

**IP CRAMMER 2010**

**2 NOVEMBER 2010**

**OFFICES OF BOWMAN GILFILLAN, SANDTON**

### **QUESTIONS POSED TO TRADE MARKS DIVISION**

***1. You have made significant improvements with respect to the examination of trade marks. How have you done this, can we expect the periods to reduce even further and what other improvements are on the cards?***

Yes, there has been a great improvement with regard to the turn-around time in relation to the examination of trade mark applications, and as an office we are very proud of this achievement. As with all things of this nature, this was a team effort by the entire division, and was achieved through hard work and dedication, as all staff shared the same vision and determination to achieve this target.

As you will be aware, there was a point in time - roundabout August 2003 - when the period for examination of new trade mark applications was 33 months from the date of application. This period was slowly reduced over a number of years through various initiatives such as appointment of additional examiners, and overtime. By March 2007, the office had managed to reduce the examination term to 10 months, and by March 2008 this term was reduced to 8 months. Since then the office has managed to keep the examination term at between 7 and 8 months after date of filing.

At all times during this process, the office was cognisant of the fact that we could not sacrifice the quality of the examination reports whilst increasing the quantity of the output.

In relation to the term for the searching of new applications – which is required before applications can be examined – the office adheres to the 6-month convention/priority period as stipulated in the Paris Convention.

For now I am satisfied with the terms in relation to both search and examination, as I am of the opinion that it compares very favourably with international standards. Even in terms of the Madrid Protocol, these time periods are well within the 12 or 18 month period stipulated under the Protocol within which designated offices are required to inform the International Bureau (IB) at the World Intellectual Property Organisation (WIPO) of provisional refusals and refusals.

Since January 2010, the office also embarked on a dedicated project to reduce the backlog with regard to the issuing of trade mark registration certificates.

In January 2010, there was a backlog of approximately 55,000 registration certificates that had to be issued, and the office was only issuing certificates 20 months after the publication of the applications in the Patent Journal.

Again, through hard work, dedication, appointment of additional resources and the assistance of the various law firms representing the majority of our trade mark stakeholders, by the end of September 2010 the backlog was reduced to approximately 16,000 outstanding certificates, and certificates are now being issued within 6 months from the date of advertisement of the applications in the Patent Journal. Keeping in mind that advertisement in the Patent Journal is followed by a statutory 3-month opposition period, it effectively means that the office now issues registration certificates within 3 months from the date upon which it becomes due.

This is an extraordinary achievement for the office, one that we are exceptionally proud of.

Going forward, the office will be placing even more emphasis on quality in relation to all the activities we perform – not only in relation to the examination of new trade mark applications.

***We heard the tragic news about Keith Sendwe. How will this impact CIPRO's functioning next year and who will replace him as CEO?***

It was indeed a sad day for the office when we received the news of the passing of Mr Sendwe.

Since his appointment as the CEO of CIPRO in 2006, and through his interaction with the staff in the IP Divisions, our IP stakeholders, as well as international IP role-players, he formed a vision for the role he wanted the three respective IP Division of CIPRO to fulfil in the global arena, specifically in relation to the African continent and other developing countries.

The achievements by the Trade Marks Division are all aligned to his vision – one which I share completely – and even after his unfortunate passing, I am of the view that it is our duty to ensure that his vision is fully realised.

In all we do going forward, it will be our aim to continue to move closer to realising this vision.

Since early in 2010, when Mr Sendwe was diagnosed with cancer and was undergoing treatment therefore, the Director General of the dti appointed Mr Lungile Dukwana as the acting Chief Executive Officer for CIPRO. It is my understanding that his tenure as acting Chief Executive Officer of CIPRO has been extended to the end of December 2010.

***When do you think it will be possible to file trade mark applications online, can you explain E-Journal when will it become a reality?***

Whilst the development of the e-filing module in relation to the IP system has been completed, the implementation thereof is hampered by the fact that the current bandwidth at the dti Campus, is not sufficient to allow for the electronic lodgement of trade mark applications. It is also for this reason that the office has not been able to rollout the e-search facility by making the Trade Marks Register available on-line.

It is my understanding that this problem will be addressed once CIPRO moves to a new office building. The move to new offices is still in the finalisation stages and at this point in time it is not possible to give any

indication as to when this would take place. But rest assured that the office will rollout both these functionalities as soon as we are able to.

On the e-Journal, the simplest way to explain it would be to indicate that the Patent Journal, historically printed by the Government Printing Works (GPW) will from the end of November 2010 be produced by the office and will be made available in an electronic format.

Again this project has been one of close cooperation between the office and various law firms, and whilst the technical details are completely foreign to me, a lot of hard work and effort is going into making sure that the office is ready to receive all documents for publication from 1 November 2010, and more so is able to successfully produce the first e-Journal on 24 November 2010.

***You have a significant challenge with hearing dates and hearing officers for trade mark oppositions. How do you expect to improve this situation?***

I think it is important to note here that the office administers 3 respective court related proceedings, namely (i) ex parte (informal) hearings, (ii) interlocutory hearings (both on unopposed and opposed basis), as well as (iii) formal hearings.

In as far as ex parte hearings are concerned, these hearings take place 2 -3 times per week, and there are no challenges experienced with regard to hearing dates nor hearing officers.

With regard to interlocutory hearings and formal hearings, it is indeed so that it is only the Deputy Registrar and myself that act as presiding officers in these hearings, and this of course brings with it its own challenges. As I am sure you will appreciate, over and above presiding over hearings in the Tribunal of the Registrar of Trade Marks, there is still an office to administer on a daily basis, a staff compliment of 80 staff to manage and the duty to ensure the smooth day-to-day running of the operations. After all, we are for all intents and purposes running a business aimed at service delivery to our stakeholders, whilst responsible for generating our own income.

I personally preside over all interlocutory matters and due to the nature of these matters (and of course based on diary availability), we are able to dispose of approximately 10 matters per month. I am confident that by mid-December 2010 there will be no long outstanding interlocutory matters remaining to be heard.

The major challenge for the office is of course in relation to formal hearings, of which most are presided over by the Deputy Registrar, even though I do sit in on all formal hearings as far as is possible. The time required for preparation to preside over such hearings, as well as the time required for the drafting of the written judgments, are but some of the challenges we experience, as it is realistically not possible to hear more than 2 or 3 formal matters per month.

The allocation of hearing dates is however severely hampered by the fact that it is very difficult to get the respective parties to agree on a hearing date. The office provides the parties with two hearing dates, and in more cases than not the parties do not agree to these dates and request further dates. This of course makes the managing of the formal court roll extremely difficult.

I have already proposed an initiative to deal with the need for additional hearing officers with both the CIPRO Executive, as well as the South African Institute of Intellectual Property Law (SAIIPL). This will revolve around exploring the possibility of having a panel of judges appointed by the Minister, as is allowed for in the Trade Marks Act. Discussions hereon are currently underway and I am of the opinion that such an initiative would greatly assist in the hearing of formal matters.

In addition, the office will be reviewing the issue of allocation of hearing dates, so as to address the problems caused when the parties cannot agree on a date. Again I have already engaged with discussions hereon with SAIPL and it is my intention – if all goes well – to implement both initiatives at the same time as soon as is possible.

***The SAIPPL is the body that represents the trade mark profession. Do you think it is effective and what improvements would you like to see at the institute?***

As is clear from the responses here above, the office has a very good working relationship with members of SAIPL, and many of our achievements have been possible with their buy-in, assistance and cooperation.

Thus from my perspective I am of the opinion that it is definitely effective as an organisation representing IP stakeholders at CIPRO.

Of course the office ensures that it maintains the same good working relations with all firms dealing with trade mark matters, not only those firm who are members of SAIPL. As such CIPRO convenes a CIPRO IP Stakeholder Liaison Committee meeting once a quarter, to which all firms are invited. This forum is used by the office to inform our stakeholders of our achievements during the quarter, for the firms to raise problems they may be experiencing, and to discuss solutions to such problems.

***We have seen a significant focus on Intellectual Property recently by the DTI and specifically with respect to funds available for publically funded innovations. Do you see CIPRO benefiting from these funds in any way?***

The bill in relation to funds emanating from public funded research was drafted by the Department of Science and Technology (DST), and as such I am not able to comment thereon in any way.

***How would you like to see law firms improve their interface and understanding of CIPRO?***

As stated above, the office has a very good working relationship with all firms representing trade mark applicants, and we indeed strive towards maintaining open channels of communication with all our clients. Whilst there is always room for improvement in the services we deliver to our clients, I am also of the opinion that if there is effective and proper two-way communication between the office and the law firms, it will go a long way in facilitating their understanding of our internal processes and challenges, and will also assist us in constantly improving our levels of service to our clients.



**Fleurette Coetzee (Ms)  
SENIOR MANAGER (REGISTRAR): TRADE MARKS**