

Study unit 4

Formalities for filing a trade mark application

Overview

In this study unit, you will find out why you should register a trade mark, how a trade mark office functions, and how to complete an application form for the registration of a mark. We will explain what needs to be taken into account when you complete an application form, and how to determine the correct class and specification for the trade mark. We will also deal with the different kinds of application and registration you might encounter.

Learning outcomes

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

- ☐ explain how a trade mark office functions
- ☐ be able to complete a trade mark application form

Setting the scene

Thandi's restaurant becomes very successful, and she decides to open a branch in another city. She comes to you, her attorney, for advice on whether she should register the restaurant's name, Crunchy Munchy, as a trade mark.

Discussion

Why should you register a trade mark?

Trade marks had their origin at common law, and the common law actions for passing off and unlawful competition remain available despite the existence of legislation providing for the registration of marks. Why then register a trade mark if it can be protected at common law? As stated in unit 1.3, protection of marks in terms of the common law is expensive and protracted, and failure to register a trade mark means that others are not able to make sure that they are not encroaching on existing trade mark rights.

So registration is a convenient and relatively inexpensive method of ensuring the safety of a trade mark which is either in use or proposed to be used. Once a trade mark has been registered, a statutory infringement action is available against anyone who uses the same or a similar mark on goods or services in respect of which the mark has been registered, and it is not necessary to prove public deception or confusion for the action to be successful.

In addition, the trade mark register is prima facie proof of the validity of the trade mark and title to the mark.

Activity 4.1

Explain to Thandi why she should register a trade mark.

Discussion

International attempts to harmonise registration procedures

The Paris Convention is the cornerstone of international cooperation regarding the protection of trade mark rights. Member countries are obliged to accord to nationals of other member countries the same rights, privileges and remedies as regards the protection of trade marks as they accord their own nationals. However, the Paris Convention does not deal with formalities as such, but merely sets out broad general requirements, and states that the conditions for filing and registration are determined by the domestic legislation of member countries (article 6). It also states that, while service marks must be protected, member countries need not register them (article 6^{sexies}).

The Trademark Law Treaty is the only international treaty thus far that deals pertinently with administrative harmonisation. Its aim is to simplify registration procedures. Some of the most important features of this treaty are:

- ☐ initial registration and renewal terms of 10 years
- ☐ protection for service marks
- ☐ authentication and legalisation of documents is not required, and documentation is limited
- ☐ multi-class applications may be filed

South Africa is not a signatory of this treaty, as South African trade mark legislation does not make provision for multi-class applications (single applications which cover multiple international classes).

Activity 4.2

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- ☐ If you are a South African student, determine whether South African legislation complies with the features of the TLT which are listed above.
 - ☐ If you are not a South African student, determine whether your country is a signatory of the TLT. If it is not, determine whether your local legislation complies with the features of the TLT which are listed above.

Discussion

Registry of trade marks

The Registrar of Trade Marks

In this unit, we will deal with South African trade mark office procedure.

Section 5 of the South African Trade Marks Act provides for the establishment of a Trade Marks Office in Pretoria, the administrative capital of South Africa. (In practice it is combined with the Patents and Designs Offices.) A public service official known as the Registrar of Trade Marks heads the Trade Marks Office (s 6). He is assisted by one or more deputy registrars and one or more assistant registrars. All applications for the registration of trade marks must be addressed to the Registrar

(s 16).

During proceedings before the Registrar, he has equivalent powers and jurisdiction to a single judge in a civil action in the High Court. When the Act does not deal with a procedural matter which arises during such proceedings, the rules governing High Court procedure must be followed. Proceedings before the Registrar are conducted at the trade marks office. If a party to the proceedings is neither resident nor carrying on business in South Africa, the Registrar may order him to give security for the costs of the proceedings. A costs order by the Registrar is taxed and enforced as if it were a costs order made by a High Court judge.

The Registrar also has the power to grant extensions of time whenever time limits are specified in the Act. He may permit amendments of pending applications. Finally, whenever he exercises a discretionary power, he may not exercise that power adversely without hearing the person affected.

The trade mark register

A register of trade marks in which details of registered marks are entered is kept at this office (s 20). This register is open to the public. It must contain particulars of:

- ☐ applications to register trade marks
- ☐ registrations of trade marks, with names and addresses for service of the proprietors and registered users; the dates of registration, any renewals and expiry
- ☐ disclaimers and other conditions
- ☐ endorsements, including endorsements of deeds of security
- ☐ assignments, transmissions, and attachments
- ☐ other prescribed information or particulars which the registrar thinks necessary (regulation 21).

The register contains details of trade marks registered under both the 1963 and the 1993 Acts. The 1963 Act made provision for Part A and Part B registrations — a Part A registration was granted in respect of distinctive marks while a Part B registration was granted in respect of marks which were capable of becoming distinctive through use. This distinction has fallen away and marks previously registered in Part B now

have the same status as Part A marks.

The register is prima facie evidence of matters inserted in the register, and a certificate by the Registrar as to any entry in the register is prima facie evidence of the contents (ss 49 and 50). A copy or extract from the register, which has been certified and sealed by the Registrar, is admissible as evidence in all court proceedings without further proof or production of the original. The Act (s 51) also provides that, in all legal proceedings, the fact that a person is registered as proprietor is prima facie evidence of the validity of the original registration and of all subsequent assignments.

Because the South African register of trade marks is situated in Pretoria, the High Court situated in Pretoria always has jurisdiction to hear disputes concerning registered trade marks.

Activity 4.3

Find out where the trade mark office in your country is situated and what official is in charge of it. Write down any differences that you can see between your trade mark office and the South African one described here.

Discussion

The registration procedure

Searches

Before applying for the registration of a trade mark, the applicant is well advised to conduct a search of the register of trade marks to determine whether there are any confusingly or deceptively similar trade marks (ie conflicting registrations or applications) which could present an obstacle to the registration of his trade mark in terms of section 10(14), (15) and (17). Ideally, such a search should cover both word marks and the equivalent graphic representations, and should also include a search for similar company names.

A search is advisable to ensure that neither the Registrar nor other proprietors raise objections. The Registrar institutes his own search as to registrability on receipt of any trade mark application to determine whether any registered marks or applications already on record might be in conflict with the new application in terms of section 10.

Formalities

The applicant applies for the registration of a trade mark in the form prescribed by the trade mark regulations, and lodges his application with the Registrar of Trade Marks.

Form TM 1, which appears together with other official forms in schedule 2 of the trade mark regulations, must be franked with the official fee and lodged in triplicate. It must be signed and dated by the applicant or his agent and a separate application must be filed for each mark in each class. Every application must contain a representation of the mark, and if the mark consists of anything more than letters or numerals in normal script, additional representations of the mark must be filed. Regulation 13 contains full details of the requirements which must be met when filing such representations.

If an application contains a word or numeral in something other than roman characters, a translation must be endorsed on the application form. In addition, if an application contains a word in a language other than one of the 11 official languages of South Africa, the Registrar may ask for a translation and require it to be endorsed on the application form.

Specifications and class headings

The most important aspect of any trade mark application is the specification of goods or services. Section 11(1) of the Act provides that a trade mark must be registered in respect of goods or services falling in a particular class 'in accordance with the prescribed classification'. This classification is an international system known as the Nice classification, and so all signatories to the Paris Convention use this system. All goods and services fall into one of 45 classes, the headings of which

are set out in schedule 3 to the regulations. The applicant applies to register his trade mark in one or more of these classes, and specifies in his application those goods or services falling in the class or classes in which he applies and for which he claims protection. It is to be noted that if application for the registration of a trade mark is made in more than one class, a separate application with its own specification is required for each class in which application is made.

The correct specification is essential to protect trade mark rights. A registered trade mark is only protected against infringement by use of the same or a similar mark 'in relation to goods or services in respect of which the trade mark is registered' (s 34(1)(a)) or in respect of 'goods or services which are so similar to the goods or services in respect of which the trade mark is registered, that in use there exists the likelihood of deception or confusion' (s 34(1)(b)). Clearly, a badly drafted specification will make infringement proceedings more difficult to institute.

But this problem cannot merely be met by drafting an extremely wide specification. First, a trade mark is vulnerable to removal or partial removal if it was registered without a bona fide intention to use the mark in respect of all or certain of the goods or services for which registered (s 27(1)(a)). Second, a trade mark may be partially or totally removed from the register if there has been no use of the mark in respect of certain goods or services for a period of five years (s 27(1)(b)).

Activity 4.4

- ☐ Determine what international class heading is appropriate if Thandi wants to file an application for the mark CRUNCHY MUNCHY for restaurant services.
- ☐ What classes would you look at if you conducted a search to ascertain whether conflicting registrations existed?
- ☐ Complete a form TM1, or your local equivalent, for this application.
- ☐ What additional material must you provide if 'Crunchy

Munchy' is to be registered in a specific fancy script? (See regulation 13 or your local equivalent.)
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Discussion

Convention applications

The International Convention for the Protection of Industrial Property was concluded in Paris in 1883. The Convention has been revised six times, the last revision being in Stockholm in 1967. South Africa joined the Convention, which currently has about 140 members, in 1947. The Convention of Paris is the cornerstone of international cooperation regarding the protection of industrial property rights including those in trade marks. In terms of article 2 of the Convention, member countries are obliged to accord to nationals of other member countries the same rights, privileges and remedies as regards the protection of trade marks as they accord their own nationals. Article 4 provides for a right of priority for six months as from the date of filing a first application in a convention country. A person who has applied for registration of a trade mark in a member country is entitled to registration in other member countries in preference to other applicants, provided application is made within the six-month priority period. The date of filing the original application will be regarded as the date of filing the later convention applications in the other member countries. Section 63 of the Trade Marks Act gives effect to the important provisions of article 4 of the convention, and operates as follows.

Should an applicant for the registration of a trade mark in South Africa, prior to lodgement of the South African application, have filed an application to register the trade mark in one or more of the member countries of the convention,

- ☐ provided the South African application was filed within six months of the earliest of the applicant's applications for the registration of the trade mark in a convention country, and
- ☐ provided the applicant claims convention priority in his application form filed in South Africa, and
- ☐ provided the applicant proves, in the prescribed manner, that the earliest application in a convention country (being the application upon which the claim to convention priority is based), does exist,

then —

- ❑ the South African application will have the same date as the earliest application in a convention country;
- ❑ the applicant shall be entitled to registration of the trade mark in priority to other applicants who have filed after the earliest application in a convention country.

The first consequence can play an important role in the event of conflicting concurrent applications whilst the second consequence mentioned gives rise to a number of questions relating to claims of prior use (see ss 10(15) and 10(16)). It must be noted that damages for the infringement of a trade mark registration in respect of which convention priority was claimed can only be recovered for infringing use which took place after the advertisement of the acceptance of the application for the registration of the mark (s 63(3)(b)).

Activity 4.5

What information should be given to the registrar of Trade Marks if you wish to claim convention priority for a trade mark application? (Look at regulation 12 of the South African Trade Mark regulations, or determine whether your country has an equivalent provision.)