

DEPARTMENT OF MERCANTILE LAW

**LAW OF COMPETITION AND TRADE MARKS
(LML402P)**

Tutorial Letter 102/2010

Dear Student

TRADE MARKS ACT 194 OF 1993

In this tutorial letter we provide you with an extract from the Trade Marks Act 194 of 1993 as amended. Only sections that should be studied for examination purposes have been included.

PART I

Introduction

Definitions

2 (1) In this Act, unless the context otherwise indicates--

- (v) "convention country" means any country or group of countries in respect of which there is in force a proclamation under section 63 declaring such country or group of countries to be a convention country or convention countries for the purposes of this Act;
- (vi) "court" means the Transvaal Provincial Division of the Supreme Court of South Africa, but in relation to any claim or counterclaim for removal, amendment or variation of, or other relief affecting any entry in, the register arising from or forming part of proceedings instituted in any other division of the said Supreme Court having jurisdiction in relation to the proceedings, includes that division in respect of such claim or counterclaim;

- (vii) "deed of security" means a written instrument signed by the proprietor of a registered trade mark hypothecating the registered trade mark;
 - (viii) "device" means any visual representation or illustration capable of being reproduced upon a surface, whether by printing, embossing or by any other means;
 - (ix) "limitation" means any limitation of the exclusive right to the use of a trade mark given by the registration thereof, including a limitation of that right as to the mode of use, as to use in relation to goods to be sold, or otherwise traded in, or as to services to be performed, in any place within the Republic, or as to use in relation to goods to be exported from the Republic;
 - (x) "mark" means 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;
 - (xxi) "services" includes the offering for sale or the sale of goods in the retail or wholesale trade;
 - (xxiii) "trade mark", other than a certification trade mark or a collective trade mark, means a mark used or proposed to be used by a person in relation to goods or services for the purpose of distinguishing the goods or services in relation to which the 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;
- (2) References in this Act to the use of a mark shall be construed as references to-
- (a) the use of a visual representation of the mark;
 - (b) in the case of a container, the use of such container; and
 - (c) in the case of a mark which is capable of being audibly reproduced, the use of an audible reproduction of the mark.
- (3) (a) References in this Act to the use of a mark in relation to goods shall be construed as references to the use thereof upon, or in physical or other relation to, such goods.
- (b) References in this Act to the use of a mark in relation to services shall be construed as references to the use thereof in any relation to the performance of such services.
- (4) The use or proposed use of a registered trade mark shall include the use or proposed use of the trade mark in accordance with the provisions of section 38, whether for the purposes of this Act or at common law.

Application of Act to trade marks registered under repealed Act

3 (1) Subject to the provisions of section 70, this Act shall apply to all trade marks registered or deemed to be registered under the repealed Act, whether in Part A or Part B of the register kept under that Act.

(2) All applications and proceedings commenced under the repealed Act shall be dealt with in accordance with the provisions of that Act as if it had not been repealed.

PART III*Registrable trade marks***Registrable trade marks**

9 (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.

Unregistrable trade marks

10 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:

- (1) A mark which does not constitute a trade mark;
- (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;
- (3) a mark in relation to which the applicant for registration has no *bona fide* claim to proprietorship;
- (4) a mark in relation to which the applicant for registration has no *bona fide* intention of using it as a trade mark, either himself or through any person permitted or to be permitted by him to use the mark as contemplated by section 38;
- (5) a mark which consists exclusively of the shape, configuration, colour or pattern of goods where such shape, configuration, colour or pattern is necessary to obtain a specific technical result, or results from the nature of the goods themselves;
- (6) subject to the provisions of section 36(2), a mark which, on the date of application for registration thereof, or, where appropriate, of the priority claimed in respect of the application for registration thereof constitutes, or the essential part of which constitutes, a reproduction, imitation or translation of a trade mark which is entitled to protection under the Paris Convention as a well-known trade mark within the meaning of section 35(i) of this Act and which is used for goods or services identical or similar to the goods or services in respect of which the trade mark is well-known and where such use is likely to cause deception or confusion;
- (7) a mark the application for registration of which was made *mala fide*;
- (8)
 - (a) 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 the 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 the 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 or warranty, in relation to goods or services of the same or similar kind as those in relation to which it indicates control or warranty, without the authorization of the competent authority of the Republic or the 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 international organisation 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;

Provided that -

- (i) paragraphs (b),(c) and (d) shall apply to a state emblem and an official sign or hallmark of a convention country and an emblem, the name, or the abbreviation of the name, of an international organization only and to the extent that -
 - (aa) the convention country or international organization, as the case may be, has notified the Republic in accordance with Article 6^{ter} of the Paris Convention that it desires to protect the emblem, official sign or hallmark, name or abbreviation, as the case may be;
 - (bb) such nomination remains in force; and
 - (cc) the Republic has not objected to it in accordance with Article 6^{ter} of the Paris Convention or any such objection has been withdrawn;
 - (ii) paragraph (b),(c) or (d) shall apply only in relation to applications for registration made more than two months after receipt of the notification referred to in paragraph (i)(aa);
 - (iii) paragraph (b) or (c) shall not prevent the registration of a trade mark by a citizen of any country who is authorized to make use of a state emblem, official sign or hallmark of that country, notwithstanding the fact that it is similar to that of another country;
- (9) a mark which contains any word, letter or device indicating State patronage;
 - (10) a mark which contains any mark specified in the regulations as being for the purposes of this section a prohibited mark;
 - (11) a mark which consists of a container for goods or the shape, configuration, colour or pattern of goods, where the registration of such mark is or has become likely to limit the development of any art or industry;
 - (12) 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;
 - (13) a mark which, as a result of the manner in which it has been used, would be likely to cause deception or confusion;
 - (14) subject to the provisions of section 14, a mark which is identical to a registered trade mark belonging to a different proprietor 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 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;
 - (15) 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;

(16) a mark which 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;

(17) a mark which is identical or similar to a trade mark which is already registered and which is well-known in the Republic, if the use of the mark sought to be registered would be likely to take unfair advantage of, or be detrimental to, the distinctive character or the repute of the registered trade mark, notwithstanding the absence of deception or confusion, unless the proprietor of such trade mark consents to the registration of such mark:

Provided that a mark shall not be refused registration by virtue of the provisions of paragraph (2) or, if registered, shall not be liable to be removed from the register by virtue of the said provisions if at the date of the application for registration or at the date of an application for removal from the register, as the case may be, it has in fact become capable of distinguishing within the meaning of section 9 as a result of use made of the mark.

Registration to be in respect of particular goods or services

11 (1) A trade mark shall be registered in respect of goods or services falling in a particular class or particular classes in accordance with the prescribed classification: Provided that the rights arising from the registration of a trade mark shall be determined in accordance with the prescribed classification applicable at the date of registration thereof.

(2) Where a trade mark has, either before or after the commencement of this Act, been registered as contemplated in subsection (1) and, during the subsistence of that registration, the prescribed classification in accordance with which the trade mark was registered as aforesaid is revised or is replaced by a new classification, the proprietor of the trade mark may, at any time, apply in the prescribed manner for revision, in accordance with the revised or new classification, of the class or classes in which the trade mark is registered.

(3) If the revised or new classification referred to in subsection (2) results in two or more identical trade marks owned by the same proprietor which were under the previous registration registered in separate classes, falling within a single class, such marks shall, if they have the same registration date, be consolidated as one registration in the revised or new class, or if as a result of the revised or new classification a trade mark is required to be recorded in more than one class, such mark shall be deemed to be separately registered in each such class and shall be treated as a separate trade mark for the purposes of renewal thereof in each class.

Name or representation of person

12 Where application is made for registration of a trade mark which consists of or includes the name or representation of a person, the registrar may require the applicant to furnish him with the consent of that person or, where such person is deceased, of his legal representative, to the name or representation appearing in the trade mark.

Honest concurrent use

14 (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 0.

(2) In the case of a trade mark which is sought to be 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 make it proper to do so, refuse to remove the trade mark from the register.

Registration subject to disclaimer

15 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.

PART IV

Application for registration

Application for registration

16 (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.

(5) The registrar or the court, as the case may be, may at any time, whether before or after acceptance of the application, correct any error in or in connection with the application, or may permit the applicant to amend his application upon such conditions as the registrar or the court, as the case may be, may think fit.

Proposed use of trade mark by body corporate to be established

19 (1) No application for the registration of a trade mark in respect of any goods or services shall be refused, nor shall acceptance thereof be withheld, on the ground only that the applicant does not use or propose to use the trade mark, if the registrar is satisfied that a body corporate is about to be established and that the applicant intends to assign the trade mark to the body corporate with a view to the use thereof in relation to those goods or services by the body corporate: Provided that the trade mark shall only be registered once the registrar has been placed in a position to register the assignment in terms of section 40 simultaneously with the registration of the trade mark.

(2) For the purposes of subsection (1)(a) of section 27 the intention referred to in that subsection shall, in relation to a trade mark registered by virtue of subsection (1) of this section, be an intention on the part of the applicant that the trade mark be used by the body corporate concerned.

Non-completed applications

20 (1) 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.

(2) 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.

PART V

Opposition

Opposition to registration

21 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.

Amendment of register

23 (1) The registrar may correct any error in the register made by an official of his office.

(2) The registrar may, on request made in the prescribed manner by the registered proprietor of a trade mark, amend or alter the register by -

- (a) correcting any error in the name or address of the registered proprietor of the trade mark or any error in the register relating to such trade mark;

- (b) altering the name or address or address for service of the registered proprietor who has changed his name or address or address for service;
- (c) cancelling the registration of the trade mark;
- (d) deleting any goods or services or classes of goods or services from those in respect of which the trade mark is registered; or
- (e) entering a disclaimer or memorandum relating to the trade mark which does not in any way extend the rights given by the registration of the trade mark.

(3) The registrar may, on request made in the prescribed manner by the registered proprietor or a registered user of a trade mark enter in the register any change in the name or address of such registered user.

General power to rectify entries in register

24 (1) In the event of non-insertion in or omission from the register of any entry, or of an entry wrongly made in or wrongly remaining on the register, or of any error or defect in any entry in the register, any interested person may apply to the court or, at the option of the applicant and subject to the provisions of section 59, in the prescribed manner, to the registrar, for the desired relief, and thereupon the court or the registrar, as the case may be, may make such order for making, removing or varying the entry as it or he may deem fit.

(2) The court or the registrar, as the case may be, may in any proceedings under this section decide any question that may be necessary or expedient to decide in connection with the rectification of the register.

(3) In the event of the registrar being satisfied that any entry relating to the registration, assignment or transmission of a trade mark has been secured *mala fide* or by misrepresentation or that any such entry was wrongly made or wrongly remains on the register, he shall also have *locus standi* to apply to the court under the provisions of this section.

Alteration of registered trade mark

25 (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.

Power to remove or vary registration for breach of condition

26 (1) Any interested person may apply for the removal from the register, or a variation, of a registered trade mark if its proprietor or any person permitted to use it in terms of section 38 fails to comply with any condition entered in the register in relation to its registration.

- (2) Such application may be made to the court or to the registrar.
- (3) The registrar has *locus standi* to make such application to the court.
- (4) The registrar or the court may make such order for removing or varying the registration of the trade mark as he or it may deem fit.

Removal from register on ground of non-use

27 (1) Subject to the provisions of section 70(2), a registered trade mark may, on application to the court, or, at the option of the applicant and subject to the provisions of section 59 and in the prescribed manner, to the registrar by any interested person, be removed from the register in respect of any of the goods or services in respect of which it is registered, on the ground either -

- (a) that the trade mark was registered without any *bona fide* intention on the part of the applicant for registration that it should be used in relation to those goods or services by him or any person permitted to use the trade mark as contemplated by section 38, and that there has in fact been no *bona fide* use of the trade mark in relation to those goods or services by any proprietor thereof or any person so permitted for the time being up to the date three months before the date of the application;
- (b) that up to the date three months before the date of the application, a continuous period of five years or longer has elapsed from the date of issue of the certificate of registration during which the trade mark was registered and during which there was no *bona fide* use thereof in relation to those goods or services by any proprietor thereof or any person permitted to use the trade mark as contemplated in section 38 during the period concerned; or
- (c) subject to such notice as the court or the registrar, as the case may be, shall direct, and subject to the provisions of the regulations, that, in the case of a trade mark registered in the name of a body corporate, or in the name of a natural person, such body corporate was dissolved, or such natural person died, not less than two years prior to the date of the application and that no application for registration of an assignment of such trade mark has been made in terms of section 40.

(2) The registrar or the court may refuse an application made under paragraph (c) of subsection (1) in relation to any goods or services if it is shown that the trade mark is used or proposed to be used in relation to such goods or services by a successor in title of the registered proprietor.

(3) In the case of an application in terms of paragraph (a) or (b) of subsection (1) the onus of proving, if alleged, that there has been relevant use of the trade mark shall rest upon the proprietor thereof.

(4) An applicant shall not be entitled to rely for the purposes of paragraph (b) of subsection (1) on any non-use of a trade mark that is shown to have been due to special circumstances in the trade and not to any intention not to use or to abandon the trade mark in relation to the goods or services to which the application relates.

(5) Subsection (1)(a) and (b) does not apply to a trade mark in respect of which protection may be claimed under the Paris Convention as a well-known trade mark within the meaning of section 35(1) of this Act.

Date of removal and partial removal

28 (1) Any order granted by the registrar or the court in relation to any entry in or omission from the register shall be deemed to operate from -

- (a) the date of the application for such order; or
- (b) if the registrar or the court, as the case may be, is satisfied that grounds for such order existed at an earlier date, that date.

(2) Where under this Act any grounds for the removal of the registration of a trade mark exist in respect of only some of the goods or services for which the trade mark is registered, the removal shall relate to those goods or services only.

PART VII

Registration and its effects

Registration

29 (1) When an application for registration of a trade mark has been accepted and advertised in the prescribed manner and either -

- (a) the application has not been opposed and the time for notice of opposition has expired; or
- (b) the application has been opposed and has been granted,

the registrar shall register the trade mark as on the date of the lodging of the application for registration, and that date shall, subject to the provisions of section 63, for the purposes of this Act be deemed to be the date of registration: Provided that where it appears to the registrar, having regard to matters which came to his notice after acceptance of an application, that the trade mark has been accepted in error, he may withdraw the acceptance and proceed as if the application had not been accepted.

(2) On the registration of a trade mark, the registrar shall issue to the applicant a certificate in the prescribed form of the registration thereof sealed with the seal of the trade marks office.

Certain trade marks to be associated so as to be assignable and transmissible as a whole only

30 (1) 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.

(2) Where a trade mark and any part or parts thereof are, by virtue of subsection (1) of section 18, registered as separate trade marks in the name of the same proprietor, they shall be deemed to be, and shall be registered as, associated trade marks.

(3) 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.

(4) 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.

(5) On application made in the prescribed manner by the registered proprietor of two or more trade marks registered as associated trade marks, the registrar may dissolve the association as regards any of them if he is satisfied that there would be no likelihood of deception or confusion being caused if that trade mark were used by another person in relation to any of the goods or services in respect of which it is registered, and may amend the register accordingly.

Use of one associated or substantially identical trade mark equivalent to use of another

31 (1) When under the provisions of this Act use of a registered trade mark is required to be proved for any purpose, the registrar or the court, as the case may be, may, if and so far as he or it deems fit, accept proof of the use of an associated registered trade mark or of the trade mark with additions or alterations not substantially affecting its identity, as equivalent to proof of the use required to be proved.

(2) The use of the whole of a registered trade mark shall for the purposes of this Act be deemed to be the use also of any registered trade mark being a part thereof and registered in the name of the same proprietor by virtue of subsection (1) of section 18.

Limitation of trade mark as to particular colours

32 (1) A trade mark may be limited in whole or in part to a particular colour or colours, and in case of any application for the registration of a trade mark the fact that the trade mark is so limited shall be taken into consideration in deciding whether it is capable of distinguishing.

(2) If and in so far as a trade mark is registered without limitation of colour, it shall be deemed to be registered for all colours.

PART VIII

Infringement

Registration a condition precedent to an action for infringement

33 No person shall be entitled to institute any proceedings under section 34 in relation to a trade mark not registered under this Act: Provided that nothing in this Act shall affect the rights of any person, at common law, to bring any action against any other person.

Infringement of registered trade mark

34 (1) The rights acquired by registration of a trade mark shall be infringed by -

- (a) the unauthorized use in the course of trade in relation to goods or services in respect of which the trade mark is registered, of an identical mark or of a mark so nearly resembling it as to be likely to deceive or cause confusion;

- (b) the unauthorized use of a mark which is identical or similar to the trade mark registered, in the course of trade in relation to goods or services which are so similar to the goods or services in respect of which the trade mark is registered, that in such use there exists the likelihood of deception or confusion;
 - (c) the unauthorized use in the course of trade in relation to any goods or services of a mark which is identical or similar to a trade mark registered, if such trade mark is well known in the Republic and the use of the said mark would be likely to take unfair advantage of, or be detrimental to the distinctive character or the repute of the registered trade mark, notwithstanding the absence of confusion or deception: Provided that the provisions of this paragraph shall not apply to a trade mark referred to in section 70(2).
- (2) A registered trade mark is not infringed by-
- (a) any *bona fide* use by a person of his own name, the name of his place of business, the name of any of his predecessors in business, or the name of any such predecessor's place of business;
 - (b) the use by any person of any *bona fide* description or indication of the kind, quality, quantity, intended purpose, value, geographical origin or other characteristics of his goods or services, or the mode or time of production of the goods or the rendering of the services;
 - (c) the *bona fide* use of the trade mark in relation to goods or services where it is reasonable to indicate the intended purpose of such goods, including spare parts and accessories, and such services;
 - (d) the importation into or the distribution, sale or offering for sale in the Republic of goods to which the trade mark has been applied by or with the consent of the proprietor thereof;
 - (e) the *bona fide* use by any person of any utilitarian features embodied in a container, shape, configuration, colour or pattern which is registered as a trade mark;
 - (f) the use of a trade mark in any manner in respect of or in relation to goods to be sold or otherwise traded in, or services to be performed, in any place, or in relation to goods to be exported to any market, or in any other manner in relation to which, having regard to any conditions or limitations entered in the register, the registration does not extend;
 - (g) the use of any identical or confusingly or deceptively similar trade mark which is registered:

Provided that paragraph (a) shall not apply to the name of any juristic person whose name was registered after the date of registration of the trade mark: Provided further that the use contemplated in paragraph (a), (b) or (c) is consistent with fair practice.

(3) Where a trade mark registered in terms of this Act has been infringed, any High Court having jurisdiction may grant the proprietor the following relief, namely -

- (a) an interdict;
- (b) an order for removal of the infringing mark from all material and, where the infringing mark is inseparable or incapable of being removed from the material, an order that all such material be delivered up to the proprietor;
- (c) damages, including those arising from acts performed after advertisement of the acceptance of an application for registration which, if performed after registration, would amount to infringement of the rights acquired by registration;
- (d) in lieu of damages, at the option of the proprietor, a reasonable royalty which would have been payable by a licensee for the use of the trade mark concerned, including any use which took place after advertisement of the acceptance of an application for registration and which, if taking place after registration, would amount to infringement of the rights acquired by registration.

(4) For the purposes of determining the amount of any damages or reasonable royalty to be awarded under this section, the court may direct an enquiry to be held and may prescribe such procedures for conducting such enquiry as it may deem fit.

(5) Before a person institutes proceedings in terms of this section he shall give notice in writing of his intention to do so to every user concerned whose name is recorded in the register, and any such registered user shall be entitled to intervene in such proceedings and to recover any damages he may have suffered as a result of the infringement.

Protection of well-known marks under Paris Convention

35 (1) References in this Act to a trade mark which is entitled to protection under the Paris Convention as a well-known trade mark, are to a mark which is well known in the Republic as being the mark of -

- (a) a person who is a national of a convention country; or
- (b) a person who is domiciled in, or has a real and effective industrial or commercial establishment in, a convention country, whether or not such person carries on business, or has any goodwill, in the Republic.

(1A) In determining for the purposes of subsection (1) whether a trade mark is well-known in the Republic, due regard shall be given to the knowledge of the trade mark in the relevant sector of the public, including knowledge which has been obtained as a result of the promotion of the trade mark;

(2) A reference in this Act to the proprietor of such a mark shall be construed accordingly.

(3) The proprietor of a trade mark which is entitled to protection under the Paris Convention as a well-known trade mark is entitled to restrain the use in the Republic of a trade mark which constitutes, or the essential part of which constitutes, a reproduction, imitation or translation of the well-known trade mark in relation to goods or services which are identical or similar to the goods or services in respect of which the trade mark is well known and where the use is likely to cause deception or confusion.

(4) Where, by virtue of section 10(8), the authorization of the competent authority of a convention country or an international organization is required for the registration of a mark as a trade mark, such authority or organization is entitled to restrain the use in the Republic of such a mark without such authorization.

Saving of vested rights

36 (1) Nothing in this Act shall allow the proprietor of a registered trade mark to interfere with or restrain the use by any person of a trade mark identical with or nearly resembling it in respect of goods or services in relation to which that person or a predecessor in title of his has made continuous and *bona fide* use of that trade mark from a date anterior -

- (a) to the use of the first-mentioned trade mark in relation to those goods or services by the proprietor or a predecessor in title of his; or
- (b) to the registration of the first-mentioned trade mark in respect of those goods or services in the name of the proprietor or a predecessor in title of his, whichever is the earlier, or to object (on such use being proved) to the trade mark of that person being registered in respect of those goods or services under section 14.

(2) Nothing in this Act shall allow the proprietor of a trade mark entitled to protection of such trade mark under the Paris Convention as a well-known trade mark, to interfere with or restrain the use by any person of a trade mark which constitutes, or the essential parts of which constitute, a reproduction, imitation or translation of the well-known trade mark in relation to goods or services in respect of which that person or a predecessor in title of his has made continuous and *bona fide* use of the trade mark from a date anterior to 31 August 1991 or the date on which the trade mark of the proprietor has become entitled, in the Republic, to protection under the Paris Convention, whichever is the later, or to object (on such use being proved) to the trade mark of that person being registered in relation to those goods or services under section 14.

PART IX

Duration and renewal of registration

Duration and renewal of registration

37 (1) The registration of a trade mark shall be for a period of 10 years, but may be renewed from time to time in accordance with the provisions of this section.

(2) The registrar shall, on application made by the registered proprietor of a registered trade mark in the prescribed manner and within the prescribed period renew the registration of the trade mark for a period of 10 years from the date of expiration of the original registration or of the last renewal of registration, as the case may be, which date is in this section referred to as "the expiration of the last registration": Provided that, in the case of an application made in terms of section 63, the date of the original registration shall, for the purposes of this subsection, be deemed to be the date of lodgement of the application at the trade marks office.

(3) At the prescribed time before the expiration of the last registration of a trade mark, the registrar shall send notice in the prescribed manner to the registered proprietor at his address for service of the date of expiration and the conditions as to payment of fees and otherwise upon which a renewal of registration may be obtained, and, if at the expiration of the time prescribed those conditions have not been duly complied with, the registrar may remove the trade mark from the register subject to such conditions, if any, as to its restoration to the register as may be prescribed.

...(4) 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: Provided that the foregoing provisions of this subsection shall not have effect where the registrar is satisfied that there has been no *bona fide* use of the trade mark that has been removed during the two years immediately preceding the date of the expiration of the last registration.

PART X

Permitted use and registered users

Permitted use and registered users

38 (1) Where a registered trade mark is used by a person other than the proprietor thereof with the licence of the proprietor, such use shall be deemed to be permitted use for the purposes of subsection (2).

(2) The permitted use of a trade mark referred to in subsection (1) shall be deemed to be use by the proprietor and shall not be deemed to be use by a person other than the proprietor for the purposes of section 27 or for any other purpose for which such use is material under this Act or at common law.

(3) Subject to the provisions of this section, a person, other than the proprietor of a registered trade mark, who uses such trade mark with the licence of the proprietor, may be registered as a registered user thereof in respect of all or any of the goods or services in respect of which the trade mark is registered.

(4) Subject to any agreement subsisting between the parties, a registered user of a registered trade mark shall be entitled to call upon the proprietor thereof to institute infringement proceedings, and, if the proprietor refuses or neglects to do so within two months after being so called upon, the registered user may institute proceedings, as contemplated in section 34, in his own name as if he were the proprietor, citing the proprietor as a co-defendant, but a proprietor so cited shall not be liable for any costs unless he enters an appearance and takes part in the proceedings.

(5) In all proceedings relating to a registered trade mark, the registration of a person as a registered user shall be *prima facie* evidence that the use of the registered trade mark by him is permitted use as contemplated by subsection (1).

(6) Where it is proposed that a person shall be registered as a registered user of a trade mark, the proprietor shall apply in writing to the registrar in the prescribed manner giving particulars of -

- (a) the name and address of the proposed registered user;
- (b) the relationship, existing or proposed, between the proprietor and the proposed registered user; and
- (c) the goods or services in respect of which the person is to be registered as a registered user of the trade mark.

(7) When the requirements of subsection (6) have been complied with, the registrar shall register the proposed registered user as a registered user in respect of the relevant goods or services.

(8) Without derogating from the provisions of section 24, the registration of a person as a registered user -

- (a) may be cancelled or varied by the registrar on application in writing in the prescribed manner by the registered proprietor or by such registered user or by any other registered user of the trade mark; shall be cancelled by the registrar where the trade mark in respect of which such person has been registered has been assigned and application has in terms of section 40 been made for registration of the assignment, unless the subsequent proprietor registered in terms of the said section requests the registrar in the prescribed manner not to cancel any such registration and furnishes the registrar with the particulars referred to in paragraph (b) of subsection (6).

(9) The registrar may at any time cancel the registration of a person as a registered user of a trade mark, in respect of any goods or services in respect of which the trade mark is no longer registered.

(10) The provisions of this section shall also apply to all trade marks registered under the repealed Act.

PART XI

Assignment and hypothecation

Powers of, and restrictions on, assignment and transmission

39 (1) Subject to any rights appearing from the register, a registered trade mark is assignable and transmissible, either in connection with or without the goodwill of the business concerned in the goods or services in respect of which it has been registered.

(2) A registered trade mark is assignable and transmissible in respect of all or some of the goods or services in respect of which it is registered.

(3) The assignment or transmission of a registered trade mark shall be subject to any deed of security hypothecating it.

(4) If, as a result of the assignment or transmission of a registered trade mark, the use of the trade mark by different persons in the Republic or elsewhere would give rise to the likelihood of deception or confusion, section 10(13) shall apply.

(5) Notwithstanding anything to the contrary contained in subsections (1) and (2) and subject to the provisions of subsection (4), where a trade mark which is the subject of a pending application for registration has subsequent to the date of the application been assigned or transmitted, the registrar may, on application in the prescribed manner, and subject to such conditions as he may deem necessary, allow the person entitled to such trade mark by reason of such assignment or transmission, to be substituted as applicant for registration of the trade mark.

(7) No assignment of a registered trade mark or a trade mark which is the subject of an application for registration shall be of any force or effect unless it is in writing and signed by or on behalf of the assignor.

Registration of assignments and transmissions

40 (1) Where a person becomes entitled by assignment or transmission to a registered trade mark, he shall make application on the form prescribed to the registrar to register his title, and the registrar shall on receipt of the application and of proof of title to his satisfaction, register him as the proprietor of the trade mark and shall cause particulars of the assignment or transmission to be entered in the register.

(2) Every application to register an assignment or transmission in terms of subsection (1) shall recite the effective date of such assignment or transmission, and if application is made more than 12 months after such date, the applicant shall be liable to pay such penalty as may be prescribed.

Hypothecation and attachment

41 (1) A registered trade mark may be hypothecated by a deed of security.

(2) A registered trade mark may be attached to found or confirm jurisdiction for the purposes of any proceedings before the Transvaal Provincial Division of the Supreme Court of South Africa or the magistrate's court for the district of Pretoria and may be attached and sold in execution pursuant to an order of any such court.

(3) (a) Where a deed of security has been lodged with the registrar in the prescribed manner, the registrar shall endorse the register to that effect.

(b) Such endorsement shall record the name and address of the person in whose favour the deed of security has been granted and the nature and duration thereof.

(4) A deed of security in respect of which an endorsement has been made in accordance with the provisions of subsection (3) shall have the effect of a pledge of the trade mark to the person or persons in whose favour the deed of security has been granted.

(5) An assignment or transmission of a registered trade mark in respect of which a deed of security has been endorsed in terms of subsection (3) shall not, without the written consent of the person in whose favour the deed of security has been granted, be registered by the registrar in terms of section 40.

(6) Where the debt or obligation secured by a deed of security in respect of which the register has been endorsed in terms of subsection (3) has been discharged, any person may apply to the registrar in the prescribed manner for the removal from the register of any endorsement in relation thereto made under subsection (3).

PART XII

Certification trade marks and collective trade marks

Certification trade marks

42 (1) 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 of 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.

(2) Subject to the provisions of this section, the provisions of this Act shall, except in so far as is otherwise provided, and in so far as they can be applied, apply to a certification trade mark.

Collective trade marks

43 (1) 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.

(2) Geographical names or other indications of geographical origin may be registered as collective trade marks.

(3) Subject to the provisions of this section, the provisions of this Act shall, except in so far as is otherwise provided, and in so far as they can be applied, apply to a collective trade mark.

PART XIV

Evidence

Register to be *prima facie* evidence

49 Any register kept under this Act shall be *prima facie* evidence of any matters directed or authorized by this Act to be inserted in that register.

Certificate of registrar to be *prima facie* evidence

50 (1) A certificate purporting to be under the hand of the registrar as to any entry, matter or thing which he is authorized by this Act to make or do, shall be *prima facie* evidence of the entry having been made and of the contents thereof and of the matter or thing having been done or left undone.

(2) Printed or written copies or extracts purporting to be copies of or extracts from any register or book or document relating to trade marks and kept in the trade marks office and certified by the registrar and sealed with the seal of that office, shall be admitted in evidence in all courts and proceedings without further proof or production of the originals.

Registration to be *prima facie* evidence of validity

51 In all legal proceedings relating to a registered trade mark (including applications under section 24) the fact that a person is registered as the proprietor of the trade mark shall be *prima facie* evidence of the validity of the original registration of the trade mark and of all subsequent assignments and transmissions thereof.

Certification of validity

52 (1) If in any proceedings the validity of any registration of a trade mark is in issue, the court finding that registration to be valid, may certify to that effect.

(2) If in any subsequent proceedings the validity of that registration is unsuccessfully attacked by any party, that party shall, unless the court otherwise directs, pay to the other party his full costs, charges and expenses as between agent or attorney and client so far as that registration is concerned.

PART XVII*International arrangements***International arrangements**

63 (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.

PART XVIII*Miscellaneous***Use of trade mark for export trade**

64 The application of a trade mark in the Republic to goods to be exported from the Republic and any other act performed in the Republic in relation to goods to be so exported which, if performed in relation to goods to be sold or otherwise traded in within the Republic, would constitute use of a trade mark therein, shall be deemed to constitute use of the trade mark in relation to those goods for any purpose for which such use is material under this Act or at common law.

Transitional provisions

70 (1) Subject to the provisions of section 3, and except as expressly otherwise provided in this Act, the validity of the original entry of a trade mark on the register of trade marks existing at the commencement of this Act shall be determined in accordance with the laws in force at the date of such entry.

(2) A trade mark which has been validly registered in terms of the provisions of section 53 of the repealed Act shall, from the date of commencement of this Act, be deemed to be a trade mark registered in terms of this Act, but shall not be removed from the register in terms of the provisions of paragraph (4) of section 10 or of section 27 within a period of 10 years from the date of commencement of this Act.

PROF BR RUTHERFORD
PROF RA KELBRICK