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TRADE MARK | REGISTERED DESIGN | COPYRIGHT | COMMERCIAL | LITIGATION

WHAT IS A TRADE MARK?

A trade mark is a distinctive indicator used by an individual, business organisation or other legal entity, to identify and designate ownership of the products or services on which the trade mark appears.

The Companies and Intellectual Property Commission (CIPC) describes a trade mark as a brand name, a slogan or logo (it can also be a sound, colour combinations and even smells). It identifies the services or goods of one person and legally distinguishes it from the goods and services of another.

A brand name could be a word or combination of words (e.g. AirPods). A slogan consists of a short phrase or a sentence, and a logo is a distinctive picture or symbol. They provide a distinctive identity in the marketplace.

For example:

Registered company name: **McDonald's Corporation**

Brand name (trade mark): **McDonald's** ®

Slogan (trade mark): **I'm lovin' it** ®

Logo (trade mark):



WHY IS A TRADE MARK ADVANTAGEOUS?

A trade mark is a proprietary term, meaning that when a trade mark has been registered, it confers the registered owner the right to exclusive use of the mark in relation to the products or services for which it is registered.

The registration of a trade mark creates a public record of your trade mark ownership. This, in turn, prevents other people or entities from registering trade marks that are deceptively similar to yours.

Furthermore, it gives you the right to institute legal proceedings against any person or entity that infringes your trade mark and can be used to stop the importation of goods that infringe your mark.

It gives you the right to use the registered trade mark symbol, ®, which makes it further known to the public that the mark is legally protected. It also makes it easier to register your mark in other countries.

THE TRADE MARK PROCESS

The trade mark registration process is as follows:

1. Attorney Briefing



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You will consult with an attorney specialising in trade mark registrations, delineating which aspects of your business you would like to trade mark.

2. Classes Defined

Your attorney will then advise you as to which class/classes you should file your trade marks under. There are 45 different trade mark classes. Classes 1-34 cover goods and classes 35-45 cover services.

3. Search

A search will be performed by your trade mark attorney on the national database of registered trade marks to ensure that the desired trade mark is not already in use in the relevant class/classes.

4. Application Filing

Once the search has proved successful, the application for your trade mark/s registration will be lodged at the Trade Marks Registry and is allocated an application number and filing date.

The filing date is used to determine the 10-year term of a trade mark, whereafter the trade mark will have to be renewed by paying a maintenance fee.

Once your application is filed, you may use the TM in subscript next to the product name on all labels/packaging/advertising etc., that will show that a trade mark has been filed and will ensure that no one tries to copy the name.

5. Examination

The application is examined approximately 12 months later, and the Registrar will issue his examination report in terms of which he will either accept the application, either unconditionally or subject to compliance with certain conditions, or he will refuse it. If it is refused, there are various means in which it is possible to attempt to argue against the refusal.

6. Acceptance

There are three levels of acceptance:

Unconditionally accepted – there are absolutely no problems with the mark.

Conditionally accepted – it has been accepted subject to complying with some order of the Registrar. Usually, it is a translation of the word, a disclaimer of a descriptive word, an admission of a misspelt word or an endorsement.

Provisionally refused – it offends against some section of the Trade Mark Act or is too similar to a mark already on the register and a detailed response and arguments must be set out in order to try to overcome the provisional refusal.



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7. Advertisement

If the trade mark is accepted and once any necessary conditions have been complied with, the application is advertised/published in the South African Patent Journal within 2 months of the official instruction to do so.

It is then maintained open for opposition purposes for 3 months. In this period, interested parties have an opportunity to lodge any objection to the registration of the mark.

8. Opposition

If any person or entity opposes the registration of your trade mark, they must do so within the 3-month period stated above.

9. Registration Certificate

If no opposition is encountered, the trade mark will proceed to registration and the registration certificate will be issued. This is likely to issue approximately 6 months after the end of the opposition period. At this point, you may stop using the TM in subscript and start using the registered trade mark symbol (®).

WHY IT IS IN YOUR BEST INTERESTS TO ALLOW SPECIALISTS IN THE FIELD TO EXECUTE THE PROCESS ON YOUR BEHALF

As trade mark attorneys, we know the value and recognise the potential of your intellectual property, and how important it is to get its protection right the first time.

We appreciate the roles that trade marks play in any business. We are well-versed in the complexities of each industry, market and niche; something that many general legal practitioners cannot fully understand.

We know the risks and can assess which you may need to mitigate and manage as part of your overall trade mark strategy; we are also better able to manage the prosecution of trade mark infringements on your behalf.

Lastly, we have access to the national database to conduct a comprehensive trade mark availability search for you at the outset, saving you a lot of time and money in the long run, as well as systems in place to maintain, enforce and monitor your trade marks across the world.

If this is important to you, please do not hesitate to contact us. We look forward to protecting your brand.