distinguishing from a particular colour or colours will be registered with a colour limitation.

Disclaimers

Where a trade mark is made up of a number of elements which, when regarded alone are not capable of distinguishing, yet when regarded in combination do form a whole which is capable of distinguishing, or where a trade mark contains matter which is not capable of distinguishing (eg descriptive matter such as the place of manufacture of an article, statement of quality, matter common to the trade, such as 'sparkling' in respect of wine), the proprietor cannot obtain a monopoly in such elements or matter. In order to prevent any misconception as to the extent of the rights which the registered proprietor has obtained through registration, provision is made for the entry of a disclaimer in respect of matter which is not capable of distinguishing. It is then clear from the register that the registered proprietor has no rights in the exclusive use of the disclaimed features (see s 15; s 13 of the UK Trade Marks Act 1994; see further *Judy's Pride Fashions (Pty) Ltd v Registrar of Trade Marks* 1997 (2) SA 87 (T)).

Disclaimers generally take the following form (using the example of 'sparkling' as the disclaimed feature): 'Registration of this mark shall give no right to the exclusive use of the word 'sparkling' separately and apart from the mark' (see Webster & Page par 9.18).

If some person other than the registered proprietor uses a disclaimed element in connection with goods or services for which the trade mark is registered, this does not infringe the trade mark rights. However, it is important to note that the disclaimed elements form part of the mark and are taken into account when assessing the mark's capability of distinguishing. A composite mark may be capable of distinguishing even though its separate components are not capable of distinguishing and have been disclaimed. Likewise the disclaimed elements of a mark are taken into consideration when the mark is compared with another for the purpose of ascertaining whether they are deceptively or confusingly similar (see *Registrar of Trade Marks v American Cigarette Company* 1966 (2) SA 563 (A); *S Wainstein & Co (Pty) Ltd v Buffalo Salt Works & Packaging Co* 1966 (3) SA 280(T); *Distillers Corporation (SA) (Pty) Ltd v Stellenbosch Farmer's Winery Ltd* 1979 (1) SA 532 (T); *Kentucky Tobacco Corporation (Pty) Ltd v Registrar of Trade Marks* 1984 (2) SA 332 (W); *Estee Lauder Cosmetics Ltd v Registrar of Trade Marks* 1993 (3) SA 34 (T); *Smithkline Beecham Consumer Brands (Pty) Ltd v Unilever plc*

1995 (2) SA 903 (A)).

Activity 7.2

Will any disclaimers be required in respect of the trade mark CRUNCHY MUNCHY? Draft such a disclaimer or disclaimers.

Discussion

Associations

Where a trade mark sought to be registered resembles another trade mark that is registered, or is the subject of an application for registration in the name of the same proprietor, and where the use of the marks by different persons would be likely to deceive or cause confusion, the Registrar may require that the marks be associated and the register endorsed accordingly (s 30(1)).

The following marks are deemed to be associated:

- ☐ a trade mark and any part thereof which the proprietor has (by virtue of section 18(1)) also registered as a separate trade mark (s 30(2))
- ☐ the association of a trade mark with another trade mark is also deemed to be associated with all other trade marks associated with the latter mark — in this way a chain of associations can be constituted on the register (s 30 (3))

Although associated marks are treated as separate marks they cannot be transferred (assigned) separately (s 30(4)), for this would conflict with the principle underlying association — different persons could then acquire and use confusingly similar marks. Association does provide a major benefit. If a mark is not used for an uninterrupted period of five consecutive years, it is liable to be removed from the register for non-use (s 27).

Where a mark that is vulnerable to removal from the register because of non-use happens to be associated with another mark, the Registrar or the court may, in the exercise of a

discretion vested by section 31(1), deem use of the associated mark to be equivalent to use of the unused mark and on this ground refuse to remove it from the register for non-use (*Distillers Corporation (SA) Ltd v SA Breweries Ltd; Oude Meester Groep Bpk v SA Breweries Ltd* 1976 (3) SA 514 (A) at 538-539).

The Registrar may dissolve an association where he deems it no longer necessary (s 30(5)).

The UK Trade Marks Act 1994 no longer makes provision for associations.

Activity 7.3

- ☐ Thandi decides to file two more application for the mark 'Crunchy Munchy' in classes 29 and 30, for various foodstuffs. Will association between these marks and the existing registration in class 42 be required?
- ☐ Name the various conditions, limitations, and other requirements that may be imposed on an application for registration under your domestic trade mark legislation.

Discussion

Effect of registration

Basically, the effect of a trade mark registration is to grant the proprietor a statutory monopoly which entitles him:

- ☐ to use the trade mark in relation to the goods or services in respect of which the trade mark is registered (see definition of 'trade mark' in s 2)
- ☐ to prevent other persons from registering the trade mark or a confusingly similar mark in relation to the same or similar goods or services (see s 10(14))
- ☐ to prevent other persons from using the trade mark or a confusingly similar mark in the course of trade in relation to the same or similar goods or services (see s 34 and article 16(1) of the TRIPS Agreement)

- ☐ to license the use of the mark (see s 38 and article 21 of the TRIPS Agreement)
- ☐ to transfer (assign) the trade mark (see s 39 and article 21 of the TRIPS Agreement)
- ☐ to hypothecate the trade mark by a deed of security (see s 41)

Activity 7.4

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- ☐ Can Thandi prevent other persons from using the name 'Crunchy Munchy' on hamburgers, if she is registered in class 42 for providing food and drink, catering services, restaurants and fast food outlets?
 - ☐ Can she prevent other persons from using the mark on t-shirts?
 - ☐ Can she prevent other persons from using the mark on computer equipment?
 - ☐ Study your domestic trade mark legislation and write down the rights conferred by a registration on the trade mark proprietor.

Discussion

Maintenance of registration

To maintain his trade-mark registration, a proprietor must renew the registration periodically. Failure to do so will result in the registration being removed from the register (s 37).

The proprietor must also use the trade mark himself or through the medium of a licensee. Failure to do so may result in the trade mark being removed from the register for non-use (s 27). Where the trade mark is used only for some of the goods or services for which it is registered, the registration can be cut down to exclude those goods or services on which it has not been used (s 27).

The proprietor must also ensure that his trade mark is used in such a way as to preserve its validity.

- ☐ He must use it in accordance with any conditions entered in the register. Failure to do so can result in the trade mark being removed for breach of a condition (s 26).
- ☐ The proprietor must use his trade mark in such a way as to preserve its capability of distinguishing. He must, for example, ensure that his trade mark is used as a brand name only and not as the ordinary name of the goods or services concerned. Generic use of a trade mark can destroy its capability of distinguishing and result in its removal from the register.
- ☐ The proprietor must never use or permit his trade mark to be used in a misleading manner. A trade mark may be removed from the register if it is likely to cause deception or confusion as a result of the manner in which it is used (s 10(13)). A proprietor must therefore exercise effective control over the use of his trade mark by licensees. He must also take care to ensure that no deception or confusion is likely to arise when transferring (assigning) a trade mark to a new owner (s 39(4)).
- ☐ A proprietor must take immediate steps to prevent any imitation of his trade mark by others.

Term of protection: renewal

Article 18 of the TRIPS Agreement provides as follows:

‘Initial registration, and each renewal of registration, of a trade mark shall be for a term of no less than seven years. The registration of a trade mark shall be renewable indefinitely.’

In terms of the South African Trade Marks Act the date of registration of a trade mark is the date on which the application for its registration was lodged at the Trade Marks Office (s 29). The registration endures for a period of 10 years from that date and is renewable for 10 year periods upon application for renewal by the registered proprietor (s 37). This is in accordance

with article 13(7) of the TLT). In the case of convention applications, the date of registration is the date of the first application in a convention country (s 63(3)). However, for purposes of renewal, the 10-year period runs from the date of lodgement of the application for registration in South Africa (s 37(2)).

If a registration is not renewed after the expiry of any 10-year period, the Registrar may remove it from the register (s 37(3)).

The Registrar may restore a registration which has been removed if he is satisfied that it would be just to do so. A mark which has been removed for non-renewal is deemed to be a mark still on the register for the purposes of section 10(14), for a period of one year following the date of expiry of the last registration. However, the Registrar is entitled to disregard such registration if he is satisfied that there has been no bona fide use of the trade mark during the two years immediately preceding the date of expiry of the last registration (s 37(4)). As in the case of trade mark applications, the TLT sets out the details which should be contained in an application for renewal of a registration. An application for renewal is made by filing a request for renewal in the prescribed form between six months prior to and six months after the expiration of the registration (see Rule 8 of the TLT). The application must be accompanied by the prescribed renewal fees. No reproduction or other identification of the mark, the furnishing of evidence to the effect that the mark has been registered or renewed in another country or the furnishing of evidence concerning use of the mark may be required (see article 13(4) of the TLT).

Activity 7.5

What is the duration of a trade mark registration under your domestic legislation?