

Study unit 5

The prosecution of a trade mark application

Overview

In this study unit, we will discuss the prosecution of trade mark applications. We will discuss the examination of the application for compliance with the requirements for registration, acceptance and advertisement of the application, opposition procedure, and the registration of a trade mark.

Learning outcomes

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

- ☐ understand how a trade mark application is prosecuted to acceptance
- ☐ understand how and on what grounds an application may be opposed
- ☐ understand how a trade mark is registered

Setting the scene

Thandi decides to use the name 'Crunchy Munchy' for her restaurant. She approaches you, her attorney, and asks you to register the name as a trade mark. You file an application in class 42 and wait for the registrar's response.

Discussion

Examination

The Registrar examines the application in order to ascertain whether the mark satisfies the requirements of the Trade Marks Act (s 16 and reg 15 of the South African Trade Mark Regulations 1995).

One can distinguish between two trade mark registration systems — a deposit system and an examination system. Under an examination system, the Registrar examines the

application for compliance with formal requirements, inherent registrability as well as for conflicts with other marks. This examination includes a search of the records of the Trade Marks Office in order to ascertain whether the trade mark applied for is confusingly or deceptively similar to a trade mark already on the register or the subject of a pending application. The United Kingdom and South Africa, as well as most countries whose trade mark law has been influenced by British trade mark law, have examination systems. Under a deposit system, the Registrar examines the application for compliance with formal requirements only. If he is satisfied that the application complies with the prescribed formalities, he will register the trade mark. Objections based on inherent registrability and conflicts with other marks do not arise at the examination stage. They can only be raised in opposition or cancellation proceedings. The validity of a registered trade mark is therefore not raised at the examination stage but is only tested when a mark is sought to be enforced. In some jurisdictions, notably those in Europe, there is an extended examination which covers compliance with formal requirements as well as inherent registrability.

Activity 5.1

- ☐ Which three matters will the registrar examine when deciding whether to accept the application for Crunchy Munchy?
- ☐ Determine whether your domestic trade mark legislation provides for an examination or a deposit system.

Discussion

Acceptance

The application having been examined, the Registrar may refuse the application, or may accept it absolutely or subject to such amendments, modifications, conditions or limitations (s 16(2)). He may, for example, require a disclaimer or that the trade mark applied for be associated with another mark on the register (The conditions, limitations and other restrictions that

may be imposed by the Registrar are discussed in Study Unit 8). If the application is refused, or accepted subject to the effecting of modifications, the Registrar must notify the applicant accordingly. The applicant then has the opportunity to amend the application or to make representations to the Registrar.

Where provision is made for multi-class applications, a single application with a single specification may be filed covering several classes. Such application results in a one and the same registration (see article 6 of the TLT). If objections to an application are raised in respect of certain goods or services, the initial application may be divided into two or more divisional applications. The unchallenged divisional application may then proceed to acceptance and registration without delay. Only when the objections to the challenged divisional application have been resolved, may it proceed to acceptance and registration.

Activity 5.2

- ☐ Does the South African Trade Marks Act provide for multi-class applications?
- ☐ Determine whether your domestic trade mark legislation makes provision for such applications.

Discussion

Advertisement

Once the Registrar has accepted the application, the applicant or the Registrar causes acceptance of the application to be advertised in the Trade Mark Journal (article 15(5) of the TRIPS Agreement; s 21 of the SA Trade Marks Act). The application is open to opposition by interested parties for a prescribed period (usually about three months from the date of advertisement of acceptance).

Opposition

An application may be opposed on any one or more of the grounds on which a trade mark registration may be refused. Opposition is usually based on either a lack of inherent registrability or conflict with other marks or both.

Opposition is commenced by the timeous filing of a notice of opposition. The notice must include a statement of the grounds of opposition. The applicant is given the opportunity to reply. Once all the pleadings have been filed, the matter is argued on behalf of both parties at the a hearing before the Registrar. The decision of the Registrar is subject to appeal (se article 62 of the TRIPS Agreement). Once any opposition has been resolved in favour of the applicant, the challenged application may proceed to registration.

Activity 5.3

Tsepo owns a restaurant called 'Munching Mouthfuls'. He feels that Thandi's proposed mark is confusingly similar to his trade mark. What should Tsepo do if he wants to prevent the registration of Thandi's mark?

Discussion

Registration

If the application has been accepted and advertised, and either

- ☐ has not been opposed, or
- ☐ has been opposed and has then been granted,

the Registrar registers the trade mark and furnishes the applicant with a certificate of registration. The date of registration is deemed to be the date upon which the application for registration was lodged at the Trade Marks Office (s 29). In the case of convention applications, the date of registration is the date of the first application in a convention country (see s 63).