

FEEDBACK ON ACTIVITIES

Activity 1.1

The industrial revolution, which ended personal contact between manufacturers and purchasers.

The owner of a mark could protect the reputation she had acquired in the trademark and so prevent others from falsely representing that their goods had some connection with her goods.

Activity 1.2

Each time the owner of a mark instituted proceedings to protect the mark, she had to prove use of the mark and the existence of a reputation in the mark.

Activity 1.3

Refer to the legislation listed above.

Activity 1.4

international cooperation for trademark registrations
the simplification of registration procedures
the Benelux Treaty
complete this yourself

Activity 2.1

No. The name is completely descriptive and so incapable of distinguishing the product concerned from similar products (see section 10(2)(b) of the 1993 Act).

Complete this yourself.

It is defined in terms of its distinguishing function in current trademark legislation.

Activity 2.2

This is possible. But note section 12 of the 1993 Act.

This is possible in South African law. The definition of 'mark' includes the phrase 'container for goods'. Note section 10(11) of the 1993 Act.

If your Trademarks Act has a definition section, quote the relevant definition here.

Activity 2.3

Yes. This would be included in the phrase 'in physical or other relation to' in section 2 of the 1993 Act. See also *Shalom Investments (Pty) Ltd v Dan River Mills Inc* 1971(1) SA 689 (A) for the identical fact situation.

Activity 2.4

It is possible that QUICK CHICK can be viewed as descriptive of the service Tandi is offering and so not inherently capable of distinguishing. (Note that, if this name was already in use, it might be registrable, because it may have become capable of distinguishing as a result of extensive use.)

PRETORIA CHICKEN is descriptive if used in Pretoria and could be misleading if used elsewhere.

An invented word is inherently capable of distinguishing.

A word which bears no relation to the goods or services concerned will usually be inherently capable of distinguishing.

This mark alludes to the service but remains inherently capable of distinguishing.

Activity 2.5

See sections 42 and 43 of the 1993 Act, or your domestic equivalent.

Activity 3.1

'Bona fide' connotes good faith.

Yes. The definition of 'trade mark' in section 2 of the 1993 Act states that it connotes a mark 'used or proposed to be used' by a person.

There are various examples. The purchaser of an existing mark will have a bona fide claim to proprietorship, as will a person who has developed a mark but not yet used it.

See the definition of 'trade mark' in section 2 and also section 19(1) of the 1993 Act, or your domestic equivalent.

Activity 3.2

No. He cannot claim to be bona fide and so the mark is unregistrable *in his name* in terms of section 10(3) of the 1993 Act.

A distributor cannot have a better claim to a mark than a manufacturer.

Activity 3.3

See section 10(6) and 35(1) of the 1993 Act, or your local equivalent.

It is unlikely that such use would lead to the mark being 'well-known' in South Africa.

If the mark is well-known in South Africa in terms of section 35(1), she cannot register the mark in her

name, despite her bona fides.

Activity 3.4

See section 2(2)–(4) of the 1993 Act, or find your domestic equivalent.

Yes; see section 19(1) of the 1993 Act.

No. Use of a mark includes ‘physical or other’ relation to the goods or services. See the examples given above.

Yes. This would be a service mark.

See section 2(1)(xxi) of the 1993 Act, or your domestic equivalent.

Activity 4.1

Registration is an inexpensive way of protecting a trademark, as infringement by use of the same or a similar mark on the same or similar goods or services is prohibited.

Activity 4.2

10 year renewal term (section 37(1)); protection for service marks (section 2(1)(xxiii)); authentication (regulation 59); multi-class applications not possible.

Follow the above example using your domestic legislation.

Activity 4.3

Do this yourself.

Activity 4.4

Class 43.

As Thandi intends to provide restaurant services, it is advisable to check the food and beverages goods classes 29–33, and possibly also the printed matter (16) and clothing (25) classes.

See the attached form TM1.

A representation of the mark as it will be used must be attached to Form TM1. In addition, two further copies of the mark must be submitted (these are to paste in the register). See regulation 13 for more specific instructions.

Activity 4.5

A certified copy of the Convention application must be lodged within 3 months of the filing of the South African application. This copy must be accompanied by a verified translation, if it is not in one of the official languages of South Africa.

Activity 5.1

The registrar will make sure that all formalities have been complied with. The inherent registrability of the mark will then be considered, and the register will be checked for possible conflicting marks.

South Africa has an examination system. Find out if the registry of your country only compliance with formal requirements, or whether it considers substantive requirements for registrability too.

Activity 5.2

No.

Answer this question yourself.

Activity 5.3

He must file form TM3 at the office of the registrar in which he sets out the order he seeks (refusal of the mark CRUNCHY MUNCHY) and the section of the Act on which he relies for this order.) See the attached form TM3.

Activity 6.1

Summarize the provisions of section 10(1)–(5) and (7)–(13) of the 1993 Act, or your domestic equivalent, in your own words.

This mark describes the goods to which it will be applied and so is not capable of distinguishing the goods in terms of section 9 (section 10(2)(a) of the 1993 Act).

This mark designates geographical origin if the goods are actually made in Belgium and so conflicts with section 10(2)(b) of the 1993 Act; if the goods are not made in Belgium, the mark is inherently deceptive (section 10(12) of the 1993 Act).

No. Thandi does not have a bona fide claim to proprietorship (section 10(3) of the 1993 Act).

It is probable that this mark is prohibited in terms of section 10(10) of the 1993 Act read with regulation 10(2).

Activity 6.2

Summarize the provisions of section 10(6), (12), and (14)–(17) of the 1993 Act, or your domestic equivalent, in your own words.

Thandi must file a TM3 notice of opposition based on the provisions of section 10(14) of the 1993 Act.

Barry can prevent Dali from registering the mark in terms of section 10(6) of the 1993 Act. This was not possible under earlier trademark legislation.

Activity 7.1

It is unlikely that the registrar will require consent as this is a common first name, not the name of a particular person.

The registrar will require consent, as the mark includes the name and representation of an actual person. As the person is dead, consent must be given by her legal representative (see section 12 of the 1993 Act).

Activity 7.2

It is probable that the registrar will require a disclaimer of the word 'crunch' and another of the word 'munch'. A disclaimer would read as follows:

'Registration of this mark shall give no right to the exclusive use of the word 'crunch' or of the word 'munch' separately and apart from the mark.'

Note that the combination of the two words remains protected. Also, while the disclaimer means that Thandi could not object successfully to a mark such as CRUNCHY COWBOY, a mark such as CRUNCHY LUNCHY would probably be viewed as likely to deceive because of its similarity.

Activity 7.3

Yes. Read section 30(1) of the 1993 Act carefully.

Section 15 of the 1993 Act deals with disclaimers and memoranda that define the rights under a registration, while section 16(2)(b) provides that the registrar may accept a mark subject to such 'amendments, modifications, conditions or limitations' as she thinks necessary. In addition, section 30 provides for the association of marks, and section 32(1) for colour limitations. The most usual limitations in terms of section 16(2)(b) are those that restrict a mark to use in a particular area or on particular goods or services.

Please look for equivalent provisions in your domestic legislation.

Activity 7.4

It is probable that this would be viewed as infringing use in terms of section 34(1)(b) of the 1993 Act.

It is unclear whether this would be viewed as infringing use, since, although restaurant staff sometimes wear t-shirts bearing the restaurant name, it is arguable whether t-shirts are 'so similar' to restaurant services that there is a 'likelihood of deception or confusion'.

It is unlikely that this would be viewed as infringing use, as computers are not 'so similar' to restaurant services that the 'likelihood of deception or confusion' could exist.

State the provisions of section 34(1) of the 1993 Act, or the corresponding provisions in your domestic legislation, in your own words.

Activity 7.5

Section 37(1) of the 1993 Act, read with section 37(2), provides for an initial registration period of 10 years (from date of filing) and, on renewal, further 10-year periods. Find the corresponding provisions in your domestic legislation.

Activity 8.1

Your answer will depend on whether the change of typescript will be viewed as 'substantially affecting the identity' of the registered mark. If she thinks that this comprises a minor change, she can apply to alter the mark in terms of section 25(1) of the 1993 Act. The registrar retains the discretion to grant or refuse the application. If the registrar feels that the identity of the mark is affected, a new application for the altered mark will have to be filed.

Activity 8.2

Peter can ask for rectification of the register in terms of section 24(1) of the 1993 Act on the ground that Thandi's mark is an entry wrongly made in the register in terms of section 10(14), because, at the time of registration of Thandi's mark, it was so similar to a registered mark already on the register that use of the two marks was likely to deceive or cause confusion.

Thandi can ask for the removal of Peter's mark from the register on the ground of non-use in terms of section 27(1)(b) of the 1993 Act, because of non-use for a continuous period of 5 years.

Activity 9.1

No. This will not protect her against a non-use allegation, as a mark must be used by its registered proprietor or user. More importantly, if the mark is owned by one person but used by another, the mark could be vulnerable to removal because of deceptive or confusing use.

See the attached form TM6.

In terms of section 39(1) of the 1993 Act, a mark may be assigned either with or without the goodwill of the business concerned in the goods in respect of which it has been registered.

This is possible in terms of section 39(2) of the 1993 Act. However, section 39(4) contains a proviso against deceptive or confusing use, so it is possible that the registrar will not sanction a partial assignment if her use of the mark on hamburgers will cause confusion or deception.

Activity 9.2

Yes. Section 41(1) of the 1993 Act allows this.

The bank must file a form TM6 with the registrar, together with a copy of the deed of security and proof that the form has been served on the registered proprietor and other interested parties. The registrar then records this endorsement in the register.

Yes. if a court grants an order against Thandi, her trade mark is viewed as an asset that can be sold in execution (section 41(2) of the 1993 Act).

Activity 9.3

Yes. A trade mark may be used by other persons with the consent of the proprietor in terms of section 38(1) of the 1993 Act. The fact that section 38(3) refers to registration as registered user in respect of 'all or any of

the goods or services' indicates that a licence may be granted for use on only some of the goods for which the mark is registered, provided, however, that such use is not deceptive or confusing.

Thandi must ensure that she is recorded as a registered user. This serves as public notice of her licence agreement and allows her to institute proceedings for infringement against use by others of the mark on the goods to which her licence relates, if the proprietor fails to do so (see section 38(3)–(7)).

Activity 10.1

As Thandi has not yet registered the mark, she is only able to institute an action for passing off at common law. To institute such an action she will have to prove, amongst other things, that she has a reputation in the mark. (Passing off is defined as 'a representation by one person that his business (or merchandise, as the case may be) is that of another, or that it is associated with that of another. . . ' (*Capital Estate & General Agencies (Pty) Ltd v Holiday Inns Inc* 1977 2 SA 916 (A) at 929). Passing off is dealt with in the module on Competition Law.)

Activity 10.2

This is the traditional form of infringement — use of the same or a similar mark in respect of the goods or services for which the mark is registered (section 34(1)(a) of the 1993 Act).

This is the wider form of infringement dealt with in section 34(1)(b) of the 1993 Act. Infringement will take place only if the court thinks that use of the mark in relation to food is so similar to use of the mark as a restaurant name that the use is likely to cause deception or confusion. This is an objective test in which the court will take various factors into account.

This is not infringement but use of the mark in a generic sense. This use can make the mark vulnerable to removal from the register because it is non-distinctive in terms of section 10(2)(c) of the 1993 Act.

This is a new form of infringement introduced in South Africa by section 34(1)(c) of the 1993 Act which is designed to protect marks against dilution by use on unrelated goods or services. Determine whether your domestic legislation contains similar provisions.

Activity 10.3

No — bona fide use of own name (section 34(2)(a) of the 1993 Act).

No — bona fide description (section 34(2)(b)).

No, in terms of section 34(2)(f). Although the two marks might be similar, Thandi's registration does not extend to cover such use by another because of the disclaimer entered against her registration.

Activity 10.4

Yes. The mark would qualify as a well-known mark in terms of section 35(3) of the 1993 Act.

Yes. Section 36(2) provides that continuous and bona fide use in South Africa from a period before 31 August 1991 will protect a mark from attack in terms of section 35(3).

This is debatable. For a mark to qualify as well-known, a South African court has held that it must be well-known to persons interested in the goods or services to which the mark relates. This court, dealing with the

McDonald's trade mark, held that interested people were potential customers and potential franchisees. Crunchy Munchy is the same type of mark, and it is probable that a court would hold that the group of people who know of the mark is too small for it to qualify as well-known.

Activity 11.1

Thandi must apply for an urgent interim interdict and, once this has been granted, institute action for the grant of a final interdict.

See the requirements listed under 'interim interdicts' above.

See the requirements listed under 'final interdicts' above. The primary distinction between the requirements of temporary and final relief is the strength of the right that can be proved coupled with a consideration of where the balance of convenience lies.

Activity 11.2

She can ask for a removal or delivery-up order (see section 34(3)(b) of the 1993 Act).

No. If Susan cannot remove the trade mark from the t-shirts, Thandi can have them destroyed, but they do not become Thandi's property and she cannot use them herself.

Activity 11.3

No. Thandi must present as much information as she can about her damages, and the court may order an enquiry to determine damages as best it can.

If Susan was unaware that Thandi had a registration, and was not negligent in failing to determine this, Thandi cannot recover damages from her. The position is different in England, where the courts have awarded damages despite the absence of any fault on the defendant's part.

Activity 11.4

It is advisable to claim a reasonable royalty when it is difficult to show or to prove actual damages.

Activity 11.5

Yes. Thandi can request a court to grant an urgent Anton Piller order, which will allow her to search Susan's premises for documents showing her profits and to have these documents attached for safekeeping.

Thandi must show that she has a cause of action against Susan, and that Susan has specific documents which are relevant to the claim which she will probably try to destroy.