

# Study unit 8

## Rectification

### Overview

In this study unit we will discuss the amendment of the trade mark register as well as the alteration of a trade mark registration. We will also deal with the loss of registration of a trade mark. You will find out how a trade mark registration may be cancelled for breach of or failure to observe a condition. You will also find out how a trade mark registration may be cancelled on the grounds of invalidity or non-use.

### Learning outcomes

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

- ☐ determine the circumstances in which an entry in the register may be amended
- ☐ determine the extent to which a trade mark registration may be altered
- ☐ determine whether a trade mark may be removed from the register on the ground of invalidity
- ☐ determine whether a trade mark may be removed from the register on the ground of non-use

### Discussion

#### *Amendment of the register*

The Registrar may correct any error in the register made by an official of his office (s 23(1)). On the request of the registered proprietor of a trade mark, the Registrar may amend or alter the register by -

- ☐ correcting any error in the name or address of the proprietor or any error in the register relating to such trade mark
- ☐ altering the name or address for service of the registered proprietor
- ☐ cancelling the registration of the trade mark  
deleting any goods or services for which the trade mark is registered

- ❑ entering a disclaimer or memorandum relating to the trade mark which does not extend the rights given by registration (s 23(2); s 64 of the UK Trade Marks Act 1994).

The Registrar may also enter in the register any change in the name or address of a registered user (s 23(3)).

### *Alteration of a registered trade mark*

The registered proprietor of a trade mark may apply to the Registrar for leave to add to or alter the trade mark in any manner not substantially affecting its identity. It is left to the discretion of the Registrar to refuse or grant the leave applied for (s 25(1); s 44 of the UK Trade Marks Act 1994). Any grant of the leave applied for must be advertised to allow interested persons the opportunity to object to the addition or alteration (s 25(2)). (See *Adcock Ingram Consumer Products Ltd v Dhansooklal Jeenabhai Mody t/a Black Magic* [1997] 3 All SA 125 (T).)

#### *Activity 8.1*

Thandi changes the typescript on her packaging. The whole package is registered as a container mark. Must she file a new application for the packaging with a different typeface?

#### *Discussion*

#### *Removal or variation of a trade mark registration for breach of condition*

If the registered proprietor or user of a trade mark breaches or fails to observe any condition entered in the register in relation to that trade mark, any interested person may apply to the Registrar or the court for an order removing or varying the registration of the trade mark (s 26). The Registrar is also vested with locus standi to bring an application to court.

## *Rectification of the register*

In the event of –

- ☐ the non-insertion in or omission from the register of any entry,
- ☐ any entry wrongly made in the register,
- ☐ any entry wrongly remaining in the register,
- ☐ any error or defect in any entry in the register

any interested person may apply to the Registrar or court for the rectification of the register by making, removing or varying the entry (s 24(1); s 47 of the UK Trade Marks Act 1994).

The Registrar is also vested with jurisdiction to apply to court for the rectification of the register in the event of any entry relating to the registration, assignment or transmission of a trade mark having been secured mala fide or by misrepresentation or having been wrongly made or wrongly remaining on the register (s 24(3)).

### *The non-insertion in or omission from the register of any entry*

This covers matters such as disclaimers and conditions of registration. (See *Cadbury (Pty) Ltd v Beacon Sweets and Chocolates (Pty) Ltd* 2000 (2) SA 771 (SCA)).

### *Any entry wrongly made in the register*

This relates to the facts existing at the time of registration of the trade mark. An application for rectification can be brought under this heading on any of the grounds on which an application for registration may be refused (s 10). (See *Staples & Wire Goods Co (Pty) Ltd v Safragraf* 1977 (1) SA 1 (T).)

### *Any entry wrongly remaining in the register*

This covers facts existing at the time of the application for rectification. An application under this heading can be brought on the ground of any defect in the registration where such defect persists. It can also be brought on the ground that the trade mark is no longer capable of distinguishing or has been abandoned or is deceptive or has been used in a manner which is likely to cause deception or confusion (See

*Ritz Hotel Ltd v Charles of the Ritz Ltd 1988 (3) SA 290 (A); Image Enterprises CC v Eastman Kodak Co 1989 (1) SA 479 (T); Luster Products Inc v Magic Style Sales CC 1997 (3) SA 13 (A); Cadbury (Pty) Ltd v Beacon Sweets and Chocolates (Pty) Ltd 2000 (2) SA 771 (SCA).*

*Any error or defect in any entry in the register*

This covers errors made by the Trade Marks Office as well as by the proprietor or his agent, provided that such errors do not substantially affect the registration.

*Removal of a trade mark from the register on the ground of non-use*

The TRIPS Agreement recognises the right of member countries to require use of a trade mark to maintain a registration. Article 19(1) provides that if use is required to maintain a registration, the registration may be cancelled only after an uninterrupted period of at least three years of non-use, unless valid reasons based on the existence of obstacles to such use are shown by the trade mark owner. Circumstances arising independently of the will of the owner of a trade mark which constitute an obstacle to the use of the trade mark, such as import restrictions on or other government requirements for goods or services protected by the trade mark, shall be recognised as valid reasons for non-use. Furthermore, use of a trade mark by another person, subject to the control of the trade mark proprietor, shall be recognised as use of the trade mark for the purpose of maintaining the registration.

In terms of the SA Trade Marks Act, any interested person may apply to the Registrar or the court for the removal of a trade mark from the register in respect of any of the goods or services for which it is registered on the ground either —

- ☐ that the trade mark was registered without any bona fide intention on the part of the applicant that it should be used in relation to those goods or services and there has in fact been no bona fide use thereof in relation to those goods or services up to the date three months before the date of the application for removal
- ☐ that up to the date three months before the date of the

- application for removal, a continuous period of five years or longer has elapsed from the date of the issue of the certificate of registration during which the trade mark was registered and during which there was no bona fide use thereof in relation to those goods or services
- that, in the case of a trade mark registered in the name of a body corporate, or in the name of a natural person, such body corporate was dissolved, or such natural person died, not less than two years prior to the date of the application for removal and that no application for the registration of an assignment of such trade mark has been made (s 27(1); s 46 of the UK Trade Marks Act 1994)

The first ground for removal is related to the ground for refusal that the applicant has no bona fide intention of using the mark as a trade mark (see s 10(4)). It should be noted that the intention on the part of the applicant to use the mark includes an intention that the trade mark be used by a body corporate to be formed (s 19(2)).

To avoid removal, the proprietor of the trade mark must show that there has been relevant use of his mark (s 27(3); *AM Moolla Group Ltd v The Gap Inc* 2005 (6) SA 568 (SCA)). In this regard the special provisions in the Act relating to 'use' are important. Note that any licensed use is deemed to be use by the proprietor (s 2(4)). Use of an associated mark may be accepted as proof of the use of the trade mark (s 31(1)), and use of the whole of a registered mark may be accepted as the use of any trade mark being a part of it (s 31(2)). Finally, the use of a trade mark for export trade is deemed to be use of the trade mark within South Africa (s 64).

To constitute bona fide use, the proprietor must use the trade mark for the purpose primarily of protecting, facilitating and furthering his trade in the goods or services for which it is registered and not for any ulterior purpose merely to protect it from removal (*Rembrandt Fabrikante & Handelaars (Edms) Bpk v Gulf Oil Corporation* 1963 (2) SA 10 (T), 1963 (3) SA 341 (A); *Wistyn Enterprises v Levi Strauss & Co* 1986 (4) SA 796 (T); Webster & Page par 13.27).

For the purposes of an application for removal on the ground of non-use, an applicant cannot rely on any non-use that is shown to have been the result of special circumstances in the trade and not of any intention not to use or to abandon the trade mark in relation to the goods or services to which

the application relates (s 27(4)). Circumstances arising independently of the will of the owner of a trade mark which constitute an obstacle to the use of the trade mark, such as import restrictions on or other government requirements for goods or services protected by the trade mark, shall be recognised as valid reasons for non-use.

Note that use of the trade mark within a period of three months before the application for removal, will not save the mark. This gives the person seeking removal time to inform the proprietor of his intention to apply without enabling him to defeat the application for removal by starting use.

A trade mark which is entitled to protection under the Paris Convention as a well known mark (see s 35(1)) cannot be removed from the register under the first and second grounds (s 27(5)).

The third ground for removal provides a means of facilitating proof of actual abandonment of a trade mark by creating a presumption of abandonment upon proof of the certain facts (see *Ex parte Ziman* 1970 (1) SA 164 (T)). The presumption of abandonment can be rebutted by proof that the trade mark is used or proposed to be used by a successor in title of the registered proprietor (s 27(2)).

Once an applicant has proved non-use he is *prima facie* entitled to have the offending registration removed. The Registrar or the court retains a general discretion to refuse removal. However, removal will only be refused in exceptional circumstances (see *McDonald's Corporation (Pty) Ltd v Joburgers Drive-Inn Restaurant (Pty) Ltd* *McDonald's Corporation (Pty) Ltd v Dax Prop CC*; *McDonald's Corporation (Pty) Ltd v Joburgers Drive-Inn Restaurant (Pty) Ltd & Dax Prop CC* 1997 (1) SA 1(A)).

### Activity 8.2

Thandi has been trading for a few years when she is approached by Peter. Peter tells her that he is the owner of a registration for MUNCHY CRUNCHY in class 42, and proposes to apply for expungement of her mark, on the grounds of his prior registration, unless she pays him half a million rands.

On what basis would Peter apply for expungement of Thandi's trade mark?

Thandi discovers that, although Peter's mark has been on the register for 9 years, he has not used it for the past six years. What can she do to protect her registration?