

## **The Trade Mark Battle Fields**

Alicia Louw

A trade mark is often described as a mark capable of distinguishing one person's goods or services from that of another, or more simply as a badge of origin for the goods or services its used in respect of. The Trade Marks Act provides the following definition of a 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"*

Once you have obtained registration of your trade mark, it entitles you to exclude others from using your trade mark or a confusingly similar trade mark in relation to the goods and services covered by your trade mark registration, or goods that are similar to them. In certain circumstances, it also enables the proprietor of a well known trade mark to protect its mark from dilution or tarnishment.

Therefore, when proprietors are faced with the somewhat inevitable scenario of a third party (usually a competitor, sometimes a former employee) trying to take advantage of the goodwill established in their trade mark, the following weapons are available to a trade mark proprietor to wield with some destructive force:

- Opposition proceedings;
- Trade mark infringement proceedings;
- Advertising Standards Authority Complaint;
- Anti –counterfeiting proceedings;
- Company and close corporation name objections; and
- Domain name complaints.

The question is: "When do you use these weapons and how much destruction can be inflicted by each of them?"

### **Opposition proceedings – before the Registrar of Trade Marks**

Opposition proceedings enable proprietors to prevent a trade mark applicant from getting his trade mark registered. All trade mark applications are advertised in the Patent Journal once they have been accepted by the Registrar, thus affording interested parties a period of 3

months to oppose the registration of those applications. The opposition procedure is usually invoked by a proprietor of an earlier trade mark, which is so similar to the applicant's trade mark that use of the advertised trade mark is likely to lead to deception and/or confusion in the market place as to the source of the goods. An alternative ground is prior use.

This is an effective tool for preventing a third party from obtaining registration of a similar or confusingly similar mark. The registration of a trade mark is a complete defence to any trade mark infringement proceedings, and it is therefore important to stop conflicting trade marks from becoming registered, even if they are not currently in use.

### **Trade mark infringement proceedings – before the High Court**

Infringement proceedings are used by trade mark proprietors to restrain third parties from making unauthorized use of a confusingly similar trade mark in relation to identical or similar goods and services. In addition, such proceedings can also be used to prevent the unauthorized use of a well known mark or one that is similar to it, where that use is likely to dilute or tarnish the goodwill and reputation established in the well known trade mark, irrespective of the absence of the likelihood of deception and confusion.

If you are successful in infringement proceedings, you will be able to obtain an order restraining a third party from making any further use of the trade mark, plus possibly the removal of the infringing mark from all material and goods, or where the mark is inseparable or incapable of being removed, delivery up of such goods for the purposes of destruction.

### **Advertising Standards Authority (ASA) Complaint – before the ASA Directorate**

It can be more appropriate or cost effective to lodge a competitor complaint with the ASA. In terms of the ASA Code of Advertising Practice an advertisement may not exploit the advertising goodwill relating to a trade name. In addition, an advertiser may, amongst others, not copy an existing advertisement or any part thereof in a manner that is clearly recognizable or clearly evokes the existing concept of another advertiser and which may result in the likely loss of potential advertising value. A successful complaint will result in the third party's advertisement being withdrawn or at least amended to remove the offensive parts in order to comply with the Code.

### **Anti counterfeiting proceedings – before a Magistrate and the High Court**

The more successful your brand becomes, the more likely it is that it will become victim to being copied and a fake version of it becoming available on the market place. This battle wound is of particular concern to the proprietors of clothing, accessories and other apparel

products.

Fortunately, it is possible to seize counterfeit products and to institute both civil and criminal proceedings against third parties who are found to be dealing in counterfeit products. A successful action will at the very least result in the goods being removed from the market place and destroyed.

### **Company and close corporation name objections – before the Registrar of Companies and Close Corporations**

The Companies and Close Corporations Acts provide a mechanism for objecting to such names.

### **Domain name complaints – before an Adjudicator**

In today's online world of internet, it is an attractive proposition for third parties to register a domain name incorporating somebody else's registered trade mark in order to unfairly attract confused customers to their own websites. It is however possible to lodge a domain name complaint, in terms of the .za Alternate Dispute Resolution Regulations, which, if successful, will result in the domain being either transferred to the bona fide proprietor of the trade mark or being allowed to lapse.

### **To your battle stations**

Take action to protect your trademarks and obtain advice on which course of action or combination of actions would be the most effective and appropriate in the circumstances. Failure to take any action may result in a trade mark, in which much time, money and effort has been invested, becoming generic, and/or the selling power of the trade mark being lost or substantially diminished.