

## **Notes on registration, renewal, appeal and review procedures in terms of the Trade Marks Act 1993**

See Parts IV and V of the Act.

### *Applications*

An application for the registration of a trade mark is made to the Registrar of Trade Marks in the manner prescribed in the Trade Mark Regulations 1995 (GN R 578 of 21 April 1995).

The Registrar, after the receipt of the application for registration of the trade mark, must search the register of 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. The essential duty of the Registrar at this stage is to determine whether the proposed mark complies with section 9 of the Act and if so whether it offends against one or more of the provisions of section 10 of the Act.

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 or subject to conditions or amendments which he shall communicate to the applicant or his agent. Section 16(4) provides that where an acceptance is subject to amendments, modifications, conditions or limitations or if the application is refused, the Registrar shall, on application by the applicant in the prescribed manner, state in writing the grounds for his decision.

In terms of section 17 when an application for registration of a trade mark has been accepted, the applicant shall, as soon as may be after acceptance, cause the application as accepted to be advertised in the *Patent Journal* by the applicant, in the form and wording required by the Registrar. The application becomes open to opposition within a period of three months from the date of the advertisement.

### *Opposition*

Regulation 52(1) provides that any person interested in opposing a trade mark application may request the Registrar, on written notice before the expiry of the three month period referred to above, not to issue the certificate of registration for a further period of three months from the date of expiry. This request sets the initial period within which a potential opponent may oppose the application.

Within three months from the date of the advertisement of the application in terms of section 17 or within such further time as the Registrar may allow, any interested person may oppose the application in the manner prescribed. A notice of opposition must be filled in, accompanied by the opponent's founding affidavits in which the opponent's case is set out. An application may be opposed on the grounds that the mark offends against any of the provisions of section 9 or 10 of the Act.

In terms of regulation 19(2)(d) the applicant for the registration of the mark is given one month to give notice that he intends to defend. Within two months thereafter the applicant for registration of the mark must deliver either his answering affidavit or

notice of any question of law which he intends to raise in the proceedings. The opponent thereafter has one month in which to deliver a replying affidavit and the Registrar may in his discretion permit the filing of further affidavits.

In essence the form taken by opposition proceedings is analogous to motion proceedings before the Supreme Court (ie on affidavit).

### *Appeals to and powers of the High Court*

Section 53 of the 1993 Act provides that, without derogating from the appeal provisions of section 53(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 court has the power to consider the merits of the matter, to receive further evidence, and to make any order as it may deem fit.

In terms of section 57 the Transvaal Provincial Division of the Supreme Court has the power to review any decision or ruling of the Registrar made under the Act.

A 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 addition to any other powers conferred upon and by the Act the Transvaal Provincial Division of the Supreme Court may in relation to such appeal –

- (a) confirm, vary or reverse the order or decision appealed against, as justice may require;
- (b) if the record does not furnish sufficient evidence or information for the determination of the appeal, remit the matter to the Registrar with instructions in regard to the taking of further evidence or the setting out of further information;
- (c) order the parties or either of them to produce at some convenient time in the said court such further proof as shall to it seem necessary or desirable; or
- (d) take any other course which may lead to the just, speedy and as far as may be possible inexpensive settlement of the case; and
- (e) make such order as to costs as justice may require.

In terms of section 58 the Supreme Court on appeal has the power to exercise the same discretionary powers as are conferred upon the Registrar in terms of the Trade Marks Act.

### **Duration and renewal**

Registration of a trade mark is for a period of ten years from the date of the filing of the application for registration and thereafter the registration can be renewed for periods of ten years. (s 37(1))

On renewal of a registration, the period of ten years runs from the date of “expiration of the last registration”. (s 37(2))

An application for renewal of a registration is made on form TM5 between six months prior to and six months after the expiration of the registration.

The renewal is advertised by the Registrar in the *Patent Journal*.