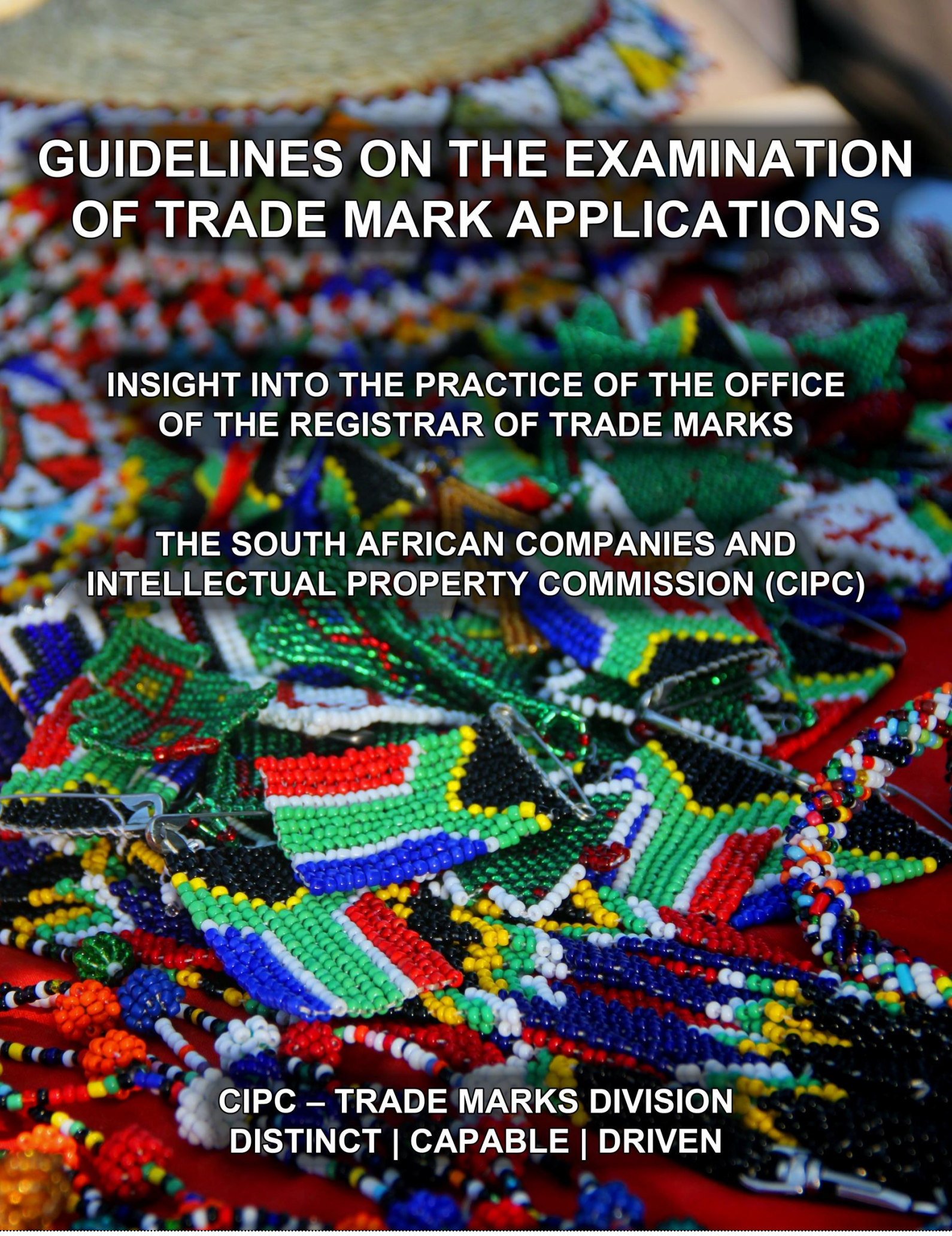


GUIDELINES ON THE EXAMINATION OF TRADE MARK APPLICATIONS

INSIGHT INTO THE PRACTICE OF THE OFFICE OF THE REGISTRAR OF TRADE MARKS

THE SOUTH AFRICAN COMPANIES AND INTELLECTUAL PROPERTY COMMISSION (CIPC)

CIPC – TRADE MARKS DIVISION
DISTINCT | CAPABLE | DRIVEN

VERSION 3 – MARCH 2019

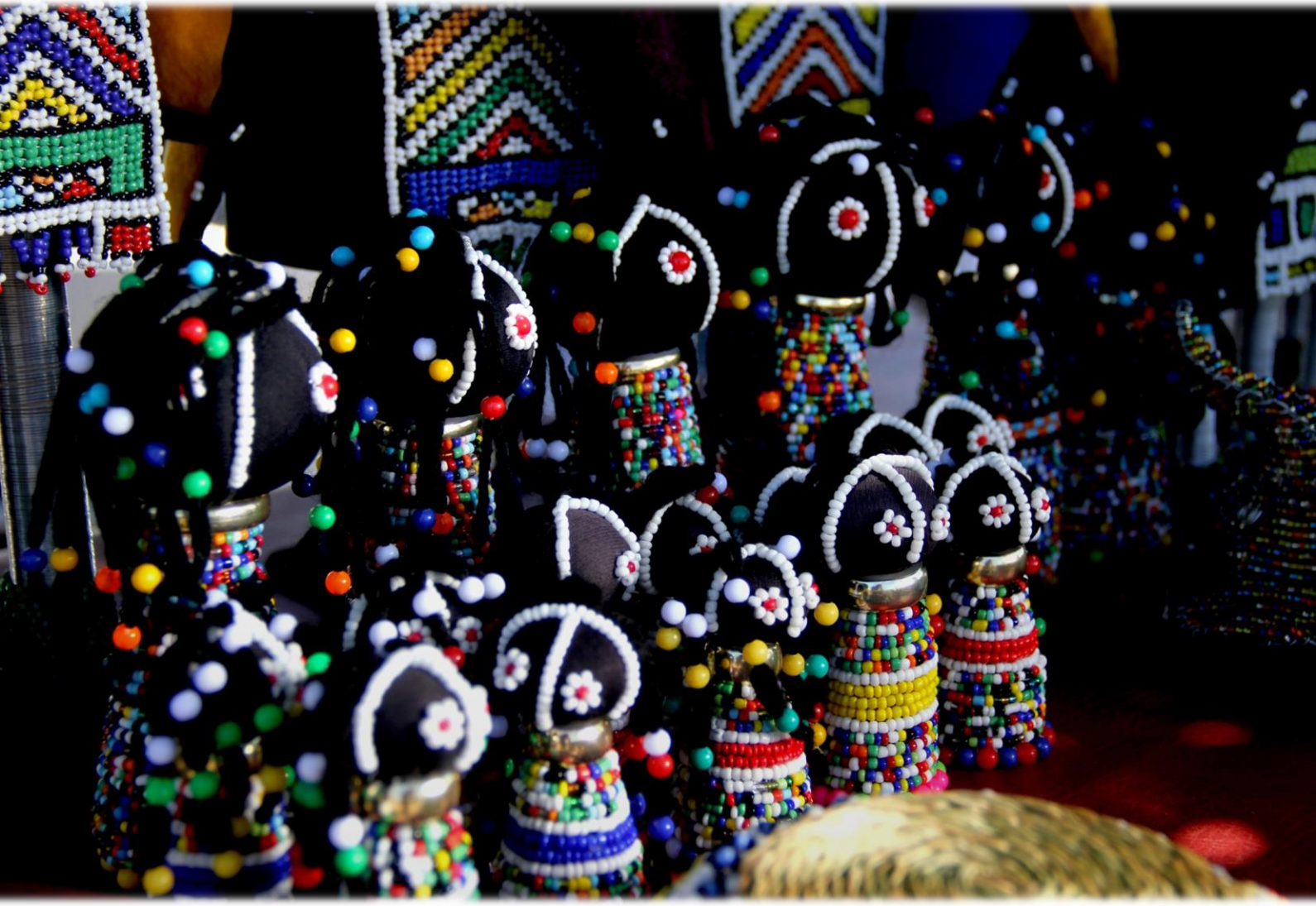
CIPC – a Member of the dti Group

Version 1: February 2017
Version 2: November 2017
Version 3: March 2019

Copyright CIPC – Trade Marks Division © 2017

Copyright subsists in this work. No part of this work may be reproduced in any form or by any means without the written permission of CIPC (Trade Marks Division). Any unauthorised reproduction of this work will constitute copyright infringement and render the doer liable under both civil and criminal law.

Photography by Christiaan J Steyn



All the art- and craftwork depicted in this document are of local artisans, selling their goods daily at the Union Building in Pretoria, South Africa.



Joseph Ndlovu - Artist



Lerato Sabangu - Artisan



Lawrance Ncwadi - Artisan



Ellen Manana - Artisan



Sandra Milhout - Artisan



Sidhubekile Moyo - Artisan



Thabo Mthumbu – Sculptor



Mary Ndlovu - Artisan



Foreword by the Commissioner 1
Senior Manager's Overview 3

1. FILING FORMALITIES 7
1.1 Application of These Guidelines 7
1.2 The Applicant and Agent (Authorised Representative) 7
1.3 Application Form Formalities 11
1.4 Different Components of the Form TM1 12

2. FORMAL EXAMINATION 17
2.1 Requirements in Terms of Other Legislation 17
2.1.1 Banks Act 9 of 1990 17
2.1.2 Liquor Products Act 60 of 1989 17
2.1.3 Financial Services Board Act 97 of 1990 18
2.1.4 Financial Markets Act 19 of 2012 18
2.1.5 Medical Schemes Act 131 of 1998 19
2.1.6 Pension Funds Act 24 of 1956 19
2.1.7 Medicines and Related Substances Control Act 101 of 1965 20
2.1.8 Merchandise Marks Act 17 of 1941 20
2.2 Classification of Goods and Services 21
2.2.1 Summary / Introduction 21
2.2.2 The NICE International Classification of Goods and Services 21
2.3 Convention (Priority) Application 21
2.4 Representation of a Trade Mark 23
2.4.1 Requirement of Graphic Representation 23
2.4.2 Signs Not Permitted 26
2.5 Types / Nature of Trade Marks 27
2.5.1 Traditional / Ordinary Trade Marks 27
2.5.2 Non-Traditional Trade Marks (in brief) 32

3. SUBSTANTIVE EXAMINATION 35
3.1 Introduction 35

3.2 Possible Outcomes of the Application 37
3.2.1 Unconditional Acceptance 37
3.2.2 Provisional Acceptance 37
3.2.3 Provisional Refusal 38
3.2.4 Invalid Application 39

3.3 Absolute Grounds for Refusal 41
3.3.1 Section 10(1) 41
3.3.2 Section 9 and 10(2)(a) 41
3.3.3 Section 10(2)(b) 52
3.3.4 Section 10(2)(c) 55
3.3.5 Section 10(3) – Lack of *Bona Fide* Claim to Proprietorship 55
3.3.6 Section 10(4) – Lack of *Bona Fide* Intention to Use The Mark as a Trade Mark . 56
3.3.7 Sections 10(5) and 10(11) 56
3.3.8 Section 10(7) – Applications Made *Mala Fide* 60
3.3.9 Section 10(8) 61
3.3.10 Section 10(9) 63
3.3.11 Section 10(10) 63

3.4 Relative Grounds for Refusal 65
3.4.1 Section 10(6) and 10(17) 65
3.4.2 Section 10(12) 65
3.4.3 Section 10(13) 69
3.4.4 Section 10(14) 70
3.4.5 Section 10(15) 82
3.4.6 Section 10(16) 83

3.5 Conditional Acceptance 85
3.5.1 Meaning and Derivation 85
3.5.2 Lodging / Validating Power of Attorney 86
3.5.3 Association 87
3.5.4 Disclaimers 88
3.5.5 Admission / Undertaking 93
3.5.6 Specifying / Rectifying / Rectification of Goods and Services in Conformity with the Trade Mark / Priority Document 97

3.5.7 Notice of Advertisement to Proprietors (Marked Journal / Mj) 99
3.5.8 Other Conditions..... 100

4. POST EXAMINATION PROCEDURE 101
4.1 Compliance with Official Actions..... 101
4.2 Submissions..... 103
4.2.1 Submissions Against Provisional Acceptance 103
4.2.2 Submissions Against Provisional Refusal..... 105
4.3 Informal (*Ex-Parte*) Hearings 109
4.4 Grounds for Decision (Written Reasons) 110

5. OF FURTHER RELEVANCE..... 113
5.1 Acceptance and Advertisement 113
5.2 Amendment of Trade Marks..... 114
5.3 Extensions of Time to Prosecute 115
5.4 External Divisional Service Delivery Standards 116

ANNEXURES 118

A. Notice on the Operational e-Filing of Trade Marks..... 119
B. List of Persons Authorised to Act on Behalf of an Applicant 124
C. Form TM1 126
D. Notice on Lodgement of Priority Documents in Respect of Patents, Designs and Trade Marks in Electronic Format 127
E. Notice on Naming Conventions Applicable to Electronic Lodgment of New Trade Mark Applications..... 129
F. Notice on Size Restrictions Applicable to Images Accompanying New Figurative Trade Marks Lodged Electronically 130
G. Guidelines with Regard to the Lodging of Non-Traditional Trade Marks..... 131
H. Guideline Document: Steps on How to do a Trade Mark Search..... 133
I. Notice on the Electronic Issuing of Official Actions 139
J. Notice on Obtaining Copies of Trade Mark Related Documents Electronically..... 140
K. Notice on Issuing of Notices of Acceptance..... 141
L. Explanatory Notes Dealing with Conditional Acceptance and Provisional Refusal of Trade Mark Applications 143

M. List of Conflicting NICE Classes 147
N. List of Possible Other Conditions for Conditional Acceptance 148



FOREWORD BY THE COMMISSIONER

It is my pleasure to present the revised and updated Companies and Intellectual Property Commission's (CIPC) **GUIDELINES ON THE EXAMINATION OF TRADE MARK APPLICATIONS**. This compendium offers a comprehensive insight into the practice of the Trade Marks Division of the CIPC (also known as "the Office of the Registrar of Trade Marks" in the IP community), in relation to the substantial examination of trade mark applications.

CIPC's broader mandate aims at creating, enhancing and sustaining an enabling and facilitative environment in the areas of entrepreneurship, investment and innovation in South Africa. In pursuit of these aims, CIPC is proud of several developments.

CIPC launched a free online searching facility for trade marks in February 2015. This online facility has been instrumental in assisting prospective applicants determine the availability of a trade mark which they intend to apply for and inform their business strategies accordingly.

In addition, since the successful introduction of e-filing in respect of new trade mark applications in September 2013 more than 95% of all trade mark applications lodged monthly, are lodged via the e-filing system.

The Division continues with the planning and roll-out of further automation in respect of trade mark functionalities. In February 2018 full e-filing for trade mark renewals and restorations were successfully rolled-out and implemented. Continued semi-automation services, as well as full automation of all other trade mark related functionalities will be implemented during the financial periods of 2019/2020 – 2020/2021.

The number of trade mark applications received from local and international applicants has increased steadily from 2012, with a record number of 39 136 trade mark applications having been received in 2018. Of these, a total of 22 948 trade mark applications were lodged by South African residents and 16 188 by non-residents. These figures indicate a healthy appetite for trade mark protection and South African market entry from both local and international entities and traders.

The Trade Mark Division continues to maintain a very acceptable examination term, and by the end of December 2018 first official actions were being issued 7 months after the date of application. In 2018 a total of 36 739 new applications were examined and official actions issued by the Division.

In fulfilling its legislative mandate with the utmost efficiency and professionalism, it is hoped that the Trade Marks Division will continue to contribute positively to the business reputation and intellectual property (IP) development mandate of the CIPC, and that this document will assist all trade mark clients in constructively engaging with the Trade Marks Division in relation to their trade mark applications.



RORY VOLLER (MR)

COMMISSIONER

March 2019

SENIOR MANAGER'S OVERVIEW

Objective of the Guidelines

The guidelines seek to capture and reflect the current examination practice of the Examination Section of the Trade Marks Division of CIPC. The main purpose of this document is to guide and train trade mark examiners in the function of substantive trade mark examination. It serves mainly as an internal training tool in the Trade Marks Division.

These guidelines can however also serve as the main point of reference for applicants and their authorised representatives alike to ensure that they have the latest information on examination practices. Whilst the guidelines seek to provide general guidance on the most frequent scenarios, it should be adapted to the particularities of each application.

Legislative mandate of the Registrar of Trade Marks

Section 6(1)(a-b) of the Trade Marks Act 194 of 1993 (the Act) states that the Registrar of Trade Marks (the Registrar) may exercise the powers and must perform the duties conferred or imposed by the Act and is responsible for the administration of the Office of the Registrar of Trade Marks.

Section 16 empowers the Registrar to make decisions in respect of trade mark applications. Recently, the Supreme Court of South Africa in *Société des Produits Nestlé SA v International Foodstuffs (100/14) [2014] ZASCA 187 (27 November 2014)* confirmed the Registrar's discretion to make substantive amendments to a trade mark application before acceptance. The Office of the Registrar is careful to exercise this discretion with the utmost care, accountability, transparency and due process in accordance with the prescripts of the Act.

The importance of the role of the Registrar as an administering authority in implementing and interpreting the Act cannot be understated. This was confirmed in *Dinkel v Union Government 1929 AD 150* and *University of Pretoria, Adams & Adams and South African Institute of Intellectual Property Law v Registrar of Patents 2002 BIP 68 (T) at 75F:*

> *"…which have held that where an interpretation to be placed on statute is not clear from its wording, the manner in which it has been applied by the administering authority can give guidance to its meaning."* (*Adcock Ingram Intellectual Property (Pty) Ltd v Actor Holdings (Pty) Ltd (20625/14) [2016] ZASCA 41 (24 March 2016)*)

As such, the Registrar strives to align its office practices with the needs and requirements of trade mark applicants and their authorised representatives. The Registry recognises the potential for development of trade mark law and the role that office practice has to play in this.

In line with the SCA's comments in *Century City Apartments Property Services CC and Another v Century City Property Proprietors Association 2010 (3) SA 1 (SCA)* at paragraph 20-23, the Office of the Registrar recognises the legislative origins of the current legislative framework and therefore seeks guidance based on international best practice where an anomaly exists in South African trade mark law:

> *"…It is necessary to consider the history of this provision more closely since both sides relied on judgments in support of their respective arguments concerning its interpretation on the supposition that our law and, for instance, English law on trade marks have always been the same, and that general propositions in older trade mark cases are still applicable under the present legislative regime.*
>
> *The Patents, Designs and Trade Marks Act (1883) 46 & 47 Vict c 57 did not deal with trade marks with a geographical connotation. It did, however, list the matters which trade marks had to consist of or contain. Trade mark registrations then were limited to names of individuals or firms represented in 'some particular and distinctive manner', a signature, a distinctive device and the like, as well as a 'fancy word or words not in common use' (s 64(1)(c)). The 1888 amendment added 'an invented word or words' to the list and replaced 'fancy word or words not in common use' with 'a word or words having no reference to the character or quality of the goods, and not being a geographical name.'…*

…The Trade Marks Act of 1905 (5 Edw VII c 15) was not much different although in regard to geographical names it prohibited the registration of any name if it was 'according to its ordinary signification a geographical name' (s 9(4)). This was introduced to overcome the objection to the registration of geographical names that were not generally known... The Act was amended to create a two-part register. The law was then consolidated in the Trade Marks Act of 1939 (1 & 2 Geo VI c 22). In relation to a registration in Part A of the register (s 9(1)), which dealt with inherently distinctive marks, this Act was identical to the 1905 Act but in relation to marks that were capable of becoming distinctive, which were registerable in Part B, a similar limitation did not exist.

South African legislation did not in all respects follow suit. The Patents, Designs, Trade Marks and Copyright Act 9 of 1916 permitted the registration of 'a distinctive word or words not reasonably required for use in the trade' and 'any other distinctive mark' (s 99). The Act accordingly did not prohibit the registration of geographical names per se and consequently any such name, which was distinctive and not reasonably required for use in the trade, could have been registered. In addition, s 126 provided that a trade mark registration could not interfere with the bona fide use by a person of his own place of business. This Act was replaced by the Trade Marks Act 62 of 1963, and although it was largely based on the 1939 British Act it retained the provisions of s 99 the 1916 Act but limited them to Part A registrations. In other words, words not reasonably required for use in the trade were capable of registration; there was no specific reference to geographical names; and s 46 was in this regard in the same terms as the mentioned s 126…"

In exercising the powers and performing the duties conferred by the Act, in so far as examination of trade mark applications is concerned, the Office of the Registrar of Trade Marks aims to protect the public interest by:

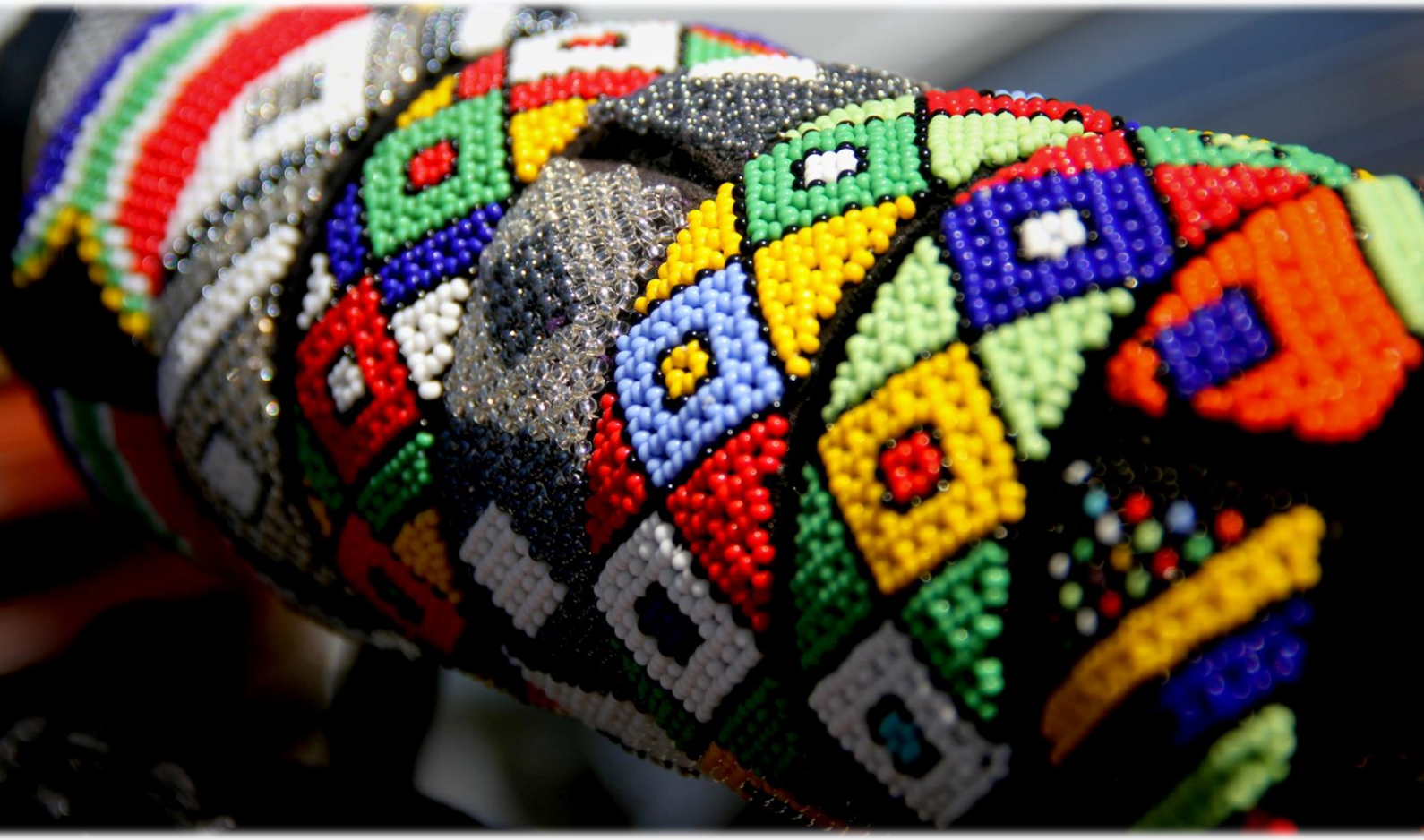
- Ensuring that the marks on the Trade Marks Register perform the basic function of a trade mark*;*

- Guarding against public deception and confusion; and

- As far as possible ensure the integrity of the national Trade Marks Register.

The Office of the Registrar of Trade Marks trusts that these guidelines will be an informative companion during the application process for current and prospective trade mark applicants and their authorised representatives.

FLEURETTE COETZEE (MS)
SENIOR MANAGER – TRADE MARKS DIVISION
March 2017





1. FILING FORMALITIES

1.1 APPLICATION OF THESE GUIDELINES

These Guidelines shall be applied to all applications on the date of examination, review or approval, irrespective of the relevant application dates. Certain parameters of these Guidelines, such as those pertaining to invalid applications, may further be applied to all pending applications up to date of registration, irrespective of the relevant application dates.

1.2 THE APPLICANT AND AGENT (AUTHORISED REPRESENTATIVE)

Trade mark application documents lodged both manually and electronically may only be signed by the applicant itself, or by an authorised representative on behalf of the applicant. The physical and electronic signatures on the application documents may therefore not be the signatures of anyone besides the applicant or the authorised representative. If the documentation has been signed by an unauthorised person or entity, the application will be deemed invalid from the date of application and will have to be re-lodged. Kindly refer to Paragraph 3.2.4 for more hereon. The published *Notice on the Operational eFiling of Trade Marks of 28 August 2013* ("Annexure A") further finds relevance herein, and states:

> *"When a customer enters his e-Filing access code into the CIPC e-Filing system, any application lodged thereafter shall be deemed to have been duly signed by the person whose signature is required in terms of the… …Trade Marks Act (Act 194 of 1993)… …for the purpose of lodging such an application."*

Further to the above, CIPC has a standing notice on its electronic filing platforms, indicating that an application must be lodged by the relevant applicant, or a practising attorney (as an authorised representative) on behalf of the applicant.

An applicant may only be represented by himself or by an authorised representative, being a practising attorney, in applications and any further dealings with the Office of the Registrar of Trade Marks. The requirement of an applicant being represented by a practising attorney within South Africa is derived from Section 8 of the 1993 Trade Marks Act, which refers to Section 8(2) of Trade Marks Act 62 of 1963 ("1963 Trade Marks Act"), read with Regulation 9(1) of the 1993 Trade Marks Act.

As Section 8 of the 1993 Trade Marks Act and Section 8(2) of the 1963 Trade Marks Act both refer to a register wherein all "agents'" names are recorded, and such a register has since been discontinued, the Office of the Registrar of Trade Marks interpret the section in relation to the definition of an "agent" under the 1993 Trade Marks Act to only refer to an attorneys (and a practising attorney as such). Section 8(2) of the 1993 Trade Marks Act reads:

> *"…agent means any person whose name has been entered in the register… …or a patent agent or an attorney…"*

Furthermore, in light of the above interpretation of Section 8(2) of the 1993 Trade Marks Act, the reference to "agent practising" contained in the wording of Regulation 9(1) under the 1993 Trade Marks Act is interpreted by the Office of the Registrar of Trade Marks to refer to an "attorney practising". Regulation 9(1) under the Trade Marks Act reads:

> *"…all attendances upon the Registrar may be made by or through an agent practising in the Republic and duly authorised to the satisfaction of the Registrar."*

Therefore, from Regulation 9(1), read with the definition of an "*agent*" as defined in Section 8(2) of the 1993 Trade Marks Act, the interpretation of Office of the Registrar of Trade Marks is that an "*agent*" is an attorney practising in the Republic, *i.e.* a 'practising attorney'.

The approach of the Office of the Registrar of Trade Mark is supported by the Court's findings in *Proxi Smart Services (Pty) Ltd v the Law Society of South Africa and Others GP (unreported case no 74313/16)*, wherein it referred to the relevant sections of the Deeds Registries Act 47 of 1937. Those sections of the Deeds Registries Act entitles only a conveyancer to execute and sign all the documents that are required for transfer in the Deeds Office. The legal question in this specific case was however not limited only to "Deeds of Transfer", but also include related certificates for a person that was not versed in conveyancing. These would typically be transfer duty certificates and clearance certificates, to name a few.

The Court in the *Proxi Smart-case* further considered Section 83(8)(a)(1) of the Attorneys Act 53 of 1979, as read with Section 83(12) of the same act, and came to the conclusion that it takes legal intellect, skill and knowledge to peruse all relevant documentation and consequently make a value judgment on how to proceed. This thus gives effect to Section 83(12) of the Attorneys Act, which exempts employees of a legal firm from the offences of Section 83(8) of the same act. The Court further noted that one needs to give a wide interpretation to the words "cause", "causing" and "preparing", thus concluding that all these prior steps fall under the so-called "reserved activities" of the conveyancer, who must be a practising attorney.

To add weight to the argument not to allow non-practising attorneys to deal with funds obtained from clients in relation to legal services, the court in the *Proxi Smart-case* also referred to Section 33(3) of the Legal Practice Act 28 of 2014 which reads:

> *"No person may, in expectation of any fee, commission, gain or reward, directly or indirectly, perform any act or render any service which in terms of any other law **[our emphasis]** may only be done by an advocate, attorney, conveyancer or notary, unless that person is a practising advocate, attorney, conveyancer or notary, as the case may be.."*

The effect of this section of the Legal Practice Act is that if other legislation, such as the 1993 Trade Marks Act, only allow "attorneys" to act, the cause would be that such reference to an attorney by default means a practising attorney, and therefore must be interpreted to mean that only a practising attorney may act, where such attorney is remunerated for the services provided.

Therefore, if at any time it is evident that the application documents have been signed by an unauthorised person or entity, such an application will be deemed to be invalid from date of application. Furthermore, if an unauthorised person or entity acts on behalf of the applicant on a valid application in any further proceedings, the applicant must appoint a practising attorney, before any further correspondence will be entertained.

Furthermore, in terms of the Attorneys Act, only practising attorneys (*ie* those holding a Fidelity Fund Certificate) are permitted to represent clients in legal matters – as is the case in trade mark applications and other related matters with this Office. The supporting argument for this is that only practising attorneys holding Fidelity Fund Certificates can assure that their clients are adequately protected by the Fidelity Fund in instances of misconduct by such attorneys. Since non-practising attorneys are not covered by the Fidelity Fund, their clients are vulnerable should any misconduct occur.

Practising attorneys are also regarded as accountable institutions under the Financial Intelligence Centre Act 38 of 2001, and therefore have a role to play in combating money laundering and countering the financing of terrorism under that Act. Admitted attorneys that represent clients as “non-practising attorneys” are simply providing legal services without a Fidelity Fund Certificate, which is in contravention of the Attorneys Act, and are furthermore attempting to circumvent the requirements of the Financial Intelligence Centre Act.

Based on the above, an application which appears to be lodged or the application documents signed by an unauthorised person or entity, shall be deemed invalid irrespective of the date of application or examination thereof. Such applications deemed to be invalid which have not yet proceeded to registration shall be marked as such on the Register.

It is important to note that trade mark applications and/or registrations lodged on behalf of a trade mark applicant by a person not authorised to do so, including non-practising attorneys, are vulnerable for removal from the Trade Marks Register on application by any interested third party as being “an entry wrongly made and/or remaining on the Register.” This could also be a ground for opposition in respect of applications subsequent to publication thereof. This vulnerability remains a risk irrespective of any invalidation of such trade mark application by the Registrar of Trade Marks.

NOTE: The status of any (apparent) practising attorney may be verified by the Office of the Registrar at any stage by requesting submission of a valid fidelity fund certificate.

For further guidance hereon, see the *List of Persons Authorised to Act on Behalf of an Applicant* ("Annexure B").

1.3 APPLICATION FORM FORMALITIES

This section relates to lodging of trade mark applications manually, by way of a duly completed Form TM1. In terms of Regulation 5, the application form (Form TM1) must be typed, lithographed or printed in legible Roman characters.

According to Regulation 14, where a form or trade mark contains characters other than Roman characters, the application form must be endorsed with a satisfactory transliteration and/or translation of such characters.

Regulation 11(3) requires that a separate application form be submitted for each class of goods or services, for which application is made.

The form must be dated, and signed by a competent person. According to Regulation 11(4), if the applicant signs the application form himself, it should be apparent from the form and the signature. Also refer to Paragraphs 1.1 and 3.2.4 hereon.

Regulation 11(5) provides that when an application form is signed by an official on behalf of a company or body corporate, it should be clear that the signatory has authority to do so. Otherwise, a request for clarification from the applicant will form part of the official action.

According to Regulation 11(2), if the application form is signed by an authorised representative on behalf of the applicant the form must show the signature as *'pp'* (*pro procuratione)*. In a case like this, the signatory must prove his mandate to sign by submitting a Power of Attorney.

The fee for an ordinary application is currently R590.00. The fee for a (a) certification-, (b) collective trade mark, and (c) for a Section 14 application is currently R900.00. Kindly note that such fees are subject to change, by notice in the prescribed manner.

In terms of Regulation 7, the application form must show an address for service which shall be in the Republic of South Africa, and shall include a street address. Where the address for service is in an area where there is no street, the address given shall contain such further indications required to readily find the exact location of such address. An address for service may, in addition, contain a post office box number, a facsimile transmission number or an email address.

1.4 DIFFERENT COMPONENTS OF THE FORM TM1

Lodging can take place either online through the e-filing facility or through manually submission. The Form TM1 will appear as depicted in “Annexure C” if a manual application is made, or will be generated automatically by the e-filing functionality after an electronic application has been processed.

Below are descriptions of the various elements contained in the Form TM1:

- **Client Reference** – This will be your CIPC customer code. This code is obtained by registering as a customer on the CIPC website.

- **Application Number (no. 21)** – This number will be assigned to your application by the Office, upon successful processing (including payment of the prescribed fees) of the application.

- **Filing Date (no. 22)** – This will be the date of lodgement and will be allocated by the Office on the date on which the application is received. Once the trade mark has proceeded to registration, registration will be effective from the filing date.

- **Applicant’s or Agent’s Reference Number** – This is a reference number chosen by yourself or your authorised representative and is merely for your own record purposes.

- **GPA Number** – If an authorised representative has applied for a General Power of Attorney to be assigned a number for ease of reference, then this number will be inserted here. This is not obligatory, but merely means that the authorised representative does not have to lodge a Power of Attorney for every application made on behalf of that specific applicant.

- **NA Nature (O=Ordinary, CE=Certification, CO=Collective, CU=Honest Concurrent User)** – This refers to the type of trade mark. See the explanations in Paragraph 2.5.1 below.

- **Applicant's details (no. 73)** – The details of the applicant must be reflected here. If there is more than one applicant, the details of each applicant must be reflected, not just one applicant.

- **Address for service (no. 74)** – If the applicant is lodging in their own capacity, their physical and postal details should be reflected here. If an authorised representative is acting on behalf of the applicant, their address details should be reflected here. An authorised representative must provide a valid Power of Attorney, or a valid General Power of Attorney number, that has been allocated by the Office. See Regulation 7 and Section 66 of the Act hereon.

- **Specification of goods/service (no. 57) and International Classification (no. 51)** – See Paragraph 2.2.2 below.

- **Endorsement(s) (no. 58)** – The Office of the Registrar of Trade Marks may request such endorsements as deemed necessary after examination has been conducted, but endorsements such as disclaimers, admission or meaning and derivation of a trade mark can be entered at the outset of the application (See Paragraphs 3.5.4 to 3.5.6).

- **Convention priority claimed (nos. 31, 32 and 33)** – See Paragraph 2.3 below.

- **Representation of trade mark (no. 54)** – This is where the representation for which trade mark protection is sought is to be inserted. If the trade mark being applied for is a word, letter, numeral or combination, insert such in the inner block (1). If the trade mark being applied for is represented in a special or particular form, place a clear copy in outer block (2) (Maximum size: 8, 5 cm x 10 cm). It is important to note that, should a mark be purely visual, no verbal description (in inner block (1)) is permitted, and only the visual representation should be placed in outer block (2). See Paragraph 2.4 below on the representation of a trade mark for further assistance.

- **AS Association No. (if applicable)** – See Paragraph 3.5.3 on associations below.

- **Signature of applicant or authorised representative** – Only the signature of the applicant or an authorised representative is allowed. In the case of an electronic lodgement, the application form will be electronically singed by use of the CIPC customer code or the prescribed advanced electronic signature (AES) (refer to Paragraph 1.1). Should the customer code not be that of the applicant or an authorised representative, the application will be deemed to be invalid. See Paragraphs 1.1 and 3.2.4 below for further information hereon.

- **Date** – the date of the signature by the applicant or an authorised representative.







2. FORMAL EXAMINATION

2.1 REQUIREMENTS IN TERMS OF OTHER LEGISLATION

2.1.1 BANKS ACT 9 OF 1990

Use of the word "bank" in a trade mark

Section 22(5) of the Banks Act 9 of 1990, states:

> *"No person shall use in respect of any business a name or description which includes the word "bank", or any derivative thereof, or the words "deposit-taking institution" or "building society", or any derivative thereof, unless the business in question is a bank or is authorized under section 18A to conduct the business of a bank by means of a branch in the Republic and the Registrar has in writing authorized such person so to use such name or description".*

Therefore, where the word "BANK" appears in a trade mark as applied for, written permission from the Reserve Bank must be requested upon examination.

2.1.2 LIQUOR PRODUCTS ACT 60 OF 1989

On every new trade mark application received, lodged in class 33, a notification thereof is sent to the Wine and Spirits Board by the Office.

In the event that the Wine and Spirits Boards finds the trade mark to contravene any provisions of the Liquor Products Act 60 of 1989, a letter is sent to the Office indicating the nature of the infringement and what appropriate steps need to be taken to address the potential contravention. It is the duty of the examiner to ensure that:

- Such notice was sent; and
- Any comments submitted by the Wine and Spirits Board is taken into consideration during the examination process.

2.1.3 FINANCIAL SERVICES BOARD ACT 97 of 1990

Use of the phrase "financial services board" in a trade mark

Section 24 of the Financial Services Board Act 97 of 1990 states:

> *"No person shall apply to any company, body, firm, business or undertaking a name or description signifying or implying some connection between such company, body, firm, business or undertaking and the board unless the person – a) has been authorised by the board to do so; and; b) complies with the conditions determined by the board."*

Where the phrases "FINANCIAL SERVICES BOARD", or the abbreviation "FSB", or any description of the Financial Services Board or reference to financial services appears in a trade mark as applied for, written permission from the Financial Services Board must be requested upon examination.

2.1.4 FINANCIAL MARKETS ACT 19 of 2012

Use of the words "exchange" and "securities" in a trade mark

Section 4(2) of the Financial Markets Act 19 of 2012 states:

> *"A person who is not — (a) licensed as an exchange, a central securities depository, a trade repository or a clearing house; (b) a participant; (c) an authorised user; (d) a clearing member; (e) an approved nominee; or (f) an issuer of listed securities, may not purport to be an exchange, central securities depository, trade repository, clearing house, participant, authorised user, clearing member, approved nominee or issuer of listed securities, as the case may be, or behave in a manner or use a name or description which suggests, signifies or implies that there is some connection between that person and an exchange, a central securities depository, trade repository, clearing house, participant, authorised user or clearing member, as the case may be, where in fact no such connection exists."*

Where the words “EXCHANGE” or “SECURITIES”, or any description of or reference to financial markets or exchanges or securities appear in a trade mark as applied for, written permission from the Registrar of Securities Services must be requested upon examination.

2.1.5 MEDICAL SCHEMES ACT 131 of 1998

Use of the phrase “medical scheme” in a trade mark

Section 21 of the Medical Schemes Act 131 of 1998 states:

> *“No person shall, without the consent of the Registrar, apply to his or her business a name which includes the words “medical scheme” or any other name which is calculated to indicate, or is likely to lead persons to believe that he or she carries on the business of a medical scheme, unless such business is registered under this Act.”*

Where the phrase “MEDICAL SCHEME”, or any other indication or reference to a medical scheme appears in a trade mark as applied for, proof of registration of the Applicant as a medical scheme must be requested upon examination.

2.1.6 PENSION FUNDS ACT 24 of 1956

Use of the phrase “pension fund” in a trade mark

Section 31(1)(d) of the Pension Funds Act 24 of 1956 states:

> *“No person shall… apply to that person's business a name which includes the words "pension fund" or any other name which is calculated to indicate that that person carries on the business of a pension fund, unless such business is provisionally or finally registered as a pension fund under this Act”.*

Where the phrase “PENSION FUND”, or any other words indicating a relation to pension funds appears in a trade mark as applied for, proof of registration of the Applicant as a pension fund must be requested upon examination.

2.1.7 MEDICINES AND RELATED SUBSTANCES CONTROL ACT 101 of 1965

On examination of a trade mark application lodged in class 5, a notification thereof may be sent to the Medicines Control Council should the examiner deem such necessary.

In the event that the Medicines Control Council finds the trade mark to contravene any provisions of the Medicines and Related Substances Control Act 101 of 1965, it is the duty of the examiner to ensure that any comments received from the Medicines Control Council is communicated to the Applicant.

2.1.8 MERCHANDISE MARKS ACT 17 of 1941

Section 15(1) of the Merchandise Marks Act 17 of 1941 states:

> *"The Minister may, after such investigation as he or she may think fit, by notice in the Gazette, prohibit either absolutely or conditionally the use of – (a) the National Flag, or any former National Flag, of the Republic; or – (b) any mark, word, letter or figure or any arrangement or combination thereof, in connection with any trade, business, profession, occupation or event, or in connection with a trade mark, mark or trade description applied to goods."*

Where a trade mark as applied for consist exclusively of, or contains as a whole, any word, phrase, letter or symbol of a mark protected under Section 15(1) of the Merchandise Marks Act 17 of 1941, such a trade mark must be refused in terms of Section 10(12) of the Trade Marks Act.

A non-exhaustive resource of such protected ("prohibited") marks may be made available by the Office of the Registrar of Trade Marks on request. It should however be noted that such protected marks are published in the Government Gazette from time to time, and that any and all such published notices finds relevance herein, whether forming part of the referred resource or not.

2.2 CLASSIFICATION OF GOODS AND SERVICES

2.2.1 SUMMARY / INTRODUCTION

The purpose of classifying goods and services is to limit the protection that can be claimed in respect of a trade mark and, therefore, clearly determine the scope of protection.

South Africa applies the NICE International Classification System in respect of the classification of trade marks and has been doing so for several decades.

2.2.2 THE NICE INTERNATIONAL CLASSIFICATION OF GOODS AND SERVICES

The NICE International Classification of Goods and Services (11th Edition) consists of 34 goods classes and 11 service classes. The relevant edition in use by the Office of the Registrar is as published on the CIPC website from time to time.

2.3 CONVENTION (PRIORITY) APPLICATION

South Africa is a member state of the Paris Convention, therefore a right of priority, in accordance with Article 4 of the Paris Convention, must be granted to other member states. This principle is confirmed by Section 63 of the Trade Marks Act:

> *"63. International arrangements.*
> *(1) The State President may, with a view to the fulfilment of a treaty, convention, arrangement or engagement, by proclamation in the Gazette declare that any country or group of countries specified in the proclamation is a convention country or are convention countries for the purposes of all or any of the provisions of this Act.*
> *(2) For the purposes of subsection (1) every territory for whose international relations another country is responsible shall be deemed to be a country in respect of which a declaration may be made under that subsection.*
> *(3) Any person who has applied for registration of a trade mark in a convention country, or his legal representative or assignee, shall, in priority to other applicants, be entitled to registration of the trade mark under this Act, and the registration shall have the same date as the date of the first application in the convention country: Provided that—*

(a) application is made within six months after the date on which the application was made in the convention country; and

(b) nothing in this section contained shall entitle the proprietor of the trade mark to recover damages for infringements happening prior to the actual date on which the application was first advertised in the prescribed manner.

(4) Where applications have been made for the registration of a trade mark in two or more convention countries, the period of six months referred to in subsection (1) shall be reckoned from the date on which the earliest of those applications was made.

(5) Where a person has applied for protection for a trade mark by an application which—

(a) in accordance with the terms of a treaty subsisting between any two or more convention countries, is equivalent to an application duly made in any one of those convention countries; or

(b) in accordance with the law of any convention country, is equivalent to an application duly made in that convention country, he shall be deemed for the purposes of this section to have applied in any of those convention countries or in that convention country.

(6) The registration of a trade mark shall not be invalidated by reason only of the use of the trade mark in the Republic during the period specified in this section as that within which application may be made.

(7) The application for the registration of a trade mark under this section shall be made in the same manner as an ordinary application under this Act, except that proof of application in a convention country shall be established in the manner prescribed.

(8) A right to priority as contemplated in subsection (3) may be assigned or otherwise transmitted."

The national application must be lodged within 6 (six) months of the date of the foreign application, and the priority documents together with the required translation (if necessary) must be lodged within 3 (three) months of the application.

The goods or services of interest in the national application may be narrower that those as set out in the priority document, but may not be broader. In the case of the latter, a restriction of goods / services in conformity with the priority document must be called for.

The Notice on Electronic Lodgement of Priority Documents ("Annexure D"), which came into effect on 2 September 2013, facilitates the timeous lodgement of priority documents.

2.4 REPRESENTATION OF A TRADE MARK

2.4.1 REQUIREMENT OF GRAPHIC REPRESENTATION

Section 2(1) of the Trade Marks Act 194 of 1993 defines a "mark" as:

> *"…any sign capable of being represented graphically, including a device, name, signature, word, letter, numeral, shape, configuration, pattern, ornamentation, colour or container for goods or any combination of the aforementioned."*

It must be capable of graphic representation. An applicant must therefore bear this definition in mind when lodging an application. Regulation 13(1-2) states:

> *"13. Representation of marks*
>
> *(1) Every application for the registration of a trade mark shall contain a representation, suitable for reproduction, affixed to it in the space provided on Form TM1 for this purpose.*
> *(2) A representation shall not exceed 8,5 cm in width and 10 cm in length."*

Specific requirements in respect of the representation of a trade mark are detailed below. The *Notice on naming conventions applicable to electronic lodgment of new trade mark applications (1 November 2013)* ("Annexure E") should also be referred to when lodging new applications via e-filing.

The *Notice on size restrictions applicable to images accompanying new figurative trade marks lodged electronically (11 November 2015)* ("Annexure F") should also be referred to in this regard.

In *Case C-273/00 Ralf Sieckmann v Deutsches Patentund Markenamt [2002] ECR I-11737* it was stated that:

> *"…graphic representation must enable the sign to be represented visually, particularly by means of images, lines or characters, so that it can be precisely identified. Such an interpretation is required to allow for the sound operation of the trade mark registration system."*

Therefore, a representation must be:

- clear;
- precise;
- self-contained;
- easily accessible;
- intelligible;
- durable; and
- objective.

Each of the seven requirements speaks to a component of graphic representation. These will be dealt with in turn below.

The overall rationale of these requirements is based on the importance of defining the rights which exist in the trade mark itself (and therefore afforded to the proprietor). The Office must know, with sufficient clarity and precision, the extent of protection afforded to any particular proprietor in order to fulfil the functions of search and examination, publication and maintenance of a precise Trade Mark Register.

Economic operators must also know, with sufficient clarity and precision, the extent and effect of the rights in applications and registrations in the name of competitors.

The determination by users of the Register of the precise nature of a trade mark on the basis of its registration must be aided by a graphic representation (as set out in Regulation 13) which is:

- clear;
- self-contained;
- easily accessible; and
- intelligible.

The potential indefinite period of protection for a registered trade mark means that its representation must be durable. The certainty of the Register requires that registered trade marks can be perceived and identified without any risk of subjectivity. Therefore, a graphic representation must be objective and unequivocal.

The Registrar may, if *"the representations of the mark are not satisfactory … at any time require other representations, satisfactory to him, to be substituted before proceeding with the application"* (Regulation 13(4)).

A single view of the representation of a three-dimensional trade mark will be accepted, provided that it is possible to determine the three-dimensional nature from the single view. Furthermore, Regulation 13(5) to (6) may be applicable to certain non-traditional trade marks:

> "*13. Representation of marks…*
>
> *(5) Where a representation cannot be given in the manner aforesaid, a specimen or copy of the trade mark may be sent either of full size or on a reduced scale and in such form as the Registrar may think most convenient*
>
> *(6) The Registrar may also call for a deposit in the office of a specimen or copy of any trade mark which cannot conveniently be shown by a representation, and may refer to it in the register in such manner as he may think fit."*

See Paragraph 2.4.2 below for further information.

2.4.2 SIGNS NOT PERMITTED

Regulation 10 sets out signs which are unregistrable, and should be read together with Sections 10(8) and 10(10) of the Trade Marks Act.

Regulation 10 states:

> "*10. Unregistrable marks [Section 10 (8)-(10)]*
>
> *(1) Subject to the provisions of any other law, the Registrar may refuse to accept any application upon which any of the following appear:*
>
> *(a) The words 'patent', 'patented', 'by letters patent', 'registered', 'registered trade mark', 'registered design', 'copyright', 'certified', 'guaranteed' or words to like effect; and*
>
> *(b) the letters ®, © or similar combinations which may be construed to import a reference to registration.*
>
> *(2) Where a representation of arms, insignia, a decoration or a flag appears on a mark, the Registrar may call for such justification, including such consent as he may deem necessary as the circumstances of the case may require."*

Where an applicant's trade mark includes the following symbols,

- ® ; and/or
- ©.

the applicant will be requested to remove these symbols by amending the representation of the trade mark, by lodging a Form TM2 (the original form must be submitted to the Office), at payment of the prescribed fee.

2.5 TYPES / NATURE OF TRADE MARKS

2.5.1 TRADITIONAL / ORDINARY TRADE MARKS

2.5.1.1 ORDINARY TRADE MARKS

An ordinary trade mark is any trade mark lodged on a Form TM1, other than a certification trade mark or a collective trade mark, which:

- is used or proposed to be used by a person;
- is used in relation to goods or services for the purpose of distinguishing the goods or services in relation to which the trade mark is used or proposed to be used, from the same kind of goods or services connected in the course of trade with any other person.

An ordinary trade mark can be in the form of any sign that is represented graphically including a:

- Device;
- Name;
- Signature;
- Word;
- Letter;
- Numeral;
- Shape;
- Configuration;
- Pattern;
- Ornamentation;
- Colour;
- Container for goods; or
- A combination of the above.

2.5.1.2 CERTIFICATION TRADE MARKS

Certification trade marks are dealt with under Section 42 of the Trade Marks Act, which states that:

> *"A mark capable of distinguishing, in the course of trade, goods or services certified by any person in respect of kind, quality, quantity, intended purpose, value, geographical origin or other characteristics of the goods or services, or the mode or time of production of the goods or rendering of the services, as the case may be, from goods or services not so certified, shall, on application in the prescribed manner, be registrable as a certification trade mark in respect of such first-mentioned goods or services, in the name, as proprietor thereof, of that person: Provided that a mark may not be so registered in the name of a person who carries on a trade in the goods or services in respect of which registration is sought".*

These trade marks are also lodged on a Form TM1 and are examined in the same manner as an ordinary trade mark application.

This trade mark applies to either goods or services that are certified in respect of the quality, kind, quantity, value, intended purpose, or geographical indication of the goods or services. A certification trade mark may not be registered in the name of a person / entity who carries on a trade in similar goods or services in respect of which the certification trade mark is applied for.

Upon examination the rules governing the use of the trade mark applied for, as well as a statement of case and evidence (which must be couched in affidavit format), must be requested, which should include the following:

- the applicant must state that he does not carry on business in similar goods and services;
- the:
  - conditions, for use must be specified, as well as
  - the circumstances in which the proprietor will certify the goods/services; and
  - which characteristics the goods or services must comply with in order to be so certified; and
- a sanction clause against abuse or misuse.

The rules may be amended either before or after registration of the trade mark.



2.5.1.3 COLLECTIVE TRADE MARKS

According to Section 43(1) of the Trade Marks Act, a collective trade mark is defined as:

> *"A mark capable of distinguishing, in the course of trade, goods or services of persons who are members of any association from goods or services of persons who are not members thereof, shall, on application in the manner prescribed and subject to the provisions of this section, be registrable as a collective trade mark in respect of such first-mentioned goods or services in the name of such association as the proprietor thereof".*

Section 43(2) provides that geographical names or other indicators of geographical origin may be registered as collective trade marks.

These trade marks are also lodged on a Form TM1, and are examined in the same manner as an ordinary trade mark application.

Collective trade marks are owned by associations who may trade in the goods or services for which they apply (unlike certification trade marks). Upon examination, that rules of the association governing the use of the trade mark must be requested.

These rules must specify:

- the persons authorised to use the trade mark;
- the conditions of membership of the association; and
- the conditions of use of the trade mark, including any sanctions against misuse, when applicable.

It is possible for these rules to be amended either before or after registration, in terms of Regulation 57(5).

Note that trade marks applied for for protection as certification- or collective trade marks must still pass the threshold of being registrable trade mark for purposes of Section 9 and 10 of the Act. Such trade marks must still serve the basic trade mark function of being capable of distinguishing, and may not consist exclusively of a sign or an indication which may designate kind, quality, quantity or geographical origin of the goods

2.5.1.4 HONEST CONCURRENT USER

Section 14 of the Trade Marks Act states the following:

(1) *"In the case of honest concurrent use or of other special circumstances which may make it proper to do so, the registrar may, on application in the prescribed manner, register, subject to such conditions and limitations, if any, as he may think fit to impose, a trade mark the registration of which would otherwise offend against the provisions of paragraph (6), (14), (15) or (17) of section 10".*

(2) *"In the case of a trade mark which is sought to the removed from the register on the ground that it offends against the provisions of paragraph (6), (14), (15) or (17) of section 10, the court or the registrar, as the case may be, may, in the case of honest concurrent use or of other special circumstances which may make it proper to do so, refuse to remove the trade mark from the register…"*

It is possible for two proprietors of similar trade marks in respect of similar goods / services to both obtain registration, provided that the adoption and use by the later applicant was honest and concurrent. In order to establish this, evidence (in the format of an affidavit) must be lodged by the applicant, showing 5 (five) years of honest and concurrent use prior to the date of application.

The affidavit needs to address the following points, as contained in *Alex Pirie & Sons Limited (1933) 50 RPC 147* (at 160 line 4):

- *"the degree of confusion likely, taking into consideration 'certain contingencies of confusion from phonetic similarity between the two words (or phrases) and giving due weight to the possibility of mistake arising from inaccurate or ill-remembered impression the mind';*

- *the fact that the choice of the applicant's trade mark was honestly made;*
- *the extent of the honest concurrent use;*
- *actual confusion. 'It is the user and not the registration which is liable to cause confusion and the commercial user has not produced any proof of confusion'; and*
- *the nature of the trades of the different proprietors concerned."*

If the Office is satisfied that the evidence as submitted complies therewith, the trade mark will be accepted as a Section 14 application. A notice indicating the Registrar's intention to accept the application as one in terms of Section 14 is issued by the Office, together with a letter to the applicant or its authorised representative indicating that copies of the evidence lodged in support of the application must be sent to the prior registrant. The notice as issued by the Office must be published in one edition of the Patent Journal, with the relevant statutory opposition period of 3 months following the publication. If no opposition is entered, and after the expiry of the opposition period, the application will then be accepted in the normal manner, and endorsed to the effect that it is a "Section 14 Application". The normal publication process and opposition phase will then apply, as part of the prescribed registration process.

2.5.2 NON-TRADITIONAL TRADE MARKS (IN BRIEF)

The *Guidelines with regard to the lodging of non-traditional trade marks (1 January 2009)* ("Annexure G") should be consulted when lodging any one of the following trade marks:

- Three-dimensional trade marks;
- Colour trade marks;
- Holograms;
- Motion/multimedia trade marks;
- Position trade marks;
- Gesture trade marks;
- Sound trade marks;
- Olfactory (smell/scent) trade marks;
- Taste trade marks; and
- Texture trade marks.

It is important to note that this notice simply provides lodgement requirements in respect of trade marks of this notice. The registrability of such trade marks will be determined upon formal and substantive examination of the application, in the normal manner.







3. SUBSTANTIVE EXAMINATION

3.1 INTRODUCTION

As stated in the Senior Manager's Overview above, Section 16, read together with Regulation 15(2) to (4), empowers the Registrar to make decisions in respect of trade mark applications. Section 16 of the Act states the following:

> *"16. Application for registration.*
> *(1) An application for registration of a trade mark shall be made to the registrar in the prescribed manner.*
> *(2) Subject to the provisions of this Act, the registrar shall—*
> *(a) accept;*
> *(b) accept, subject to such amendments, modifications, conditions or limitations, as he may deem fit;*
> *(c) provisionally refuse; or*
> *(d) refuse, the application.*
> *(3) The registrar shall advise an applicant for registration in writing within a reasonable period from the date of the application of his decision in terms of subsection (2).*
> *(4) In the case of an acceptance in terms of subsection (2) (b) or a refusal in terms of subsection (2) (d), the registrar shall, on application by the applicant in the prescribed manner, state in writing the grounds for his decision."*

Essentially, Section 16 forms the legal base for the substantive examination of a trade mark. The substantive examination function and decisions in respect of trade mark applications are based on comprehensive searches performed by the Office of the Registrar of Trade Marks (refer to *Guideline document: Steps on how to do a trade mark search* ("Annexure H") for an overview of the Office practices in relation to searching of trade marks).

In line with Practice Note 3 of 2016 (“Annexure I”), which came into effect on 1 September 2016, official actions issued in terms of Section 16(3), read with Regulations 15(3) and 15(4) of the Act, are issued electronically via e-mail to the e-mail address reflected on the CIPC customer profile of the customer code under which the application is lodged. Electronic copies of official actions, notices of acceptance, as well as other selected trade mark related documents, may in addition be accessed electronically and printed via the CIPC website, at no additional costs, from links as specified in Practice Note 1 of 2016 (“Annexure J”), which came into effect on 4 April 2016; and Practice Note 2 of 2017 (“Annexure K”), which came into effect on 5 June 2017.



3.2 POSSIBLE OUTCOMES OF THE APPLICATION

For a brief overview of the possible outcomes of an application, refer to the *Explanatory Notes Dealing with Conditional Acceptance or Provisional Refusal of Trade Mark Applications* ("Annexure L").

3.2.1 UNCONDITIONAL ACCEPTANCE

Regulation 15(3) states:

> *"…if after such search and a consideration of the application the Registrar considers that there is no objection to the mark being registered, he shall accept it absolutely…"*

In this instance, the file would be signed off and the signed Notices of Acceptance would be prepared and issued to the applicant or its authorised representative.

3.2.2 PROVISIONAL ACCEPTANCE

Regulation 15(3) states:

> "…*if after such search and a consideration of the application the Registrar considers that there is no objection to the mark being registered, he shall accept it … subject to conditions, modifications or amendments which he shall communicate to the applicant or his agent...*"

The various conditions for acceptance which an application may be subject to, are briefly listed below for ease of reference (full details of each condition are set out later in this document):

- Provide the meaning and derivation of the trade mark for further consideration of the application;
- Lodge a Power of Attorney;
- Agree to association;
- Agree to disclaimer requirements;
- Enter the usual admission/undertaking;

- Specify/rectify/restrict/the goods/services in conformity with the trade mark/priority document;
- Give an undertaking to send a notice of advertisement to the proprietors of certain registered trade marks; and/or
- Other conditions which the Registrar may impose.

Written representations can be made to overcome a condition(s) for acceptance. The examiner who issued the provisional acceptance will consider the representations, and decide whether to waive such condition(s), or not.

3.2.3 PROVISIONAL REFUSAL

Regulation 15(2) states:

> *"The Registrar shall after receipt of the application for the registration of the trade mark cause a search to be made amongst registered marks and pending applications for the purpose of ascertaining whether there are on record any marks for goods or services which may conflict with the trade mark forming the subject of the application in terms of Section 10."*

Furthermore, Regulation 15(4) states:

> *"If after such search and consideration of the application any objections exist, a statement of those objections shall be sent to the applicant, in writing, and unless within three months of the date of the statement the applicant submits arguments, in writing, or applies for a hearing or an extension of time, the application shall be deemed to have been abandoned."*

These sub-regulations refer to relative grounds for refusal. The details of these grounds for refusal are set out in detail further in this document. The grounds for refusal based on absolute grounds are also set out later in this document.

Written representations can be made to overcome a provisional refusal. The examiner who issued the provisional refusal will consider the representations, and decide whether to waive the refusal, or not. Details on how to overcome the most commonly cited grounds for refusal are set out later in this document.

3.2.4 INVALID APPLICATION

An application is deemed as invalid as from the date of lodgement if it was electronically signed and lodged by a person not authorised to do so in terms of the Act. The same applies to manually submitted applications signed and lodged by an unauthorised person (for further details on who is an authorised representative, see Paragraph 1.1 above).

Under these circumstances, the applicant must be advised in the official action that the application is deemed invalid from the date of lodgement and the application should be re-filed using an authorised representative, or by the applicant himself. Notably, official fees are not refundable in such instances.





3.3 ABSOLUTE GROUNDS FOR REFUSAL

For a discussion on written submissions against the following absolute grounds for refusal, kindly refer to Paragraph 4.2.2.

3.3.1 Section 10(1)

If a trade mark does not fit the definition of a trade mark, Section 10(1) states that it cannot be registered (see the definition of a trade mark in Paragraph 1 above). In *Beecham Group Plc and Another v Triomed (Pty) Ltd 2003 (3) SA 639 (SCA)*, it was held that the enquiry under Section 10(1) of the Act is a 'badge of origin' enquiry, as this is the primary function of a trade mark.

In Lubbe NO v Millenium Style [2007] 4 All SA 692 (SCA); 2007 6 SA 241 (SCA), it was held that if a trade mark has been used as mere ornamentation it would be difficult for the proprietor of the trade mark to demonstrate that it has the requisite capacity to distinguish. For use of the trade mark by the proprietor to qualify as "use" within the meaning of the Act (Section 2(2)), it must be used as a trade mark in the normal course of trade. Therefore, even if ornamentation is decorative, it does not stand to reason that it is decorative in a trade mark sense.

A trade mark must fulfil three criteria:

- It must be capable of graphic representation (see Paragraph 2.4.1 above for more details).
- It must be capable of use; and
- It must be capable of distinguishing (see Paragraph 3.3.2 below).

3.3.2 Section 9 and 10(2)(a)

A trade mark must be capable of distinguishing (*i.e.* must be "distinctive"). Therefore if a trade mark is not distinctive, it cannot be registered.

This is supported by Section 10(2) of the Trade Marks Act:

> *"(2) a mark which —*
>
> *(a) is not capable of distinguishing within the meaning of section 9; or*
>
> *(b) consists exclusively of a sign or an indication which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin or other characteristics of the goods or services, or the mode or time of production of the goods or of rendering of the services; or*
>
> *(c) consists exclusively of a sign or an indication which has become customary in the current language or in the bona fide and established practices of the trade."*

Section 9 of the Trade Marks Act states the following:

> *"(1) In order to be registrable, a trade mark shall be capable of distinguishing the goods or services of a person in respect of which it is registered or proposed to be registered from the goods or services of another person either generally or, where the trade mark is registered or proposed to be registered subject to limitations, in relation to use within those limitations.*
>
> *(2) A mark shall be considered to be capable of distinguishing within the meaning of subsection (1) if, at the date of application for registration, it is inherently capable of so distinguishing or it is capable of distinguishing by reason of prior use thereof."*

Distinctiveness can therefore be inherent or acquired through use. An inquiry under Section 10 and in terms of Section 9, is, therefore, carried out in two stages, namely: inherent distinctiveness, and then distinctiveness through use (*Beecham Group plc and Another v Triomed (Pty) Ltd 2003 (3) SA 639 (SCA)*).

Where distinctiveness has been acquired through use, one must look at the market share, whether there has been longstanding use, what resources have been devoted to marketing, the knowledge of the population in respect of the trade mark, and any other relevant information (*Windsurfing Chiemsee Produktions-und Vertriebs GmbH v Boots-und Segelzubehor Walter Huber and Franz Attenberger [1999] ETMR 585*).

It must be borne in mind that the onus of proving distinctiveness, rests on the applicant for registration (*Cadbury (Pty) Ltd V Beacon Sweets & Chocolates (Pty) Ltd and Another 2000 (2) SA 771 (SCA)*). It is not in the public interest *"to have trade marks on the register that cannot perform the basic trade mark function of distinguishing as set out in [Section] 9(1)".*

In determining the inherent distinctiveness of a trade mark, the following test is useful:

> *"If one considers that a trade mark performs an adjectival function in relation to goods or services, the fact that another noun for the product is not readily apparent is a fair indication that the term does not perform any function."* (*Cadbury (Pty) Ltd V Beacon Sweets & Chocolates (Pty) Ltd and Another 2000 (2) SA 771 (SCA)*)

Therefore,

> *"[a] word or words to be really distinctive of a person's goods must generally speaking be incapable of application to the goods of anyone else."* (*Canadian Shredded Wheat Co Ltd v Kellogg Co of Canada [1939] S.C.R. 329*)

Mere use does not equal distinctiveness (*British Sugar PLC v. James Robertson & Sons Ltd., 1996 R.P.C. 281 (Chancery Division) (U.K.)*).

In this regard, the following passage is useful:

> *"…it is all too easy to be beguiled by … evidence [of use]. There is an unspoken and illogical assumption that 'use equals distinctiveness'. The illogicality can be seen from an example: no matter how much use a manufacturer made of the word 'soap' as a purported trade mark for soap, the word would not be distinctive of his goods."*

Furthermore:

> *"…in the case of common or apt descriptive or laudatory words compelling evidence is needed to establish [distinctiveness through use]."*

This was confirmed in *Cadbury (Pty) Ltd V Beacon Sweets & Chocolates (Pty) Ltd and Another 2000 (2) SA 771 (SCA)*:

> *"The sole producer or distributor of a product, whether new or old, cannot by means of advertising and selling the product under its generic name render that name capable of distinguishing in terms of [Section] 9."*

Acquired distinctiveness cannot be applicable where the trade mark is so descriptive or so commonplace that it is factually incapable of distinguishing. No amount of use will render trade marks, which factually have no capacity to distinguish, distinctive. Evidence of use must be treated with circumspection especially where the goods or services in question have a sole producer. (*On-Line Lottery Services v National Lotteries Board [2009] All SA 470 (SCA)*).

Use must be proven for at least 5 (five) years prior to the date of application and must always be submitted in an affidavit format, which must *inter alia* contain reference to turn-over figures and advertisement costs for such time period.

In assessing distinctiveness, what must be taken into account is the essential function of a trade mark to indicate the origin of the goods or services in connection with which it is used. Visual appearance of a trade mark cannot be altogether separated from its sense. The distinctiveness or otherwise of a trade mark depends upon the message conveyed to the public and how the public perceive and understand that message. Trade marks are all about public perception. (*Cowbell AG v ICS Holdings Ltd 2001 3 SA 941 (SCA)*).

There is a scale of distinctiveness (*Die Bergkelder Bpk v Verendal Koop Wynmakery and Others 2006 4 SA 275 (SCA)*). Below are specific examples:

Invented Words

These are seen to be inherently distinctive (*Plascon-Evans Paint Ltd v Van Riebeeck Paints (Pty) Ltd 1984 3 SA 623 (A)*).Take the words "KODAK", "MINOLTA" and "EXXON" for example. Today these are respectively associated with photographs, cameras and printers, and petroleum, but are not words with a specific meaning in any language.

Portmanteau Words

These are ordinary words that have been joined together to create a particular effect. In the case of *Campina Melkunie BV v Benelux-Merkenbureau Case C 265/00 (ECJ)* (the BIOMILD case), the Court held that even though the combination of the two words, "BIO" and "MILD", created a new expression, the meaning of the two words still described the goods. The test here would be whether it creates something unexpected. Is there a skilful illusion present? If not, the trade mark is descriptive and cannot be distinctive.

In *Proctor & Gamble v OHIM (BABY-DRY) [2002] RPC 369 (ECJ) 377 at paragraph 40*, it was held that:

> *"[a]ny perceptible difference between the combination of words submitted for registration and the terms used in the common parlance of the relevant class of consumers to designate the goods or services or their essential characteristics is apt to confer distinctive character on the word combination enabling it to be registered as a trade mark."*

Furthermore, the combination of the two words must be juxtaposed in a *"syntactically unusual"* way (*BABY-DRY case at paragraph 43*).

Geographical Terms

In *Century City Apartment Property Services CC and Another v Century City Property Proprietors' Association 2010 (3) SA 1 (SCA)*, it was stated:

> *"it is in the public interest that they [geographical names] remain available, not least because they may be an indication of the quality and other characteristics of the categories of goods concerned, and may also, in various ways, influence consumer tastes by, for instance, associating the goods with a place that may give rise to a favourable response (Windsurfing Chiemsee Produktions-und Vertriebs GmbH v Boots-und Segelzubehor Walter Huber and Franz Attenberger [1999] ETMR 585 para 26.)"* (see Paragraph 3.3.3. below).

Laudatory Epithets

In *Estee Lauder Cosmetics Ltd v Registrar of Trade Marks 1993 3 SA 43 (T)*, it was held that laudatory epithets can never be the subject of a trade mark monopoly as this would unduly limit the free choice of language in the trade to advertise and market goods. Certain laudatory words, such as “good”, “best”, “excellent”, can never acquire distinctiveness no matter how much use is made thereof. However, there are instances where although laudatory in effect, words can acquire distinctiveness through extensive use.

Surnames

Surnames can be very distinctive, or completely non-distinctive. If the surname is a common one (ascertained by verifying electronic telephone directories to establish whether there are more than 100 such surnames in the directory), then the surname alone cannot be distinctive. If the surname is not common, then it may be distinctive.

In the case of *Gerst v Registrar of Trade Marks 1950 (3) SA 95 (T)* (also known as the *Dell case*), the Court was of the opinion that a surname could be problematic to register as a trade mark as it could prevent others with the same surname from using it for their own *bona fide* trading purposes.

The Court also mentioned that distinctiveness can be shown through evidence of use.

Letters and Numerals

The more random and atypical the letters or numerals are, the more likely it is that the sign will have the necessary distinctive character. Accordingly, the more a letter or numeral trade mark resembles signs commonly used in the relevant trade for non-trade mark purposes, the less likely it is to be distinctive.

Numerals and letters or number combinations will be accepted as trade marks, provided that they appear sufficiently random to individualise the goods or services of one undertaking. The distinctiveness of the trade mark must be assessed in respect of the goods or services as applied for.

Colour

In *Libertel Groep BV v Benelux-Merkenbureau C-104/01 (ECJ)*, it was held that:

> *"…it must be borne in mind that, whilst colours are capable of conveying certain associations of ideas, and of arousing feelings, they possess little inherent capacity for communicating specific information, especially since they are commonly and widely used, because of their appeal, in order to advertise and market goods or services, without any specific message…*
>
> *…However, that factual finding would not justify the conclusion that colours per se cannot, as a matter of principle, be considered to be capable of distinguishing the goods or services of one undertaking from those of other undertakings. The possibility that a colour per se may in some circumstances serve as a badge of origin of the goods or services of an undertaking cannot be ruled out. It must therefore be accepted that colours per se may be capable of distinguishing the goods or services of one undertaking from those of other undertakings."*

Therefore, the applicant would have to provide evidence of use that the colour(s) as applied for is capable of distinguishing in respect of each and every item covered by the specifications.

In *Societe Des Produits Nestle SA v Cadbury UK Ltd [2014] RPC 7 202 (CA)*, it was stated that an endorsement accompanying a colour trade mark should not include an unknown number of signs which is inconsistent with the definition of a trade mark*:*

> *"…In brief, the description of the mark as including not just the colour purple as a sign, but other signs, in which the colour purple predominates over other colours and other matter, means that the mark described is not "a sign." There is wrapped up in the verbal description of the mark an unknown number of signs. That does not satisfy the requirement of "a sign" within the meaning of Article 2, as interpreted in the rulings of the CJEU, nor does it satisfy the requirement of the graphic representation of "a sign", because the unknown number of signs means that the representation is not of "a sign." The mark applied for thus lacks the required clarity, precision, self-containment, durability and objectivity to qualify for registration..."*

Furthermore, it was held by the Tribunal of the Office of the Registrar in *Cadbury Limited v Beacon Sweets & Chocolates (Pty) Ltd*, that a single colour, being a word or the colour itself, is generally not capable of distinguishing:

> *"…It stands to reason that a colour in isolation cannot serve as a badge of origin. It can [only] best serve this purpose through prior use..."*

The colour depletion doctrine should be borne in mind. This doctrine states that the registration of colour trade marks should not be so that it does not allow for others to make *bona fide* use of colours.

Containers

Container trade marks refer to a bottle, tin, box, carton, packet or packaging used in relation to specific goods. In the case of *AW Faber-Castell (SA) (Pty) Ltd v Schwan-Stabilo Schwanhauser GmbH & Co SAPJ August 1981 22722-8 (TPD)*, the principle of the container being registrable only in respect of the goods it contains was upheld. The Court stated the following:

> "*…the well-known Dimple bottle that contains a familiar brand of whisky is registrable as a container for goods because what is purchased in such a case is whisky, not the bottle. A bottle of glue with a rubber applicator would fall into the same group. The highlighter, on the application of this test, is no more entitled to a container mark registration than a fountain pen. It could hardly be said that the purchaser of a fountain pen is merely buying ink."*

The shape of a container must still be capable of distinguishing. In *Die Bergkelder Bpk v Verendal Koop Wynmakery and Others 2006 4 SA 275 (SCA)*, Harms JA referred to the *Henkel C-218/01 (ECJ)* judgments of the ECJ and stated that a container trade mark must at least differ "*significantly from the norm or custom of the sector*".

Slogans

As per *Heublin Inc v Golden Fried Chicken (Pty) Ltd 1982 4 SA 84 (T)* in order to be registrable, the slogan must "*not [be] a phrase in ordinary use in the English language."* It must be *"a novel and original combination of words".*

Name and Likeness

Generally, the name and likeness of well-known individuals cannot be capable of distinguishing as it does not perform the "badge of origin function". If the well-known individual has licensed his name and likeness in respect of certain goods or service, then the name and likeness may very well be capable of distinguishing.

One must be cognisant of the fact that the goodwill of a person and brand must be protected.

Shape

In *Beecham Group Plc and Another v Triomed (Pty) Ltd 2003 (3) SA 639 (SCA)*, the SCA asked whether (i) the shape of the tablets were for the purpose of distinguishing Beecham's tablet from other traders' tablets, or (ii) whether the function of the shape of the tablet was to distinguish these particular Beecham tablets from other Beecham tablets (*i.e.* Beecham's tablets vs. Beecham's tablets OR Beecham's tablets vs. other traders' tablets). The SCA concluded that the shape did not serve to distinguish the tablets of Beecham from those of other traders, but may somewhat distinguish the tablets from other Beecham tablets.

Relying on the ECJ judgment in *Case C-299/99 Koninklijke Philips Electronics NV v Remington Consumer Products Ltd. [2002] ECR I-05475*, the Court stated that where a trader has been the only supplier of goods to a particular market, extensive use of the sign may be sufficient for it to have acquired distinctiveness if as a result of that use, a substantial portion of the relevant class of persons associate that shape with that trader, or believe that goods of that shape come from that trader. Specific reliable data of consumer perception would need to be adduced.

Misspelt Phonetic Equivalents

In the case of *Hasbro Inc & Ors v 123 Nahrmittel GmbH & Anor [2011] EWHC 199 (Ch) (11 February 2011)*, the registrability of the misspelt phonetic equivalent of a non-distinctive word was considered.

The principle that a phonetic equivalent of a descriptive word is not registrable was founded on the law considered in *Electrix Ltd's Application [1959] RPC 283; [1960] AC 722*:

> *"My Lords, I can conveniently state the problem to be solved by the citation of a single sentence from the judgment of the Court of Appeal: "The doctrine," they said, "as we understand it, is that, if a given word is for any reason unregistrable in its proper spelling, then, inasmuch as trade marks appeal to the ear as well as to the eye, the objection (whatever it may be) to the registration of the properly spelt word applies equally to a word which is merely its phonetic equivalent." Applying that view of the law to the facts of the present case, the Court of Appeal held that, "electrix" being the phonetic equivalent of "electrics," and that word being unregistrable, "electrix" also was unregistrable."*

In *Hasbro*, however, the learned judge made the following observations at paragraph 176:

> *"The doctrine was nevertheless a very narrow one … Furthermore, those cases were decided at a time when there were some marks which were regarded as inherently unregistrable in law, no matter how distinctive they were in fact: see e.g. York Trade Mark [1984] RPC 231. So to shift the enquiry to the phonetic equivalent merely raises a whole set of further questions about registrability of the equivalent."*

Therefore, as per *Hasbro at paragraph 177*, the registrability of a misspelt phonetic equivalent of a non-distinctive word must be assessed as a whole, in light of trade mark law now recognising the factual distinctiveness of trade marks. This is to say that the high degree of phonetic equivalence is *"but one factor which might fall to be taken into consideration in that assessment."*

The other factors which should be taken into account are *"market share, intensity of use, length of use, amount of investment in promotion"* (*Hasbro at paragraph 178*).

Consideration is given to the phonetic aspect of a trade mark and the fact that the phonetic equivalent of a non-distinctive word *"has an inherent inability … to distinguish"* (*as per Hasbro at paragraph 178 and 179*):

> *"When the mark is heard rather than seen those elements* [i.e phonetic aspects] *are at their strongest. This is the most powerful argument against the validity of the mark. It means in my judgment that the mark has an inherently quite low capacity to distinguish the goods of one undertaking from those of another."*

Evidence of use may be considered in assessing whether the trade mark as applied for has acquired distinctiveness.

Decorative stitching/patterns/ornamentation

A factual enquiry about the trade mark significance of decorative stitching/pattern/ornamentation marks is carried out in terms of Section 10(1) (see *Lubbe* above) and is inextricably linked with whether the mark is capable of distinguishing as illustrated in *Adidas AG and Another v Pepkor Retail Ltd (187/12) [2013] ZASCA 3 (28 February 2013)*:

> *"[T]he question of whether the respondent was using the two and four stripes as trademarks or not: whether they were 'marks' (they were clearly 'ornamentation' and were covered by the definition of 'mark') used in relation to goods for the purpose of distinguishing these goods from the same kind of goods connected in the course of trade from any other person (and would therefore be 'trademarks' as defined in the Act). This is a factual issue, which must be determined, objectively, by how the marks would be perceived by the consumer. It seems to me that it will be very difficult to persuade a court that any mark applied to goods for 'embellishment' or 'decoration' (which are both covered by the ordinary meaning of 'ornamentation') is not applied for the purpose of distinguishing the goods."*

The inherent distinctiveness or otherwise of these types of marks is assessed in the following way:

> *"…Inasmuch as pocket stitching is a "commonly-adopted and well known form of ornamentation" for jeans, a "mere refinement" cannot be inherently distinctive. However, such stitching is capable of acquiring distinctiveness and the record shows the extent to which some purveyors of jeans tout their stitching and assert it as a source identifier…"* (*In re Right-On Co., Ltd. (USPTO Trademark Trial and Appeal Board)*).

Under the proviso to Section 10, decorative stitching/pattern/ornamentation marks can acquire distinctiveness as clearly illustrated with the remarks in *IN THE MATTER OF Application No 2070715 by Vivat Holdings Limited to register a trade mark in Class 25 AND IN THE MATTER OF Opposition thereto under No 49694 by Levi Strauss & Co.*:

> *"…I am satisfied that the opponent's use of its arcuate stitching mark is material - that is that it has been used as a trade mark. Further the article from Sportswear International that the applicant relies upon to show that stitch marks were commonly used on jeans by 1994 (in exhibit DW7 to Mr Wilson's declaration) identifies the Levi Strauss "Double Arcuate" stitch mark as the mark which started the trend and resulted in decorative stitching becoming "the unique signature of a jeans brand…*
>
> *…I believe that the evidence is sufficient for me to find that the opponent's arcuate trade mark is distinctive to a significant proportion of the relevant public for jeans, albeit as a secondary means of identifying the opponent's goods..."*

3.3.3 Section 10(2)(b)

In terms of Section 10(2)(b), it must be noted at the outset that as per *Discovery Holdings Ltd v Sanlam Ltd and Others 2015 1 SA 365 (WCC)* at paragraph 84:

> *"Section 10(2)(b) … is not concerned with distinctiveness, but serves a public interest and seeks to preserve the rights of other traders."*

This section prohibits the registration of trade marks that are comprised solely of words or signs which are descriptive of the product or service and would therefore be required by other traders to conduct their business. There is not an exhaustive list, but the following are expressly mentioned:

- **Kind** – This refers to generic expressions or names of goods or services. A good test is to ask if the product or service can be called anything else. A word may allude to the product or service.
- **Quality** – This generally includes the prohibition on laudatory words.

- **Quantity** – This does not *per se* preclude the registration of numerals. A unit of measurement would have to be present to indicate quantity, such as “100 grams”.

- **Intended Purpose** – This precludes generic expressions such as “tyre replacement”.

- **Value** – This is similar to the prohibition on intended purpose such as “sale” or “discount”.

- **Geographical Origin** – this prohibits the registration of trade marks consisting solely of a geographical name, unless the geographical location has no current or possible future association with the goods or services as applied for.

- **Mode or Time of Production or Rendering of Services** – This prohibits words which traders would use, such as the time when grapes are harvested, or the year in which a wine was bottled.

In line with the public interest objective of Section 10(2)(b), in *Case C-191/01 Office for Harmonisation in the Internal Market (Trade Marks and Designs) v Wm. Wrigley Jr. Company* at paragraph 32, the ECJ stated:

> *"[I]t is not necessary that the signs and indications composing the mark that are referred to in [the absolute ground for refusal] actually be in use at the time of the application for registration in a way that is descriptive of goods or services such as those in relation to which the application is filed, or of characteristics of those goods or services. It is sufficient, as the wording of that provision itself indicates, that such signs and indications could be used for such purposes."*

Furthermore,

> *"A sign must therefore be refused registration under that provision if at least one of its possible meanings designates a characteristic of the goods or services concerned".*

As per *Starbucks (HK) Ltd v British Sky Broadcasting Group Plc [2013] FSR 29 623 (ChD)* at paragraphs 92 – 97, the authors of Webster and Page at page 3-64(7) state:

> *"A sign is caught by the exclusion [of section 10(2)(b)] if at least one of its possible meanings designates a characteristic of goods or services concerned."*

In *Century City Apartment Property Services CC and Another v Century City Property Proprietors' Association 2010 (3) SA 1 (SCA)*, the reason for this section's prohibition was due to the fact that descriptive words in the English language belong to everyone and that no single person can prevent another from using a descriptive term of a product or service.

The proviso of Section 10 states that a trade mark falling foul of Section 10(2) may become registrable by proving use of the trade mark as depicted on the goods or services in question, for a continuous period of five years prior to the date of application. However, in *Beecham Group plc and Another v Triomed (Pty) Ltd 2003 (3) SA 639 (SCA)*, it was stated that no amount of use of a highly descriptive or laudatory word can render a trade mark distinctive (also see Paragraph 3.3.2 hereon).

3.3.4 Section 10(2)(c)

Section 10(2)(c) prohibits the registration of all generic features and includes all signs such as shapes, colours, configurations, patterns and ornamentation which have become customary in the current language or established practices of the particular trade at the date of application. This section thus means that the current language and market place is taken into account and not the future, such as in Section 10(11) (*Estee Lauder Cosmetics Ltd v Registrar of Trade Marks 1993 3 SA 43 (T)*).

Mere use of the trade mark is not sufficient to overcome a Section 10(2)(c) refusal. The applicant or proprietor would have to prove that the trade mark as applied for has developed a secondary meaning despite being customary in the particular trade.

3.3.5 Section 10(3) – Lack of *bona fide* claim to proprietorship

In terms of Section 10(3), the proprietor of a trade mark is seen as the person who has *bona fide* (honestly and in good faith) first made use of, or appropriated, a mark, in relation to the goods or services offered thereunder, as a trade mark. The fact that a trade mark might be registered in another country does not by default mean that an applicant in South Africa cannot adopt and register the trade mark. This flows from the nature of a trade mark as in general being territorial in protection. Of course there are exceptions hereto, for example foreign trade marks which are possibly well-known in South Africa.

The relevant factors to consider when determining a *bona fide* claim to proprietorship include:

- dishonesty
- breach of confidence
- sharp practice

3.3.6 Section 10(4) – Lack of *bona fide* intention to use the mark as a trade mark

Section 10(4) deals with the requirement that there must be a real and *bona fide* intention to use the trade mark in relation to the goods or services as applied for, in the course of trade. If an applicant has not made use of the trade mark at the date of application, he must have a *bona fide* intention of using the mark as a trade mark either himself or through any person permitted by him or to be permitted by him, in the future (*South African Football Association v Sandton Woodrush (Pty) Ltd 2002 2 SA 236 (T)*). An intention to use the mark as simple ornamentation would not qualify as a *bona fide* intention to use the mark as a trade mark.

3.3.7 Sections 10(5) and 10(11)

In terms of Section 10(5) of the Act, registration is excluded in the following instances:

The shape which results from the nature of the goods themselves

This shape is not registrable as a trade mark, but grounds for refusal will apply only when the trade mark applied for consists exclusively of the actual shape of the goods. The shape cannot be registered if it is found that the shape in question is descriptive of the nature of the goods.

The shape which is necessary to obtain a technical result

Signs which consists exclusively of a shape which is necessary to obtain a technical result cannot be registered.

It was held in *Case C-299/99 Koninklijke Philips Electronics NV v Remington Consumer Products Ltd. [2002] ECR I-05475* that when it comes to signs which consist exclusively of the shape of goods which is necessary to obtain a technical result, Section 10(5) precludes the registration of shapes where the essential characteristics of the shape performs a technical function, with the result that the exclusivity inherent in the trade mark right would limit the possibility of competitors supplying a product incorporating such a function, or at least limit their freedom of choice with regard to the technical solution they wish adopt in order to incorporate such a function in their product.

Registration of a trade mark which would therefore actually impede the use of that technical solution by other undertakings, are thus not to the registered.

The shape which gives substantial value to the goods

Signs consisting exclusively of the shape which gives substantial value to the goods cannot be registered, or, if registered, are liable to be declared invalid.

In essence, this ground of refusal will mostly apply to those goods where the shape of the object concerned is the main (although not necessarily the only) factor that determines the decision to buy it.

Therefore, in terms of the Act, a shape, configuration, colour or pattern of goods is registrable subject to the condition that it is not required to obtain a specific technical result, or that it results from the nature of the goods themselves. The shape, configuration, colour or pattern of goods should not limit the development of any art or industry. It is also important to note that a shape, configuration, colour or pattern cannot be registered in relation to services, but only in relation to goods.

An application for registration of a shape, configuration, colour or pattern of goods as a trade mark in relation to goods could be accepted if:

- the application is lodged in relation to goods;
- the shape, configuration, colour or pattern is applied to the goods;
- the shape, configuration, colour or pattern, as applied to the goods, is distinctive in relation to the specific goods;
- the application clearly and precisely defines the shape, configuration, colour or pattern of goods through the appropriate endorsement, and that the required representations are attached;
- the shape, configuration, colour or pattern of goods is not necessary to obtain a specific technical result;

- the shape, configuration, colour or pattern of goods does not results from the nature of the goods themselves; and
- the shape, configuration, colour or pattern of goods is not likely to limit the development of any art or industry.

The more closely the shape, configuration, colour or pattern is to being purely functional, the more likely it is or will become likely to limit the development of any art or industry. The following case law can be referenced in this regard:

Philips Electronics NV v Remington Consumer Products Ltd 1999 RPC 809 (CA) and Triomed (Pty) Ltd v Beecham Group Plc 2001 2 All SA 126 (T):

> *"…In my view a shape of an article cannot be registered in respect of goods of that shape unless it contains some addition to the shape of the article which has trade mark significance. It is that addition which makes it capable of distinguishing the trade mark proprietor's goods from the same sort of goods sold by another trader…"*

Koninklijke Philips Electronic NO v Remington Consumer Products Ltd 2003 RPC 2 14:

> *"…The criteria for assessing the distinctiveness of a shape mark is the same as that for other marks. The mark must simply be capable of distinguishing the goods from that of other proprietors. Functionality is therefore not disqualified per se – only if that functionality is specific to the goods…"*

Beecham Group Plc and Another v Triomed (Pty) Ltd 2003 (3) SA 639 (SCA):

> *"…Where a functional product is bought because of the functionality attained by its shape and not the aesthetics thereof, such a shape would not be capable of distinguishing and is likely to limit the art or industry if registered…"*

Die Bergkelder Bpk v Verendal Koop Wynmakery and Others 2006 4 SA 275 (SCA):

> *"…The problem they pose for their promoters is that according to the public perception containers and shapes generally do not, in American parlance, serve as a source identifier…"*

Lubbe NO v Millennium Style 2007 4 All SA 692 (SCA):

> *"…shapes and configurations may be registered as trade marks. But the mere fact that they may be distinctive does not mean that they are distinctive in the trade mark sense, i.e. to indicate a source of origin. Typically the pattern or shape of a shoe sole would be regarded by the purchasers as either ornamental or as part of the design of the shoe tread and it is seldom that it will be considered to be a source identifier…"*

Société des Produits Nestlé SA v International Foodstuffs 100/14 (2014) ZASCA 187:

> *"…Where the evidence submitted by the applicant shows that all the essential features of the shape in question serves a technical function, or that the shape gives a substantial value to the goods, such mark is unregistrable…"*

Hauck GmbH & Co. KG v Stokke A/S & Others 2014 Case C-205/13:

> *"…Consequently, in order to apply the first indent of Article 3(1)(e) of the trade marks directive correctly, it is necessary to identify the essential characteristics — that is, the most important elements — of the sign concerned on a case-by-case basis, that assessment being based either on the overall impression produced by the sign or on an examination of each of the components of that sign…*
>
> *…In that regard, it must be emphasised that the ground for refusal of registration set out in the first indent of Article 3(1)(e) of the trade marks directive cannot be applicable where the trade mark application relates to a shape of goods in which another element, such as a decorative or imaginative element, which is not inherent to the generic function of the goods, plays an important or essential role…*
>
> *…Thus, an interpretation of the first indent of that provision whereby that indent is to apply only to signs which consist exclusively of shapes which are indispensable to the function of the goods in question, leaving the producer of those goods no leeway to make a personal essential contribution, would not allow the objective of the ground for refusal set out therein to be fully realised…"*

When dealing with container trade marks, Section 10(11) provides that a container for goods is registrable as long as it does not limit the development of any art or industry.

An application for registration of a container for goods as a trade mark in relation to goods could be accepted if:

- the application is lodged in relation to goods;
- the container will be used in relation to the packaging and sale of the goods. It must therefore be a trade mark in relation to the content of the container and not in relation to the container itself;
- the container is distinctive in relation to the specific goods;
- the application clearly and precisely defines the trade mark as a container for goods through the appropriate endorsement, and that the required representations are attached; and
- the container for goods is not likely to limit the development of any art or industry.

Where an application for a container of goods has matter other than decorative matter (for example another trade mark), both the container and the added matter must be examined respectively.

The more closely the container is to being purely functional, the more likely it is, or will become likely, to limit the development of any art or industry. Also refer to Paragraph 3.3.2 on container marks, above.

3.3.8 Section 10(7) – Applications made *mala fide*

Section 10(7) deals with the prohibition of the registration of a trade mark where the applicant has an improper motive or intention for seeking registration. An example would be where the trade mark contains copyrighted material of a 3rd party.

This section follows on from Section 10(3), which requires a *bona fide* claim to proprietorship. Although an applicant is not barred from registering a trade mark which is registered outside South Africa, if the applicant had contact with the proprietor or establishment of the foreign trade mark and thereafter sought registration in South Africa, he would be seen as acting *male fide* (in bad faith).

3.3.9 Section 10(8)

Section 10(8) of the Act gives effect to South Africa's international obligations under Article 6*ter* of the *Paris Convention for the Protection of Industrial Property of 1883*. The purpose of Article 6*ter* (and therefore Section 10(8)) is:

> *"…to protect armorial bearings, flags and other State emblems of the States party to the Paris Convention as well as official signs and hallmarks indicating control and warranty adopted by them. This protection was extended to armorial bearings, flags, other emblems, abbreviations and names of international intergovernmental organizations by the Revision Conference of Lisbon in 1958." (World Intellectual Property Organization (WIPO) website)*

As such, the wording of Section 10(8), in giving effect to Article 6*ter* of the *Paris Convention* reads:

> *"10. Unregistrable trade marks.*
>
> *The following marks shall not be registered as trade marks or, if registered, shall, subject to the provisions of sections 3 and 70, be liable to be removed from the register:*
>
> *(8) (a) mark which consists of or contains the national flag of the Republic or a convention country, or an imitation from a heraldic point of view, without the authorization of the competent authority of the Republic or convention country, as the case may be, unless it appears to the registrar that use of the flag in the manner proposed is permitted without such authorization;*
>
> *(b) a mark which consists of or contains the armorial bearings or any other state emblem of the Republic or a convention country, or an imitation from a heraldic point of view, without the authorization of the competent authority of the Republic or convention country, as the case may be;*

(c) a mark which consists of or contains an official sign or hallmark adopted by the Republic or a convention country, or an imitation from a heraldic point of view, and which indicates control and warranty, in relation to goods or services of the same or a similar kind as those in relation to which it indicates control and warranty, without the authorization of the competent authority of the Republic or convention country, as the case may be;

(d) a mark which consists of or contains the flag, the armorial bearings or any other emblem, or an imitation from a heraldic point of view, or the name, or the abbreviation of the name, of any international organization of which one or more convention countries are members, without the authorization of the organization concerned, unless it appears to the registrar that use of the flag, armorial bearings, other emblem or imitation or the name or abbreviation in the manner proposed, is not such as to suggest to the public that a connection exists between the organization and the mark, or is not likely to mislead the public as to the existence of a connection between the organization and the proprietor of the mark."

In practice, the trade mark examiner will, in terms of Regulation 10(2) of the Regulations made in terms of the Act, request the applicant to furnish consent from the competent authority of the Republic (of South Africa), or another convention country, for use of armorial bearings, flags, other state emblems, and/or official signs and hallmarks of a state party to the Paris Convention, viewed as possibly indicating control and warranty (Section 10(8)(a)-(d)). Regulation 10(2) reads:

"Where a representation of arms, insignia, a decoration or a flag appears on a mark, the Registrar may call for such justification, including such consent as he may deem necessary as the circumstances of the case may require."

If consent cannot be obtained from the competent authority for use of a national flag, the mark will fall foul of Section 10(8)(a), *"…unless it appears to the registrar that use of the flag in the manner proposed is permitted without such authorization."*

In respect of marks which consist of or contain the flag, the armorial bearings or any other emblem, or an imitation from a heraldic point of view, or the name, or the abbreviation of the name, of any international organisation of which one or more convention countries are members, such use may be allowed by the Registrar if the use does not *"…suggest to the public that a connection exists between the organisation and the mark, or is not likely to mislead the public as to the existence of a connection between the organization and the proprietor of the mark"* (Section 10(8)(d)).

3.3.10 Section 10(9)

Section 10(9) states that a mark is unregistrable if it:

> *"…contains any word, letter or device indicating State patronage…"*

Definitionally, Section 10(9) aims to prohibit the registration of any mark which suggests that the mark (and therefore the applicant) is vested with a power which only the State and State Organs can be vested with.

3.3.11 Section 10(10)

Section 10(10) states that a mark is unregistrable if it:

> *"…contains any mark specified in the regulations as being for the purposes of this section a prohibited mark…"*

This sub-section should be read in conjunction with Regulation 10(1)(a)-(b):

> *"Subject to the provisions of any other law, the Registrar may refuse to accept any application upon which any of the following appear:*
>
> *(a) The words 'patent', 'patented', 'by letters patent', 'registered', 'registered trade mark', 'registered design', 'copyright', 'certified', 'guaranteed' or words to like effect; and*
>
> *(b) the letters ®, © or similar combinations which may be construed to import a reference to registration."*

The reason these sub-regulations are read in conjunction with Section 10(10) is because of the express reference to Section 10(10) in parentheses below the heading of Regulation 10.



3.4 RELATIVE GROUNDS FOR REFUSAL

For a discussion on written submissions against the following relative grounds for refusal, kindly refer to Paragraph 4.2.2.

3.4.1 Section 10(6) and 10(17)

Both Sections 10(6) and 10(17) deal with the protection of trade marks that are well-known (the dilution provisions). These sections are not used by the Office for purpose of provisional refusal of an application, and are mainly used in opposition and rectification proceedings. For the sake of completeness however, a discussion on these sections will follow later in this document.

3.4.2 Section 10(12)

Section 10(12) of the Act states that the following trade marks cannot be registered:

> *"…a mark which is inherently deceptive or the use of which would be likely to deceive or cause confusion, be contrary to law, be contra bonos mores, or be likely to give offence to any class of persons…"*

This section therefore stipulates four categories of trade marks that are unregistrable:

- Inherently deceptive or likely to deceive cause confusion;
- Contrary to Law;
- *Contra bonos mores;* and
- Likely to give offence or cause annoyance to any persons or class of persons.

Inherently deceptive or likely to deceive or cause confusion

The deception or confusion that is referred to is the deception or confusion that would be caused in respect of the consumer. This deception or confusion need not be permanent, and can last only for a few moments, as pointed out in the case of *John Craig (Pty) Ltd v Dupa Clothing Industries (Pty) Ltd 1977 3 SA 144 (T) 151C*.

A trade mark may be inherently deceptive in the following ways:

- ***The character or quality of goods***

  In *McGlennon 1908 RPC 797 (Shamrock case)* it was held that the presence of a device, or a word or a name as part of a trade mark can only be said to deceive as to origin when there is a reasonable probability that such device, word, or name would suggest a misleading origin which must depend largely upon the question of whether or not the place has any particular significance in relation to the goods.

  In *Portalto Trade Mark (1967) RPC 617* it was held that where the word 'Portalto' is used as part of a trade mark in relation to wines that are not varieties of port, the trade mark is deceptive as it is likely to suggest that the wine is a variety of port.

- ***Deception resulting in danger to the public***

  In *Application for a Trade Mark of Lewis Thomas Edwards 1946 RPC 19 (Jardox case)*, where JARDOX was registered in relation to meat extracts and JARDEX was applied for in relation to disinfectants, it was pointed out that the goods might be used side by side with serious consequences to members of the public arising out of negligence or mistake.

  Oils International (Pty) Ltd v Wm Penn Oils Ltd 1965 (3) SA 64 (T) adopted a test formulated under Section 10(12), namely if the trade mark is used in a normal and fair manner in connection with any of the goods covered by the registration proposed, it should not be reasonably likely to cause deception and confusion amongst a substantial number of persons.

Contrary to Law

This is applicable when a trade mark contravenes any statutory provisions of any legislation in force in South Africa, including but not limited to the Trade Marks Act and legislations referred to in Paragraph 2.1 above. Any trade mark must be disentitled to registration if in its application for registration, it is contrary to any statutory provisions.

In applying this provision, the Office of the Registrar of Trade Marks is obligated to take cognisance of social developments and public perceptions.

For example the recent judgement of *Minister of Justice and Constitutional Development and Others v Prince; National Director of Public Prosecutions and Others v Rubin; National Director of Public Prosecutions and Others v Acton and Others* [2018] ZACC 30, wherein it was stated:

> *"The effect of the reading-in adopted above is that whenever the impugned provisions prohibit the use or possession or cultivation of cannabis, an exception is created with the result that the use or possession of cannabis in private or cultivation of cannabis in a private place for personal consumption in private is no longer a criminal offence."*

has as effect that any mark which includes a word, phrase, letters, symbol or image related to cannabis, shall no longer be deemed to be contrary to law, on condition that it meets the overall threshold of trade mark registration.

However, applications relating to cannabis itself or products made of or containing cannabis, in any class, shall still be deemed to be contrary to law. This is based thereon that even though private consumption and private cultivation of cannabis is allowed, its sale is not, nor is the trade in any product that contains cannabis. A distinction should however be made between cannabis (or marijuana) and hemp – the latter of which is not contrary to law.

It should be noted that, in the above judgment, the Court set a deadline to the Legislator to *"cure the constitutional defects"* within 24 months of the judgment being handed down, and the Office of the Registrar of Trade Marks shall take any further developments herein into consideration going forward.

Contra bonos mores

Section 10 (12) provides that if the use of a trade mark is *contra bonos mores,* the trade mark is disentitled to registration.

It was stated in *Oils International (Pty) Ltd v Wm Penn Oils Ltd 1965 (3) SA 64 (T)* that it is by no means clear that the refusal of registration by reason of the applicant's conduct was based upon the ground that use of the trade mark would be contrary to morality, and pointed out that such a refusal could be based on an exercise of the Registrar's discretion.

The case of *Schultz v Butt 1986 (3) SA 667 (A)* discussed a sense of fairness or good conduct. While fairness and honesty are relevant criteria in deciding whether competition is unfair, they are not the only criteria. Questions of public policy may be important in a particular case, for example, the importance of a free market, and of competition in our economic system.

Likely to give offence to any class of persons

Section 10(12) is not limited to majority groups. The fact that the views, beliefs or feelings which render a trade mark offensive are limited to a smaller group of people or individuals should not necessarily remove the trade mark outside the ambit of the prohibition.

In the case of the *"Hallelujah" Trade Mark 1976 RPC 605 610*, it was stated that registration may be refused in the exercise of the Registrar's discretion if registration would reasonably be likely to offend persons who might be in a minority in the community, yet be substantial in number.

In the case *of "Basic" Trade Mark SA's Trade Mark Application 2005 RPC 25 (AP) 611* (the "*Jesus*" trade mark), the Court stated the following:

> *"The power of a trade mark to produce a reaction inevitably varies according to the nature and intensity of the perceptions and recollections triggered by the relevant mark."*

The Court went on to state that when considering a refusal based on offence caused, the trade mark should cause "*greater offence than mere distaste*".
It must be borne in mind that the scope of this element of Section 10(12) is very wide and that each case should be considered on its own merits.

3.4.3 Section 10(13)

Section 10(13) of the Trade Marks Act states that the following trade marks cannot be registered:

> *"…a mark which as a result of the manner in which it has been used would be likely to cause deception or confusion…"*

New South Wales Dairy Corporation v Murray Goulburn Co-operative Co Ltd 1991 RPC 144 – Section 10(13) applies equally to use after registration leading to deception or confusion. *Webster and Page at page 3-79*, provides further clarity hereon:

> *"This subsection relates to marks which by reason of the manner of their use have led or would lead to the expectations of the public being unfulfilled."*

Licensing

Uncontrolled licensing could lead to deception or confusion as envisaged in this section, as it could lead to the trade mark concerned losing its capacity to indicate the goods or services of a consistent standard of quality and not being able to distinguish such goods or services. This would refer to a situation of bare licensing. This essentially means that the licensee is not subjected to any quality control (in terms of the use of the mark) by the licensor.

In this regard, *Webster and Page* at page 3-80, state:

> *"…so-called bare licensing is not prohibited in terms of the 1993 Trade Marks Act, and the issue of whether the grant or exercise of a bare license has lead to loss of distinctiveness or to a mark causing deception or confusion is one of fact..."*

Quality

If a trade mark alludes to the quality or kind of goods or services, and the goods or services do not have such a quality or are not of such a kind, the use of the trade mark will lead to deception or confusion.

Geographical origin

Section 10(13) precludes registration of trade marks which in use are confusing and deceptive as to geographical origin.

In the *Smirnoff Trade Mark [2006] RPC 16 453 (AP)* case, the Court found that the 'deceptive use' was not likely to mislead the reasonably well-informed and circumspect customers, and that their economic behaviour would not be affected. Further, it found that the public would not be misled with regard to the place of origin.

3.4.4 Section 10(14)

Section 10(14) sets out the ground for refusal dealing with a conflict of prior registered rights. It states that the following trade marks shall not be registered:

> *"…a mark which is identical to a registered trade mark belonging to a different proprietor or similar thereto that the use thereof in relation to goods or services in respect of which it is sought to be registered and which are the same as or similar to the goods or services in respect of which such trade mark is registered, would be likely to deceive or cause confusion, unless the proprietor of such trade mark consents to the registration of such mark…"*

This ground for refusal can be overcome by written consent being obtained from the proprietor of the prior trade mark. In such a circumstance, the applicant will be required to furnish the Office with the original written consent and enter an endorsement stating: *"By consent of the proprietor(s) of trade mark registration number(s) xxxx/xxxxx…".*

Comparison of trade marks

In *Cowbell AG v ICS Holdings Ltd (250/99) [2001] ZASCA 18; [2001] 4 All SA 242 (A) (16 March 2001)*, the Supreme Court of Appeal followed the approach of the European Court of Justice ("the ECJ") in *Sable BVV Puma AG, Rudolf Dassler Sport [1998] RPC 199 ECJ 224* in respect of comparing trade marks. In this case, the ECJ stated the following:

> *"[The] global appreciation of the visual, aural or conceptual similarity of the marks in question, must be based on the overall impression given by the marks, bearing in mind in particular, their distinctive and dominant components."*

The applicant's trade mark will be compared with trade marks already registered by applying a **'sound, sense and appearance'** comparison as set out above. It should be noted that for purposes of comparison of trade marks, a mark as applied for need not fall foul of all three these characteristics. Should it be found to be similar to a prior mark in terms of any one of the three characteristics, the latter mark is still to be refused.

In *Yair Shimansky v Browns the Diamond Store 2014 BIP 341 (SCA)*, the SCA reaffirmed that it is sufficient if there is confusion as to only one aspect of sense, sound OR appearance:

> *"It is important, however, to take into account a number of cases that state that a likelihood of deception or confusion in any one of the characteristics of sense, sound or appearance will be sufficient…"*

The comparison of trade marks is a factual issue. Below are a list of factors which are taken into account by the Office in determining whether trade marks are confusingly similar.

Nature of the goods or services and the class of customer

The test to determine confusing similarity does vary to an extent, in accordance with the nature of the goods.

Webster and Page at page 7-4(2) states:

> *"[I]n the case of a commodity that would be consumed over … a large section of the community, the likelihood of confusion could be greater than in the case of a commodity… … that would find its way to discriminating persons only."*

The following remarks were made in *Cointreau et cie SA v Pagan International 1991 4 SA 706 (A) 717B*:

> *"A liqueur is an expensive type of liquor. It is consumed less frequently than other liquor products and also as an after dinner drink with coffee. It appeals to the more educated and sophisticated sections of the community and purchasers of liqueur are generally discerning buyers, very brand conscious and careful to seek out the brand they want."*

Doctrine of imperfect recollection and perception

In *Plascon-Evans Paints (TVL) Ltd. v Van Riebeck Paints (Pty) Ltd. (53/84) [1984] ZASCA 51; [1984] 2 All SA 366 (A); 1984 (3) SA 623; 1984 (3) SA 620 (21 May 1984)*, it was held that the notional consumer is one of average intelligence, having proper eyesight, and buying with ordinary caution. Furthermore, it was held that trade marks must not only be considered side by side, but also separately, taking into account the imperfect recollection of the consumer.

In this regard, the following statement from UK courts can be of assistance:

> "*The court must be careful to make allowance for imperfect recollection and effect of careless pronunciation and speech on the part not only of the person seeking to buy under the trade description, but also of shop assistants ministering to that person's wants*." (*Re: Rysta Ltd's Application 1943 RPC 87 108*)

The principle that marks should not be compared side by side given the plethora of ways in which a mark can be communicated to the ultimate consumer was set out in *American Chewing Products Corporation v American Chicle Co 1948 2 SA 736 (A)*:

> *"It must also be remembered that in coming to a conclusion on the question in issue, the court must not only consider the marks when placed side by side, but must have regard to the position of a person who might at one time see or hear one of the marks and later, possibly with an imperfect recollection of that mark, come across the other mark."*

Idea conveyed by the trade mark

This factor simply means that what must be taken into account is the feature which is likely to impress itself on, and remain in, the memory of the notional user. However, in *Cowbell AG v ICS Holdings Ltd (250/99) [2001] ZASCA 18; [2001] 4 All SA 242 (A) (16 March 2001)*, it was held that registered trade marks do not create monopolies in concepts or ideas.

The Court made the following statement in *National Brands Ltd v Blue Lion Manufacturing (Pty) Ltd 2001 3 SA 563 (SCA) 568D*:

> *"A word mark, and particularly one that makes use of ordinary language, is not merely a combination of abstract symbols … but is usually recognisable as a whole…"*

Therefore, the visual appearance and similarity cannot altogether be separated from its sense.

Dominant feature of the trade mark

In *Plascon-Evans Paints (TVL) Ltd. v Van Riebeck Paints (Pty) Ltd. (53/84) [1984] ZASCA 51; [1984] 2 All SA 366 (A); 1984 (3) SA 623; 1984 (3) SA 620 (21 May 1984)*, it was held that the dominant features or idea of the trade marks must be taken into account when assessing the impact on the notional consumer. Trade marks are remembered by a striking or dominant feature, rather than by a photographic recollection.

Trade marks containing a common element

Webster and Page at page 7-14(2) states:

> *"Where marks contain a common element, which is in common use in the market in the goods concerned, the public are likely to pay more attention to the other features and to distinguish the goods by those features."*

Adoption by the applicant of the whole of the cited trade mark

The authors of *Webster and Page at page 7-19* state that when comparing if trade marks are confusingly similar it:

> *"…naturally depend[s] on the manner in which the [cited] marks appear as part of the [A]pplicant's mark. If it retains its identity, deception or confusion will be likely – but it will not be, if the identity is lost or absorbed."*

Furthermore, the authors of *Webster and Page at page 7-19* states:

> *"In the case of a composite mark which incorporates the [cited] mark[s] … it appears that the question to be considered is whether the average consumer would perceive the common element to have significance independently of the composite mark as a whole and whether that would lead to a likelihood of confusion."*

Comparison of goods and services

In *British Sugar Plc v James Robertson & Sons Ltd. [1996] RPC 281*, the following factors relevant in considering whether there is similarity between goods were set out:

- The respective uses of the respective goods and services;
- The respective users of the respective goods and services;
- The physical nature of the goods or acts of service;
- The respective trade channels through which the goods or services reach the market;

- In the case of self-serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves; and
- The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sector.

Goods can be deemed to be similar to services. It is important to note that the abovementioned factors only provide general guidance and serve to stimulate the enquiry (*Mettenheimer and Another v Zonquasdrif Vineyards CC and Others (965/12) [2013] ZASCA 152; 2014 (2) SA 204 (SCA); [2014] 1 All SA 645 (SCA)*).

Goods can be deemed to be similar to services. It is important to note that the abovementioned factors only provide general guidance and serve to stimulate the enquiry and are not exhaustive (*Mettenheimer and Another v Zonquasdrif Vineyards CC and Others (965/12) [2013] ZASCA 152; 2014 (2) SA 204 (SCA); [2014] 1 All SA 645 (SCA)*):

> *"[13] …Included amongst the considerations proposed in these cases are: (a) the uses of the respective goods; (b) the users of the respective goods; (c) the physical nature of the goods; and (d) the respective trade channels through which the goods reach the market. It is clear that the list of proposed considerations was never intended to be exhaustive. Yet they serve to stimulate and guide the required process of reasoning in the enquiry as to the likelihood of confusion."*

In this case, it must be noted that a very specific factual matrix was at issue: the similarity or otherwise of wine grapes vs. wine. In applying the factors mentioned above, the SCA in its judgment focused to a large extent on the users, uses, physical nature and trade channels. In this regard, the SCA made the following remarks:

> *"[14] On application of these considerations to wine grapes and wine, first impressions are that the likelihood of confusion is slight indeed. The nature of the two products is entirely different. The one is a fruit – albeit inedible – and the other is an alcoholic beverage. As are their uses, their users and the trade channels through which they are marketed. Since wine grapes are not suitable for consumption as a fruit, they are not sold to the public and they are therefore not to be found in any retail outlets. Wine, on the other hand, is marketed, advertised and sold directly to the public in supermarkets, liquor stores and other retail outlets. The prospects of Zonquasdrift wine and Zonquasdrif grapes ever being marketed or sold in close proximity can therefore safely be excluded as non-existent…*
>
> *[15] The appellants' argument as to why, despite these distinct differences between the two products, they have succeeded in showing a likelihood of confusion, went along the following lines. Wine grapes constitute the raw material from which wine is made. Hence the two products are associated with one another. It is known in the industry that while some farms sell their wine grapes to wineries, others make their own wine from grapes produced on the farm or purchased from other farms. There is therefore no clear delineation between farms producing and selling grapes and those selling both wine and grapes. Although the appellants do not make their own wine and only sell their Zonquasdrift wine in Germany, they are entitled to sell their wine in South Africa as well. What must also be postulated as part of the appellants' notional use is that they may integrate their grape growing and wine-making activities on the farm Zonquasdrift. In these circumstances, so the appellants' argument went, the notional member of the public may very well be confused in thinking that the appellants' wine and the respondent's grapes originate from the same farm…*
>
> *[16] In evaluating the appellants' argument, it seems to me that it draws no distinction between the notional purchasers of grapes, on the one hand, and the notional purchasers of wine, on the other. But, in the light of the distinct differences between the two products that I have alluded to, I do not believe logical reasoning allows this conflation. For the very reason that wine grapes are suitable for wine-making only, they are exclusively sold to wine makers and wine co-operatives for that purpose. The undisputed evidence by the*

respondent is that wine cellars and wineries purchase grapes based on a number of factors, including the cultivar and the terroir, the vineyards and the like but not with reference to the trade names of wine or the names of farms. Furthermore, wineries and co-operative cellars make use of specialists in the wine industry to buy their wine grapes from approved suppliers who comply with their own established quality control standards. The chances of these buyers confusing the respondent's wine grapes as the source of the appellants' wine can therefore safely be excluded…

[17] The only enquiry worthy of pursuit therefore relates to the likelihood of notional purchasers of Zonquasdrift wine believing that they originate from the same farm as the respondent's grapes. The first question raised by this enquiry is whether the notional wine purchaser would be aware of the respondent's grapes that are sold under its trade name. Since the respondent does not market its wares in retail outlets or advertise them in the public domain, I cannot see why this awareness should be assumed. My second problem with the appellants' argument is this: in order for the notional purchaser to be confused in thinking that Zonquasdrift wine comes from the same farm as Zonquasdrif grapes, he or she must infer that (a) there is a farm Zonquasdrift; (b) that farm is owned by the same entity as the trade mark; and (c) that the wine is made of grapes grown on that farm. As I see it, however, there is no reason to assume that the notional purchaser will make all these inferences just by looking at the appellants' trade mark on their wine label…

[18] As to (a): it is well known that many trade marks in the wine industry are not associated with farms at all. That is so even where the trade mark bears resemblance to the name of an existing or non-existing farm. As to (b): even if the notional wine purchaser knew of the farm Zonquasdrift, there is no reason to think that he or she would have known or infer that the farm and the trade name belong to the same proprietor. As to (c): even if the notional purchaser knows or infers that there is a farm Zonquasdrift which belongs to the same entity as the trade mark, he or she would have no reason to infer that Zonquasdrift wine is made of grapes grown on that farm. An interesting exchange on the papers illustrates this point. In the answering affidavit Walters contended that, since the appellants' Zonquasdrift wine is made by Riebeek Cellars that sources its grapes from 32 farms, it cannot even be said that the wine sold under the appellants' trade mark is made from grapes grown on its farm. In reply the appellants then said – and this was confirmed by Mr Izak Bester who is the wine-maker at Riebeek Cellars - that Zonquasdrift wine is indeed made from chenin blanc grapes grown on the appellants' farm. The moral of the story is this: although there is no reason to doubt the correctness of Bester's version, he was clearly one of a very few who could say where the grapes came from. For all the potential purchaser knows, the grapes could come from one or more of 32 farms..."

The European Court of Justice in *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc 1999 RPC 117 (ECJ); 1999 FSR 332 (ECJ)* stated an additional factor to be taken into account when assessing the similarity of goods. The ECJ stated that a determination must also be made about whether the goods "*are complementary*".

Recently, in the English case of *Elliot's Trade Mark Application RPC (2014) 131 (6)* ("LUV" trade mark) the meaning of "*complementary*" was analysed. The appointed person in ***Elliot*** had regard to the principles stated in *Case T-325/06 Boston Scientific Ltd v Office for Harmonisation in the Internal Market (Trade Marks and Design) (OHIM)*. Webster and Page give a useful synopsis of these two cases:

> *"[G]oods are complimentary where although it is not necessary to use the products together, it may be important to use them together. The fact that the goods share an intended purpose render them complimentary. Another factor to take into account is whether the respective kinds of goods are in fact produced by the same manufacturers."*

As per *Ramsay, Son and Parker (Pty) (Ltd) v Media 24 Ltd and Another 2008 BIP 149 CPD PAR 12* cited by *Webster and Page at page 7-24*:

> *"[S]ection 10(14) requires the [Registrar] to postulate notional use by the [proprietors of the cited marks] of [their] registered trade mark[s] in respect of some or all of the goods covered by the registration and use in a normal and fair manner of the applicant's trade mark in respect of any of the goods covered by his application for registration."*

In *New Media Publicity v Eat Out Web Services CC and Another 2005 5 SA 388 (C)*, it was held that there is an interdependence between the two legs of the inquiry into the similarity of trade marks and similarity of goods. The more similar the trade marks, the less similar the goods, and *vice versa*. If goods or services are so dissimilar, no amount of resemblance between trade marks will result in a likelihood of confusion.

When comparing goods or services, the Registrar will analyse the wording of the specification. This is the frame of reference for comparing goods or services. However, there are generally accepted classes which are likely to be in conflict with each other. A table of classes and their conflicting counterparts can be found in "Annexure M".

Therefore, while the Registrar will look specifically at the specification in comparing goods or services, the table of conflicting classes assists in searching for conflicting marks during both the search and substantive examination processes.

Likelihood of deception or confusion

In *Cowbell AG v ICS Holdings Ltd (250/99) [2001] ZASCA 18; [2001] 4 All SA 242 (A) (16 March 2001),* it was asked whether on a comparison of the two trade marks, it can properly be said that there is a reasonable likelihood of confusion if both are used together in a normal and fair manner in the ordinary course of business. Likelihood in this context means a reasonable probability. In determining likelihood of deception or confusion, regard must be had to the essential function of a trade mark as a badge of origin.

Deception or confusion is amplified if the cited trade mark is highly distinctive or has a reputation (*Adidas AG and Another v Pepkor Retail Ltd (187/12) [2013] ZASCA 3 (SCA) (28 February 2013)*).

The Court in *Roodezandt Ko-operatiewe Wynmakery Ltd v Robertson Winery (Pty) Ltd and Another 2014 BIP 294 (SCA)* as cited by *Webster and Page at page 7-4* states:

> *"'Deception' will result, so it has been held, when the similarity were to cause members of the purchasing public to assume that the goods bearing the two competing trademarks come from the same source. 'Confusion', on the other hand, would occur if these members of the public will be caused to wonder if the goods had a common origin…"*

This deception or confusion does not have to transpire for an extended period of time and even when dealing with goods or services, where an argument could be made for the goods or services to be specialised and would have a more discerning consumer, the Court in *Orange Brand Services v Account Works Software (970/12) [2013] ZASCA (158)* as cited by *WEBSTER AND PAGE at page 7-5* states:

> *"Much was also made of the fact that customers in the market for accounting software, unlike consumers who select goods from a supermarket shelf, can be expected to be intelligently discerning, selecting to purchase the software only after careful scrutiny of its suitability, and not merely the mark. I have no doubt that computer software for accounting is indeed purchased with considerable care, but confusion need not be lasting for it to disqualify a mark from registration. It is sufficient if it is confusing only for a short time, sufficient to attract initial interest, albeit that the confusion might later be cleared up."*

Webster and Page at page 7-4 further states:

> *"The deception or confusion need last only a fraction of time and only one of the persons involved need to be deceived or confused…"*

As per *Hollywood Curl (Pty) Ltd v Twins Products (Pty) Ltd (1) 1989 1 SA 236 (A)*, it was held that the Registrar can take into account a disclaimed feature in assessing likelihood of deception or confusion.

Removed prior trade marks

For the purposes of determining any conflict with prior registered rights under both Sections 10(14) and 10(15), it is important to note that Section 37(4) states the following:

> *"Where a trade mark has been removed from the register for non-payment of the fee for renewal, it shall, nevertheless, for the purpose of any application for the registration of a trade mark during one year next following the date of the expiration of the last registration, be deemed to be a trade mark that is already on the register."*

This means that even where the status of an earlier mark is reflected as “unpaid” or “removed”, this mark will still be considered as a mark on the Register, and therefore posing a bar to the registration of the application in question under both Sections 10(14) and 10(15), for a period of one year following the date of its expiration.

“Extension of range” principle

When comparing goods or services in terms of Section 10(14), the following remarks in *Danco Clothing (Pty) Ltd v Nu-Care Marketing and Sales Promotions (Pty) Ltd and Another 1991 (4) SA 850 (AD)* inform another consideration to be taken into account:

> *"[Whether the proprietor/s of potential conflicting marks] at the time of registration [have] some definite and present intention to deal in certain goods or descriptions of goods, and not a mere general intention of extending his business at some future time to anything which he may think desirable."*

This consideration is inextricably linked with the *British Sugar* test of assessing whether the respective goods/services are competitive (*Chantelle v Designer Group (Pty) Ltd (A743/2013) [2015] ZAGPPHC 222 (24 April 2015)*).

In *Danco*, the following factual circumstances evidence the existence of “an extension of range” principle:

> *“In November 1986, according to the affidavit of Mr Cohen, the appellant's chairman and joint managing director, decided to expand its business into the field of cosmetics, toiletries and perfumery, which it proposed to sell under the mark "French Connection". This was in line with a trend, started by well-known designers and manufacturers of clothing such as Pierre Cardin, Yves St Laurent and Gucci; and according to which, so Cohen stated, it had lately become common "for manufacturers of well-known brands of clothing to extend their range of goods to items which are related to clothing, in particular cosmetics, perfumery, toiletries and jewelry..."*

"…It is a phenomenon which, according to Cohen, had become well known amongst members of the buying public generally who had come to "associate a particular brand of cosmetics, perfumery, toiletries or sun-tan preparations with clothing bearing the same trade mark…"

"…These statements (which were supported by similar views expressed by Mr Garden, a merchandise director of Edgars Stores Ltd, Mr Todd, the merchandise director of Truworths Ltd and Miss Black, the merchandise manager of the sportswear division of Foschini Stores) were not controverted by any evidence from the respondent…"

3.4.5 Section 10(15)

Section 10(15) sets out the ground for refusal dealing with a trade mark application being in conflict with an earlier pending trade mark application. It states that the following trade marks shall not be registered:

"…subject to the provisions of section 14 and paragraph (16), a mark which is identical to a mark which is the subject of an earlier application by a different person, or so similar thereto that the use thereof in relation to goods or services in respect of which it is sought to be registered and which are the same as or similar to the goods or services in respect of which the mark in respect of which the earlier application is made, would be likely to deceive or cause confusion, unless the person making the earlier application consents to the registration of such mark…"

Similar to Section 10(14), the ground for refusal under Section 10(15) can *inter alia* be overcome by written consent being obtained from the applicant of the cited prior trade mark application. In such circumstance, the applicant in the later application will be required to furnish the Office with the original written consent from the prior applicant, and enter an endorsement indicating such consent. Such an endorsement would typically read: *"By consent of the applicant(s) of trade mark application number(s) xxxx/xxxxx…".*

3.4.6 Section 10(16)

Section 10(16) stipulates that a mark is unregistrable if it:

> *"…is the subject of an earlier application as contemplated in paragraph (15), if the registration of that mark is contrary to existing rights of the person making the later application for registration as contemplated in that paragraph."*

Webster and Page at page 6-37 explains the practical effect of this:

> *"The practical effect of section 10(16) is that while the earlier application will pose a bar to the later application, the later applicant is able to oppose the earlier application on the grounds that it is contrary to his existing rights."*

This section therefore typically applies where convention applications are lodged (see Paragraph 2.3 hereon).

The learned authors further elaborate at page 6-30:

> *"…It is not clear [p]recisely what is meant by the phrase 'contrary to existing rights of the person making the later application' or, more particularly, what additional rights might be contemplated under section 10(16) which are not already dealt with in other subsections of section 10, and, in particular, subsections (3), (6), (12) and (17) of section 10..."*

In *Turbek Trading CC v A & D Spitz Ltd [2010] 2 All SA 284 (SCA)*, Spitz relied on the provisions of Section 10(16) to remove Turbek's registration on the basis that Turbek's trade mark was contrary to the existing rights of Spitz, who filed a later application or the same mark. The SCA made the following comments:

> *"…[17] In context the question is whether the mark 'KG' formed part of Spitz's goodwill. Spitz had to show that it was at the date the common-law proprietor of the 'KG' trade mark, and this required proof that Spitz 'originated, acquired or adopted it and has used it to the extent that it has gained the reputation as indicating that the goods in relation to which it is used' belonged to Spitz (Moorgate Tobacco Co Ltd v Philip Morris Inc – a trade mark determination by Hon WG Trollip referred to inter alia by Southwood J in Butterworths*

Publishers (Pty) Ltd v Jacobsens Group (Pty) Ltd [2005] 2 All SA 588 (T) para 34). As Colman J explained, extensive use creates the intangible property rights in an unregistered (common-law) trade mark (Oils International (Pty) Ltd v Wm Penn Oils Ltd 1965 (3) SA 64 (T) 70G). In other words, Spitz had to discharge the same onus in relation to reputation that it would have had under a passing-off claim (Adcock-Ingram Products Ltd v Beecham SA (Pty) Ltd 1977 (2) SA 434 (W) 436H-437E; Caterham Car Sales & Coachworks Ltd v Birkin Cars (Pty) Ltd [1998] ZASCA 44; 1998 (3) SA 938 (SCA) para 16 and 21-22)..."



3.5 CONDITIONAL ACCEPTANCE

Refer to paragraphs 4.1 and 4.2.1 below for further relevant information hereon.

3.5.1 MEANING AND DERIVATION

An application which is accepted subject to this condition is based on Regulation 14(1)-(2). Regulation 14(1)-(2) read as follows:

> *"14. Translation of languages*
>
> *(1) Where a trade mark or application contains a word or numeral in other than roman characters, there shall be endorsed on Form TM1 a transliteration and/or translation to the satisfaction of the Registrar of each such word or numeral.*
>
> *(2) Where a trade mark contains a word in a language other than an official language of the Republic the Registrar may ask for a translation thereof, and if he so requires, such translation shall be endorsed on Form TM1."*

Below are a couple of examples from the Register, which may provide clarity:

- Trade mark registration no. 2004/07994 

has been registered subject to and endorsement which reads: *"The Chinese characters appearing in the mark mean China Construction Bank."*

- Trade mark registration no. 1995/12312 

has been registered subject to an endorsement which reads: *"The Arabic characters in the mark mean EMIRATES and its transliteration is AL-IMARAT."*

3.5.2 LODGING / VALIDATING POWER OF ATTORNEY

Section 8(1) of the Act states:

> *"The registrar shall permit an agent to perform on behalf of the person for whom he is agent, any act in connection with registration under this Act or any proceedings relating thereto, and shall not permit a person other than an agent so to act."*

Furthermore, Regulation 9(1), which gives effect to the abovementioned section states:

> *"All communications to the Registrar relating to trade marks or trade mark applications may be signed by and all attendances upon the Registrar may be made by or through an agent practising in the Republic and duly authorised to the satisfaction of the Registrar. In any particular case the Registrar may, if he thinks fit, require the personal signature of an applicant, objector or other person."*

Therefore, on behalf of the applicant, an authorised agent must lodge a special- or General Power of Attorney authorising the agent to act on behalf of the applicant. The former refers to the circumstance where the applicant authorises the agent to specifically act on his/her/its behalf in respect of a particular trade mark application.

The latter refers to the circumstance where the applicant authorises the agent to act on his/her/its behalf in respect of all its trade mark matters before the Registrar. In this instance, upon lodging a General Power of Attorney, the applicant will be allocated a GPA number which can be included on the Form TM1 or any official form of the Office, for future applications and/or post-registration procedures.

If the special Power of Attorney or General Power of Attorney (or a GPA number, if allocated) is not on file or reflected on the Form TM1 at the time of examination, the Office will require a Power of Attorney to be lodged. In this instance, the official action issued will stipulate the following condition: *"Lodge a Power of Attorney."*

3.5.3 ASSOCIATION

Section 30(1) of the Act states:

> *"Where a trade mark that is registered or is the subject of an application for registration so resembles another trade mark that is registered or is the subject of an application for registration in the name of the same proprietor that the use of both such trade marks by different persons in relation to goods or services in respect of which they are respectively registered or proposed to be registered would be likely to deceive or cause confusion, the registrar may at any time require that the trade marks be entered in the register as associated trade marks."*

Therefore, as a condition of acceptance, the Office will call for an inter-association of marks if filed in a series and may also call for an association with the most recent prior mark in the name of the same proprietor (if any). If the mark is not filed in a series, the Office may call for an association with the most recent prior mark in the name of the same proprietor (if any). Thereon, Section 30(3) states:

> "*…Any association of a trade mark with any other trade mark registered in the name of the same proprietor shall be deemed to be an association with all trade marks associated with that other trade mark."*

When agreeing to the association requirement, applicants are required to agree to such association, to authorise the Office to deduct the official fees from the CIPC customer account, and to ensure that sufficient fees are available in their customer accounts to prevent delays in processing acceptance of the application(s).

The effect of an association in terms of Section 30(4) is as follows:

> *"…trade marks that are registered as, or that are deemed by virtue of this Act to be, associated trade marks shall only be assignable or transmissible together and not separately, but they shall for all other purposes be deemed to have been registered as separate marks…"*

3.5.4 DISCLAIMERS

Section 15 of the Trade Marks Act stipulates:

> *"15. Registration subject to disclaimer*
> *If a trade mark contains matter which is not capable of distinguishing within the meaning of section 9, the registrar or the court, in deciding whether the trade mark shall be entered in or shall remain on the register, may require, as a condition of its being entered in or remaining on the register*
>
> *(a) that the proprietor shall disclaim any right to the exclusive use of all or any portion of any such matter to the exclusive use of which the registrar or the court holds him not to be entitled; or*
> *(b) that the proprietor shall make such other disclaimer or memorandum as the registrar or the court may consider necessary for the purpose of defining his rights under the registration:*
> *Provided that no disclaimer or memorandum on the register shall affect any rights of the proprietor of a trade mark except such as arise out of the registration of the trade mark in respect of which the disclaimer is made."*

The purpose of disclaimers

Section 15 of the Trade Marks Act provides that:

> *"…if a trade mark contains matter which is not capable of distinguishing within the meaning of [section] 9, [the Registrar] may require that the proprietor disclaim any right to the exclusive use of such matter."*

Therefore,

> *"…[s]ection 15 is not concerned with the question whether a trade mark itself is incapable of distinguishing, but whether matter contained in a trade mark lacks this capability."* (*Cadbury (Pty) Ltd v Beacon Sweets & Chocolates (Pty) Ltd and Another 2000 (2) SA 771 (SCA)*).

A call for a disclaimer is an exercise of discretion. The particular function of a disclaimer was captured in the following passage in *Cadbury (Pty) Ltd v Beacon Sweets & Chocolates (Pty) Ltd and Another 2000 (2) SA 771 (SCA)*:

> *"As was pointed out by the hearing officer in Philip Morris Inc's Trade Mark Application [1980] RPC 527 at 532 - 3, a disclaimer is, theoretically, never necessary since registration of a trade mark cannot give rise to any rights except those arising from the mark as a whole. It has nonetheless a function. Primarily, it is to prevent the registration of a composite mark from operating so as to inhibit the use of the disclaimed element by others… Statutory monopolies are the exception, not the rule and they need to be justified (Wagamama Ltd v City Centre Restaurants plc and Another [1995] FSR 713 (Ch) at 728 - 9)."*

Therefore, the disclaimer of a word or device allows other traders to use the disclaimed feature in their trade marks, and disallows the claiming of the rights in the disclaimed features, with the result that the registered proprietor cannot institute an action for trade mark infringement in respect of the use or limitation of the disclaimed feature alone.

Where an application consists of, or contains a device, which is related to the goods or services of interest, and the device is sufficiently stylized to merit registration, the applicable device should be disclaimed in general. If the device is in itself not sufficiently distinctive so as to ensure registration, it should be disclaimed.

When non-distinctive words appearing in the trade mark are reflected in the goods or service description, these words need not be disclaimed as it is clear that they are used descriptively and that no rights can be obtained therein.

Forms of disclaimers

The following standard wording applies to a disclaimer:

"Registration of this trade mark shall give no right to the exclusive use of […] separately and apart from the mark."

In the case of a geographical disclaimer, the following wording is acceptable:

"Registration of this trade mark shall give no right to the exclusive use of the term [GEOGRAPHICAL NAME] descriptively in its bona fide geographical signification and otherwise as a trade mark."

Where a "device in general" is the subject of a disclaimer, the following wording is acceptable:

"Registration of this trade mark shall give no right to the exclusive use of […] device in general."

The "Common in the class" test

Disclaimers are called for where the word or device is common in the class. A word or device is regarded as 'common' when it appears 3 (three) or more times on the Register in the same class, in relation to prior registered marks.

For purposes of legal certainty, a disclaimer must be called for even when it is clear that no exclusive rights can be obtained in the word or device.

Where a registered trade mark(s) has lapsed, causing the number of registrations to fall below the required 3 (three), cognizance can be taken of the fact that there used to be 3 (three) registrations, which rendered the trade mark or device in common use in the relevant class.

Geographical names, continents, colours, symbols, numerals, etc.

Various elements, including but not limited to geographical names, depictions of continents, maps and the globe, colours, numerals, wind directions, certain symbols (for example #, % and @), currency, etc. should always be disclaimed, even if such an element is not common in the class.

Words, phrases, terms and devices required in trade

A disclaimer of a word will be called for if, in relation to the goods or services applied for, it is deemed to be reasonably required in the trade (despite such an element not being common in the class).

It is apposite to have regard to Jacob J's quotation of an assertion of Sir Herbert Cozens-Hardy MR in 1909 in *British Sugar PLC v James Robertson &Sons Ltd. [1996] RPC 281:*

> *"[T]raders are habitually eager to enclose part of the great common of the English language and to exclude the general public of the present day and of the future from access to the enclosure (Joseph Crosfield & Son's Appn ("Perfection") (1909) 26 RPC 837 at page 854.)"*

It has been held in *Kentucky Tobacco Corp (Pty) Ltd V Registrar of Trade Marks 1984 (2) S 335(T) at 340:*

> *"…the Registrar must not only have regard to the requirements of the trade at the time but must also safeguard the interests of traders in future."*

Further emphasising this principle, in *Distillers Corp (S) v Stellenbosch Farmers Winery 1979 (1) SA (T)* at p536 G, H Franklin J stated:

> "*The fact that other traders have not sought to use a particular word or phrase comprised in a trade mark to distinguish their goods is, however, by no means decisive. In a case where a mark has never been used by anyone, the true test in my view is:*
> *Whether other traders are likely, in the ordinary course of their business and without any improper motive, to desire to use the same mark, or some mark nearly resembling it, upon or in connection with their own goods."*

It has been accepted by our courts that where a number is juxtaposed with the word 'star/s' the entire phrase should be disclaimed (*Star Shirt Clothing Factory Natal v Registrar of Trade Marks 1972 (1) SA 562 (T)***,** for example, 'SEVEN STARS' or '7 STARS' OR '*******'. The rationale behind this is that such signs represent a guarantee of quality and as such, all traders should be free to use such signs uninhibited.

In *M-Systems Group (Pty) Ltd v Cochrane Steel Products (Pty) Ltd (61028/2015) [2016] ZAGPPHC 677 (10 August 2016)*, the court, in pursuit of legal certainty and the protection of other traders, ordered that the following endorsements be entered onto the Register:

> *"Endorsement…*
> *[52] In conclusion it is necessary to briefly deal with the opponent's submission, although in the alternative, for the entry of one or more endorsements. More in particular it is submitted that the Court should not allow the applicant to become entitled to any exclusive right to the word "clear" or "view" (or "VU") when used in relation to fences (separately from "CLEARVU").*
> *[53] I am in agreement with this submission and has made it part of my order in so far as the words "clear" and "view"(not "vu") is concerned…*
>
> *Order…*
> *[55] It is ordered that:*
> *1. Trademark Applications 2010/13544 and 2010/13545 are registered in the name of the Trademark Applicant (Cochrane Steel Products (Pty) Ltd) subject, in each case, to the following conditions:*
> *1.1. The registration of this mark shall give no right to the exclusive use of the word "clear" and "view "separately and apart from the mark;*
> *1.2. The trademark registrant admits that the registration of this mark shall not debar others from the bona fide descriptive use in the course of trade of the words "clear view" and "view"..."*

This case confirms and upholds the Registar's discretionary power under Section 15 of the Act.

Effect of prior registrations in South Africa and abroad

In *Star Shirt Clothing Factory Natal v Registrar of Trade Marks 1972 (1) SA 562 (T)*, it was emphasised that although trade marks have been allowed on the Register before (without disclaimers), it does not stand to reason that they were correctly so allowed. Therefore, it is not sufficient for an applicant to point out that its prior registrations have not been subject to disclaimers, when presenting arguments against a disclaimer requirements contained in an official action.

Furthermore, evidence setting out that the applicant has not entered disclaimers in other jurisdictions would be viewed in the following way:

> *"It is to the market in South Africa alone that the Registrar must have regard in determining whether a mark is 'capable of distinguishing'...*
> *…The bare fact of registration in other countries is not sufficient to establish that the mark is registrable in South Africa"* (*Webster and Page at paragraph 3.40.2*).

3.5.5 ADMISSION / UNDERTAKING

3.5.5.1 Admissions

The purpose of admissions

Calling for admissions is unique to South Africa and even pre-dates the current Trade Marks Act. The current practice is to require an admission where a trade mark consists of a misspelling of a word, which would normally have been disclaimed under the applicable guidelines. Examples are indicated below:

- Sooper, soeper, supir - Super
- Cheez, cheas - Cheese
- Kwik, quik, kwick, kwik - Quick
- Sweat, zweet, swiet - Sweet

The correct spelling of the word must be admitted.

Admissions will not be artificially enforced upon proprietors where it is clear that the 'misspelled' word is in fact open to various interpretations and can in fact be referring to a variety of words or products, for example 'tech', which can refer to technology or technical, or 'pharm', which can refer to 'pharmacy' or 'pharmaceutical'. In such instances disclaimers of such words / prefixes / suffixes will be requested.

Where the word, which is the subject of the proposed admission appears in the specification of the goods or services, an admission will not be required either.

Simpliciter trade marks which consist of misspellings of words required in the trade, and which differ only “slightly” from the correct spelling, are not to be held as invented, and will be refused as not capable of distinguishing where applicable (see section on misspelt phonetic equivalents in Paragraph 3.3.2 above). The effect of this practice is that the entering of an admission endorsement shall not be sufficient to overcome a provisional refusal, where a trade mark is, in itself, non-distinctive.

Admitting a word which is spelled correctly in order to not disclaim it, is further not acceptable and will not be allowed.

Form of admissions

The following standard wording applies to an admission:

“*Applicants admit that registration of this trade mark shall not debar others from the bona fide descriptive use in the ordinary course of trade of the word […].”*

3.5.5.2 Undertakings

Undertakings are requested when there are specific elements of the trade mark that need to be clarified or addressed due to the nature of the trade mark, or the class of goods or services it falls in. The aim of the undertaking is to address any potential confusion or deception to the public, possibly arising from the trade mark.

Some specific undertakings are as follows:

Varietal endorsement

This endorsement would typically read: *“The applicant undertakes that […] will not be used as a varietal name”.*

This endorsement is applicable only in class 31, where live plants, seeds and animals are part of the specification. In the case of *Registrar of Trade Marks v. Wassenaar 1957 (4) SA 513 (A)*, Reynolds JA stated the following at page 530:

> *"Hence it seems to me that the word 'Ronpha', standing by itself, only meant at most a grass associated with the name of the respondent as an originator or producer and, naturally, a seller of it. It did not, standing by itself, indicate that that grass was to be distinguished from the grass of other sellers who may have obtained their supplies from the respondent and then cultivated 'Ronpha' for sale…"*

The genetic strain of a plant cannot be registered as a trade mark, so the plant species name (which usually appears in Latin wording), must also be disclaimed.

This only applies to word trade marks or a combination of a device and words, as devices alone cannot be used as varietal names.

Class 31 deals with fresh produce also, and should be distinguished from other goods on that basis.

This undertaking does not apply to a class 31 application where the specification is limited to only 'animal feeds'.

Country or place of origin endorsement

This endorsement would typically read: *"Applicant undertakes that the country of origin of the goods shall be clearly indicated on the goods".*

This endorsement must be requested where the trade mark could possibly indicate a source of origin that might mislead or confuse the consumer. Usually, a geographical location would be disclaimed. In the case of *Kentucky Tobacco Corp. v. Registrar of Trade Marks 1984 (2) SA 337 (T)*, Slomowitz AJ held at page 341 that:

> "…*if the mark is likely to deceive or cause confusion, the disclaimer would not save it*…"

Slomowitz AJ went on to state that to avoid any confusion in the marketplace, the appellant's suggestion of clearly displaying on the packaging that the goods are indeed produced in South Africa, would be an agreeable solution.

The rule of thumb, therefore, is unless the proprietor is willing to restrict their goods to being goods made or originating from a particular place, the country of origin must be clearly indicated on the packaging of the goods themselves.

Such an undertaking would not detract from the fact that the geographical name in of itself must also be disclaimed, as it is a word required for use in the trade by other traders and no single entity can monopolise a geographical name (also see Paragraph 3.3.2, 3.3.3 and 3.5.4 hereon).

The cross device

This endorsement would typically read: *"It is a condition of registration that the representation of a cross present in the trade mark will not be used in red on a white background or in white on a red background, or in silver or similar colours on a red background".*

South Africa is a party to the Geneva Convention, which places certain obligations on a country regarding the use of a cross device.

The cross device endorsement should only be called for if a cross device appears to be similar to the Geneva Cross (a red cross on a white background, formed by reversing the Swiss Federal colours - white on a red background). There is no need to request the endorsement if the cross is in the form of a shield or if it is diagonal, or if it is incorporated into an overall pattern or device, and as such is not similar to the Geneva Cross.

Bilingual/multilingual endorsements

This endorsement would typically read: *"This trade mark is shown in the two (multiple) forms in which it is used (proposed to be used) in conducting business in two (multiple) languages, the wording represented thereon having equivalent meanings. In use, both (all) forms of the trade mark will be used either separately or together, but when used together they will not necessarily be in close approximation one to the other(s)".*

This should only be called for when the trade mark as applied for is depicted in two or more languages.

Blank space endorsements

This endorsement would typically read: *"The applicant undertakes that blank spaces will be occupied only by […]".*

Blank space endorsements are called for when there is a blank space in a trade mark as applied for which is clearly intended for added matter.

In providing the required blank space endorsement, the applicant has three options which he may utilise. The blank space may be occupied by the following:

- Matter of a wholly descriptive or non-distinctive character; or
- A trade mark already registered in the name of the same proprietor in respect of the same goods or services; or
- A trade mark of which the applicant is the registered user in respect of the same goods or services.

3.5.6 SPECIFYING / RECTIFYING / RECTIFICATION OF GOODS AND SERVICES IN CONFORMITY WITH THE TRADE MARK / PRIORITY DOCUMENT

A restriction may be called for in two instances:

- where the trade mark implies specific goods; and
- where the specification is broader than the specification in the priority documentation, in the case of a convention application.

Restriction in terms of the trade mark

The general rule is that restrictions of this nature should apply only to goods and not services, *i.e.* call for restriction in relation to goods, as opposed to calling for a disclaimer in relation to services. The restriction must be practicable and "make sense", and it should at all times be kept in mind that the purpose of a restriction is to ensure that the public is not possibly deceived or confused as to the trade mark as applied for, and the goods it is being used in respect of.

Examples of a justified restriction appears below:

- "Magnesit" - Class 5

To restrict the goods to products containing magnesium will be justified as the trade mark clearly alludes to the nature of the goods.

Restriction in terms of the priority documents (also see Paragraph 2.3)

A convention application grants the applicant an earlier filing date based on a foreign application lodged in another member state of the Paris Convention, within a specific time period.

It stands to reason that the specification of the national application may not be wider than the specification of the convention application on which reliance is placed. The specification of the national application may however be narrower than that of the convention application.

Therefore, if the specification in the South African application goes beyond the specification as listed in the priority documentation, a restriction of the specification in line with the specification in the priority documentation must be called for in the official action.

General rules in relation to restrictions

- Restrict in goods classes, and disclaim in service classes.

- Always give the applicant the choice of entering an undertaking regarding use of the mark in relation to specific goods, *in lieu* of a restriction, unless confusion or deception will still arise despite such undertaking.

- Restrictions are generally required when it can be foreseen that there will be a possibility of confusion or deception amongst the public, and where the interests of members of the public are best served through the restriction.

3.5.7 NOTICE OF ADVERTISEMENT TO PROPRIETORS (MARKED JOURNAL / MJ)

A Notice of Advertisement (or "Marked Journal") (MJ) is a condition imposed for acceptance of a trade mark application, whereby such acceptance is subject to the applicant undertaking to send a notice of advertisement of such application to the proprietor of a prior identical or confusingly similar trade mark registration. It is important to bear in mind that an MJ can only be requested against a registered trade mark and that multiple MJ's may be required against a single application.

An MJ can be requested under the following circumstances:

- Where a trade mark may be subject to a Section 10(14) objection, but the Office is of the opinion that a provisional refusal would be too excessive; or
- As part of the conditions to overcome a Section 10(14) refusal and consent from the prior registrant is not lodged.

The practice of requesting an MJ to be sent to a proprietor of a prior registered trade mark merely has the intended purpose of ensuring that such proprietor is aware of the advertisement of the pending application(s). Asking for an MJ is also within the discretion of the Registrar. It should further be noted that it is not customary to accept any submissions against an MJ, as an alternative to a MJ would be a refusal in terms of Section 10(14).

Administrative aspects

After an undertaking has been made by the applicant to send the required MJ, a note must be made on the outside file cover to that extent by the examiner. The applicant must provide proof to the Office that the MJ was sent, before the application(s) can proceed to registration.

3.5.8 OTHER CONDITIONS

Further to the above conditions for acceptance, various other conditions can be imposed on the application. Some examples of such further conditions are listed in “Annexure N”.





4. POST EXAMINATION PROCEDURE

4.1 COMPLIANCE WITH OFFICIAL ACTIONS

Paragraphs 3.2.2 and 3.5 above has relevance to the below information.

Endorsement of meaning and derivation

The English meaning of foreign words in a mark must be endorsed by way of lodging a Form TM2 and the prescribed fees.

If a word in a mark is in characters other than Roman characters, a Form TM2 must be submitted in order to formally place the endorsement in the Register.

Lodging / validating Power of Attorney

The authorised representative need only provide the original Power of Attorney, or copy of the Power of Attorney (if previously lodged), or provide the General Power of Attorney number that was allocated to that applicant. No fees are associated with this requirement.

Associations

Associations must be expressly agreed to in writing. The association will then be recorded in the Register. There is no need to submit a Form TM2 in this regard.

The association must still be agreed to even if it is already endorsed on the original Form TM1 when the application is lodged. The reason for this is that the fee in line with Regulations 2 and 22, and Schedule 1 of the Trade Mark Regulations, remains payable and must be deducted from the relevant CIPC customer account, for which written authorisation is required from the applicant or its authorised representative.

Disclaimer

Disclaimers must be expressly agreed to in writing. There are no fees associated with the recording of disclaimers and it is not necessary for a Form TM2 to be submitted in this regard.

Admission / Undertaking

Admissions and undertakings must be expressly agreed to in writing. There are no fees associated with the recording of admission and undertaking and it is not necessary for a Form TM2 to be submitted in this regard.

Specifying / rectifying and rectification of goods and services in conformity with the trade mark or priority document

This must be recorded by way of a Form TM2, with the prescribed fees.

Notice of advertisement to proprietors (Marked Journal / MJ)

This must be expressly agreed to in writing. Furthermore, the applicant or authorised representative must submit a copy of the Notice of Advertisement, as sent to the proprietor(s), to the Office, for it to be placed on file, prior to the application proceeding to registration.

Other

The requirements for acceptance here is generally to comply with the request of the Office, whether it be to provide proof of lodgment and copies of the priority documents or to clarify the legal relationship between the applicant, the address for service, and/or the signatory of the application form. All such communication with the Office must be submitted in writing.

4.2 SUBMISSIONS

4.2.1 SUBMISSIONS AGAINST PROVISIONAL ACCEPTANCE

Where the Registrar has indicated that the trade mark application shall be accepted subject to certain conditions, amendments or undertakings, the procedure is as follows:

Time period for compliance and or response to official actions

All compliances or responses to the Registrar's official action must be submitted within 3 (three) months from date of issue of the official action.

Hereon, Regulation 15(4) states:

> *"…unless within three months of the date of the statement the applicant submits arguments, in writing, or applies for a hearing or an extension of time, the application shall be deemed to have been abandoned…"*

Written representation on provisional acceptances may be submitted electronically to the relevant examiners who issued such.

Request for an extension of the prosecution term

The Applicant may, in writing, apply for an extension of prosecution term, in order to respond to the official action. The Office may, on receipt of such application, extend such term.

Section 45(3) states hereon that:

> *"…the Registrar may, on application by that person and unless otherwise expressly provided, extend the time either before or after its expiration…"*

Objections to the condition(s) of acceptance

Where the applicant is of the view that the condition(s) of acceptance is not appropriate, then the applicant may submit arguments in writing. The submission should also include evidence in so far as it is necessary, in substantiating the reasons for the objection.

If the objections have not been resolved after submission of written arguments, it can be requested for the matter to be discussed at an informal ("*ex parte*") hearing.

Receipt and assessment of submissions

Where objections to the condition of acceptance have been submitted, the arguments will be considered by the relevant examiner who issued the official action, whereupon the conditions imposed may be waived or upheld.

The submissions should be properly drafted with substantial evidence, or any other relevant evidence adduced against the conditions of acceptance.



4.2.2 SUBMISSIONS AGAINST PROVISIONAL REFUSAL

When a provisional refusal has been issued on a trade mark application, written representations can be made to overcome the provisional refusal (see Paragraphs 3.3 and 3.4). The representations will be considered by the relevant examiner who issued the official action, whereupon the provisional refusal may be waived or upheld. The purpose of this section is therefore to shed light on how to go about making these representations in respect of the most commonly cited grounds for refusal.

Written representations may be submitted electronically to the relevant examiner who issued the provisional refusal.

Section 10(1)

An applicant may overcome this ground for refusal by proving that the mark is capable of functioning as a trade mark in relation to the goods or services as applied for. As noted in Paragraph 3.3.1 above, even if a mark is distinctive, it does not stand to reason that it is distinctive in a trade mark sense (*Lubbe NO v Millennium Style 2007 4 All SA 692 (SCA)*).

Section 10(2)(a)

An applicant may overcome this ground for refusal by proving that at the date of application for registration, the trade mark had in fact become capable of distinguishing within the meaning of Section 9, as a result of prior use made by the mark.

The factors which will be taken into account when considering acquired distinctiveness are noted in Paragraph 3.3.2 above.

Sections 10(2)(b) and 10(2)(c)

An applicant may overcome these grounds for refusal by proving that at the date of application for registration, the trade mark had in fact become capable of distinguishing within the meaning of Section 9, as a result of the use made of the trade mark. It must be noted that this ground for refusal is related to the interest of other traders.

To overcome this refusal, the applicant will have to address the substantive legal requirements as outlined in Paragraphs 3.3.3 and 3.3.4 above.

Section 10(3)

An applicant may overcome this ground for refusal by proving that the applicant has not been dishonest, in breach of confidence or conducted himself in a way that is considered to be sharp practice (*Victoria's Secret Inc v Edgars Stores Ltd 1994 (3) SA 739 (A)*).

The above legal aspects have been fully addressed in Paragraph 3.3.5 above.

Section 10(4)

An applicant may overcome this ground for refusal (see Paragraph 3.3.6) by proving that at the date of application for registration, the applicant had a *bona fide*, definite and present intention of using the mark as applied for as a trade mark, either himself or through any person permitted or to be permitted by him, or to use the trade mark as contemplated in Section 38 of the Act.

Sections 10(5) and 10(11)

An applicant may overcome these grounds for refusal by proving that the trade mark as applied for is not necessary to achieve a technical result, does not result from the nature of the goods themselves, and is not likely to inhibit the development of any art or industry. These substantive issues have been addressed in Paragraph 3.3.8 above.

Section 10(12)

If a trade mark has been refused as being inherently deceptive to some, but not all of the goods or services in the specification, this provisional refusal may be overcome by removing the goods or services in the specification which renders the trade mark inherently deceptive.

Trade marks which have been refused as being *contra bonos mores,* or likely to cause offence to any class of persons, may be overcome by addressing the substantive legal requirements as outlined in Paragraph 3.4.2 above.

Sections 10(14) and 10(15)

These relative grounds for refusals can by overcome by obtaining written consent from the proprietor(s) of the prior cited trade mark(s). This consent must be furnished by the applicant and an endorsement entered accordingly in the Register. These grounds may also be overcome by disproving the similarity of the trade marks and goods or services, as fully fleshed out in Paragraphs 3.4.4 and 3.4.5 above.

In the appropriate circumstance, the applicant may consider to convert its ordinary application into one for honest concurrent use or any special circumstance in terms of Section 14 of the Act (see Paragraph 2.5.1.4 above).





4.3 INFORMAL (*EX-PARTE*) HEARINGS

The purpose of these hearings is to discuss, in person, written representations already submitted in relation to official actions (*i.e.* provisional acceptances or provisional refusals), where the matter could not be resolved by way of such written communication between the relevant examiner who issued such official actions, and the applicant or its authorised representative.

Process

Every six (6) months the Court Roll Administrator prepares an *Ex Parte* court roll, indicating dates in each month on which *ex parte* hearings will take place.

In order to request to be allocated a time slot for *Ex Parte* hearings, a request must be submitted in writing to the Court Roll Administrator, who will advise the requester of the next available hearing date.

A list of the matters to be discussed (5 (five) or more matters) must be submitted in writing to the Court Roll Administrator 14 (fourteen) days before the allocated hearing date, to facilitate timeous retrieval of the files. The Court Roll Administrator will communicate to the relevant law firm 2 (two) days prior to the hearing which files will be available for discussion at the upcoming hearing.

Note therefore:- matters **may only** be placed on lists for ex parte hearings where (a) written representations have already been submitted, and (b) the matters could not be resolved by way of such written representations.

Note also further:- matters may **not** be placed on lists for ex parte hearings in order to discuss any other issues not pertaining to written representations of official actions, for example outstanding amendments, assignments or notice of acceptance. The latter must be addressed in line with the standing office practice and operating procedures in place with the Trade Marks Division.

4.4 GROUNDS FOR DECISION (WRITTEN REASONS)

Application for Written Reasons (by applicant)

In terms of Section 16(4), 53(1) and 53(2), and Regulations 54(1) and 54(2), any person objecting to an order or decision by the Registrar may apply, in the appropriate manner, for written reasons for the Registrar's decision. These ground for decision may then be used in appeal proceedings in the appropriate forum. These sections respectively state:

Section 16(4) states:

> *"In the case of an acceptance in terms of subsection (2) (b) or a refusal in terms of subsection (2) (d), the registrar shall, on application by the applicant in the prescribed manner, state in writing the grounds for his decision…"*

Sections 53(1) and 53(2) states further:

> *"…(1) Without derogating from the provisions of subsection (2), any person aggrieved by any decision or order of the registrar may, within a period of three months after the date of any such decision or order, apply to the Transvaal Provincial Division of the Supreme Court for relief, and the said court shall have the power to consider the merits of any such matter, to receive further evidence, and to make any order as it may deem fit…*
>
> *(2) Any party to any opposed proceedings before the registrar may appeal to the Transvaal Provincial Division of the Supreme Court against any decision or order pursuant to such proceedings…"*

In terms of Regulation 54(1):

> *"When any person objects to any order or decision of the Registrar he may apply on Form TM2, within three months of the date of the Registrar's order or decision, or such further time as the Registrar may allow, requiring the Registrar to state in writing the grounds of his decision and the date used by him in arriving at it. The date of such statements shall be deemed to be the date of the Registrar's order or decision for the purpose of appeal…"*

Further, Regulation 54(2) states:

> *"All written reasons for decisions and judgements of the Registrar shall be published in the Patent Journal within three months from the date of signing by the Registrar if the Registrar so directs..."*

Such written reasons are therefore requested for the purpose of appealing a specific decision or order of the Registrar. Once such written reasons have been provided, no further submissions shall be entertained by the Office in the related matter, unless the written reasons are followed by compliance with the decision or ordered as originally issued by the Office.

Compiling Written Reasons

When drafting the written reasons, the author thereof must compile it in the following format:

- Detail and timeline of the application(s);
- Relevant section(s) of the Act;
- Reasons for the decision with all relevant considered resources; and
- Conclusion and confirmation of the decision.

Such written reasons must include reference to relevant case law, literature, legislation, relevant rules and procedural guidelines, as well as other resources considered by the Office in reaching the decision.







OF FURTHER RELEVANCE

5.1 ACCEPTANCE AND ADVERTISEMENT

Acceptance of an application(s) is authorised by the relevant examiner who issued the official action(s), once such examiner is satisfied that the content of the official action(s) has been sufficiently addressed and that the application(s) is in order to proceed to acceptance.

Section 20(1) of the Act stipulates:

> *"If, by reason of default on the part of the applicant, after acceptance of the application, the registration of a trade mark has not been completed within six months from the date of such acceptance, the registrar shall give notice of the non-completion to the applicant, and, if at the expiration of two months from that notice or of such further time as the registrar may allow, the registration is not completed, the application shall be deemed to have been abandoned…"*

It is therefore the duty of the applicant, in terms of Section 20(1), to ensure that the application(s) is published for opposition purposes.

Section 21 states:

> *"Any interested person may, within three months from the date of the advertisement of an application in terms of section 17 or within such further time as the registrar may allow, oppose the application in the manner prescribed."*

5.2 AMENDMENT OF TRADE MARKS

Section 25 of the Act stipulates:

> …"*(1) The registered proprietor of a trade mark may apply in the prescribed manner to the registrar for leave to add to or alter the trade mark in any manner not substantially affecting the identity thereof, and the registrar may refuse leave or may grant it on such terms and subject to such limitations as he may think fit.*
>
> *(2) (a) The registrar shall require the applicant to advertise the grant of the application in the prescribed manner.*
> *(b) Any interested person may, within three months from the date of the advertisement or such further period as the registrar may allow, object in the prescribed manner, to the grant of the application…"*

The principle of an amendment to a registered mark not being permissible where such amendment substantially affects the identity of the mark, is also applied by the Office in relation to applications to amend marks in pending applications.

The rationale behind this principle is two-fold. Firstly, an amendment to a mark in a pending application could potentially effect the rights of a 3rd party, as registrability searches could have been conducted prior to such an amendment, and whereas the subsequent amendment could impact on later applications lodged by such 3rd parties. Secondly, an amendment of a mark in a pending application is not advertised for purposes of objections by 3rd parties, and as such an amendment of a mark in a pending application could further impact the rights of 3rd parties.

The following are generally accepted in relation to applications for the amendment of marks as already applied for, subject at all times to the over-arching principle as discussed above:

- the addition of a word mark already registered in the name of the same proprietor;
- the deletion of elements from the mark; or
- the addition of a device.

5.3 EXTENSIONS OF TIME TO PROSECUTE

Section 45(3) stipulates:

> *"…the Registrar may, on application by that person and unless otherwise expressly provided, extend the time either before or after its expiration…"*

Extensions of time to prosecute an application should therefore be applied for in writing, in the following circumstances:

Where Section 20(1) applies, which stipulates:

> *"If, by reason of default on the part of the applicant, after acceptance of the application, the registration of a trade mark has not been completed within six months from the date of such acceptance, the registrar shall give notice of the non-completion to the applicant, and, if at the expiration of two months from that notice or of such further time as the registrar may allow, the registration is not completed, the application shall be deemed to have been abandoned…"*

Or, where Section 20(2) applies, which states:

> *"If the application is refused or is conditionally accepted and the applicant, having been advised of the registrar's objection to the application, or of his conditions for acceptance, fails to take such steps as are available to him under this Act within three months of the date of such advice, or such further time as the registrar may allow, the application shall be deemed to have been abandoned."*

Extension of time to prosecute an application can further only be requested up until the application has been accepted.

5.4 EXTERNAL DIVISIONAL SERVICE DELIVERY STANDARDS

Turn-around times for certain activities are reflected in the external Divisional Service Delivery Standards document, as published on the CIPC website and updated from time to time.

This document also sets out a 3-tier query escalation process, which includes direct contact details of certain staff in the relevant sections of the Division. At all times it must be ensured that queries are directed in line with, and adheres to:

- the stipulated time frames;
- the query escalation process; and
- the correct staff member(s)

as indicated in the said document.





ANNEXURES



NOTICE ON THE OPERATIONAL E-FILING OF TRADE MARKS

Companies and Intellectual Property Commission
a member of the dti group

OPERATIONAL REQUIREMENTS IN RESPECT OF ELECTRONIC FILING OF NEW TRADE MARKS, PATENTS, DESIGNS AND COPYRIGHT APPLICATIONS WITH THE COMPANIES AND INTELLECTUAL PROPERTY COMMISSION (CIPC)

CIPC is introducing an Electronic Filing Facility (**e-Filing**) for lodgment of Trade Marks, Patents, Designs and Copyright in Cinematograph Films **new applications**.

The e-Filing facility for lodgment of Trade Marks will be available as from 2 September 2013. The dates on which e-Filing will be made available for the remainder of the domains will be announced in the Patent Journal and on the CIPC website in due course.

The e-Filing facility offers two options that could be used for e-filing of new applications, depending on the customer convenience.

CUBA DESKTOP CLIENT

CUBA (CIPC Utility for Bulk Applications) Desktop Client has been designed to cater for the lodging of bulk applications by way of XML file uploads directly into the CUBA application.

Business Address
77 Meintjes Street
the dti Campus
Sunnyside
0001

Postal Address
Intellectual Property
Private Bag x400
Pretoria
0001

Contacts
National: 086 100 2472
International: +2712 394 95
www.cipc.co.za

The steps that have to be followed to make use of **CUBA DESKTOP CLIENT** are outlined here below:-

- Access the CIPC Website at www.cipc.co.za;
- Register as a CIPC Customer by clicking **CUSTOMER REGISTRATION** and follow the instructions;
- Deposit sufficient funds for the transaction you wish to perform into the CIPC account. For example, if you wish to file a new trade mark, you must deposit the exact amount of R590-00;
- Create XML files according to the XML schema provided by CIPC. XML schemas and description documents can be downloaded from www.cipc.co.za/IPservices.aspx;
- Any development which may be required to utilise CUBA Desktop Client to lodge new applications in bulk, will be the responsibility of the person/s who wishes to make use of such method to lodge new applications;
- Download the latest version of CUBA Desktop Client and user guide documents from http://efile.cipc.co.za/Downloads.aspx;
- Register on www.cipc.co.za/IPservices.aspx to obtain a user account for e-Filing services;
- To make use of the CUBA Desktop Client application for purposes of e-filing, a user must contact the SAPO Trust Centre at sales@trustcentre.co.za to be issued with an advanced electronic signature. **The SAPO registration process is outlined here below**;
- Follow the user guide documents to start filing with CUBA Desktop Client;
- For assistance in using the CUBA Desktop Client, call +27 12 394-5037 or e-mail swalters@cipc.co.za or fharlis@swordsa.com.

SAPO Trust Centre Registration Process in respect of Advanced Electronic Signatures

- The following will be required for the SAPO Trust Centre registration process:-
  - a valid SA Identity Document (ID);
  - a clean, new USB (*may be purchased from the Issuing Agent by prior arrangement*);
  - proof of residence; and
  - a valid CIPC customer code which will be used to authenticate the applicant as a registered CIPC e-filing user.
- The issue process takes place at a designated Post Office Branch, or can be undertaken by a Docex or Trust Centre trained agent at the premises of the applicant, where five (5) or more certificates are issued;
- An annual fee of R250-00 is payable in respect of an advanced electronic signature;
- A *Subscriber Agreement* will be entered into between the purchaser of the certificate and SAPO;
- The purchaser's name and address details will be recorded by SAPO;
- A photograph of the purchaser will be taken by SAPO;
- The purchaser's fingerprints will be taken by SAPO for validation against the Department of Home Affairs (HANIS) Database;
- The advanced electronic signature will be uploaded onto the USB provided by the purchaser (above);
- An advanced electronic signature is valid for a period of 12 months, where after it will need to be renewed;
- For further details regarding the use and management of an advanced electronic signature, visit the Trust Centre website at www.trustcentre.co.za.

WEB CLIENT

The Web Client interface has been designed to cater for single application submissions. This application will also allow you to attach your logo (device), and any other supporting documents which should accompany your application.

The steps that have to be followed to make use of **WEB CLIENT** are outlined here below:-

- Access the CIPC Website at http://www.cipc.co.za;
- Register as a CIPC Customer by clicking **CUSTOMER REGISTRATION** and follow the instructions;
- Deposit sufficient funds for the transaction you wish to perform into the CIPC account. For example, if you wish to file a new trade mark, you must deposit the exact amount of R590-00;
- Create an e-Filing access code by registering on www.cipc.co.za/IPservices.aspx. This access code must be used to log into the Web Client interface;
- When a customer enters his e-Filing access code into the CIPC e-Filing system, any application lodged thereafter shall be deemed to have been duly signed by the person whose signature is required in terms of the Patents Act (Act 57 of 1978), the Trade Marks Act (Act 194 of 1993), the Designs Act (Act 195 of 1993), and the Copyright in Cinematograph Films (Act 98 of 1978), for the purposes of lodging such an application;
- Follow the instruction for filing the new application via the Web Client Interface;
- For assistance in using the Web Client interface, call +27 12 394-5037 or e-mail swalters@cipc.co.za or fharlis@swordsa.com.

WHEN IS A SUBMITTED APPLICATION DEEMED TO HAVE BEEN RECEIVED BY CIPC

A new application lodged via either CUBA DESKTOP CLIENT or WEB CLIENT, is deemed to have been received by CIPC when the applicant receives a system generated **confirmatory e-mail** from the CIPC e- Filing system that the application/s has been received.

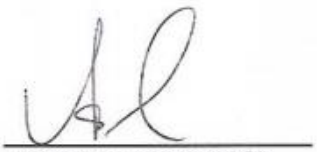
At that stage the application status is reflected as "received" in the CIPC e-Filing system. **Important to note** is that at this point in time the application/s cannot yet be considered as having been "processed".

The date on the confirmatory e-mail (above) will be deemed to be the filing date of the new application, on condition that there are sufficient funds available upon processing of the application/s by CIPC.

ACKNOWLEDGEMENT OF RECEIPT OF THE NEW APPLICATION

Once the new application is received by the CIPC e-Filing system, and if the required funds are available in the customer's account, the application will be processed. The application will be allocated an official application number (e.g. Trade Mark 2013/19000) upon billing and processing, and an **acknowledgment of receipt** (e-mail) will be sent to the customer, containing a duly completed confirmation application form, together with a payment receipt.

It is at this point in time that the application/s can be considered as having been "processed", for purposes of having an official application number allocated thereto, and the application having been entered in the relevant South African Register, e.g. the Trade Marks Register.



ASTRID LUDIN (MS)
REGISTRAR OF PATENTS, TRADE MARKS, DESIGNS AND COPYRIGHT
COMMISSIONER: CIPC
28 August 2013

ANNEXURE B

LIST OF PERSONS AUTHORISED TO ACT ON BEHALF OF AN APPLICANT

Save for a practising attorney (admitted attorney practising in South Africa), the following persons are deemed to be authorised to act on behalf of an applicant in trade mark matters.

APPLICANT TYPE	**PERSON AUTHORISED TO ACT**	**REQUIRED DOCUMENTATION AND INFORMATION**
Natural Persons	Natural person ONLY	None
Companies (private-, public-, section 21- or personal liability-)	Company itself	None
	A director of the company	1. Company resolution authorising specific director to act; and 2. Company registration documents confirming directorship.
	A designated employee employed by the company	1. Company resolution authorising specific employee to act; and 2. Proof of employment.
Close Corporations	CC itself	None
	A member of the CC	1. Resolution by members authorising specific member to act; and 2. CC registration documents confirming membership.
Trusts	A Trustee (or Trustees) of the Trust	Letter of authority, issued by the Master of the High Court, authorising Trustee(s) to act.
Partnerships	Partnership itself	Copy of the partnership agreement
	A partner (or partners) in the partnership	1. Copy of the partnership agreement; and 2. Resolution authorising such partner(s) to act.
Sole Proprietors	Sole proprietor in his/her own name	None
	Sole proprietor in trading name	1. ID Document of Sole Proprietor; and 2. Confirmation of trading name

Co-operations	The co-op itself	Copy of co-operation agreement
	Member(s) of co-op	1. Copy of co-operation agreement; and 2. Resolution by co-op authorising specific member(s) to act.
Public Entities	Public entity itself	Evidence of mark being used in the normal course of trade.
	A designated public employee employed by the public entity	1. Resolution authorising specific employee to act; 2. Proof of employment; and 3. Evidence of mark being used in the normal course of trade.

The following persons and/or entities are not permitted to act on behalf of any trade mark applicant, for the purposes of Section 8 and Regulation 9 of the Trade Marks Act (see Paragraph 1.1 of the Guidelines):

- Accountants, accounting firms, auditors and auditing firms
- Administrative companies
- Advocates
- Any company employing an admitted attorney, but not trading as a law firm
- Banks and other financial institutions
- Business consultants and business consulting firms
- Company consultants, company consulting firms and other secretarial service providers
- Legal consultants and legal consulting firms
- Non-practising attorneys (being admitted or not)*
- Other non-attorney firms
- Tax consultants and tax consulting firms

* The status of any (apparent) practising attorney may be verified by the office at any stage by requesting submission of a valid fidelity fund certificate.

Note that this list is not an exhaustive list of unauthorised persons.

FORM TM1

G.P-S. 019-0035

FORM TM1

Document should be typewritten in triplicate.

Client Reference	

OFFICIAL DATE STAMP

One copy will be returned to the applicant's address for service as proof of lodgement and is only valid if endorsed with the official date stamp.

REPUBLIC OF SOUTH AFRICA
TRADE MARKS ACT, 1993

APPLICATION FOR THE REGISTRATION OF A TRADE MARK
Sections 9,14,16, 425 43 and 63 - Regulations 11, 56 and 57

For office use only		
21	Application Number	
22	Filing Date	

Applicant's or agent's	
GPA number	

NA	Nature (O=Ordinary, CE=Certification, CO=Collective, CU=Honest Concurrent User)

73	Owner/company Forename(s) Street address	74	Address for service (postal address)

57	Specification of goods/services	51	International Classification

58	Endorsement(s)

Convention priority claimed	31	Number	32	Date	33	Country	

54	Representation of trade mark (2)	AS	Association No. (if applicable)

If trade mark is a word, letter, numeral or combination, insert in inner block (1)

If trade mark is represented in a special or particular form, place a good copy in outer block (2) (Maximum size: 8,5 cm x 1 0 cm)

.....
(1)

.....

The applicant claims to be the proprietor of the accompanying trade mark which is proposed to be/is being used in respect of the above-mentioned goods or services.

.....
Signature of applicant or authorised agent

Date .....

NOTICE ON LODGEMENT OF PRIORITY DOCUMENTS IN RESPECT OF PATENTS, DESIGNS AND TRADE MARKS IN ELECTRONIC FORMAT

Companies and Intellectual Property Commission
a member of the dti group

NOTICE

LODGMENT OF PRIORITY DOCUMENTS IN RESPECT OF PATENTS, DESIGNS AND TRADE MARKS IN ELECTRONIC FORMAT

In terms of Regulation 25 of the **Patents Act (Act 57 of 1978)**, the applicant is required to lodge, in support of an application in terms of Section 31(1)(c) of the Act, a copy of the application in the convention country ("priority document"), duly certified to the satisfaction of the Registrar.

In terms of Regulation 17(2) of the **Designs Act (Act 195 of 1993)**, the applicant is required to lodge, in support of an application in terms of Section 44 of the Act, a copy of the application in the convention country ("priority document"), duly certified to the satisfaction of the Registrar.

In terms of Regulation 12 of the **Trade Marks Act (Act 194 of 1993)**, the applicant is required to lodge, in support of an application in terms of Section 63 of the Act, a copy of the application in the convention country ("priority document"), duly certified to the satisfaction of the Registrar.

Notice is hereby given that CIPC will, for purposes of the Sections and Regulations stipulated here above, accept copies of the priority documents as downloaded from the websites of the relevant convention countries which have discontinued issuing of priority documents in paper form.

Business Address
77 Meintjes Street
the dti Campus
Sunnyside
0001

Postal Address
Intellectual Property
Private Bag x400
Pretoria
0001

Contacts
National: 086 100 2472
International: +2712 394 95(
www.cipc.co.za

Notice is hereby also given that CIPC will accept priority documents submitted in electronic form where an original is issued on paper form by a convention country, on condition that the applicant thereof will bear the onus to store and produce the original for litigation or any other purposes as may be required by CIPC.

This notice will come into effect on 2 September 2013.



ASTRID LUDIN (MS)
COMMISSIONER: CIPC
REGISTRAR OF PATENTS, TRADE MARKS, DESIGNS AND COPYRIGHT
28 August 2013

NOTICE ON NAMING CONVENTIONS APPLICABLE TO ELECTRONIC LODGMENT OF NEW TRADE MARK APPLICATIONS

Companies and Intellectual Property Commission
a member of the dti group

NOTICE

NAMING CONVENTIONS APPLICABLE TO ELECTRONIC LODGMENT OF NEW TRADE MARK APPLICATIONS

The Trade Marks Act requires the Registrar of Trade Marks to maintain a Register of Trade Marks and to grant the public access thereto, upon application in the prescribed manner. One of the functions of the Trade Marks Register is to enable the proper recordal of trade marks, and the searching of prior trade mark rights.

For the Trade Marks Register to fulfill these functions, and particularly following the implementation of electronic filing of new trade mark applications as from 2 September 2013, it is essential that new trade mark applications lodged via e-filing should be described in accordance with the following naming conventions/rules:-

1. Where the trade mark consist of **only a device/logo**, the "*representation of trade mark*" field should be left blank and the device/logo should be attached as an attachment to the application.
2. Where the trade mark consist of **a device/logo with words/letters or numerals, OR where words/letters/numerals are depicted in fanciful (stylized) script**, the words/letters or numerals should be captured in the "*representation of trade mark*" field in Roman characters, and the device/logo should be attached as an attachment to the application. With the understanding that:-
   - Descriptive words such as *inter alia* "logo", "device", "picture", "special form", "colour", "shape", "slogan", "container" or any combination thereof, may not form part of the description of the trade mark as inserted in the "*representation of trade mark*" filed";
   - Special characters may not form part of the description of the trade mark as inserted in the "*representation of trade mark*" field"; and
   - The "*representation of trade mark*" field will be limited to 150 (Roman) characters.

CIPC will align all applications lodged electronically with the above-mentioned naming conventions before including such applications in the Trade Marks Register. CIPC will also review all applications lodged since 2 September 2013 to ensure alignment with these naming conventions, so as to facilitate searching of the Trade Marks Register.

This notice will come into effect on **1 November 2013**.

ASTRID LUDIN (MS)
COMMISSIONER OF CIPC and REGISTRAR OF TRADE MARKS
28. October 2013

Business Address
77 Meintjes Street
the dti Campus
Sunnyside
0001

Postal Address
Intellectual Property
Private Bag x400
Pretoria
0001

Contacts
National: 086 100 2472
International: +2712 394 95
www.cipc.co.za

NOTICE ON SIZE RESTRICTIONS APPLICABLE TO IMAGES ACCOMPANYING NEW FIGURATIVE TRADE MARKS LODGED ELECTRONICALLY

Companies and Intellectual Property Commission
a member of the dti group

PRACTICE NOTE 2 OF 2015

TRADE MARKS DIVISION,

COMPANIES AND INTELLECTUAL PROPERTY COMMISSION (CIPC)

Notice is hereby given that with immediate effect the following size restrictions will apply to all **images** accompanying **new figurative trade mark applications lodged electronically**:-

Minimum width or height	250 pixels
Maximum width or height	950 pixels
Minimum resolution	300 dpi (300 dots per inch)
Maximum resolution	350 dpi

RORY VOLLER (MR)
ACTING COMMISSIONER: CIPC
..11.. NOVEMBER 2015

The dti Campus (Block F - Entfutfukweni), 77 Meintjies Street, Sunnyside, Pretoria I Private Bag X400, Pretoria, 0001
Call Centre: 086 100 2472
Website: www.cipc.co.za

GUIDELINES WITH REGARD TO THE LODGING OF NON-TRADITIONAL TRADE MARKS

COMPANIES AND INTELLECTUAL PROPERTY REGISTRATION OFFICE
a member of the dti group

NOTICE

CIPRO OFFICE GUIDELINES WITH REGARD TO THE LODGING OF NON-TRADITIONAL TRADE MARKS

1. PURPOSE

The purposes of this document is to amend the existing office guidelines in relation to the examination of trade marks, by the addition of procedures on dealing with non-traditional trade marks.

This document will provide guidelines with regard to requirements for lodging applications for non-traditional trade marks. For purposes of examination of non-traditional trade marks in order to determine registrability, further requirements such as, for example, evidence of use may be set by the Registrar.

2. DISCUSSION

a. **Three-dimensional marks**
- a single view of the representation of a three-dimensional mark will be accepted, provided it is possible to determine the three-dimensional nature from the single view
- the trade mark as advertised must correspond with the trade mark as depicted in the application form, i.e. all views as originally submitted must be published

b. **Colour marks**
- the representation should consist of a sample of colour(s) on paper or in electronic format (which sample will constitute an addition to the subject matter of the trade mark)
- the application should contain an indication of the recognized international colour codes
- a written description of how the colour is applied to the goods or used in relation to the services must accompany the application

c. **Holograms**
- with regard to representation, either a single or multiple views will be acceptable, provided it is possible to determine the holographic nature of the mark from the view/s as submitted
- a description explaining the holographic effect of the mark must accompany the application

d. **Motion/Multimedia marks**
- with regard to representation, a series of still images of the mark will be required
- a detailed written description explaining the movement of the mark will be required
- the chronological order of the images should be specified by including the sequence in the written description
- an electronic file in analog or digital format, together with a written description outlining the nature of the mark and describing the movement may be required for purposes of examination of the applications

NOTICE

CIPRO OFFICE GUIDELINES WITH REGARD TO THE LODGING OF NON-TRADITIONAL TRADE MARKS

e. **Position marks**
- position marks will be treated as figurative marks
- a clear description of what constitutes the mark that protection is sought for will need to accompany the application

f. **Gesture marks**
- gesture marks will be treated as the subject of the other type of mark it represents, for example a motion or figurative mark
- the representation of such a mark could consist of a single picture when the mark is treated as a figurative mark, or several frames depicting the gesture if the mark is considered a motion mark
- a written description explaining the gesture may also be required for purposes of examination of the applications

g. **Sound marks**
- with regard to representation, it will be required that the mark be reflected in a musical notation on a stave
- a written description of the mark will be required
- an analog or digital recording of the mark will be required

h. **Olfactory (smell/scent) marks**
- with regard to representation, at the least a written description of the mark will be required
- any other conditions as may be required for purposes of examination of the mark, eg specimen of the mark, may be required by the office
- the "Sieckmann criteria" will be applicable in relation to marks of this nature – it must be clear, precise, self-contained, easily accessible, intelligible, durable and objective

i. **Taste marks**
- with regard to representation, an indication of the type of mark will be required
- a written description depicting the characteristics of the taste will be required

j. **Texture marks**
- with regard to representation, an indication or statement concerning the type of mark will be required
- a detailed written description of the mark will be required
- a representation/sample of the surface must accompany the application

REGISTRAR OF TRADE MARKS
JANUARY 2009

GUIDELINE DOCUMENT: STEPS ON HOW TO DO A TRADE MARK SEARCH

Important Note

The purpose of a trade mark search is:-

- To determine whether prior conflicting marks exist on the Trade Marks Register
- As well as the state of the register, i.e. whether a word is common and/or required in a certain class

The basic test to always keep in mind is **SOUND, SENSE and APPEARANCE**

Dictionary Work

Geographical Dictionary
Medical Dictionary
Wines Dictionary
Technical Dictionary
Chemical Dictionary

- primarily the website www.onelook.com is used for search purposes
- the website www.google.com is used as an alternative
- print-out from website with dictionary meaning must be attached to the inside page of the file - if no results are obtained from the dictionary search, a note to this effect must be made on the front page of the file, eg. **"One Look √"**

Surname Search

- primarily the website www.yellowpages.co.za is used for search purposes
- if a surname appears more than 100 times, then it is considered to be common and a note to this effect must be recorded on the front page of the file. If it appears less than 100, it is not common and the approximate number of times it appears, must be recorded on the front page of the file.

Ptolemy Search

8 steps of Ptolemy search

1. Identical mark in the same class
2. Identical mark in the same class and conflicting class/es
3. Wildcard (%) at the beginning of the mark in the same class
4. Wildcard (%) at the beginning of the mark in the same class and conflicting class/es
5. Wildcard (%) at the end of the mark in the same class
6. Wildcard (%) at the end of the mark in the same class and conflicting class/es
7. Wildcard (%) in the beginning and end of the mark in the same class
8. Wildcard (%) in the beginning and end of the mark in the same class and conflicting class/es
9. Proprietor search on request for well known marks and for association purposes
10. Any further additional searches on request

- **Note: Ptolemy reports should not exceed 100 hits**
- *See Annexure "H1" hereto for categories of Ptolemy search with search steps prioritised*

ACSEPTO Search

Verbal search

8 steps of Verbal ACSEPTO search

1. Enter the trade mark - exact - and possible alternatives e.g. translated, miss-spelt words, etc.
2. Enter the main class/es of the application/s
3. Enter the conflicting class/es for all the main class
4. Choose words for search from system generated list
5. Manually add additional words e.g. prefixes, suffixes and identical words
6. Save and execute the search
7. Select trade marks to be included in the search report
8. Generate & print search report; attach report to file

If required (eg bulky search reports) split search report in two and attach to opposite inside pages of file

Principles to be applied when selecting trade marks for a verbal search report Identical Marks

- where the search reveals **10 or less** identical marks not in the name of the same applicant, quote **all 10** marks in both main and conflicting classes
- where the search reveals **more than 10** identical marks, only quote **the latest/most recent 10 marks** (all the other marks will appear in the Ptolemy list)

Common Words

- where search reveals for example **100 marks** containing the same common element, quote **minimum of 10 registered and/or pending and/or accepted and/or advertised and/or unpaid marks in each main class**
- do not quote "dead" records, e.g. abandoned/withdrawn/cancelled/lapsed/expunged

Relevant Date

(i.e "cut-off" date for search reports)

Only marks appearing on the register up to the day preceding/before the day on which the applications being searched was lodged, must be quoted in the search report

FIGURATIVE SEARCH

Figurative Search

7 steps of Figurative ACSEPTO Search

1. Enter the device – exact – and possible alternatives
2. Enter the main class/es of the application/s
3. Enter the conflicting class/es for all the main class
4. Choose/identify codes that are relevant to the device
5. Select a **minimum of 10 (ten)** exact or similar devices (if applicable)
6. Confirm the status of the selected devices to ensure that **at least 10 (ten) of the marks are "live"** records
7. Generate & print search report; attach report to file

If required (eg bulky search reports) split search report in two and attach to opposite inside pages of file

Principles to be applied when conducting a figurative search

Common Elements

the following will **not** be searched:-

= basis shapes eg circle/square/triangle

= straight lines

= stylized alphabet letters

A note to the effect that the figurative element is common must be recorded on the front page of the file

Combined Search

7 steps of a Combined COMBINED ACSEPTO Search

1. Enter trade mark and device – exact – and possible alternatives
2. Enter the main class/es of the application/s
3. Enter the conflicting class/es for all the main classes
4. Choose words for search from system generated list
5. Manually add additional words e.g. prefixes, suffixes and identical words
6. Choose/identify codes that are relevant to the device
7. Generate & print search report; attach report to file

If required (eg bulky search reports) split search report in two and attach to opposite inside pages of file

When combining search reports of marks that are similar but not identical

eg APPLE and APPLE & DEVICE

and which are in the name of the same proprietor, separate search reports may not be generated.

A reference note must be recorded on all the applicable files as to which file (number) contains the search report

Colour Marks

- where **no colour endorsement** is entered on the application form, the mark is considered as being lodged in black & white
- where a trade mark is **limited to colours**, same and/or similar black & white marks must also be included in search report
- where a trade mark consists **only of a colour**, the relevant international colour code will be required for examination purposes. in cases such as these individual register sheets showing details of colour endorsements will be printed and included in the search reports

Chinese Characters and other Marks in Foreign Language

- no search will be done initially
- once meaning and translation of word/element/entire mark has been obtained, search - **both verbal and figurative** - will be done on the translated meaning
- a reference note will be recorded on the front page of the file to the effect that no search was done as the meaning of the mark is required before search can take place

Individual Register Sheets

Individual print-outs of register sheets will **only** be made:-

- of an identical mark
- in an identical class
- where prior identical marks are **5 or less**, all 5 register sheets will be printed
- where prior identical marks are **more than 5**, only the 5 most recent/latest register sheets will be printed

Categories of Ptolemy search with search steps priorities

NOTE:

- **STEPS IN BOLD ARE "MUST DO" STEPS**
- **STEPS NOT IN BOLD ARE STEPS TO DO AT DISCRETION OF SEARCHES AND/OR REQUEST BY EXAMINER**

Word mark with common element		**Word mark with distinctive element**		**Translated mark**		**Stylized alphabetical letters & numerals**		**(e). Misspelt words**		**(f). Combined words/marks incl. slogans**	
e.g. **BLUE** Steps: 1 2 5 6 7 8 3 4 (as element of mark)	e.g. **SPOT** Steps: 7 8 5 6 1 2 3 4 (as element of mark)	e.g. **Pharmaceutical** Steps: 8 7 5 6 4 3 2 1	e.g. **KODAK** Steps: 8 7 5 6 4 3 2 1 9	e.g. **KGOSI** Steps: 8 7 5 6 4 3 2 1	*Also search **KING** Steps: 1 2 5 6 7 8 3 4	e.g.  Steps: 1 2	e.g. **24** Steps: 1 2 * Also search **"twenty four"** Steps: 7 8	e.g. **XTREME** Steps: 7 8 5 6 3 4 1 2 * Also search **"extreme"** Steps: 1 2 5 6 3 4 7 8	e.g. **CIR-KIT** i) **CIR** Steps: 7 8 ii) **CIRK** Steps: 7 8 5 6 3 4 2 1 iii) **CIRCUIT** Steps: 7 8	e.g. **PROLINE** i) **PRO-** Steps: 5 6 7 8 3 4 1 2 ii) **LINE** Steps: 1 2 iii) **PROL** Steps: 7 8 5 6 3 4 1 2	e.g. **WE ARE NUMBER ONE** i) **%WE ARE N%** Steps: 7 8 ii) **NUMBER 1** Steps: 7 8 iii) **NUMBER ONE** Steps: 7 8 iv) **NUMBER O** Steps: 8 7 v) **NO. 1** Steps: 7 8

NOTICE ON THE ELECTRONIC ISSUING OF OFFICIAL ACTIONS

Companies and Intellectual Property Commission
a member of the dti group

PRACTICE NOTE 3 OF 2016

TRADE MARK OFFICIAL ACTIONS

SECTION 16(3) AND REGULATIONS 15(3) AND 15(4) OF THE TRADE MARKS ACT, ACT 194 OF 1993

TRADE MARKS DIVISION

COMPANIES AND INTELLECTUAL PROPERTY COMMISSION (CIPC)

Notice is hereby given that as from **1 September 2016** official actions, issued in terms of Section 16(3), read with Regulations 15 (3) and 15(4) of the Trade Marks Act (Act 194 of 1993), will be **issued electronically via e-mail**, to the e-mail address as reflected in the CIPC customer profile of the customer code under which the application was lodged.

In addition, the official action/s may be accessed electronically and printed via the CIPC website, at no additional costs, and will be available from either of the following links:-

1. http://iponline.trevenna.net/home/default.aspx *
2. http://esearch.cipc.co.za

** when using the IP Online link the nominal prescribed fee in relation to conducting a search of the Trade Marks Register will be payable; however there will be no fee payable in relation to the obtaining of the copy of the document as already issued.*

When accessing the above listed links, search for the particular trade mark record/s using the official trade mark application number number/s, and then access the official action/s in respect of such application/s.

RORY VOLLER (MR)
ACTING COMMISSIONER: CIPC
30 August 2016

The dti Campus (Block F - Entfulfukweni), 77 Meintjies Street, Sunnyside, Pretoria I Private Bag X400, Pretoria, 0001
Call Centre: 086 100 2472
Website: www.cipc.co.za

NOTICE ON OBTAINING COPIES OF TRADE MARK RELATED DOCUMENTS ELECTRONICALLY

Companies and Intellectual Property Commission
a member of the dti group

PRACTICE NOTE 1 OF 2016

TRADE MARKS DIVISION

COMPANIES AND INTELLECTUAL PROPERTY COMMISSION (CIPC)

Notice is hereby given that as from **4 April 2016** copies of all **official actions**, issued in terms of Section 16(3) of the Trade Marks Act (Act 194 of 1993) in respect of trade mark applications lodged from the year 2010 onwards, may be accessed electronically and printed via the CIPC website, at no additional costs.

The official actions will be available from the following links:-

1. http://iponline.trevenna.net/home/default.aspx *
2. http://esearch.cipc.co.za

** when using the IP Online link the nominal prescribed fee in relation to conducting a search of the Trade Marks Register will be payable; however there will be no fee payable in relation to the obtaining of the copy of the document as already issued.*

When accessing the above listed links, search for the particular trade mark record using the official trade mark application/registration number, and then access the copies of the documents available in respect of such application/registration.

In addition, and where available, the following documents may also be accessed electronically and printed via the CIPC website, at no additional costs:-

- Copy of Form TM1 (application form)
- Copy of Notice of Acceptance
- Copy of notice of removal of trade mark registration due to non-payment of renewal fees

CIPC customers are encouraged to make use of this new, no-cost, self-help service offering from CIPC in order to obtain copies of the trade mark related documents as listed in this notice, as opposed to submitting requests to the Trade Marks Division to be provided with copies of such trade mark related documents, in the prescribed manner and at payment of the prescribed fee.

Andre Kritzinger
ACTING COMMISSIONER: CIPC
..24.. March 2016

The dti Campus (Block F - Entfutfukweni), 77 Meintjies Street, Sunnyside, Pretoria I Private Bag X400, Pretoria, 0001
Call Centre: 086 100 2472
Website: www.cipc.co.za

NOTICE ON ISSUING OF NOTICES OF ACCEPTANCE

Companies and Intellectual Property Commission
a member of the dti group

PRACTICE NOTE 2 OF 2017

TRADE MARK NOTICES OF ACCEPTANCE

SECTION 16(2) AND REGULATIONS 15(3) OF THE TRADE MARKS ACT, ACT 194 OF 1993

TRADE MARKS DIVISION

COMPANIES AND INTELLECTUAL PROPERTY COMMISSION (CIPC)

Notice is hereby given that as from **5 June 2017** all **NOTICES OF ACCEPTANCES**, issued in terms of Section 16(2), read with Regulations 15(3) of the Trade Marks Act (Act 194 of 1993), will be **issued electronically via e-mail**, to the e-mail address as reflected in the CIPC customer profile of the customer code under which the application was lodged.

In addition, the notice/s of acceptance may be accessed electronically and printed via the CIPC website, at no additional costs, and will be available from either of the following links:-

1. http://iponline.trevenna.net/home/default.aspx *
2. http://esearch.cipc.co.za

** when using the IP Online link the nominal prescribed fee in relation to conducting a search of the Trade Marks Register will be payable; however there will be no fee payable in relation to the obtaining of the copy of the document as already issued.*

When accessing the above listed links, search for the particular trade mark record/s using the official trade mark application number number/s, and then access the Notice/s of Acceptance in respect of such application/s.

KINDLY NOTE: the applicant or its duly recorded address for service, as detailed in the Trade Marks Register, will remain responsible for ensuring that such Notice/s of Acceptance is advertised in the prescribed manner, in line with the provisions of Sections 17 and 20(1), read with Regulation 18 of the Trade Marks Act (Act 194 of 1993).

RORY VOLLER (MR)
COMMISSIONER: CIPC
...5.. June 2017

The dti Campus (Block F - Entfutfukweni), 77 Meintjies Street, Sunnyside, Pretoria I Private Bag X400, Pretoria, 0001
Call Centre: 086 100 2472
Website: www.cipc.co.za



ANNEXURE L

EXPLANATORY NOTES DEALING WITH CONDITIONAL ACCEPTANCE AND PROVISIONAL REFUSAL OF TRADE MARK APPLICATIONS

A. CONDITIONAL ACCEPTANCE

1. Endorse the meaning of the trade mark for further consideration of the application

If a trade mark application contains a word/words in a language other than one of the eleven official languages of South Africa, the applicant is required to furnish a translation thereof and also indicate the language of origin thereof. If the word(s) have no meaning or are invented, this should be indicated in writing in response to the official action.

2. Lodge a Power of Attorney

If the application form (TM1) is signed by any person other than the applicant, a Power of Attorney must be lodged. Only an attorney practising in the Republic of South Africa is entitled to represent a trade mark applicant in trade mark matters. If a director or member of a company or close corporation signs the application form, proof of his/her authority to sign must be lodged. This would for example be a special resolution by the board of directors. In the instance of an application lodged in the name of a specific community or tribe, a tribal resolution would be required.

3. Agree to the association with each other/and with the following trade marks

If an application is the same or similar to another trade mark owned by the same proprietor, association between these trade marks is required. Association fees are R5-00 per application that must be associated. When agreeing to the association requirement, applicants are advised to ensure that sufficient fees are available in their accounts to prevent delays in processing acceptance of the application/s.

4. Disclaim

A disclaimer will be required of those elements (words/phrases/logos) in a trade mark which are in common use in that particular field/trade; or are required for use by other traders in the same filed/trade; or which are not capable of distinguishing. The applicant will acquire no exclusive rights to the disclaimed part/s of the trade mark, but will obtain rights to the trade mark as a whole.

5. Enter the usual admission/undertaking

- **Admission:** This is requested if a word has been mis-spelt, eg “xcllent” as opposed to “excellent”. The applicant will obtain rights in the mis-spelt word/words.

- **Undertaking:** Where a trade mark refers to a certain geographical area, eg “New York” but it is clear that the goods do not originate there from, an undertaking will be required that the country or place of origin be clearly indicated on the goods, so as not to lead to deception and confusion of the public.

6. Specify/rectify/restrict the goods/services in conformity with the trade mark

Where the trade mark as applied for contains words or signs that allude to the goods as applied for, eg. use of the word “chocolate” in a trade mark falling in one of the food classes, it will be required that the goods as applied for be restricted in conformity with the trade mark to goods made or, or containing chocolate or being chocolate flavoured.

7. Give an undertaking to send the notice of advertisement to the proprietor/s of the following registered trade marks

In instances where the application under consideration is viewed as confusingly similar to a prior registered trade mark on the Trade Marks Register, but not similar enough so as to warrant a refusal of such a trade mark application, the applicant will be required to send a copy of the notice of acceptance to the proprietor of the registered trade mark so as to inform the latter of the acceptance of the application. Proof of such notification must be forwarded to the Registrar,

as the registration certificate will not be issued without such proof having been received by the office.

8. Further requirements

Further provisions may be set for acceptance of the application, but which are not covered by the provisions detailed above. Such examples could include:-

- a request for the applicant to clarify what is the trade mark being applied for, or what are the goods and/or services that protection is sought for in order for the office to determine if the application has been lodged in the correct class
- a request to remove certain matter appearing in the trade mark which may not form part of the trade mark as applied for in terms of the Act, such as the ™ or ® symbols, or wording that contains detail of the product such as the composition, volume of the container, etc.

IMPORTANT TO NOTE

An applicant is required to comply to all the conditions for acceptance as set in the official action in writing, before the application can proceed to acceptance.

The official action must be responded to within three (3) months from the date on which the official action was issued.

B. PROVISIONAL REFUSAL

An application may be provisionally refused based on various sections of the Act, for example if:-

- it conflicts with a prior registered trade mark on the Trade Marks Register
- it conflicts with a prior application on the Trade Marks Register
- the application may be deemed as being offensive
- the application may be deemed as not being registrable as it is not capable of distinguishing the goods/services of one person or entity from that of another

Full details of the possible grounds of refusal appear in Section 10 of the Trade Marks Act, Act 194 of 1993 (the Act).

IMPORTANT TO NOTE

An applicant has the opportunity to make representations – either in writing or in person – in order to overcome the refusal. However the acceptance or not of an application, remain within the discretion of the Registrar of Trade Marks.

The official action must be responded to within three (3) months from the date on which the official action was issued.

LIST OF CONFLICTING NICE CLASSES

CLASS	CONFLICTING CLASSES
CLASS 1	2-5,35,42-45
CLASS 2	3-5,16,17,19,35,42-45
CLASS 3	1,2,4,5,8,16,21,35,42-45
CLASS 4	1-3,5,7,12,35,42-45
CLASS 5	1-4,10,29-32,34,35,42-45
CLASS 6	7-21,25,26,35,42-45
CLASS 7	8,9,11,12,21,35,42-45
CLASS 8	7,9,10,13,14,16,21,28,35,42-45
CLASS 9	10-12,16,25,35,42-45
CLASS 10	5,9,35,42-45
CLASS 11	4,6-11,17,20,21,35,42-45
CLASS 12	7-9,11,28,35,42,44,45
CLASS 13	28,34,35,42-45
CLASS 14	6,7-13,25,35,42-45
CLASS 15	1,2,5,8,9,17,35,42-45
CLASS 16	1,2,5,8,9,17,35,42-45
CLASS 17	1,2,6,16,19-21,35,42-45
CLASS 18	9,14,16,25,28,35,42-45
CLASS 19	1,2,6,17,35,37,42-45
CLASS 20	16,18,19,21,24-27,35,42-45
CLASS 21	3,5-8,10,17,35,42-45
CLASS 22	7,16,18,22-24,35,42-45
CLASS 23	22-27,35,42-45
CLASS 24	9,10,20,22-27,35,42-45
CLASS 25	9,10,14,24,28,35,42-45
CLASS 26	6,35,42-45
CLASS 27	11,20,24,35,42-45
CLASS 28	9,12-14,16,18,25,35,42-45
CLASS 29	5,30-33,35,42-45
CLASS 30	5,29,31-33,35,42-45
CLASS 31	5,29,30,32,33,35,42-45
CLASS 32	5,29-31,33,35,42-45
CLASS 33	5,29-32,35,42-45
CLASS 34	5,35,42-45
CLASS 35	ALL CLASSES
CLASS 36	9,16,19,35,42-45
CLASS 37	11,12,16,18-20,27,35,36,42-45
CLASS 38	9,16,35,42-45
CLASS 39	9,12,35,42,44,45
CLASS 40	1,35,42-45
CLASS 41	9,16,28,35,42-45
CLASS 42	ALL CLASSES
CLASS 43	ALL EXCEPT 12 & 39
CLASS 44	ALL CLASSES
CLASS 45	ALL CLASSES

ANNEXURE N

LIST OF POSSIBLE OTHER CONDITIONS FOR CONDITIONAL ACCEPTANCE

** Note that this is not an exhaustive list of conditions, but merely lists some examples thereof.*

- Kindly remove the current endorsement of (…) by lodging a Form TM2 and paying the related official fees.
- Kindly amend the endorsement to clearly and precisely define the colour trade mark.
- Kindly amend class (…) to class (…) by lodging a Form TM2 and paying the related official fees, as the specified goods or services do not fall in class (…).
- Kindly correct specification by deletion of (…) therein, by lodging a Form TM2 and paying the related official fees.
- Kindly clarify the exact goods or services you intend covering under this trade mark, as it is not clear from the specification provided in relation to the specific class.
- Kindly clarify the meaning of the word (…) as used in this instance.
- Kindly clarify the legal relationship between (…) and (…), for further consideration.
- Kindly provide proof of timeous lodgement of priority documents for further consideration, as well as copies thereof for record purposes.
- Kindly provide certified English translations of the priority documents for further consideration.
- The application date indicated on the priority documents differ from the date stated on the Form TM1. Kindly clarify this discrepancy for further consideration.
- The trade mark consists of the name of a well-known person. Kindly provide proof of consent from (…) or his or her estate for the use of the name (…).
- The trade mark consists of a misspelling of-, or is phonetically identical to-, the name of a well-known person. Therefore, kindly provide proof of consent from the artist known as (…) or his or her estate for the use of the name (…).
- Kindly delete the priority claim as the priority documents were not lodged timeously as required in terms of Regulation 12.
- Kindly amend (…) to show the same proprietor details as that of the applicant herein, by lodging a Form TM2 and paying the related official fees.

- Kindly amend the address for service to comply with Section 66 by lodging a Form TM2 and paying the related official fees.
- Kindly provide written consent from the Registrar of Banks for the use of the word “BANK” in the trade mark, in accordance with Section 22(5) of the Banks Act 9 of 1990.
- Kindly correct the specification of the trade mark to conform to NICE Class (…) by lodging a Form TM2 and paying the related official fees.
- The trade mark appears to contain a typographical error on the word (…). Kindly advise whether this is an intentional misspelling of this word, for further consideration.
- The trade mark appears to contain a depiction of a national flag, kindly advise hereon for further consideration.
- Kindly deposit a specimen of the goods bearing the trade mark at the Office of the Registrar of Trade Marks in accordance with Regulation 13(6) for further consideration of this application.
- Kindly deposit a specimen of the trade mark at the Office of the Registrar of Trade Marks in accordance with Regulation 13(6) of the Trade Marks Act for further consideration of this application.
- Kindly provide a clearer representation of the trade mark as per Regulation 13(4) for further consideration of this application.
- Kindly indicate whether the trade mark as applied for is a container for goods or if protection is only sought in respect of the labelling.
- (Certification trade mark) Kindly submit the required documents as stipulated in Regulation 56(3) for further consideration.
- (Collective trade mark) Kindly submit the required documents as stipulated in Regulation 57(3) for further consideration.
- Applications (…) and (…) appear to be duplications of each other, kindly advise for further consideration.
- Kindly remove the (…) and other certification symbols, as well as the phrases (…) and (…) from the trade mark by lodging a Form TM2 and paying the related official fees, as these elements do not constitute trade mark matter.
- Kindly remove the ® / ^{TM} / © symbol from the trade mark by lodging a Form TM2 and paying the related official fees, as this symbol does not constitute trade mark matter.
- Kindly correct the typographical error in the name of the applicant by lodging a Form TM2 and paying the related official fees.

- The address for service must be that of the applicant or of a practising attorney acting on behalf of the applicant. Kindly amend the address for service to comply with the Trade Marks Act 194 of 1993 by lodging a Form TM2 and paying the related official fees.
- The current address of the applicant appears to be the same as the law firm recorded as address for service. Kindly amend the address of the applicant to show the applicant's actual physical address, by lodging a Form TM2 and paying the related official fees.
- The name of the foreign applicant and the address for service differ. The Trade Marks Act 194 of 1993 stipulates that an applicant not based in the Republic of South Africa must be represented by a practising attorney. This application therefore does not comply with the Trade Marks Act 194 of 1993. Kindly appoint a practising attorney in the Republic to represent the applicant herein for further consideration of this application.
- The applicant herein is a public entity. Kindly advice how, as a public entity, the applicant intends to use this trade mark "in the normal course of trade", for further consideration of this application.
- Kindly amend the address for service to (…) by lodging a Form TM2 and paying the related official fees.
- Kindly amend the name of the applicant of (…) to (…) by lodging a Form TM2 and paying the related official fees.
- Kindly indicate what the trade mark consists of for further consideration of this application.
- The endorsement refers to supporting documents which have been omitted. Kindly advise and provide such documents for further consideration of this application.
- Kindly provide an analogue or digital recording of the sound trade mark, along with an appropriate written description thereof, for further consideration.
- Kindly provide proof that (…) is an entity or person permitted in terms of the Trade Marks Act 194 of 1993 to represent the trade mark applicant herein, for further consideration of this application.

