TRADE MARKS: Frequently Asked Questions:

Trade marks are extremely valuable assets and deserve effective and comprehensive protection. The registration of a trade mark does, however, take place within a complex legal environment, which demands close attention to procedural and formal requirements. These may vary from country to country, and unnecessary delays and/or costs may result from non-compliance with the procedures and formalities.

If this is the first time that you are planning to register a trademark, the information outlined in the FAQs will certainly help you to make an informed decision when assessing the quoted fees and charges and in planning the way forward.

While registration is undoubtedly an important step, it is only one stage in the process of maximising the value of a trade mark within your IP portfolio. Spoor & Fisher offers expert advice and assistance concerning the effective management of IP, including IP audits to determine whether your brand is fully protected, and proactive policing by our in-house Anti-counterfeiting Unit. The information outlined in our FAQs also covers other forms of intellectual property which may be associated with your brand.

1. Why conduct a search prior to filing a trade mark?

A trade mark search at the Trade Marks Office will establish whether there are any prior conflicting marks that may pose an obstacle to the registration of your trade mark. If potential problems are anticipated, we will be in a position to advise you on possible ways to resolve these issues at an early stage.

2. What is a trade mark?

Generally speaking, a trade mark is a word, symbol, phrase or device which uniquely identifies a particular company or individual. Therefore, it can also be a design, or a combination of words, phrases, symbols or designs.

A trade mark can take just about any form provided that it is:
- distinctive, and
- capable of being represented graphically.

A trade mark is a mark used in relation to goods or services for the purposes of distinguishing those goods or services from similar goods or services connected with other businesses. Not only should a trade mark help with identifying your goods and services but it should further serve to distinguish the source of the goods of one party from those of others.

A word that is descriptive of the goods or services and therefore common in the trade would not be capable of distinguishing and would not qualify for registration. An example of a descriptive mark is MUSIC MAGAZINE used for music magazines or STEAKHOUSE for a restaurant.

Invented words like KODAK and XEROX are good examples of words that are inherently capable of distinguishing.

3. Why register a trade mark?

A registered trade mark confers upon you the exclusive rights, in the country of application, to use your trade mark in respect of the goods or services for which it was registered. This will prevent unauthorised use of your trade mark by others in your industry.
A trade mark registration provides official notice to others that a trade mark is already taken; as a result, a company that later adopts an identical and/or confusingly similar trade mark cannot claim ignorance of the mark.

A trade mark owner receives the presumption of being the valid owner of the mark and therefore, a trade mark registration further reduces your chances of becoming involved in potentially costly litigation.

Many businesses now treat a trade mark as a capital asset. Your registered trade mark can easily be commercialised through licensing agreements such as franchising.

4. **What information is required to file a trade mark?**
   - The full name, physical address and nationality of the trade mark applicant.
   - The goods and/or services for which protection is sought i.e. in relation to what goods or services is the mark going to be used or is being used.
   - If the trade mark is a logo mark we require 10 clear prints measuring 8 x 10 cm of such logo. This may be e-mailed to us and we will make the necessary copies.
   - The only documentation required is a Power of Attorney, signed by the applicant authorising our firm to act on your behalf in respect of trade mark matters. No authentication is required. It is not, however, a prerequisite that such Power of Attorney accompany the application form. It may be placed on file at a subsequent stage. General Powers of Attorney may be utilised in which case separate Powers of Attorney need not be lodged. Please note that we need the original signed Power of Attorney form to submit at the Trade Marks Registry. A faxed or emailed copy will not suffice.

5. **What does the registration process entail and how long does it take to obtain registration?**
   1. After filing a trade mark application, it is examined by the Trade Marks Registry, both as to the distinctiveness of the trade mark itself and as to possible conflict the existing trade marks on the Trade Mark Register. (Unfortunately, delays are being experienced at the Trade Marks Registry. A period of approximately 9 to 12 months elapses from date of filing of an application until first examination by the Registrar.)
   2. After examination, an official action is issued in which the Registry indicating whether, and subject to what conditions, it would be prepared to accept and then register the mark.
   3. Once the Registry is satisfied that a trade mark can proceed to registration, it will issue notice of acceptance of the application. Thereafter, advertisement will be arranged in the Patent and Trade Mark Journal.
   4. At advertisement, the application is open to opposition by interested parties for a period of three months. If a party believes that it has grounds for opposing, an extension of the opposition period is usually requested prior to the filing of formal notice of opposition. Once the threat of opposition is resolved or withdrawn, the Certificate of Registration will be issued. Alternatively, if there is no opposition, after three months have expired, the trade mark will proceed to registration.
   5. Once the application proceeds to acceptance and advertisement, a further 9 to 12 months could pass before the Certificate of Registration is issued. It takes between 30 and 36 months before the Registration Certificate is received.
6. **On completion of the registration process, rights in the trade mark commence from the date of filing of the application and last for ten years. A trade mark is renewed every ten years.**

6. **When to use the symbols ™ and ®?**

The ™ symbol (or the words “Trade Mark”) may be used alongside registered and unregistered trade marks. The ® symbol (or the words “Registered Trade Mark”) should only be used in respect of a trade mark that has been registered. It is an offence in terms of the Trade Marks Act to falsely indicate that a trade mark has been registered, when it is not the case.

There is no objection to using the words “Trade Mark” or the ™ symbol in connection with a trade mark which is not registered.

In addition, the © symbol may be used on your manuals, brochures, books, websites etc to clearly indicate that copyright is being claimed in such works. The appropriate way to use the © symbol would be to indicate the date from which copyright is claimed along with the name of the owner.

7. **Will my trade mark be protected in more than one country?**

Trade marks are territorial and the rights are limited to the territory in which registration has been obtained. Thus, a registration in South Africa does not confer any rights in the trade mark in export markets. As a result, rights in the mark must be protected in each country of interest or potential interest by the best means possible, that is, by registration.

In some cases, however, regional filing systems apply. If you wish to file in Europe, or in the French-speaking and English-speaking countries in Africa, we could apply for the registration of your trade mark through a centralised intellectual property registration office system, offered by each of these collective entities. By filing for the registration of your mark in this manner, you need only file one trade mark application at the central office, which will afford you protection in a number of territories.

In Europe, the Office for the Harmonisation of Intellectual Property Law (OHIM) allows for the registration of a trade mark in Austria, Belgium, Bulgaria, Denmark, Finland, France, Germany, Greece, Ireland, Italy, Luxembourg, Netherlands, Portugal, Spain, Sweden, Cyprus, Czech Republic, Estonia, Hungary, Latvia, Lithuania, Malta, Poland, Romania, Slovakia and Slovenia and the United Kingdom.

For the French-speaking African countries, the African Intellectual Property Organization (OAPI) provides for the registration of a trade mark in Benin, Burkina Faso, Cameroon, Central African Republic, Chad, Congo, Equatorial Guinea, Gabon, Guinea, Guinea-Bissau, Ivory Coast, Mali, Mauritania, Niger, Senegal and Togo.

The African Regional Industrial Property Organisation (ARIPO) covers English-speaking African countries and includes Botswana, Gambia, Ghana, Kenya, Lesotho, Liberia, Malawi, Mozambique, Namibia, Sierra Leone, Sudan, Swaziland, Tanzania, Uganda, Zambia and Zimbabwe. National trade marks may be covered in each country. Please note that not all of these countries have amended their national legislation to recognise rights arising from an ARIPO registration.

For more information on OAPI and ARIPO, please see our website.

8. **Does my company registration protect my name and what is defensive company registration?**

Here is a brief explanation of the difference between company names, trading styles and trade marks:
A company name is the name under which a business operates and is registered on the Register of Companies and Close Corporations. On the other hand, a trade mark is applied to the goods or in relation to the services of the proprietor of the trade mark and is registered on the Register of Trade Marks.

Our costs for lodging the application for the reservation of a company name, preparing the necessary company documents (with a standard memorandum and articles of association having a share capital of R1 000-00) and lodging these documents with the Registrar for registration, amounts to approximately R6 500-00. Please note that this quote does not include our costs in the event that we have to make further representations to the Registrar should he disallow the name reservation application.

8.1 What is a defensive company name?

In South Africa it is not necessary to register a company in order to have a name added to the Companies Register. One can in fact register a defensive company name. The registration of defensive company names prevents others from incorporating a company or close corporation under a name that is confusingly similar. This can prevent confusion in the market place and it is, therefore, advisable to register a defensive company name as well as a trade mark.

In the event that you have registered a defensive company name containing your trade mark, the Registrar of Companies will pick up the defensive company name registration at the time when any unauthorised person submits an application for the reservation of either a company or close corporation name containing your defensive company name. Such application for the reservation of the name will then be refused by the Registrar of Companies.

8.2 What does the registration of a defensive company name entail?

In order to secure registration of a defensive company name we are required to satisfy the Registrar of Companies as to your direct and material interest in the name/s. This means that we have to prove a pecuniary or proprietary interest, which is important or significant, directly connected with the name, e.g. it is a trade mark owned by the applicant.

Generally this requirement can be satisfied by furnishing the Registrar with specimen letterheads, business cards, catalogues, proof of registration of a trade mark or trade mark application, advertising material and the like which clearly reflect the use of the particular name which protection is being sought.

If you choose to proceed along this route, you (or Spoor & Fisher, acting on your behalf) would be required to submit an application for the reservation of the proposed defensive company name. The name reservation, if granted, is valid for a period of two months. Within the aforementioned period of two months the application for the registration of the defensive company name is to be submitted to the Registrar. The application for registration must be made containing particulars of the name, as approved by the Registrar. Once the registration is secured it remains valid for a period of two years. The cost for attending to the defensive company name registration, including the reservation of the name amounts to approximately R1 950.

Renewal of the registration may be secured at two yearly intervals but at each stage of renewal the Registrar may call for further evidence as to the continuing direct material interest in the name. The current charge for a renewal of a defensive registration amounts to approximately R1 300.
9. **Why register a domain name on the internet?**

Domain names are valuable corporate assets and identifiers. With the expansion of the internet and e-commerce it is important for trade mark owners to protect their trade marks on the internet by registering domain names. We are able to conduct a search to ascertain whether your relevant trade mark/brand name can be registered as a domain name in South Africa under the most commonly used commercial domain space "co.za". Our approximate costs involved in attending to the availability search of a `.co.za` domain name are R395 (excluding VAT).

However, should you require us to search for a domain name and proceed with the registration thereof (should the domain name be available for registration), our approximate costs involved in registering will be R1 138 (excluding VAT). This amount includes official registration fees and our professional fees but excludes minor sundry costs and disbursements. We will not charge an additional R350 (excluding VAT) in this case.

The only registration requirement that the South African Domain Name Registrar has is that the domain name must be hosted on two operational domain name servers. When registering a domain name on our clients' behalf, we can enter the required domain name onto our domain name servers. Once the domain name has been registered, our practice is to link all domain names that we register on our clients' behalf to an existing website of theirs. The domain name is then considered to be "used" for the purposes of registration. However, should you wish to actively use your domain name, either as a web page or as an e-mail address, it is necessary that the domain name be transferred away from Spoor & Fisher’s domain name servers to your Internet Service Provider's (ISP's) servers, as we are unfortunately unable to host active websites and e-mail addresses.

A `.co.za` domain name is due for renewal on an annual basis. Our current fee for attending to the renewal of a domain name is R653 (excluding VAT). Without accepting any responsibility, we forward a reminder in respect of the renewal at the appropriate time.

The only information we require is the full name and physical address of the proposed domain name owner and the correct spelling of the proposed domain name. Domain names are allocated on a “first come, first served” basis.

Once we submit the registration and it is successful, it takes approximately 24 hours for us to receive the confirmation from our Registrar.

10. **What is the overlap between design registration and trade mark law?**

Both our Trade Marks Act and Designs Act overlap with one another and there are numerous examples in which it may be possible for a product to be protected by way of both the Designs and Trade Marks Act. Examples would be the tread in a motor vehicle tyre, the peculiar shape of a tennis racket, distinctive shapes of furniture, to name but a few. There are however strict novelty requirements in the Designs Act and in some cases it might be to your advantage to file for a trade mark rather than a design.

11. **What is copyright law?**

Copyright prevents another party from copying (or performing certain other activities in respect of) a work provided for and covered by the Copyright Act without the authorisation of the copyright owner. Copyright subsists automatically and does not need to be registered, as is required for Trade Marks, Patents and Designs. The only exception is the copyright which subsists in cinematography films, which is registrable in South Africa.

Only qualified “works” are eligible for copyright protection:
The subject matter(s) must qualify as a particular “work” in order to be eligible for protection under the Copyright Act. Examples of these “works” are:

- literary works (for example novels, poems, tables and manuals);
- artistic works (for example photographs, paintings and drawings);
- musical works (for example music, exclusive of any words or action, reduced to writing or musical notations preserved in a material form, e.g. a record or a tape);
- sound recordings (for example a compact disc or tape on which sounds are embodied);
- cinematography films;
- broadcasts (for example radio and television);
- programme-carrying signals (for example a signal being emitted passing through a satellite);
- published editions (i.e. the first print of a particular typographical arrangement of a literary or musical work); and
- computer programs.

11.1 What are the requirements for copyright protection?

- The relevant subject-matter must constitute a "work" as provided for by the Act.
- A work must be original meaning that it was not copied from another source, but that the author has invested his / her own time, money, effort, skill, knowledge and endeavours to create the work.
- A work must be in a material form in that a physical or tangible product exists. This requirement entails that the work cannot be a mere thought or idea, but that it must have been created and then "fixed" in some manner. The fixing can take place in a number of ways, e.g. by having the content written down, recorded, filmed or captured electronically. The essential requirement is that the content has become locked into the physical world in some way;
- The author of the work must be a citizen of South Africa, or be resident / domiciled in South Africa, or a country to which the operation of the Copyright Act has been extended.

11.2 What is the duration of copyright?

The duration depends on the type of work concerned, but can generally be considered as a period of at least 50 years from the moment of a certain event, such as:

- literary, musical and artistic works - 50 years after the death of the author;
- cinematography films and computer programs - copyright will expire 50 years after the work is made available to the public with the consent of the owner of the copyright or after the work is first published, whichever is the longer.

12. How does Spoor & Fisher safeguard your rights?

Spoor & Fisher offers various services to help safeguard your rights. Watching Services are offered by the Trade Marks Department specialists. Provided that Spoor & Fisher is the recorded address for service, we offer the following two categories of watching services at no charge in respect of the client's trade mark/s:

12.1 Company and close corporation name searches

This watching service entails the comparison of the names of all newly registered companies and close corporations (or company and close corporation name changes) as advertised in the Government Gazette against the trade mark applications and registrations on our records in respect of which Spoor & Fisher is the address for service. This would highlight any company or close corporation names that are confusingly or deceptively similar to any of your existing trade mark applications or registrations. Company and close corporation name objections can then be lodged within the statutory time limits in the event that there is any infringement of your rights.
12.2 Trade mark applications advertised for opposition purposes in the Patent Journal

This watching service entails the comparison of all trade mark applications that are advertised for opposition purposes in the South African Patent Journal against the trade mark applications and registrations on our records in respect of which Spoor & Fisher is the address for service. This would also highlight any trade mark applications in the names of competitors or other third parties that are confusingly or deceptively similar to any of your existing trade mark applications or registrations. This allows for extensions of the opposition period to be obtained or for trade mark opposition proceedings to be instituted before the statutory 3 month opposition expires.

These watching service reports are forwarded to clients without obligation and without any legal advice or opinion as to the merits of any potential objection. Costs would only be incurred if we are instructed to provide an opinion on the merits of a possible objection or to take any further action such as the institution of formal opposition proceedings.

The following two categories of watching services are charged at very reasonable rates:

12.3 New trade mark applications filed in South Africa in the names of specific proprietors

A watching service could, for example, be conducted on behalf of your Company in order to provide you with full details, on a monthly basis, of all new trade mark applications filed by specific competitors in your field. This would enable you to keep track of new products that are intended to be launched by competitors.

12.4 New trade mark applications filed in South Africa in specific trade mark classes

This is a more comprehensive monthly watching service and would enable you to keep a monthly track of all new trade mark applications that are filed in South Africa in the main trade mark classes of interest to your business. The main purpose of this watching service would be to alert you to new trade mark applications that may be confusingly similar to any of your South African trade marks. It is much easier to challenge a trade mark application at the filing stage than to wait up to two years for the application to be advertised in the Patent Journal.