



Trade Marks Guide

Overview

RC&I manages the registration and maintenance of trade mark applications on behalf of UCT that relate to inventions or products that may be commercialised. The Registrar's Office are responsible for assisting research groupings with the filing of trade marks that are associated with their names. Please refer to the UCT IP Policy (which can be found here: <http://www.uct.ac.za/main/about/policies>) for more details.

This outline will describe, firstly and on a general basis only, the use of a trade mark as an intellectual property tool, and secondly, will provide insights into the UCT policy in terms of the management of trade marks within UCT.

Definition

A trade mark, is a distinctive sign or indicator used by an individual, business organization, or other legal entity, to **identify** and designate ownership of the products or services on which the trade mark appears, and to **distinguish** its products or services from those associated with other competing entities such as manufacturers or dealers. It must be a distinctive mark or feature particularly characteristic of, or identified with, a person or thing.

CIPC describes a trade mark as a brand name, a slogan or a logo. It identifies the services or goods of one person and distinguishes it from the goods and services of another.

A brand name could be a word or combination of words (e.g. Kentucky Fried Chicken). 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. They can apply to both products and services. Examples include:

- *Brand Name*: COCA COLA, AQUAFRESH
- *Slogan*: "Everything keeps going right Toyota" or "I'm lovin' it" – see the McDonalds pic
- *Logo*: The Nike tick, or the McDonalds "M"
- *Specific shape*: The Coca Cola bottle (where this has become distinctive of the product – normally it would be registered as a design first).



A trade mark is a proprietary term. When a trade mark (brand name, slogan or logo) has been registered, then its exclusive use by its owner has been assured. Nobody else can use this trade mark, or one that is confusingly similar. If this happens, legal action may result.

A trade mark can be registered if it is able to:

1. distinguish the goods or services of a party;
2. will not confuse consumers about the relationship between one party and another;
3. will not otherwise deceive consumers with respect to the qualities of the product.

A registered trade mark confers a bundle of exclusive rights upon the registered owner, including the right to **exclusive** use of the mark in relation to the **products or services** for which it is registered. The law also allows the owner of a registered trade mark to prevent unauthorized use of the mark in relation to products or services which are identical or "colourfully" similar to the registered products or services, and sometimes, prevent use in entirely dissimilar products or services. The test is whether a consumer of the goods or services will be confused as to the identity of the source or origin.

Terminology

A trade mark can take many forms, such as a name, signature, word, phrase, letter, numerical, motto, brand, logo, label, symbol, figure, mark, symbol, design, device, image, or a combination of these elements.

There are also non-conventional trade marks for example, those based on colour or combination of colour, shape of goods, packaging, smell, fragrances, sound or movement or any combination thereof which is capable of distinguishing goods and services of one business from those of others.

A trade mark must be capable of graphical representation and must be applied to goods or services for which it is registered.

It is possible to file a mark in the form of a **"device"** which comprises a *logo* and *text*, and then for additional protection, the logo alone can be filed simultaneously as a separate application. This would protect against someone using a similar-looking logo but with a different choice of text (or no text). For example a device consisting of a logo of the SC letters together with the words "Scientific Computing".



A **"Word Mark"** is the strongest protection as one is protecting the specific word(s) itself. So it would cover any font or its use associated with a logo or not. In the example of Scientific Computing the terms are too commonly used, so one cannot generally protect them. Here a made up word where the C is shared between the word "scientific" and "computing" was able to be protected. Typically a made up word is more likely to be granted. Interestingly the name of a product can enter common use to

describe a product – e.g. “hoover” for vacuum cleaner, or “Jacuzzi: for a spa bath – this can result in ones trade mark being lost. But there are specific ways in which you use the term that ensure that it is not a descriptor of the product.

Registrability Requirements

In South Africa, two basic requirements must be met for a mark to be eligible for trade mark protection:

1. It must be **distinctive** (not descriptive).
2. It must be **in use** in commerce.

In other countries similar requirements apply, with certain variations from one jurisdiction to another.

A trade mark is not registrable if it is identical, or so similar to, an existing registered trade mark that the use of the proposed trade mark would be likely to deceive or cause confusion in the market place.

Duration

A trade mark can be in force indefinitely, as long as the mark is used and is renewed at 10-yearly intervals. Thus a trade mark is a form of intellectual property protection which can thus last long after a corresponding patent has expired.

Symbols

A trade mark may be designated by various symbols which represent the status of the mark and its level of legal protection. The appropriate symbol should be used every time the trade mark is referred to, i.e. at every single use of the mark in a given document, for example.

The symbols are:

® The letter "R" surrounded by a circle, represents a Registered Trade Mark. A Registered Trade Mark has been officially registered with the relevant national authority. It is therefore legally protected. It can only be used once the registration process is complete and can only be used immediately after the trade mark that has been registered. The TM symbol (below), or phrase **Trade Mark pending** can be used prior to the registration to indicate that it is a business trade mark.

TM The letters TM represent the "trade mark symbol" for an unregistered trade mark used to promote or brand goods. This symbol denotes that you are asserting your rights to the unregistered trade mark and are also *using* it as a trade mark. The TM symbol should be placed in close proximity to the trade mark in a manner that makes it clear that the symbol refers to the relevant trade

mark. It is good practice to include the TM symbol on every single use of the mark in the same document, i.e. every time the title is referred to, even though it is not a legal requirement. There are good reasons doing so in a published document, a foreword written by others or even in a funding proposal:

- It signifies use of the word as a trade mark. If it is used by the public as a generic descriptor then the ownership rights could be lost;
- It is easier to enforce rights on the basis that the infringing party were put on notice of ownership rights to the trade mark.

Other options are:

- To insert an asterisk [*] every time the trade mark is used, and include a disclaimer at the bottom of the article, saying for example “*CHILD GAUGE is a trade mark of the University of Cape Town”;
- To capitalize the word CHILD GAUGE every time your trade mark is used, and then include the disclaimer above without the use of the *.

SM The letters "SM" in superscript, represent an unregistered service mark used to promote or brand services.

The proper manner to display such symbols is immediately following the mark in superscript style. However the superscript is not a legal requirement.

Trade Mark Registration Processes

The law considers a registered trade mark to be a form of property to which ownership is secured by through **registration** of the mark with the national trade mark office.

Jurisdiction

Trade mark rights are established in a particular national jurisdiction and these rights are generally only enforceable in that jurisdiction.

Classes

A trade mark identifies the services or goods of one person/entity and distinguishes it from the goods and/or services of another person/entity. In order to do this effectively, trade marks can be lodged in any one or many of a total of 45 different trade mark classes, depending on the goods and/or services in respect of which the trade mark will be used.

South Africa follows international classification system, called the Nice Classification. Classes 1 - 34 cover goods and classes 35 - 45 cover services.

- For the complete list of class headings **click here**.

- For a cross-search list of classes that are considered “similar” **click here**
- A good website for searching for the relevant class for a product/service is <http://www.ipo.gov.uk/types/tm/t-os/t-find-class.htm>

If the goods or services for a given trade mark fall in one class, only one application is necessary. If the goods or services fall in more than one class, a main class can be selected, and additional applications can be filed in other classes as well. This will provide extra protection for the trade mark.

A trade mark must be assigned a class or classes ahead of any priority searches that may be done.

Search

A search should be performed to ensure that the desired trade mark is not already in use in the relevant class/classes.

Trade Marks may be searched on national database of registered trade marks. These searches are performed by a trade mark attorney, for which search fees are charged. A mark may also be searched informally on popular search engines such as Google.

Procedure in for Trade Mark Registration in South Africa

The South African registration procedure can be lengthy due to the administrative backlog at the South African Trade Marks Registry.

Application Filing

The Companies & Intellectual Property Commission (CIPRO) administers the Register of Trade Marks which is the record of all the trade marks that have been formally applied for and registered in the Republic of South Africa.

The application is 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.

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.

Acceptance

There are three levels of acceptance:

- *Unconditionally accepted* i.e. there are absolutely no problems with the mark.
- *Conditionally accepted* i.e. it has been accepted subject to complying with some order from 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* i.e. it offends against some section of the 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.

Note that small spelling differences between marks could result in the marks being considered too similar for trade mark purposes because they are phonetically, visually and conceptually similar.

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 Acceptance. 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.

Registration Certificate Issued

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 opposition period.

The ® symbol may only be displayed once the Registration Certificate has been issued.

Registration Requirement in the USA

In the US, a registration of a “statement of use” is required to be submitted within 6 months of grant of trade mark, evidencing *use* of the trade marked device in the United States, as follows:

Confirmation of services/goods rendered

- Date that the mark was first used in the United States in commerce.
- Date that the mark was first used anywhere in the world including South Africa in commerce.
- Specimens of the mark as used in commerce in the US, ie a picture or photograph.

Maintenance of Registered Trade mark

In order to maintain a valid trade mark, the mark must be continuously in use and renewal fees must be paid timeously. The trade mark renewal schedule occurs at 10 year intervals. The 10-yearly renewal date falls due on the anniversary of the filing date of the trade mark (not the grant date). The 10-year term can be renewed indefinitely as long as the trade mark is in use.

Priority

International applications can claim priority if they are filed within 6 months of filing the SA national application. Steps should be initiated 3 months after filing to allow enough time to request the necessary priority document from the SA Trade Marks Office and file the applications overseas (see below).

If priority from the date of filing date is secured then any other filing of a similar mark thereafter will be “second in the queue” as your mark will be examined first.

Unlike a patent, the trade mark can be used immediately without filing the application.

The fact that it has been released to the public does not prevent a trade mark application being filed at a later date.

Foreign Jurisdictions

A trade mark can be filed at any time in other countries, provided that nobody else has competing rights in that country.

However, if the trade mark is filed in South Africa first, in order to then claim priority from the South African application in other countries (i.e. take advantage of the earlier filing date) then the corresponding trade marks must be filed in the relevant foreign countries within 6 months from the South African filing date.

Filing a trade mark in foreign jurisdictions can be a very costly process as local attorneys need to be instructed in each country. Costs are calculated from a benchmark of filing one mark in one class in any one country. There is an additional registration fee as well as a filing fee.

A **Community Trade Mark (CTM)** in the European Union is one of the few “regional cover” jurisdictions in the world. A CTM application is the best value for money, as it covers all 27 countries of the European Union, namely: Austria, Belgium, Bulgaria, Cyprus, Czech Republic, Denmark, Estonia, Finland, France, Germany, Greece, Hungary, Ireland, Italy, Latvia, Lithuania, Luxembourg, Malta, The Netherlands, Poland, Portugal, Romania, Slovakia, Slovenia, Spain, Sweden and the United Kingdom.

An application for one trade mark in the EU covers up to 3 classes.

Costs

Any cost estimate is subject to changes in the exchange rate and includes attorney fees, agents fees and the official fees. They do not include any prosecution costs which may arise on examination of the mark or if a third party opposes the mark on advertisement. The costs are generally quoted for one trade mark only. To file a word mark and a logo, for example would double the costs.

UCT Policy on Trade Marks within the University

The Registrar's office is responsible for trade mark protection at the University level (e.g. protecting the use of UCT, University of Cape Town, GSB, Jammie Shuttle, AIM).

The Registrar's Office continues to be responsible for registration of the badge with the State Herald. RC&I handles trade mark protection for the names of research groups that might require this, on the basis that the University will always own any trade mark so registered.

The Registrar's Office and RC&I is informed of all applications made and all trade marks granted.

The Registrar's Office funds all University-wide trade mark protection. RC&I and/or the research units involved will do so where trade mark protection is sought for products and research groups' names respectively.

It is noted that in many instances, common law remedies can be relied upon for use against parties attempting to pass off their entities/products. Examples of recourse to these include:

- An estate agency that was advised that they may not use a photograph of the Jameson Hall. The agency backed down and proceedings were not necessary.
- A student accommodation enterprise was told that it may not use "UCT" in its domain name.

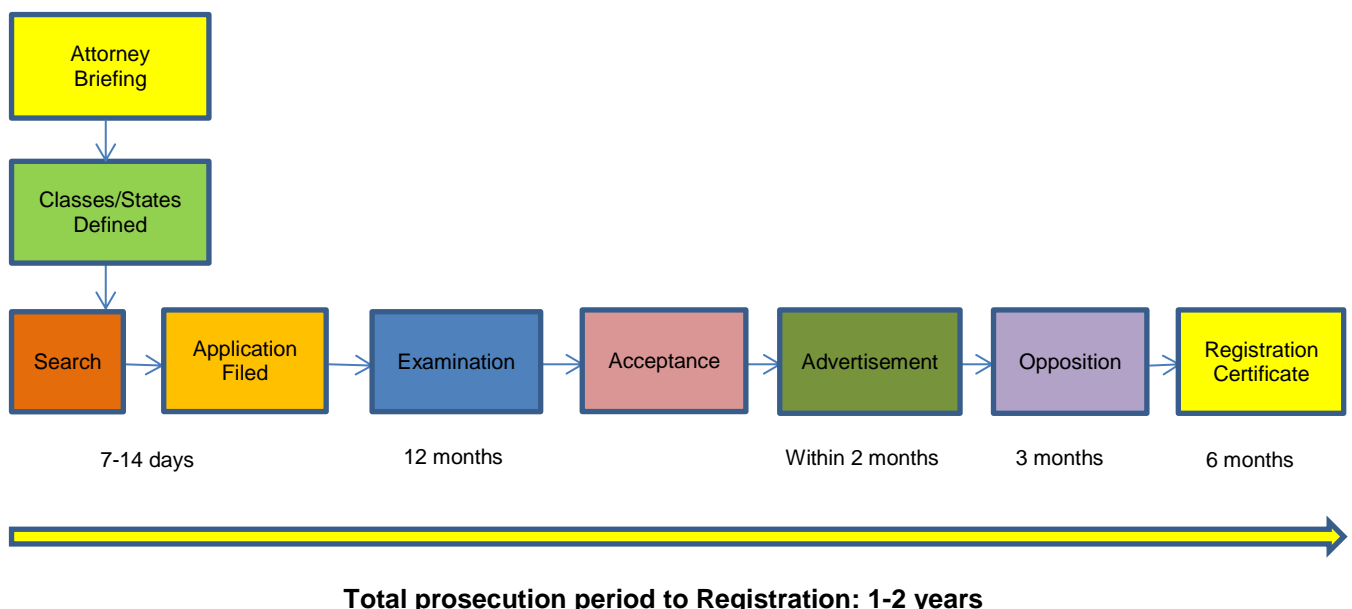
Acknowledgements

www.wikipedia.org/wiki/Trademark

www.vonseidels.co.za

www.cipro.co.za

Trade Mark Registration Timeline



APPENDIX

Trade Mark Class Headings

- Class 1** Chemicals used in industry, science and photography, as well as in agriculture, horticulture and forestry; unprocessed artificial resins, unprocessed plastics; manures; fire extinguishing compositions; tempering and soldering preparations; chemical substances for preserving foodstuffs; tanning substances; adhesives used in industry; unprocessed plastics in the form of liquids, chips or granules.
- Class 2** Paints, varnishes, lacquers; preservatives against rust and against deterioration of wood; colorants; mordants; raw natural resins; metals in foil and powder form for painters, decorators, printers and artists.
- Class 3** Bleaching preparations and other substances for laundry use; cleaning, polishing, scouring and abrasive preparations; soaps; perfumery, essential oils, cosmetics, hair lotions; dentifrices; deodorants for personal use.
- Class 4** Industrial oils and greases; lubricants; dust absorbing, wetting and binding compositions; fuels and illuminants; candles and wicks for lighting; combustible fuels, electricity and scented candles.
- Class 5** Pharmaceutical and veterinary preparations; sanitary preparations for medical purposes; dietetic substances adapted for medical use, food for babies; plasters, materials for dressings; material for stopping teeth, dental wax; disinfectants; preparations for destroying vermin; fungicides, herbicides; foods and beverages which are adapted for medical purposes; air deodorising preparations.
- Class 6** Common metals and their alloys; metal building materials; transportable buildings of metal; materials of metal for railway tracks; non-electric cables and wires of common metal; ironmongery, small items of metal hardware; pipes and tubes of metal; safes; goods of common metal not included in other classes; ores; unwrought and partly wrought common metals; metallic windows and doors; metallic framed conservatories.
- Class 7** Machines and machine tools; motors and engines (except for land vehicles); parts of engines and motors; machine coupling and transmission components (except for land vehicles); exhausts and starters (for vehicles); vacuum cleaners; electric drills; electric screwdrivers; incubators for eggs.
- Class 8** Hand tools and hand operated implements; cutlery; side arms; razors; electric razors and hair cutters.
- Class 9** Scientific, nautical, surveying, photographic, cinematographic, optical, weighing, measuring, signalling, supervision, life-saving and teaching apparatus and instruments; apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling electricity; apparatus for recording, transmission or reproduction of sound or images; magnetic data carriers, recording discs; automatic vending machines and mechanisms for coin operated apparatus; cash registers; calculating machines, data processing equipment and computers; fire-extinguishing apparatus; recorded media, computer hardware and firmware; computer software; software downloadable from the Internet; downloadable electronic publications; compact discs; digital music; telecommunications apparatus; computer games equipment adapted for use with an external display screen or monitor; mouse mats; mobile phone accessories; contact lenses, spectacles and sunglasses; clothing for protection against injury, accident, irradiation or fire; furniture adapted for laboratory use.
- Class 10** Surgical, medical, dental and veterinary apparatus and instruments, artificial limbs, eyes and teeth; orthopaedic articles; suture materials; sex aids; massage apparatus; supportive bandages; furniture adapted for medical use.
- Class 11** Apparatus for lighting, heating, steam generating, cooking, refrigerating, drying, ventilating, water supply and sanitary purposes; air conditioning apparatus; electric kettles; gas and electric cookers; vehicle lights and vehicle air conditioning units.
- Class 12** Vehicles; apparatus for locomotion by land, air or water; wheelchairs; motors and engines for land vehicles; vehicle body parts and transmissions.
- Class 13** Firearms; ammunition and projectiles, explosives; fireworks.
- Class 14** Precious metals and their alloys; jewellery, costume jewellery, precious stones; horological and chronometric instruments, clocks and watches.
- Class 15** Musical instruments; stands and cases adapted for musical instruments.

- Class 16** Paper, cardboard and goods made from these materials; printed matter; book binding material; photographs; stationery; adhesives for stationery or household purposes; artists' materials; paint brushes; typewriters packaging materials; printers' type; printing blocks; disposable nappies of paper for babies; printed publications; paint boxes for children; cheque book holders.
- Class 17** Rubber, gutta-percha, gum, asbestos, mica and goods made from these materials; plastics in extruded form for use in manufacture; semi-finished plastics materials for use in further manufacture; stopping and insulating materials; flexible non-metallic pipes.
- Class 18** Leather and imitations of leather; animal skins, hides; trunks and travelling bags; handbags, rucksacks, purses; umbrellas, parasols and walking sticks; whips, harness and saddlery; clothing for animals.
- Class 19** Non-metallic building materials; non-metallic rigid pipes for building; asphalt, pitch and bitumen; non-metallic transportable buildings; non-metallic monuments; non-metallic framed conservatories, doors and windows.
- Class 20** Furniture, mirrors, picture frames; articles made of wood, cork, reed, cane, wicker, horn, bone, ivory, whalebone, shell, amber, mother-of-pearl, meerschaum or plastic which are not included in other classes; garden furniture; pillows and cushions.
- Class 21** Household or kitchen utensils and containers; combs and sponges; brushes; brush-making materials; articles for cleaning purposes; steel wool; articles made of ceramics, glass, porcelain or earthenware which are not included in other classes; electric and non-electric toothbrushes.
- Class 22** Ropes, string, nets, tents, awnings, tarpaulins, sails, sacks for transporting bulk materials; padding and stuffing materials which are not made of rubber or plastics; raw fibrous textile materials.
- Class 23** Yarns and threads, for textile use.
- Class 24** Textiles and textile goods; bed and table covers; travellers' rugs, textiles for making articles of clothing; duvets; covers for pillows, cushions or duvets.
- Class 25** Clothing, footwear, headgear.
- Class 26** Lace and embroidery, ribbons and braid; buttons, hooks and eyes, pins and needles; artificial flowers; badges for wear; tea cosies.
- Class 27** Carpets, rugs, mats and matting, linoleum and other materials for covering existing floors; wall hangings (non-textile); wallpaper.
- Class 28** Games and playthings; playing cards; gymnastic and sporting articles; decorations for Christmas trees; childrens' toy bicycles.
- Class 29** Meat, fish, poultry and game; meat extracts; preserved, dried and cooked fruits and vegetables; jellies, jams, fruit sauces; eggs, milk and milk products; edible oils and fats; prepared meals; soups and potato crisps.
- Class 30** Coffee, tea, cocoa, sugar, rice, tapioca, sago, artificial coffee; flour and preparations made from cereals, bread, pastry and confectionery, ices; honey, treacle; yeast, baking-powder; salt, mustard; vinegar, sauces (condiments); spices; ice; sandwiches; prepared meals; pizzas, pies and pasta dishes.
- Class 31** Agricultural, horticultural and forestry products; live animals; fresh fruits and vegetables, seeds, natural plants and flowers; foodstuffs for animals; malt; food and beverages for animals.
- Class 32** Beers; mineral and aerated waters; non-alcoholic drinks; fruit drinks and fruit juices; syrups for making beverages; shandy, de-alcoholised drinks, non-alcoholic beers and wines.
- Class 33** Alcoholic wines; spirits and liqueurs; alcopops; alcoholic cocktails.
- Class 34** Tobacco; smokers' articles; matches; lighters for smokers.
- Class 35** Advertising; business management; business administration; office functions; electronic data storage; organisation, operation and supervision of loyalty and incentive schemes; advertising services provided via the Internet; production of television and radio advertisements; accountancy; auctioneering; trade fairs; opinion polling; data processing; provision of business information; retail services connected with the sale of [list specific goods].
- Class 36** Insurance; financial services; real estate agency services; building society services; banking; stockbroking; financial services provided via the Internet; issuing of tokens of value in relation to bonus and loyalty schemes; provision of financial information.
- Class 37** Building construction; repair; installation services; installation, maintenance and repair of computer hardware; painting and decorating; cleaning services.
- Class 38** Telecommunications services; chat room services; portal services; e-mail services; providing user access to the Internet; radio and television broadcasting.

- Class 39** Transport; packaging and storage of goods; travel arrangement; distribution of electricity; travel information; provision of car parking facilities.
- Class 40** Treatment of materials; development, duplicating and printing of photographs; generation of electricity.
- Class 41** Education; providing of training; entertainment; on-line entertainment; sporting and cultural activities; lottery services; electronic games services provided by means of the Internet; the provision of on-line electronic publications.
- Class 42** Scientific and technological services and research and design relating thereto; industrial analysis and research services; design and development of computer hardware and software; computer programming; installation, maintenance and repair of computer software; computer consultancy services; design, drawing and commissioned writing for the compilation of web sites; creating, maintaining and hosting the web sites of others; design services.
- Class 43** Services for providing food and drink; temporary accommodation; restaurant, bar and catering services; provision of holiday accommodation; booking and reservation services for restaurants and holiday accommodation; retirement home services; creche services.
- Class 44** Medical services; veterinary services; hygienic and beauty care for human beings or animals; agriculture, horticulture and forestry services; dentistry services; medical analysis for the diagnosis and treatment of persons; pharmacy advice; garden design services.
- Class 45** Legal services; conveyancing services; security services for the protection of property and individuals; social work services; consultancy services relating to health and safety; consultancy services relating to personal appearance; provision of personal tarot readings; dating services; funeral services and undertaking services; fire-fighting services; detective agency services.