

Trademarks Law in South Africa and its Comparison with India

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ABSTRACT: South Africa is also colonized by the United Kingdom. After the South African War (1899-1902) in the year 1910 the Union of South Africa was created. Following this, in the year 1931 South Africa was regarded as self-governing states. Before that it will be of no consequence to discuss the existence of the Intellectual Property Law (primarily Trademark Law). However, after getting the status of self-governance and Republic (in the year 1961) the government of the South Africa have taken active participation in most of the International Convention. As far as trademark law is concerned it is clear from the name that trademark is mark associated with any business or trade, especially for the purpose of distinguishing a particular manufacturer or seller's products from those of others. In 18th century when the industrialization began, the importance of trademark has been realized worldwide. Similarly, the importance of trademark was recognized in South Africa. In this review paper researcher will try to explain trademark law of South Africa which shall include their legal framework, trademark registration criteria, registration process, landmark judgment and a comparative analysis of the whole registration process existing in South Africa and India. Further, the concept of well-known trademark in south Africa is also discussed in brief.

KEYWORDS: Criteria, India, Industrialization, Registration, South Africa and trademark.

INTRODUCTION

After getting the status of the Self-governance (1931) and Republic (1961) the government of South Africa started thinking about the development of the states in all the field including intellectual property. It can be showed from the fact that soon after its independence they have signed Paris Convention in the year 1947. Similarly, they have signed The Hague Convention, The Convention Establishing WIPO, The TRIPS Agreement, Nice Agreement and etc.¹

In South Africa, trademark law was primarily regulated by Trade Marks Act, 1993 and Trademarks Regulation 1995. The other related acts includes- The Counterfeit Goods Act, 1997; the Intellectual Property Laws Amendment Act, 1997 & 2013; and the Intellectual Property Laws Rationalisation Act. The Trade Marks Act, 1993 provides that trademark means mark used or proposed to be used for distinguishing the goods or services of one person from those of others. Further, Section 2 (x) of the Act defines the word "mark" as mark means any sign capable of being represented graphically and includes device, name, signature, word etc. and any combination thereof. Thus, on comparing the definition of the trademark it can be find that the two requirement for the marks to be regarded as trademark is same as in India viz.

- Mark must be capable of being represented graphically; and
- Mark must be capable of distinguishing the goods or services of one person from those of other

Secondly, as contrast to the Indian Trademark Law the definition of trademark as given in the Act excludes certification and collective mark from its preview.

1. Requirement for registrable trademarks

Section 9 of the Act, laid down criteria for registering trademarks viz.

- Trade Marks must be capable of distinguishing the goods or services of one person from those of other
- Capable of distinguishing means it is inherently capable of so distinguishing or it is capable of distinguishing by reason of prior use thereof.

¹ Trademark rights and protection in South Africa, Lexology

2. Marks that cannot be registered

The Act further lays down the list of the marks that cannot be registered as a trademark. Section 10 of the mark says that mark cannot be registered as trademark-

- If it does not constitute a trademark as given in the definition of the Act
- Within the sense of section 9, not capable of distinguishing
- If it designates the kind, quality, quantity, value, GI, or other characteristics of goods and services
- If it has become common practice in the current language
- If the applicant has no *bonafide* claim to proprietorship of the mark
- If the applicant has no *bona fide* intention to use mark as trademarks
- If it consists only of shape, configuration or colour of goods which is required as to get required technical result
- If it is exact imitation, reproduction or translation of a well-known trademark
- *Mala fide*ly applied for the registration of the mark
- If it consists of coat of arms, seal or national flag
- If it consists of mark which contains any letter, word or device indicating State patronage
- If the mark has been prohibited under the act
- If the mark consists of the shape, configuration, colour and registration of such mark would limit the development of any art or industry
- If such mark is inherently deceptive similar or is likely to cause confusion amongst consumers
- If such mark is contrary to law or against the public morality, such mark is likely to give offense to any particular class of people
- If such mark is identical to registered trade mark that it would likely to deceive or cause confusion
- If mark is identical or similar to trademark to already register trademarks which is also a well-known.

3. Registration Procedure

Trademark Registration procedure was enumerated in Part IV of the Act. The whole crux of the registration procedure can be divided in 10 different stages for the sake of understanding as follows:

3.1. Filling of Application:

Section 16 of the Act provides that application for trademark registration shall be in prescribed manner. It can be filled either manually with TM-1 forms or can also be filled online. It is always advisable to perform preliminary search before filling for trademark registration so as to check the availability of his/her trademark. This search inquires the register of trademark and notify that whether the trademark is barred from the registration or not. It also contains opinion as to the registrability of the trademark. The Application must include the description of the Trademark and classes for it is proposed to be registered. Like, India South Africa also follow NICE Classification for the registration of the trademark. Since, it is necessary to mention the classes of goods and services it can be concluded that trademark registration is class specific unless it has acquired good reputation or is considered as a well-known mark.

3.2. Processing of Trademark Application:

While filling of the trademark application, data is recoded and accordingly registrar issue or allots an application number with filling date. The filling date is important in case of “proposed to be used trademark” where applicant can claim the priority date based on the trademark application. Secondly, the filling date is also important since all the rights acquired by the applicant will be counts from the date of the filling.

3.3. Coding & Searches:

A formal search was conducted by the registrar to check the availability of the trademark. The search was based on the result of the prior art already registered in the trademark register with the trademark office.

3.4. Examination:

A formal examination of the application and annexed document was conducted. It is generally conducted by registrar to ensure that the trademark application was in compliance with the rules and regulation of the trademark act.

3.5. Correspondence:

After, searching and conducting formal examination of the trademark application the shortcomings, if any, in the application will be communicated to the applicant of the trademark application. The application can only proceed further if such shortcomings will be rectified. Further, if the registrar has imposed some limitation that must be complied by the applicant in order to proceed with registration.

3.6. Ex-Parte Hearing:

Since, the examination and searches is done only for the applicant so there will be ex-parte hearing related to any objection raised in the search or during the formal examination of the application. It may include the relevancy of the submitted document or it can be related conflicting mark appears during the search report.

3.7. Acceptance and Advertisement:

After completing the search, formal examination and ex-parte hearing (if any) the trademark application is:

- Either accepted as it is in original form; or
- Accepted subject to certain modification and conditions or limitation; or
- Provisionally refused; or
- May completely refused the application

Registrar shall inform his decision within the reasonable time about acceptance and rejection of the trademark. With decision of the acceptance and rejection the registrar shall also state his ground for such acceptance (in case of certain modification, alteration and limitation) and refusal of the trademark application. If the trade mark application is accepted, then applicant can as soon as possible because the application to be advertised in the Patent and Trademark Journal (a monthly periodical journal). The advertisement is basically for the purpose of calling an opposition to ensure that no one is using similar or identical marks and to inform the third-party that particular trademark is under pipeline to get registration.

Section 20 provides that after the acceptance, if there is any default from the applicant side and trademark registration is not completed within 6 months of the approval date, registrar will give the applicant a notice of non-completion of the application. If within the period of 2 months (or as extended by registrar) the registration is not completed then it shall be deemed to be abandoned.

Section 20 (2) provides that if the applicant is failed to take steps within 3 months (or such further time as registrar may allow) in a case when-

- His application is refused; or
- His application is provisionally accepted and advice was made by the registrar to remove objections.
- His application shall be deemed to be abandoned.

3.8. Opposition:

Here, the importance of the pre-filing trademark search can be underline which will suggest the possibility of the opposition. There is higher possibility that no opposition will be appeared if we have already gone through pre-filing trademark search and have made changes accordingly. The opposition provides the right to third party to oppose the registration application if the proposed trademark for registration is deceptive similar or

identical with their own existing trademarks. The trademark application can be opposed in following conditions:

- When the proposed mark is in conflict with the already registered trademark
- When the proposed mark is in conflict with trademark which is not registered but is in the use (common law remedy)

As enumerated in the Section 21 of the Act any person may file opposition proceedings. That means opposition can be initiated by any interested party within **3 months** counting from application's advertisement date. In some special circumstances the registrar may extend the term. Generally, it was observed that 1/3 months' further extension was given for opposition to resolve the dispute friendly amongst themselves.

The Opposition application by the opponent's mentions details of his right with regard to the proposed mark and request the applicant to withdraw the trademark application. The application was addressed to either applicant directly or his legal representative.

After receiving the opposition application if the applicant denied the withdrawals of the application then the opponents can move to file official opposition notice at the registrar's office. The Notice of Opposition filed at Registrar office shall have all the supporting evidence and affidavits to make his grounds on which opposition application was made. After notice of opposition is served to the applicant he can reply to the Notice of Opposition (in an affidavit form). And then again opponent can file reply to the Counter Statement and then finally matter goes for hearing.

3.9. Hearings:

If any opposition is arising the same can be now resolved at the hearing stage. The registrar of the trademark office who have similar power as those of the Judge of the local division of the High Court hears the opposition hearing. The decision taken by the registrar can be challenged before the North Gauteng Division of the High Court. Further, appeal can be lodged to full bench of the North Gauteng Division of the High Court after taking consent from the court from where the appeal is lodged. The appeal can also be filed before the Supreme Court of Appeal, subject to the same condition that consent is required from the court from where the appeal is lodged (Figure 1).

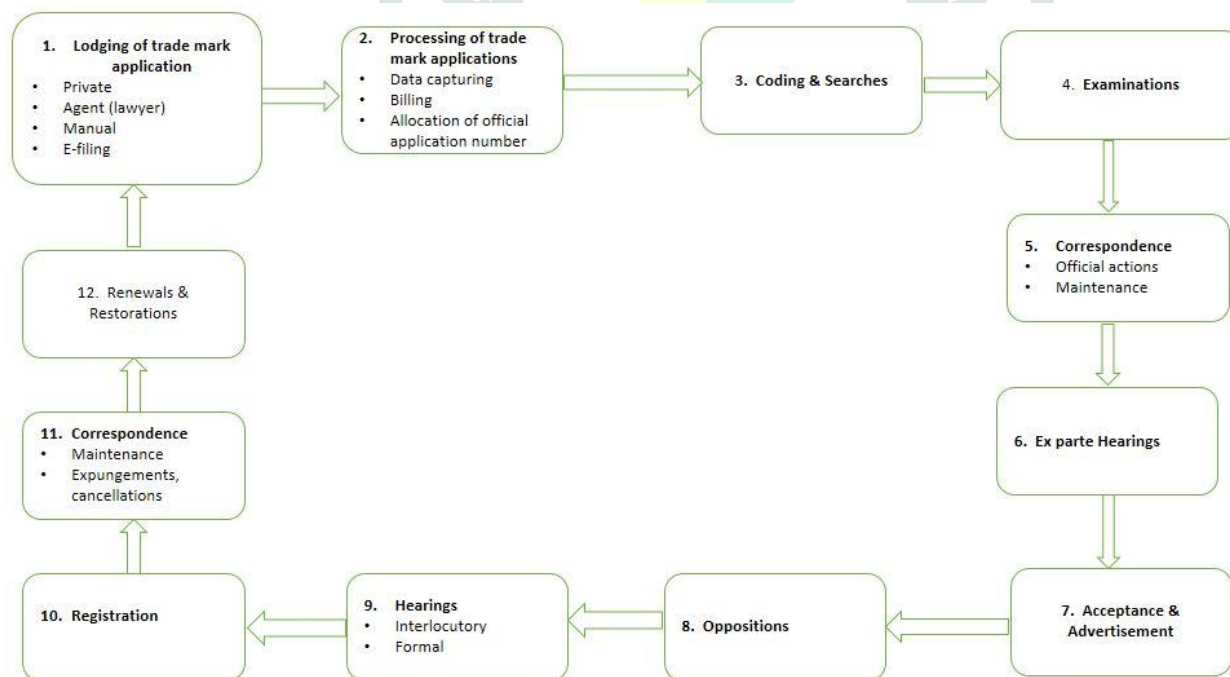


Figure 1: The Complete Registration Procedure (Source: Companies and Intellectual Property Commission)

3.10. *Registration:*

As given in the section 29 of the Act after the advertisement if no opposition is processed and time for the notice of opposition is lapsed or if any opposition was made and decided in the favor of the applicant then the registrar shall register the trademark.

3.11. *Correspondence:*

Registration is not the last step and even after the registration of trademark maintenance is required for the enforcement. For instance, trademark is registered for 10 years counting from the application's submission date and may be revived after payment of renewal fee on expiry of the 10 years. That means after each 10 years if you want to protect your trademark you have to pay maintenance fee regularly.

3.12. *Removal and Restoration:*

There are also provision related to the removal and restoration of the trademark. Section 26 of the Act provides that any interested person may apply for the removal of the marks from the register on the ground that proprietor or any person allowed to use marks as per Sec. 38 fails to comply with the requirement in the register in reference to the registration of the mark. The removal application under Section 26 can be placed before registrar or the court.

Further, section 27 of the act prescribed the removal of the mark on the ground of non-use. It lays down certain grounds for the removal of the trademark:

- That trademark was not registered for the purpose of using in relation to goods and services for which it was registered; and
- There has been no use of the trademark before the three months from the date of the application.

4. *Effects of Registration:*

Part VII of the Act provides the provision related to the effects of the registration of the trademarks. Sub clause 29 (2) of the act provides that registrar shall after the registration issue the certificate to the applicant having seal of the trademark office on it.

5. *Duration of trademark:*

Section 37 under Part IX of the Act provides that the registration of the trademark shall be subsist for the period of 10 years counting from the application's submission date and may be revived for every next 10 years within the prescribed period. Before the expiration of the 10 years the registrar shall provide the notice of the date of expiration

6. *Assignment and Licensing of Trademark*

Part XI of the Act prescribed about Assignment and Hypothecation.

7. *Concept of Well-Known Trademarks*

Conventional use of the trademark is to distinguish the product of one manufacturer from those of others competitor in the market. However, today the trademark is not only limited for the liability purposes but now they have been understood as an assets of the company.² As specifically mentioned in an article by the Roshana, trade-mark protection is based on two-principle:

- Territoriality
- Specialty

²Roshana Kelbrick, The term 'well-known' in South African trade-mark legislation: some comparative Interpretations

Where the concept of the territoriality is generally associated with the protection of the trademark in particular region or locality whereas the concept of the specialty is associated with the particular goods or services for which the protection is sought. The concept of well-known mark in South Africa was based on the position in United Kingdom. It was asserted that the term well known mark was first used in United Kingdom under Trademark Act 1938. In South Africa the similar position is adopted in the The Chowles Report 1963 as defensive registration to register a trademark.³The current trademark act provides the special provision related to the Protection of the well-known trademark under Paris Conventions. Section 35 of the Act provides that marks entitled guard under Paris Convention as a well-known trademark are well-known trademark in the Republic of South Africa if-

- The proprietor of the trademark has national of any convention country; or
- The proprietor of the trademark has domiciled in the convention country; or
- The proprietor of the trademark has real and effective business or commercial establishment in any of the convention country.

8. Comparing the Position of India and South Africa

On the basis of the discussion made above we can have made a comparison table which will depict the whole registration process in South Africa and similarity/differences in its procedure with India. In the given Table 1 grace period means the period provided after the expiry of the duration to renew the trademark.

Table 1: Trademark Registration Comparison between India and South Africa

| S.NO. | | SOUTH AFRICA | INDIA |
|-------|---------------------------------------|--|--|
| 1. | Filing System | Single-Class | Multi-Class |
| 2. | Time taken for Registration | 24 Months | 18 Months |
| 3. | Duration of Protection | 10 Year (Renewable for another 10 years) | 10 Year (Renewable for another 10 years) |
| 4. | Type of Examination | Formal and Substantive Examination | Formal Examination |
| 5. | Examination Time | 12 Months | 3 Months |
| 6. | Opposition Period | 03 Months | 04 Months |
| 7. | Renewal Application | Within 6 Months from Expiry | Within 6 Months from Expiry |
| 8. | Grace Period | 06 Months | 06 Months |
| 9. | Method of Conducting Search | Official Only | Official and Non-official Search |
| 10. | Usual time taken in completing search | 06 Days | 08 Days |

9. Landmark Judgements

9.1. The Peppadew Case

The Peppadew Case of South Africa is one of the landmark judgment for trademark. In this case, 'Peppamate' trademark is applied for registration along with the device under class 29, 30 and 31.⁴It was opposed by the proprietor of the similar trademark 'Peppadew' having also a similar device for the goods and was success in his attempt. The applied mark was held to be confusingly similar to the opposed mark (Figure 2).

³ibid

⁴ South Africa: The Peppadew Case: Similar or Confusing? By Gaelyn Scott



Proposed Mark “Peppadew”



Registered Mark “Peppamates”

Figure 2: Difference between Applied mark and Opposed Mark

However, the Supreme Court of Appeal allowed the use of trademark ‘Peppamate’. While allowing the use of the trademark Peppamate the court ruled that you cannot have monopoly over the word ‘Peppa’ which is commonly used as spices in foods.⁵ The case became more relevant when the word ‘Peppa’ has very little distinctiveness and in that case how the court has come up with the different perspective rather than thinking about the distinctiveness of the mark. The court in his judgment also mentioned that the word like Pepper cannot be granted monopoly and further states that- ‘one cannot monopolize the commons of the English language’.

CONCLUSION

From the discussion made above it is clear that registration process in the South Africa and India is somehow similar. This may be because we both follow the same international convention like Paris Convention, TRIPS Agreement and Madrid System for the Registration of the Trademark. Since the trademark law is territorial in nature there is minor difference in timeline to be followed in both countries as evident from the Table above. The CIPC Intellectual Property Online is South Africa's official portal for IP services. It includes the portal for online filling and conduct of the trademark search. However, method of conducting search is official and we cannot conduct the search on our own.

⁵ You can't have a monopoly on 'Peppa', court tells Peppadew