

Important general comments regarding trade mark registration



TERRITORY COVERED

Trade mark registrations are only enforceable in the country in which the trade mark is registered. Consideration should therefore be given to the area in which a trade mark will be used and where protection is required. Trade mark protection in neighbouring states or other countries may be advisable. South Africa joined the SADC, comprising of Tanzania, Malawi, Angola, Zimbabwe, Zambia, Botswana, Namibia, Mozambique, Lesotho, Swaziland and Mauritius on the 29th August 1994 and as cross border trading between these countries will increase substantially, it is recommended that protection of your trade mark be considered in these countries.

RECORDAL OF LICENSEES AS REGISTERED USERS

The Trade Marks Act provides for the recordal of permitted users as registered users. Such recordal constitutes *prima facie* evidence of the licence to use the trade mark and *inter alia*, assists the proprietor in establishing accrued rights arising out of use by the licensee.

NON-USE

Non-use for a continuous period of five (5) years is grounds for the removal of a registration from the register. Use by a licensee is deemed to be use by the proprietor and accordingly overcomes an attack against a trade mark based on non-use. Recordal of a licensee as a user is therefore recommended.

DEFENSIVE COMPANY NAMES

Separate registers are kept for Companies, Close Corporations and Trade Marks. No cross searching is done by the respective Registrars. This may result in third parties registering Company or Close Corporation names that are confusingly similar to your trade mark. This danger can be avoided by registering your trade mark as a defensive company name.

INFRINGEMENT

Use of an identical or confusingly similar mark to that now registered is prohibited in the following circumstances:-

- (i) on goods or services covered by the registration,
- (ii) on goods or services "similar" to those covered by the registration, if such use is likely to give rise to deception or confusion,
- (iii) on any goods or services (whether or not this gives rise to confusion) if such use makes unfair use of or is detrimental to the repute or distinctive character of the registered mark.

MARKING

It is now appropriate to use the symbol ® with the registered trade mark to indicate that the mark is subject to registered rights.

HYPOTHECATION

A registered trade mark may be hypothecated by deed of security. Such a deed of security will have the effect of a pledge of the trade mark to the person in whose favour the deed of security has been granted.

COUNTERFEITING

With counterfeiting being on the rise, registering certain trademarks with Customs may be an effective safety-net. For a detailed strategy and approach in terms of counterfeit protection of registered trademarks, please do not hesitate to contact our anti-counterfeiting team at ac@kisch-ip.com for more information.