IPSP044 - Essential Trade Mark Law

Assignment 03 - 788684

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NOTE

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[1] This is a footnote.

(a) Advise Dr Genius whether Dr De Ville is infringing his patent rights.

As per [section 45(1)][1] and [Article 28(1)][2], Dr Genius' patent grants him monopoly and exclusive rights to exclude others from making *(manufacture, fabrication and production of)*, using *(incorporating into motor vehicles, and possession with intent to sell)*, exercising *(making use of and incorporating into motor vehicles)*, disposing of (distributing, marketing and selling), or offering to dispose of *(offering to distribute, market or sell)* his patented invention.

Therefore anyone who performs any one of these acts, except where specifically qualified by a statutory provision such as a license [section 53][1] and [Article 28(2)][2], without consent of patentee, infringes the patent, and the patentee is entitled to enforce his patent rights by instituting proceedings against such an infringer, [section 65(1)][1] and [Article 41(1)][2].

Traditionally, in manufacturing and marketing a similar device which embodies all of the essential features or characteristics of the patent claim, Dr Genius would have been able to seek remedies against Dr De Ville for infringement as per the *'doctrine of pith-and-marrow'*, as worded in *Frank & Hirsch (Pty) Ltd v Rodi Wienenberger Aktiengesellschaft* [3].

The fact that Dr De Ville has manufactured and marketed a device that may have a similar result or similar fundamental operation to that of Dr Genius, has no bearing on infringement. For any remedy against infringement, Dr Genius will need to demonstrate that **all** the essential components or integers that are present in his patent claim, are indeed present in the allegedly infringing article, collectively acting in the manner claimed.

In South African law this is referred to as the *'doctrine of purposive construction'*, and was particularly well articulated in *Raubenheimer and another v Kreepy Krauly (Pty) Ltd and another* [4], where the court held that the swimming pool cleaning device of the respondent did not infringe appellants' patent where one of the essential integers of a claim in the appellants' patent was not present in the respondents' device, even though the two devices achieve the same result and have the same fundamental operation.

Should Dr Genius be able to demonstrate that Dr De Ville's device comprises all the essential or integral components of his patent, the manner claimed, then Dr Genius may be see relief in the form of and interdict or injunction [section 65(3)(a)][1] and [Article 44][2], delivery of infringing product or articles of which infringing product forms an inseparable part [section 65(3)(b)][1], damages [section 65(3)(c)][1] and [Article 45][2], through royalties in lieu of damages [section 65(6)][1], or disposal or destruction of the infringing articles, outside the channels of commerce and without compensation [Article 46][2].

(b) Advise Aroma Company whether the mark qualifies for registration as a trade mark. [25]

As per the definitions of [section 2(1)][5] and given that the Republic is a Paris Convention Member State, [article 15(1)][2], [article 1(2)][6], it follows that *'TROPIC GLOW'* will be understood to be a **mark**, in that it is either a name or sign capable of being represented graphically. Moreover it constitutes a **trade mark**, as it has been proposed by Aroma Company, in relation to distinguishing their trade or use from other goods or services connected in the course of trade regarding *'soaps, perfumery, essential oils and cosmetics'*. Therefore it follows as per [section 9(1)][5], that TROPIC GLOW qualifies for registration as trade mark, subject to limitations, in relation to use within those limitations, and thus the unregistrability conditions of the provisions of [paragraphs (1), (4), (5), (8), (9), (10) or (11) of section 10][5], cannot be

applied.

As per [section 2(4)][5], *'use'* or *'proposed use'* shall be construed as the use of a visual representation of the mark [section 2(2)(a)][5], as pertaining to physical form or other relation in terms of goods[section 2(3)(a)][5], or as pertaining to the use thereof in any relation to the performance of any services[2] [section 2(3)(b)][5]. Provided that no others claim priority to the TROPIC GLOW mark at the of application for registration, then as per [section 9(2)][5], TROPIC GLOW shall be considered to be capable of distinguishing within the meaning described above. Thus also negating the unregistrability conditions of the provisions of [paragraphs (2), (3) or (6) of section 10][5]

As per [section 11(1)][5], the TROPIC GLOW mark is proposed to be registered in respect of goods falling in a particular class, namely class 3, hence [section 10(4)][5] cannot be applied. Moreover TROPIC GLOW does not include or consist of the name or representation of a person [section 12][5], hence there would be no need to furnish the registrar with additional legal consent from any parties. There would be no need for the registrar to impose honest concurrent use conditions and limitations [section 14(1)][5], as the mark TROPIC GLOW does not offend against the provisions of [paragraphs (6), (14), (15) or (17) of section 10][5]. It has already been demonstrated that TROPIC GLOW contains matter which is indeed capable of distinguishing within the meaning of [section 9][5], hence registration shall be subject to neither disclaimer nor memorandum [section 15][5], and Aroma Company shall not be required to disclaim any right to the exclusive use of all or any portion of TROPIC GLOW, [section 15(a)][5].

Provided that TROPIC GLOW does not inherently [section 10(12)][5] or from the manner of its use [section 10(13)][5] , likely to deceive, cause confusion or offend any class of person, it cannot be deemed unregistrable. Moreover provided that TROPIC GLOW does not constitute an identical or similar trade mark registration [section 10(14)][5] or prior application [paragraphs (15) and (16) of section 10][5], where use of TROPIC GLOW would likely amount to deceit or confusion in relation to the goods and services of a different proprietor or applicant, respectively, without their consent; the registrar cannot refuse registration on those grounds. Lastly provided TROPIC GLOW does not constitute an identical or similar mark already registered and well known in the Republic, [section 10(17)][5], the registration cannot be refused on the grounds of unfair competition through the dilution of good will.

(c) Advise Aroma Company whether any of these prior applications/registration will present an obstacle to the registration of its marks. [25]

(d) What must Aroma Company establish in order to succeed with any infringement action against Beaver Company? [25]

(e) Advise Aroma Company whether any formalities are necessary and/or advisable to protect its trade mark rights. [25]

References

[1] Patents Act No. 57, 1978. [Online]. Available: http://www.wipo.int/wipolex/en/details.jsp?id=6256.

[2] Agreement on Trade-Related Aspects of Intellectual Property Rights, 1994. [Online]. Available: https://www.wto.org/english/tratop_e/trips_e/trips_e.htm.

[2] Also referred to as service marks, [article 1(2)][6]

[3] *Frank & Hirsch (Pty) Ltd v Rodi Wienenberger Aktiengesellschaft*, 1960 (3) SA 747 (A).

[4] *Raubenheimer and another v Kreepy Krauly (Pty) Ltd and another*, 1987 (2) SA 650 (A).

[5] Trade Marks Act No. 194, 1993. [Online]. Available: http://www.wipo.int/wipolex/en/text.jsp?file_id=130446.

[6] Paris Convention for the Protection of Industrial Property, 1883. [Online]. Available: http://www.wipo.int/treaties/en/text.jsp?file_id=288514.