

Trademarks

Contributing editors

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South Africa

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1 Ownership of marks

Who may apply?

Any legal or natural person who can claim to be the bona fide proprietor of a trademark may apply for the registration of the trademark.

2 Scope of trademark

What may and may not be protected and registered as a trademark?

Any sign capable of being represented graphically, including a device, name, signature, word, letter, numeral, shape, configuration, pattern, ornamentation, colour, sound, container for goods or any combination of the above may be registered as a trademark.

The following cannot be registered as a trademark:

- a mark that does not conform with the definition of a trademark;
- a mark that is not capable of distinguishing, or that is a descriptive term, or that has become customary or commonplace in respect of the relevant goods or services;
- any mark where the applicant has no bona fide claim to proprietorship;
- any mark where there is no bona fide intention to use the mark;
- a mark that consists of a shape, configuration or colour dictated by the nature of the product;
- a mark that is essentially a reproduction or imitation of a well-known trademark and that is used in relation to the same or similar goods;
- a mark where the application for registration is in bad faith; a coat of arms, seal or flag of the Republic of South Africa, or of other countries;
- any word, letter or device indicating state patronage;
- a mark that contains matter declared in published regulations as being prohibited;
- a container for goods or the shape, configuration, colour or patterns of goods where such registration will be likely to limit the development of any art or industry;
- matter that is inherently deceptive or would be likely to deceive or cause confusion or would be otherwise against the law or morality or would give offence;
- a mark that, as a result of the manner in which it has been used, would be likely to cause deception or confusion;
- any mark that is similar to a trademark already applied for, registered, or in use; and
- any mark that would take unfair advantage of a registered and well-known trademark or that would be likely to cause deception or confusion with a registered or unregistered well-known trademark.

3 Common law trademarks

Can trademark rights be established without registration?

What are known as 'common law' trademark rights can be established, but only where trademarks have been used, promoted and exposed to the extent that they have acquired a reputation and goodwill in South Africa.

4 Registration time frame and cost

How long does it typically take, and how much does it typically cost, to obtain a trademark registration? What circumstances would increase the estimated time and cost of filing a trademark application and receiving a registration? What additional documentation is needed to file a trademark application?

It can take up to 30 months to obtain registration of a trademark. Once the application has been filed the registrar will begin their examination of the application, both from formal and substantive points of view. This usually takes between 10 and 12 months. Should any conditions for acceptance or unfavourable points be raised by the registrar it may lead to a delay in the prosecution period as well as an increase in costs. Once the trademark has been accepted, it is then advertised in the monthly Patent and Trademark Journal, whereafter third parties may oppose the application for a three-month period. Should any oppositions be encountered it will necessarily have an effect on the costs and the time taken to prosecute the application. After the opposition stage, if no opposing third party is successful in its objection, the registration certificate will be issued, which can take a further 12 months.

The cost of filing a trademark application in one class is approximately US\$768. Further trademark prosecution costs would depend upon the registrar's official action and his or her conditions for acceptance of the application. Conditions could include endorsements such as associations, disclaimers, admissions and the like. The additional costs for prosecuting the application would be around a half to two-thirds of the filing costs.

It is necessary to file an original power of attorney, simply signed by the applicant.

5 Classification system

What classification system is followed, and how does this system differ from the International Classification System as to the goods and services that can be claimed? Are multi-class applications available and what are the estimated cost savings?

South Africa follows the 10th edition of the Nice classification system. Multi-class applications are not permitted and it is necessary to file a separate application in each class. It is permissible to use broad specifications, including class headings.

6 Examination procedure

What procedure does the trademark office follow when determining whether to grant a registration? Are applications examined for potential conflicts with other trademarks? May applicants respond to rejections by the trademark office?

The registrar examines the application, both from formal and substantive points of view. It is at this stage that the registrar may raise objections based on exclusions provided in the Trade Marks Act (see question 2) or on the basis of an earlier existing registration or application. The registrar may require certain endorsements to be entered against the application. These often have the effect of limiting the

rights of the trademark to be registered or the manner in which the trademark may be used. Alternatively, they may make it clear that registration of the trademark does not provide the owner with exclusivity in respect of certain parts or words contained in the mark.

The applicant may respond to the registrar formally in writing and if still aggrieved may refer the matter to an informal hearing before the registrar.

7 Use of a trademark and registration

Does use of a trademark or service mark have to be claimed before registration is granted or issued? Does proof of use have to be submitted? Are foreign registrations granted any rights of priority? If registration is granted without use, is there a time by which use must begin either to maintain the registration or to defeat a third-party challenge on grounds of non-use?

An applicant for the registration of trademark is not required to claim or prove use at any stage of the application process, including application, registration and renewal. However, the applicant for registration must have the bona fide intention to use the mark at the date of filing the application for registration of the mark or the mark may be vulnerable to cancellation. Further, if no use of the mark has been made for a continuous period of five years after the date of issuance of the registration certificate, the mark may be vulnerable to cancellation by way of third-party application proceedings.

Any person who has made an application for registration of a trademark in a Convention country shall be entitled to registration of the trademark in priority to other applicants and the registration will have the same date as the date of the first application in the Convention country. The priority application must be filed within six months of the date on which the application was made in the Convention country.

8 Appealing a denied application

Is there an appeal process if the application is denied?

If on examination an application is provisionally refused registration, or if it is accepted subject to conditions that are not acceptable to the applicant, then the applicant may lodge written submissions in order to try overcome the objection or conditions raised. In practice, he or she may in addition or alternatively request an informal hearing with the registrar in order to try persuade the registrar to accept the application.

If either or both options are not successful or are not exercised, then the applicant may apply for the issuance of written reasons for the refusal or imposition of conditions within three months from the date of the examination report. The applicant may then appeal the registrar's ruling on application to the High Court within three months from the date of issue of the registrar's reasons for their ruling. The High Court then has the power to consider the merits of the matter, to receive further evidence and make any ruling that it deems fit.

9 Third-party opposition

Are applications published for opposition? May a third party oppose an application prior to registration, or seek cancellation of a trademark or service mark after registration? What are the primary bases of such challenges, and what are the procedures? May a brand owner oppose a bad-faith application for its mark in a jurisdiction in which it does not have protection? What is the typical range of costs associated with a third-party opposition or cancellation proceeding?

Any interested party may oppose the registration of a mark within three months from the date of advertisement of its acceptance. Alternatively, he or she may apply for the cancellation of it at any stage after registration on the basis that registration of the mark amounts to an entry that was wrongly made on the register at the time of registration, or that it is an entry wrongly remaining on the register as at the date of the application for cancellation.

Opposition and cancellation can be based on the ground that the mark does not meet the absolute requirements for registration: it is not capable of distinguishing the goods or services the application covers from those of other traders, or it is specifically prohibited from being

registered as it consists exclusively of an indication that serves to designate characteristics of the goods or services covered by the application. Other absolute grounds include prohibitions against registration of shape, configuration, colour or pattern marks that are required to achieve a specific technical purpose, or where registration would be likely to limit the development of any art or industry; marks that consist of heritage or state patronage symbols; and marks that are specifically prohibited from being registered by other legislation.

Registration can also be objected to on the basis of relative grounds, where the interested third party has better or prior rights to a similar mark, or where use and registration of the mark by the applicant or registrant would be likely to cause deception or confusion in the market, or dilution or tarnishing of a well-known mark.

Opposition and cancellation proceedings are launched in the Registry by the filing of a Notice of Application or Rectification respectively, together with all supporting evidence. The trademark applicant or registrant is then afforded one month to file their Notice of Intention to Defend, failing which the matter may be set down for hearing on the unopposed roll following the lapse of a further 10 court days. If defended, the trademark applicant or registrant will have a further two months to serve and file their answering evidence. The opponent or applicant for cancellation may then file replying evidence within a further one month. Pleadings close and the matter is set down for hearing.

Applications for cancellation may also be filed with the High Court at the instance of the applicant for cancellation, provided that if proceedings regarding the same mark are already pending in one tribunal, then the application for cancellation must be lodged in the same tribunal. The time periods for High Court applications are much shorter: five court days to file a notice of intention to oppose; a further 15 court days for answering evidence; and five court days for evidence in reply.

Currently, all opposition and cancellation proceedings that are instituted in the Registry and contested by the other party are being referred by the Registrar to the High Court for hearing.

With regard to the question as to whether a brand owner may oppose a bad faith application for its mark in the jurisdiction in which it does not have protection, as previously mentioned, any interested person may oppose the registration of a trademark, provided that they have adequate grounds to do so. An interested person would be a person having some real and direct interest in the mark itself or in the subject matter of an opposition or expungement of the mark. This would primarily be a financial or proprietary interest relating to or affected by the relevant mark and would include the interest of a trade rival. It is also to be noted that well-known trademark protection is available in South Africa for proprietors, even if they have no registered rights in South Africa. If the opponent cannot prove an adequate reputation in South Africa to show a likelihood of confusion, dilution or tarnishment of a well-known mark, then the opponent would need to show that the applicant has acted in bad faith because of a prior relationship between the parties, or has otherwise been dishonest or engaged in sharp practice. It is not enough to show that the opponent has a reputation in other countries and that the applicant in South Africa has adopted that identical mark.

10 Duration and maintenance of registration

How long does a registration remain in effect and what is required to maintain a registration? Is use of the trademark required for its maintenance? If so, what proof of use is required?

A trademark registration remains in effect for 10 years as from the date of filing the application for its registration and may be renewed for subsequent 10-year periods indefinitely. No proof of use is required, unless the application is attacked by a third party.

11 The benefits of registration

What are the benefits of registration?

A registration certificate is prima facie proof of validity of a registration, and if the validity of the registration is not challenged in a counterclaim, it is not necessary for the claimant to prove that it has a reputation in respect of all or any of the goods or services covered by the registration.

Registration does not afford access to the Registry for infringement, and both passing-off and infringement proceedings must be lodged in the High Court.

Registered trademarks can form the basis of a section 15 registration with border control authorities, who are then empowered to detain goods that are suspected to be counterfeits of the goods covered by the registration.

12 Licences

May a licence be recorded against a mark in the jurisdiction? Are there any benefits to doing so or detriments to not doing so?

A licensee may be recorded against a mark on the trademarks register as a registered user. It is not compulsory to do so, and use by the licensee will still be regarded as permitted use and deemed as use by the proprietor without recordal on the register, but it will be necessary to prove the licence. Subject to any agreement subsisting between the parties, a registered user is entitled to call upon the proprietor of the registered mark to institute infringement proceedings, and, if the proprietor refuses or neglects to do so within two months, the registered user may institute proceedings in his or her own name as if he or she were the proprietor, citing the proprietor as a co-defendant. The cited proprietor shall not be liable for any costs unless he or she enters an appearance and takes part in the proceedings.

13 Assignment

What can be assigned?

A trademark is assignable either with or without the goodwill of the business. A trademark is assignable in respect of all or some of the goods or services in respect of which it is registered.

14 Assignment documentation

What documents are required for assignment and what form must they take?

In terms of the Trade Marks Act, an assignment must be in writing and signed by or on behalf of the assignor. In this regard, a Deed of Substitution or Deed of Assignment, simply signed by authorised representatives on behalf of the assignor, as well as the assignee, would be sufficient. The registrar does not insist on original documents. No notarisation or legalisation of the assignment agreement is required. If a trademark is assigned from a local proprietor to a foreign one, exchange control approval must be obtained.

15 Validity of assignment

Must the assignment be recorded for purposes of its validity?

In order to be valid, an assignment must be in writing and signed by or on behalf of the assignor. If the assignment is not recorded at the Registry within 12 months from the effective date, the applicant shall be liable to pay such a penalty as may be prescribed.

16 Security interests

Are security interests recognised and what form must they take? Must the security interest be recorded for purposes of its validity or enforceability?

A registered trademark may be hypothecated by a deed of security. The Trade Marks Act does not prescribe that the deed of security must be recorded in order to be enforceable. However, if the deed of security is recorded it will have the effect of a pledge and will limit the transferability of the trademark.

17 Markings

What words or symbols can be used to indicate trademark use or registration? Is marking mandatory? What are the benefits of using and the risks of not using such words or symbols?

The TM symbol is used to designate use of a mark as a trademark. The [®] symbol is used to designate that the mark is a registered trademark in South Africa.

The benefit to using such markings is that it may act as a deterrent to infringement and may assist in proving that a third party had knowledge of wrongdoing in 'common-law' passing-off matters.

The risk of using the [®] symbol where a trademark is not a registered trademark in South Africa or, where it indicates that the mark is registered in respect of any goods or services in respect of which it is not registered, is that the person using such marking will be guilty of an offence and shall be liable to a fine or to imprisonment for a period not exceeding 12 months.

18 Trademark enforcement proceedings

What types of legal or administrative proceedings are available to enforce the rights of a trademark owner against an alleged infringer or dilutive use of a mark, apart from previously discussed opposition and cancellation actions?

Are there specialised courts or other tribunals? Is there any provision in the criminal law regarding trademark infringement or an equivalent offence?

Infringement of a registered or unregistered trademark is not a criminal offence. However, any person who knowingly deals in counterfeit goods commits a criminal offence in terms of the Counterfeit Goods Act. If a person dealing in counterfeit goods did not know that the goods were counterfeit, but he or she had reason to be suspicious or failed to take all reasonable steps to prevent or avoid dealing in counterfeit goods, then he or she may also be held criminally liable. Counterfeit goods are goods that imitate goods protected by intellectual property rights to the extent that they are substantially identical to the protected goods. Protected goods in turn, are those that bear or embody the intellectual property right, or that are of the same class or kind of goods that may bear or embody the intellectual property right.

Dealing in counterfeit goods includes being in possession or control of counterfeit goods for the purpose of dealing in them in the course of business; manufacturing or producing counterfeit goods for purposes that are not private and domestic; selling, hiring out, or offering for sale or hiring out of counterfeit goods; exhibiting counterfeit goods in public for the purposes of trade; distributing counterfeit goods for the purpose of trade or to such an extent that the rights owner suffers prejudice; importing into, exporting from, or importing or exporting counterfeit goods through South Africa for use that is not private and domestic.

The Counterfeit Goods Act also enables the owner of an intellectual property right to apply to the commissioner for customs and excise to seize and detain all counterfeit goods bearing or embodying the right that are imported into or enter South Africa during the period covered by the section 15 registration (renewed annually).

Where police officials have reasonable grounds to suspect that an offence of dealing in counterfeit goods has taken, is taking or will take place, either pursuant to a complaint laid by a rights holder or other person or on the strength of other information at their disposal, they may enter and search premises or vehicles, seize any suspected counterfeit goods, and collect evidence pertaining to the offence.

Once suspected counterfeit goods have been detained by a police official, customs officer, or other appointed inspector, a magistrate or judge of the High Court must confirm the detention within 10 court days, failing which the goods must be released.

Trademark rights are also afforded some protection by the Advertising Code of the self-regulatory Advertising Standards Authority of South Africa. In addition to prohibiting misleading advertising, the Code also regulates comparative advertising, and prohibits the exploitation of another's advertising goodwill so that advertisements may not take advantage of the advertising goodwill relating to another's trade name or product symbol. It also bans the imitation of another's advertisement in a manner that is recognisable or clearly evokes the existing concept and that may result in the likely loss of advertising value. Although rulings are not enforceable under the law, most forms of media are contractually bound by membership to comply with rulings, and in the event of non-compliance, a damaging Ad Alert can be issued to media members.

In terms of the Companies Act, one can also rely on trademark rights to object to the registration or change of name of an entity that is registered with a name that is confusingly or deceptively similar to a registered or well-known trademark, or one that is protected under the common law.

19 Procedural format and timing

What is the format of the infringement proceeding?

Infringement proceedings can be brought in the High Court by way of trial action proceedings, in which evidence is exchanged through a discovery process and examination and cross-examination of witnesses (factual and expert) at the hearing of a matter, or by way of application or motion proceedings in which all evidence is brought before the court through affidavits (in the names of factual or expert witnesses) that are served and filed by both parties prior to the hearing.

A single judge of the High Court will decide the matter. Hearings in application proceedings are for the presentation of oral legal arguments and usually only take one day. Hearings in trial actions will span a few days, depending on the number of witnesses called by each party, and can take even longer in more complicated matters where there are, for example, counterclaims for cancellation of the registration relied on.

20 Burden of proof

What is the burden of proof to establish infringement or dilution?

In infringement proceedings, the rights owners must show that he or she has a registered trademark (simply by producing the trademark certificate, which is prima facie proof that the registration is valid), that the infringing mark is identical or so similar to the registered mark, that when it is used in respect of goods or services that are either identical to those covered by the registration or so similar to them, deception or confusion is likely to arise. The rights owner must accordingly show sufficient similarity between the marks and between the goods or services, so that deception or confusion is likely to occur as a result. The comparison is between the goods and services covered by the registration and those of the infringer, rather than those in respect of which the proprietor has actually used his or her registered mark for. The rights owner must also show that the infringer is using the mark as a trademark, that is, to denote the origin of the alleged infringer's goods or services.

In dilution proceedings, the proprietor of the well-known mark bears the onus of proving that their mark is well known to the relevant sector of the community, that the infringing mark is identical or similar to it, and that use of the infringing mark is likely to take advantage of (blurring) or be detrimental to (tarnishing) the distinctive character or repute of the well-known mark. The proprietor must also show that this advantage that the alleged infringer takes is unfair. Further, the proprietor must show that the infringer's use of the mark will affect the advertising value of their own mark detrimentally, to the extent that he or she is actually likely to suffer economic harm. Although the proprietor does not have to show any likelihood of confusion, he or she will still need to show that the consumers will make a mental association between the infringers mark and the proprietor's own. Pursuant to case law, as the dilution provision protects the advertising value of a mark rather than the mark itself, the proprietor of the well-known mark does not have to show that the infringer is using the mark as a badge of origin, but this inquiry will still be relevant to determine whether unfair advantage has been taken of or whether the use was detrimental to the advertising value of the well-known mark.

In both infringement and dilution proceedings, the proprietor must show that the use by the other side is in the course of trade, and that the use is unauthorised.

21 Standing

Who may seek a remedy for an alleged trademark violation and under what conditions? Who has standing to bring a criminal complaint?

The owner of a registered trademark may bring infringement proceedings in their own name, but must give notice of the proceedings to all parties that are recorded on the trademarks register as users of the mark. Such registered users may then intervene in the proceedings, and may also recover any damages that he or she may have suffered as a result of the infringement. Subject to any agreement between a registered user and the trademark proprietor, a registered user is entitled to call upon the proprietor to institute infringement proceedings, and if the proprietor refuses or fails within two months of being called upon to

do so, the registered user may institute proceedings in their own name, citing the proprietor as a co-defendant.

Any person who has an interest in goods that are protected by an intellectual property right (owner, licensee or importer, exporter or distributor) may lay a criminal complaint with any inspector in terms of the Counterfeit Goods Act if he or she suspects that the offence of dealing in counterfeit goods has, is, or will take place.

In passing-off proceedings, the applicant or plaintiff must prove that the property in the goodwill that he or she seeks to protect, vests in them. Generally agents or distributors will not have the requisite legal standing, unless they have marketed the product in such a manner so as to convey that the products emanate from them.

22 Foreign activities

Can activities that take place outside the country of registration support a charge of infringement or dilution?

The act of importing counterfeit goods into or exporting them from South Africa is an offence, and imported counterfeit goods can be detained by customs officials, who are empowered to act through registration of the relevant intellectual property right with customs.

Infringement of a trademark also occurs where a registered trademark or a mark that is confusingly similar to it is applied, without the owner's consent, to goods that are intended to be exported from South Africa, where such goods are covered by the trademark registration or are similar to them.

23 Discovery

What discovery or disclosure devices are permitted for obtaining evidence from an adverse party, from third parties, or from parties outside the country?

Once the pleadings have closed in a trial action proceeding for infringement or passing off, both parties may give notice to the other to make discovery on oath of all documents and tape recordings within their control and relating to the matter. Within 20 days the party making discovery must then specify separately each of the documents or tape recordings within their possession or control, those that were previously in their possession or control, and those against which he or she has a valid objection to produce. He or she may then be required by the other party, on service of notice, to make any or all of those documents available for inspection by the other party. If a document is not specified in the discovery affidavit or made available for inspection, then that party will not be allowed to rely on it or use it at the trial. Any party can give another notice to produce any discovered document at the hearing of the trial.

If one party believes that the other has more documentary evidence in their possession that has not been listed in the discovery affidavit, then he or she may, on notice, require that party to make those additional documents available for inspection or to state on oath that such documents are not in their possession.

Ordinarily there is no discovery process in application proceedings, but the court may, in its discretion, direct that discovery take place in accordance with the provisions that regulate discovery in trial actions.

24 Timing

What is the typical time frame for an infringement or dilution, or related action, at the preliminary injunction and trial levels, and on appeal?

Infringement actions must be instituted in the jurisdiction of the court where the defendant is based or where the infringement takes place. The backlogs in the court roll are of varying lengths in the jurisdictions.

Unless one proceeds on an urgent basis, it is unlikely that a matter will be heard within six months, and depending on the number of interlocutory applications that are lodged, it can take a year or two before a matter is heard or ruled upon.

Matters that proceed on an urgent basis can be heard in a matter of days, but the requirements for a matter to qualify as urgent are stringent, and trademark infringement matters very seldom proceed on this basis (although it is possible).

25 Litigation costs**What is the typical range of costs associated with an infringement or dilution action, including trial preparation, trial and appeal?**

The costs for infringement or dilution actions vary widely between cases, as they depend on numerous factors, such as the type of proceedings instituted (trial action versus application or motion proceedings), the urgency of the matter, the amount and type of evidence adduced by each party, the length of time that the matter ensues for, and the number and type of any interlocutory proceedings.

An award for costs is usually given to the successful party, and can either be on a party-and-party scale (taxed on the High Court scale, so that 40 to 70 per cent of legal costs incurred are recovered) or, very rarely, on an attorney-and-own-client scale (being actual legal costs incurred). Punitive cost awards beyond this are possible, but very seldom granted.

26 Appeals**What avenues of appeal are available?**

Rulings of the registrar of trademarks are treated as if they are rulings of a single judge of the High Court, and both rulings by the registrar or by a single High Court judge are appealable to a three-judge bench of the High Court, or if leave to appeal is obtained, directly to the Supreme Court of Appeal. Leave to appeal is always required when appealing a decision of a single judge in the High Court, but is not required when appealing a decision of the registrar to a three-judge bench of the High Court.

27 Defences**What defences are available to a charge of infringement or dilution, or any related action?**

In addition to denials of the allegations on which the claim for infringement of a registered trademark is based, the Trade Marks Act lists seven defences to infringement. These circumstances are:

- the mark being used in good faith is the alleged infringer's own full name or that of their predecessors, or is the name of their predecessors' place of business;
- the mark is being used in good faith as a description or indication of the characteristics of their goods or services;
- the good faith use of the mark where it is reasonable to indicate the intended purpose of goods, including spare parts and accessories, and services;
- the otherwise infringing mark was applied by or with the consent of the proprietor to goods that are imported;
- the bona fide use by any person of any utilitarian features embodied in a container, shape, configuration, colour or pattern that is registered as a trademark;

- the use of a mark in a manner, place, in relation to goods or service, or in any other manner in relation to which the registration does not extend; and
- the otherwise infringing mark is registered.

A registered trademark proprietor cannot stop the use by any person of a mark that the other party was already using before he or she registered or used their own mark (whichever is the earlier). Other common law defences such as unclean hands (must prove dishonesty) or estoppel (only if unequivocal action has been taken to indicate that the infringing activity is acceptable) may also be available.

28 Remedies**What remedies are available to a successful party in an action for infringement or dilution, etc? What criminal remedies exist?**

A party whose trademark rights have been infringed may apply for an interdict to prevent further unauthorised use of the offending trademark, quantified damages, or in lieu of damages, a reasonable royalty. The court may also, on application, order that the infringing mark be removed from all material, and if the mark is inseparable from the material, then it may order the delivery up of that material for the purposes of destruction.

In the case of passing off, the proprietor may apply for an interdict to prevent further passing off and misrepresentation (this will not necessarily result in the cessation of use of the trademark, only a prohibition against use that does not clearly distinguish the goods), damages for the harm that he or she has suffered and that he or she can quantify and prove, or damages based on what royalty the proprietor would have charged the infringer.

Both the proprietors of registered trademarks and those that are protected under the common law may ask for an award in respect of the legal costs they have had to incur to enforce their rights in the courts.

29 ADR**Are ADR techniques available, commonly used and enforceable? What are the benefits and risks?**

In theory, ADR techniques are available for trademark disputes where the parties have provided for resolution of disputes by alternative means or where both parties agree to participate in and be bound by a finding, but are not commonly used and are only enforceable in terms of a contract between the parties.



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30 Famous foreign trademarks

Is a famous foreign trademark afforded protection even if not used domestically? If so, must the foreign trademark be famous domestically? What proof is required? What protection is provided?

A famous trademark that is not used domestically, but is locally well known and locally registered, will be protected against infringement, including by dilution or tarnishing where use of an identical or similar mark by a third party would be likely to take unfair advantage of or be detrimental to the distinctive character or repute of the registered well-known mark.

If the mark is well known domestically (whether by way of local or foreign use) but is not registered, then the foreign proprietor can still prevent the use or registration of a mark that constitutes, or the essential part of which constitutes, a reproduction, imitation or translation of the well-known mark and that is used or intended to be used for goods or services that are identical or similar to the goods or services in respect of which the foreign mark is well known locally, and where such use is likely to give rise to deception or confusion.

Proof of a reputation in the relevant local industry, such as affidavits by suppliers, leading participants and consumers, survey evidence and any other proof of the international and local reputation would be useful.

Getting the Deal Through

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Anti-Money Laundering
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Automotive
Aviation Finance & Leasing
Banking Regulation
Cartel Regulation
Class Actions
Commercial Contracts
Construction
Copyright
Corporate Governance
Corporate Immigration
Cybersecurity
Data Protection & Privacy
Debt Capital Markets
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Domains & Domain Names
Dominance
e-Commerce
Electricity Regulation
Energy Disputes
Enforcement of Foreign Judgments
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Government Investigations
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High-Yield Debt
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Insurance & Reinsurance
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Intellectual Property & Antitrust
Investment Treaty Arbitration
Islamic Finance & Markets
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Licensing
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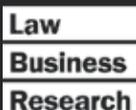
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