



THE WORLD OF INTELLECTUAL PROPERTY



the **dti**

Department:
Trade and Industry
REPUBLIC OF SOUTH AFRICA

towards full-scale **industrialisation** and
inclusive growth



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Contents

THE WORLD OF INTELLECTUAL PROPERTY	4
WHAT ARE IP RIGHTS?	4
WHY PROMOTE AND PROTECT IP?	4
WHAT IS COPYRIGHT?	5
INDUSTRIAL DESIGNS	9
PATENTS	9
TRADE MARKS	15



THE WORLD OF INTELLECTUAL PROPERTY

You might not realise it, but Intellectual Property (IP) is all around us ... from the clothes we wear to the books we read and the music we listen to, IP is everywhere!

IP applies to the fruits of human creativity. It is the property that derives from the work of the mind or intellect, such as inventions, ideas, literary and artistic works.

WHAT ARE IP RIGHTS?

IP rights are like any other property rights, allowing the creator or owner of a copyright, design, patent or trade mark to benefit from his or her own work or investment. These rights are outlined in article 27 of the Universal Declaration of Human Rights, which sets forth the right to benefit from the protection of moral and material interests resulting from authorship of any scientific, literary or artistic production.

The importance of IP was first recognised in the Paris Convention for the Protection of Industrial Property in 1883 and the Berne Convention for the Protection of Literary and Artistic Works in 1886. Both treaties are administered by the World Intellectual Property Organisation (WIPO), of which South Africa is a member state.

WHY PROMOTE AND PROTECT IP?

An efficient and equitable IP system can help South Africa realise IP's potential as a powerful tool for economic development and cultural well-being.

The progress and well-being of humanity rests on its capacity for new inventions in the areas of technology and culture. The legal protection of these new inventions encourages the expenditure of additional resources, which leads to further innovation, spurring economic growth, creating new jobs and industries, and enhancing the quality and enjoyment of life.

The IP system helps to strike a balance between the interests of the innovator and public interest, providing an environment in which creativity and invention can flourish, to the benefit of all.

WHAT IS COPYRIGHT?

Copyright is the legal term that describes rights given to a broad range of literary and artistic work. Copyright provides creators with exclusive rights to use or authorise others to use their work in certain ways, giving them the ability to control and receive payments. Additionally, rights related to copyright provide protection for performing artists (such as musicians and actors), producers and broadcasting organisations.

What can be protected using copyright?

- Advertisements, maps and technical drawings
- Artistic works, such as paintings, drawings, photographs and sculptures
- Architecture
- Broadcasts, e.g. any form of telecommunication service of transmission consisting of sounds, images or signals
- Films
- Computer program databases, e.g. source codes of a program
- Musical compositions and choreography
- Literary works, such as novels, textbooks, poems, plays, reference works, newspaper articles
- Songs
- Programme-carrying signals, e.g. signal embodying a programme through satellite
- Published editions, e.g. any form of typographical arrangement of literary or musical work
- Sound recordings

Copyright protection extends to expressions only, and not ideas, procedures and methods of operation or mathematical concepts. Copyright may or may not be available for a number of objects, such as titles, slogans or logos, depending on whether they contain sufficient authorship. For a work to be eligible for copyright, it must be written down, recorded or otherwise reduced to material form.

What rights does copyright give me?

- Economic rights, which allow the rights owner to derive financial reward from the use of his/her works by others.
- Moral rights, which protect the non-economic interests of the author.

Most copyright laws state that the rights owner has the economic right to authorise or prevent certain use in relation to work or, in some cases, to receive remuneration for the use of his/her work, such as through collective management.

The economic rights owner of work can prohibit or authorise:

- its reproduction in various forms, such as printed publication or sound recording;
- its public performance, such as in a play or musical work;
- its recording, for example, in the form of compact discs or DVDs;
- its broadcasting by radio, cable or satellite;
- its translation into other languages; and
- Its adaptation, such as a novel into a film screenplay.

Examples of widely recognised moral rights include the right to claim authorship of a work and the right to oppose changes to a work that could harm the creator's reputation.

Can I register copyright?

In many countries, and according to the Berne Convention, copyright protection is obtained automatically without the need for registration or other formalities. Most countries nonetheless have a system in place to allow for the voluntary registration of works. Such voluntary registration can help solve disputes over ownership or creation, as well as facilitate financial transactions, sales and the assignment and/or transfer of rights.

What is the lifespan of a copyright?

The lifespan of copyright depends on the type of work protected. Copyright and its financial benefits usually last for a period of at least 50 years after the creator's death. In some countries these rights have been extended to last up to 90 years after the creator's death. Once the copyright period ends, the work goes into the public domain and reproduction is free. Credit for the work or authorship will, however, forever belong to the creator.

Note the following:

- The copyright of written works lasts for 50 years after the writer has passed away.
- The copyright of computer programs lasts for 50 years after the first copies were made available to the public.
- The copyright of sound recordings, radio and TV broadcasts lasts for 50 years from the day the work was first broadcast.
- The copyright for films lasts for 50 years from when the film was first made/shown.

Copyright infringement

One of the greatest fears among copyright holders is infringement of their rights in the form of piracy and plagiarism. The recent controversy over peer-to-peer networks and file sharing, for example, deals with issues of copyright infringement and piracy. In many cases, the copyright owners are not being compensated for the reproduction of their work.

Generally, in respect of written material, the following guidelines apply:

- Wherever possible, the author's permission should be obtained to reproduce his/her work.
- When referring to the work of another in an article, paper or speech, details of the reference must be provided in the form of the name of the author and details of his/her publication, i.e. title of book or magazine, publisher, date of publication etc.
- Permission is not needed from the author if only a small portion of his/her work is used, such as a few sentences or a paragraph, and provided that an acknowledgement is made.
- The author's permission is required if a 'significant' section is reproduced, such as a chapter.
- It is generally accepted that work that is being used in academic institutions, research or for private use may be reproduced.

A contentious area of copyright is the field of music. Clearly, if you were to copy a CD and sell this, it would constitute copyright infringement (referred to as 'pirating'). Is copyright being infringed, however, when a deejay at a party plays CDs? As a general guide,

copyright infringement can be said to occur where the copyrighted material of others is used for commercial gain as opposed to private or personal use.

Making photocopies of work for private use, and quoting or copying from public speeches or lectures do not constitute infringement of copyright.

Registration of copyright

- Generally, a person who has written, printed, published, performed, sculpted, painted, filmed or recorded a work is automatically the owner of the copyright to that work., provided that it is original reduced to material form.
- Sometimes, when a person has been commissioned and paid to do a particular piece of work, the copyright belongs to the employer.
- For most works (except films), it is not possible to apply for a copyright as it exists automatically.
- Copyright is claimed by putting the words 'copyright' or 'copyright reserved' or 'copyright, followed by the name and year' (copyright Mahlangu 2002), or the copyright symbol followed by name and year (© Baloyi 2002).
- You can obtain copyright protection in South Africa if you are South African or if your work was produced in the country. If you are not South African, you can obtain copyright protection provided the country you are national of is a member of the Berne Convention. The Berne Convention is an international agreement by which member countries grant each other copyright protection.
- Registration for cinematograph films grants statutory protection and must be formally applied for by way of the following formats:
 - Form RF 1, submitted in duplicate
 - Form RF 2, submitted in duplicate
 - Form RF 3, submitted in duplicate
 - Form RF 9, together with the 'Statement of Case'
 - Power of Attorney letter if services of an attorney are used.
 - Fee of application for registration of a copyright is R510.00.

INDUSTRIAL DESIGNS

Industrial design is the ornamental or aesthetic aspect of an article. The design makes the article attractive and visually appealing, thus adding to its commercial value. For that reason, industrial designs are registered and protected. An owner of a registered design is assured an exclusive right against unauthorised copying or imitation of that design. This protection helps economic development by encouraging creativity in industrial as well as traditional arts and crafts. Additionally, it helps to promote more innovative and aesthetically attractive products, thus providing consumers with a wider choice.

An industrial design can serve a function similar to that of a trade mark in that a product with a certain shape or look can just as easily be identified as a trade mark, and as a result may also help to increase a product's commercial value. Furthermore, designs have many of the products we use today more efficient, attractive and in tune with our constantly changing needs. This is true of products ranging from shoes to computers.

PATENTS

A patent is an exclusive right granted for an invention, which is a product or process that provides a new way of doing something or offers a new technical solution to a problem. The patent provides the owner with protection of the invention and is usually granted for a limited period, generally 20 years.

Patents protect inventions and provide exclusive rights to the patent owner, meaning that the invention cannot be commercially made, used, distributed or sold without the patent owner's consent. Once a patent expires, the protection ends and an invention enters the public domain and becomes available for commercial use and exploration by others.

Patents not only provide protection, but also incentive for investors by ensuring recognition and material reward, while helping to enrich the body of technical knowledge in the world. Patent owners are obliged to publicly disclose information on their invention, which serves as a valuable resource for other inventors, as well as inspiration for future researchers and inventors. Patents help inventors earn a living from their work. They

are like titles that are transferable; they can be bought and sold to others besides the original owner. For example, if a patent owner cannot afford to manufacture and market the invention himself, he can license the right of the patent to a company.

Services of patent experts

In terms of the South African Patent Act, individuals may file their own provisional patent applications. It is, however, advisable for applicants to seek the assistance of patent attorneys.

Patent attorneys and agents are familiar with international requirements and therefore in a position to draft provisional specifications in an internationally acceptable fashion, to promote protection both in South Africa and abroad.

If a provisional patent is filed and the invention is then made public, the strength and breadth and scope of protection ultimately obtained will depend upon the wording and content of the specification, the broad definitions and detailed description of the invention. The Patent Office takes precautions to maintain confidentiality, but cannot be held responsible for what occurs outside the office.

South Africa is one of more than 125 countries in the world that have acceded to Patent Cooperation Treaty (PCT). This treaty allows an individual to file an International Patent, along with a National Patent, by designating the countries where the patent should be registered. Extra fees are payable for this type of filing. The Patent Office cannot accept any responsibility for the loss of rights arising if the invention becomes public and is copied and the specifications have not been properly drafted.

What is the lifespan of a patent?

A patent can last up to 20 years, provided that it is renewed annually from the third year. It is important to pay an annual renewal fee to keep it in force. The patent expires after 20 years from the date of application.

Registration procedure for patents

Regardless of whether the registration process will be done via the services of a patent attorney or agent or the applicant initiates it him/herself, the following stages must be followed:

Step 1: Conduct a search on existing patents

- This search can be undertaken by the applicant /inventor or by the patent attorney/agent.
- This is done to ensure that no existing patents are being infringed.
- Although this initial search is not essential it is advisable.

The search is conducted at the Companies and Intellectual Property Commission (CIPC) offices in Pretoria or by visiting www.cipc.co.za

Step 2: Application to register

- The application for a patent can be done in one of the three ways:
 - filing a provisional application – the applicant can undertake this with or without the assistance of an attorney.
 - filing a complete application – this must be done with a patent attorney.
 - filing via a Patent Cooperation Treaty application (if applicable)
- The following forms can be obtained free of charge from the CIPC or via its website, must be completed in full (in black ink or typewritten) and then submitted to the CIPC:
 - P1: Application for the Patent (must be submitted in duplicate)
 - P2: Register of Patents (must be submitted in duplicate)
 - P3: Declaration of Power of Attorney (one form to be submitted)
 - P6: Provisional Specification (one form to be submitted)
- All documents should preferably be type-printed.
- The assistance of a patent attorney is not essential when submitting a provisional patent application. It is important that the description of the specification is comprehensive and clear and, where applicable, drawings must be attached on A4 pages.
- Forms P1, P2 and P6 must be completed as well as P3, which serves as a declaration should no attorney be used.
- The fee for application for registration of a provisional patent is R60.00.

- In the case of a provisional patent application, the office will open a file and provide a provisional patent application number for the purpose of enquiries. The applicant is notified by the return of one of the copies of the P1 submitted.
- Thereafter, a complete patent application must be submitted via a patent attorney or agent before the end of the 12 months from the date of filing the provisional patent application.
- During this 12-month period the inventor is able to work on his/her invention.
- The inventor manufacturer can also 'test-the-market' to assess the viability of the invention before incurring the costs involved in a complete patent application.
- The assistance of a patent attorney is essential when submitting a complete patent application.
- Forms P1, P2, P3 (power of attorney), P7 and P8 must be completed.
- The fee for application for registration of a complete patent is R590.00.
- A full, detailed description and the specifications of the invention as well as drawings on A4 pages should be included.
- Consideration may also be given to applying for patent rights protection in other countries.
- Patent Cooperation Treaty applications are regarded as complete applications.

Step 3: Registration of a Patent

Formal examination commences once a complete patent application has been lodged. This process usually takes about six months. The application is accepted when all formalities have been complied with. The applicant is then required to publish his/her patent in the *Patent Journal*, which is published monthly by the CIPC. It contains information on copyright in cinematographic films, designs, patents and trade marks. This allows members of the public the opportunity to lodge objections. After publication, the Patents Registrar will issue a patent certificate.

Patent Co-operation Treaty (PCT)

With the traditional patent system, if patent protection is sought in other countries, individual patent applications need to be made for each respective country. This involves the preparation and filing of several patent applications, translation costs, the services of patent attorneys in these countries, and fees to the various patent offices all resulting in considerable costs.

Under the traditional system, the patent office in each country (where protection is sought) must carry out formal examination of the application and search procedures, i.e. duplication of effort. The PCT was concluded in 1970 in order to overcome some of these problems. This treaty came into effect in South Africa in March 1999. More than 125 Paris Convention countries (including South Africa) are part of this international treaty.

What is the PCT?

The PCT is an agreement for international cooperation in the field of patents. More specifically, it provides for rationalisation and cooperation with regard to the filing, searching and examination of patent applications.

- PCT does not provide for the granting of international patents.
- The task and responsibility for the actual granting of patents remains in the hands of the Patents Office in the designated countries where protection is being sought.
- PCT streamlines the international search and examination process, which results in cost-cutting.
- PCT provides for the formal examination of the international application by way of a single patent office – Receiving Office.
- Each international application is subjected to an international search, and the searching authority provides a report on whether any similar invention has been lodged. This enables the applicant to decide if the invention is patentable.
- PCT provides a centralised international publication of applications together with related international search reports. It provides the option of an international preliminary examination as well as reports that assist the Patents Offices in various signatory countries, together with opinion as to whether the claimed invention meets certain international criteria for patentability.

- The services streamline the traditional procedures for patent application to foreign countries, and result in considerable reduction in time and costs.
- Under the traditional system, the applicant for a patent registration would:
 - file for a provisional application;
 - file a complete patent application within 12 months of filing the provisional application;
 - file a patent application abroad to designated countries (as required) under the Paris Convention. These international patent applications result in:
 - a. multiple formality requirements
 - b. multiple searches
 - c. multiple examinations and procedural formalities
 - d. translations and national fees, all payable when the patent is lodged in each country.
- With regards to the PCT system, when an international application is made, a further four to 12 months is added for the international search and publication, i.e. up to 21 months or even 31 months before the applicant has to finally decide whether to proceed with the actual patent application in other designated countries. Thus the applicant, under the PCT system, “buys time” before committing to applying for patents in other countries and incurring considerable costs involved in this process.

PCT System Procedures

- If an applicant has come up with an invention that he/she wishes to patent in a number of countries, he/she is advised to utilise the PCT prior to actually lodging the patent applications in these countries to take advantage of the benefits the system offers. However, certain “benefits” or “discounts” can apply and CIPC is able to provide advice and guidance in respect of how to qualify for these.
- The applicant or patent attorney will complete a PCT request form (in triplicate) together with the respective specifications, drawings etc.
- PCT office at CIPC processes this application and calculates the costs associated.
- Any national or resident of a PCT contracting state, e.g. a South African national or resident can file an international application at the Receiving Office in South Africa.

- The PCT system is a patent filing system and not a patent granting system. There is no PCT patent.
- The PCT provides for:
 - an international phase comprising
 - filing of the international application
 - international search
 - international publication
 - international preliminary examination
 - a national/regional phase before designated offices and/or elected offices
 - the decision on granting patents is taken exclusively by national or regional offices in the national phase.
- Only inventions may be protected via PCT by applying for patents, utility models and similar titles.
- Design and trade marks protection cannot be obtained via the PCT. There are separate international conventions dealing with these types of industrial property protection (the Hague Agreement and Madrid Agreement respectively). South Africa is not yet a member to these agreements.

TRADE MARKS

A trade mark is a brand name, slogan or logo. It identifies the services or goods of one person and distinguishes it from those of another. A brand name is a word or combination of words, e.g. Kentucky Fried Chicken; a slogan is a short phrase or sentence; and a logo is a distinctive picture or symbol. They provide a distinctive identity in the market place and can apply to both products and services. When a trade mark (brand name, slogan or logo) has been registered, nobody else can use this trade mark or one that is confusingly similar. If this happens, legal action may result.

Trade marks are distinctive signs that identify certain goods and services from one another. A registered trade mark provides protection to the owner by ensuring the exclusive right to use it to identify goods and services, or to authorise another to use it. A trade mark usually lasts for 10 years, but can be renewed.

Prestige and reputation are important since consumers link certain trade marks with certain products. A well-received product will become a well-recognised trade mark, which will become better known and thus increase the overall value of the product as well as other products with the same trade mark. A trade mark can also be used to create an image and/or a style for a product.

Today, counterfeiting is the biggest threat to trade-mark owners. Counterfeiters illegally use or copy registered trade marks to sell non-genuine goods under the guise of a recognisable trade mark reputation. Copied consumer goods, such as clothing or accessories, are available for nearly all recognisable trade mark brands; however, these imitations do not possess the same quality or craftsmanship as the originals.

Must a trade mark be registered?

A trade mark can only be protected as such and defended under the Trade Marks Act, 1993 (Act no. 194 of 1993) if registered. Unregistered trade marks may be defended in terms of common law. The registration procedure results in a registration certificate that has legal status, allowing the owner of the registered trade mark the exclusive right to use that mark. The CIPC 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.

What is the life span of a trade mark?

A registered trade mark can be protected forever, provided it is renewed every 10 years upon payment of the prescribed renewal fee. Additional fees include photocopies of documents – R1.00; inspection of register, a file or documents – R4.00; collating documents for certification – R4.00 for every 100 words or part thereof; and certification of extracts from register or documents (per document) – R34.00.

A trade mark can be registered if:

- it serves the purpose of distinguishing the goods/services of one trader from those of another;

- it does not consist exclusively of a sign or an indication that may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin or other characteristics of your goods or services, or the mode or time of their production or rendering of the services;
- it has not become customary in your field of trade;
- it does not represent protected emblems, such as the national flag or a depiction of a national monument such as Table Mountain;
- it is not offensive or contrary to the law or good morals or deceptive by nature or way of use; and
- there are no earlier conflicting rights.

Special search (optional)

Before applying for a trade mark registration, you may use form TM2 to apply for a special (preliminary) search in the Trade Marks Register to determine if there are no existing prior rights to trade marks that are identical or confusingly similar to your intended mark. The cost for a special search is R190.00 and the proof of payment must reach the CIPC on or before the date that you apply for the special search. This fee is payable for each separate class/es for which you require the special search and the processing time is approximately 15 working days.

Trade mark application process

- Complete form TM1 in triplicate. Two copies are for office use and the third will be returned to the applicant with an official application number entered on it as proof of receipt of the application.
- An application fee of R590.00 is payable in respect of every class in which an application is lodged. Please note that you have to file a separate trade mark application for each international class of goods or services for which you would like to use your trade mark. For example, if you manufacture and also sell cars, you have to lodge two trade mark applications; one in class 12 for the manufacturing of motor vehicles and one in class 35 for the sale of motor vehicles.
- To identify the correct class for goods or services, view the International Classification of Goods and Services. Alternatively, contact the CIPC Office for

assistance. Our staff will be able to assist you in identifying the correct class or classes for your goods and/or services.

- Indicate the class in field 51 of the form TM1.
- Indicate all the goods and/or services for which you would like to use the trade mark in field 57 of the form TM1. Take care not to put goods or services that belong in different classes on one trade-mark application form. If you do, your application will not be processed, will be returned to you requesting that you indicate the goods/services of interest for one class only, and advising that you lodge further applications for the additional classes.
- Field 74 of form TM1 “address for service” is the address at which you will be receiving all communications from the CIPC Office. Should this address change, please inform the Office by requesting “a change of address for service” on form TM2. The address for service must be an address within the Republic of South Africa.
- Should your application comply with all the formal requirements, and the required official fee has been received by the Office, the application will be allocated an application date and official application number. All communications with the CIPC Office should include the application number as a reference.

Caveat

A caveat is a document requesting information from the Registrar of any proceedings relating to a specific trade-mark application. Any person may apply to the Registrar for this information, by lodging form TM2 (caveat). The information to be included in fields 21, 51 and 54 of TM2 relates to the trade mark in respect of which information is sought and the caveat is lodged. All other information relates to the requester. A fee of R100.00 is payable (per caveat per trade mark).

The Registrar can provide the following information:

- publication of the trade mark – acceptance
- registration of the trade mark
- the making of any entry in the register against the trade mark, e.g. assignments, amendments.

Amendments BEFORE registration of a trade mark	Amendments AFTER registration of a trade mark
<p>Requests for amendments before registration must be applied for on form TM2, unless otherwise specified in the regulations, and a fee of R19.00 is payable for each trade mark. For example, an assignment of an application has to be requested on form TM6 and a fee of R150.00 is payable for the first trade mark and R26.00 for each trade mark thereafter.</p>	<p>The requests for amendments after registration must be applied for on form TM2, unless otherwise specified in the regulations, and a fee of R19.00 is payable. For example, an assignment (change of ownership of a trade mark) of a trade mark has to be requested on form TM6 and a fee of R150.00 is payable for the first trade mark and R26.00 for each trade mark thereafter.</p>

Amendments of trade mark applications (alteration of trade mark in terms of section 25)

Note that if you wish to alter the trade mark as lodged, you will not be allowed to change it to such an extent that it will substantially alter the identity of the mark as originally lodged. The Registrar may allow any such amendments of the mark as he/she may think fit as long as the identity of the mark as originally lodged is not changed substantially by way of the requested amendment.

- Complete form TM2 requesting amendment of the mark, and furnish two copies of the mark as it will appear when altered. Before recording the requested amendment of the mark, the Registrar will direct that the request for amendment of the mark be advertised in the *Patent Journal* to allow any person who wishes to object to the amendment to be able to do so within three months of the publication of the proposed amendment.
- The fee payable for alterations to a registered trade mark is R100.00.

Other amendments

- Amendments of goods and/or services
- Change of address for service – form TM2 to be accompanied by a Power of Attorney or General Power of Attorney (GPA) or the number of an existing GPA
- Change of physical address of the applicant
- Change of name of the applicant – form TM2 to be accompanied by a copy of the Certificate of Change of Name from the Commissioner of Companies, where applicable
- Field 74 of form TM1 “address for service” is the address at which you will be receiving all communications from the CIPC Office. Please inform the Office if this address changes by requesting “a change of address for service” on form TM2. The address for service must be within the Republic of South Africa
- Should your application comply with all the formal requirements, and the required official fee has been received by the Office, the application will be allocated an application date and an official application number. All communications with the Office should include the application number as a reference.
- Correction of clerical error
- Dissolution of Association
- Request by the applicant to enter an endorsement – form TM2 and fee of R26.00 for each trade mark
- Certified extract from the Register of Trade Marks – a fee of R34.00 per trade mark is payable
- Association between trade marks – a fee of R5.00 per association is payable

Substitution of applications

Section 39 and 46 (2) of Trade Marks Act 194 of 1993

Any person may apply on form TM6 for the substitution of an applicant in respect of a trade mark that is the subject of a pending application for registration. Applicable fees are the same as for an assignment, penalty fees are not payable and a formal certificate will not be issued as confirmation of the substitution.

Oppositions

Regulation 52 (1) provides that any person interested in opposing a trade mark may, within a period of three months from the date of advertisement of the application in the *Patent Journal*, request the Registrar not to issue the registration certificate. Should you wish to oppose a trade mark, kindly refer to the provisions of Section 21 of the Trade Marks Act, read together with Regulation 19. Please familiarise yourself with the provisions of Regulation 19 when entering into opposition proceedings.

Powers and jurisdiction of the Registrar

The Act provides that the Registrar shall, in connection with any proceedings before him/her, have such powers and jurisdiction as that of a single judge in a civil action before the North Gauteng Division of the High Court of South Africa.

Procedure

Proceedings before the Registrar are essentially the same as application proceedings in the High Court. Where a matter before the Registrar cannot be properly decided on affidavit, he/she may refer the matter to the High Court, or make such an order as is deemed just and expeditious.

Assignments

Kindly refer to the provisions of Sections 39 and 40 of the Trade Marks Act in relation to assignments. For purposes of recording an assignment, i.e. where one trade mark owner sells his/her trade mark to another person/entity, the following is required:

- complete form TM6 requesting the recording of the assignment and submit to the Registrar;
- the application for assignment is to be accompanied by a document concluded between both parties (the “assignor” = previous trade mark holder, and the “assignee” = the new trade mark holder), evidencing the assignment, i.e. Deed of Assignment;
- a Power of Attorney in the name of the assignee;
- application for assignment to be accompanied by the prescribed fee of R150.00 for

the first trade mark to be assigned, and R26.00 thereafter for each additional mark being assigned;

- the application for assignment should be lodged within 12 months from the effective date of the assignment, as stipulated in the Deed of Assignment;
- should the application for assignment not be made within 12 months, a penalty fee of R48.00 is payable for every 12 months or portion thereof following the expiration of the 12-month period from the effective date; and
- where an assignment certificate is required in the name of the assignee/new trade mark owner, a further fee of R48.00 is payable. Should no fee be paid, the office will only issue a formal notification confirming recording of the assignment and not an assignment certificate.

Hypothecation and attachments

Kindly refer to the provisions of Section 41 of the Act, read together with Regulation 43.

Registered users (Licensees)

Kindly refer to the provisions of Section 38 (6) of the Trade Marks Act, read together with Regulation 39.

- To record a registered user with the Registrar of Trade Marks, a licence agreement should be concluded between the parties involved, being the licensor (the trade mark holder) and the licensee (the person permitted to use the trade mark). The licence agreement must be signed by all parties involved. Form TM7 must be completed, signed by both parties and lodged together with the licence agreement, as well as a Power of Attorney, if the recordal is applied for by an attorney on behalf of the licensor.
- The prescribed fees payable for the recordal of a registered user is R150.00 for the first trade mark and R26.00 thereafter for each additional trade mark.
- A further R34.00 is payable if a registered user certificate is required.
- Form TM7 is also required with regards to the variation and cancellation of a registered user. Kindly refer to the provisions of Section 38 (8)(b) of the Act, read together with Regulation 41.
- A prescribed fee of R60.00 per trade mark is payable in respect of variations or

cancellations of registered user details.

- Form TM7 must be completed and lodged for the maintaining of a registered user recordal and must be signed by both parties. Kindly refer to the provisions of Section 38 (8)(b) of the Act, read together with Regulation 41.
- A prescribed fee of R60.00 per trade mark is payable in respect of maintenance of registered user details.

Renewals

Duration of a trade mark registration

A trade mark is registered for a period of 10 years, and the renewal date is determined from the date of application. A trade mark can be renewed indefinitely for subsequent periods of 10 years, upon payment of the prescribed renewal fees.

Procedure

- A renewal reminder will be sent to the trade mark proprietor, at its address for service, six months prior to the expiry date of the registered trade mark.
- The proprietor of the registration, however, also has a duty to ensure that the registration does not expire.
- A form TM5 must be completed and lodged in duplicate for each trade mark to be renewed, on/or before the expiry date.
- A prescribed fee of R260.00 is payable in respect of each trade mark that must be renewed.
- In respect of a renewal application/s that is lodged within six months after the expiry date, an additional penalty fee of R48.00 plus R260.00 is payable.
- Where the renewal application/s is lodged more than six months after the expiry date, a further penalty fee of R145.00 plus R260.00 is payable.

Restorations

If the renewal fee is not paid within the prescribed time period as set out above, the Registrar may remove the trade mark from the Register. If a trade mark has been removed from the Register due to non-payment of the prescribed renewal fees, it may be restored through a restoration procedure.

- Form TM2 must be completed and lodged together with the prescribed fee of R190.00 per trade mark to be restored. A special search will then be conducted to determine whether an identical or confusingly similar trade mark was lodged during the period in which the lapsed trade mark was removed from the Trade Mark Register.
- If the search results confirm that no identical or confusingly similar trade mark was lodged during that period, form TM5 must be completed and lodged together with the prescribed restoration fee of R405.00. In addition, an affidavit from the proprietor indicating the reasons why the renewal fee was not paid timeously must accompany the application for restoration.
- The Office will send a notice to the proprietor at his/her address for service, informing him/her that the restoration application has been processed.
- The proprietor is responsible for having this notice published in the *Patent Journal*, for opposition purposes.
- The restoration will only be finalised and the status of the trade mark updated in the Trade Mark Register if no opposition to the restoration is lodged within the prescribed three-month period from the date of advertisement of the notice in the *Patent Journal*.

Geographical indications

Geographical indications of source apply to particular products that have particular characteristics closely identified with and due to their geographic place of origin. Products associated with the names of geographic locations often acquire a valuable reputation for a particular quality or characteristic and are therefore protected by various national laws and international agreements. For instance, sparkling wine from the champagne region of France is called “champagne”, while other similar wines produced elsewhere are identified as “sparkling wine”.

Disclosure of corporate information

The CIPC discloses information on registered entities in the form of copies/certified copies and access to the CIPC database in the form of electronic disclosure certificates and data sales in the form of CDs and hard drives. The offering provides confirmation of statutory information and certainty about corporate identities.

The following steps are required to receive disclosed corporate information:

- contact **the dti** Customer Contact Centre at 086 100 2472 or visit the **dti** Campus, 77 Meintjies Street, Sunnyside, Pretoria, 0002;
- submit an application for the necessary files or information; and
- pay the required fee.

Assuming that everything is done correctly, the turnaround time for disclosure of information is five working days.

To enquire about this offering, visit us at *Entfutfutkwani* at the **dti** Campus, 77 Meintjies Street, Sunnyside, Pretoria, 0002.

The disclosure unit provides an important support function to the departments that deal with company and close corporation registrations. The disclosure unit also provides the public with information in respect of particular enquiries. An important aspect of its work is the provision and maintenance of a database, which provides a tracking system for the receipt and processing of all matters relating to company registrations, amendments, de-registrations and restorations.

IP is valuable! Help us protect the rights of our creatives

Without IP the world would be a much less interesting place, and for this reason we should all work together to protect the rights of those who create and innovate. Creativity is the world's greatest natural resource and we should not waste it!

The next time you want to download a song from the internet without paying for it, or buy counterfeit jeans, think about the rights of your favourite artists who have worked so hard to create your favourite tunes, and the designers who create the clothes you love. And imagine your world if such people were not around to create the products you love.

Patent

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Department:
Trade and Industry
REPUBLIC OF SOUTH AFRICA

towards full-scale industrialisation and
inclusive growth

