

SOUTH AFRICA

Trade Mark Registration Procedure

Your Trade Mark

To qualify for registration, a trade mark must be distinctive and not simply describe the nature or quality of the products or services to which it is applied. Marks that are purely descriptive cannot be registered.

Even if registered, your monopoly in a particular mark will be limited to the extent that others need to use the word in trade.

A descriptive mark can acquire distinctiveness through widespread use and promotion if consumers have come to exclusively associate the mark with you (like **SHARP** for televisions), although a trade mark that consists exclusively of descriptive matter (like **APPLE** for apples) may never be registrable.

Therefore, the best marks are made-up words (like **KODAK**) or words that are not related to the products they are used in relation to (like **APPLE** for computers). Suggestive words (like **JAGUAR** for cars, evoking the idea of elegance and speed) or combination words (like **AIRBUS** for airplanes) also work well.

What to File?

You can file a **word mark** (a name in plain text), a **stylised word mark** (a word mark in a particular front) or a **logo** (an image that represents your brand with or without wording). A word mark will give you the widest protection. A stylised word mark or logo will give you more specific protection that covers the design elements forming part of your brand.

Classification of Goods and Services

Trade marks are registered in 45 different classes in accordance with the “Nice” International Classification of Goods and Services.

You can read more about the classes further on in this brochure, or you can play around with the search terms field here – <http://tmclass.tmdn.org/ec2/> or on our website search at <https://www.brandlaw.co.za/search/> - to see which classes may be relevant.

Alternatively, we can assist you with classification if you provide us with:

1. *a list of the goods or services you would like to protect, and/or*
2. *a link to your website or product or service offering*

Ultimately, the classes in which you register your mark should be guided by how you use the mark, your business, your product/service offering and future plans, your branding and budget, the level of protection you need and the classes in which your competitors have filed.

We are happy to discuss your options further.

Searches

We recommend conducting a search of the South African Trade Marks Register to identify obstacles to the registration of your mark – including other marks that look the same, sound the same or mean the same as your mark and cover identical or similar products/services.

The search results will also help us to increase the possibility of successful registration by tailoring our filing strategy.

If you do not conduct a trade mark search, you could discover *after* filing that your mark is not available and then be forced to rebrand - and may also have to file a new application down the line.

Our search options are as follows:

Search Service		Price
Full registrability search	We conduct a full search of the South African Trade Marks Register in all relevant classes of goods/services for brands similar to yours. We provide a full opinion on your mark's registrability, as well as a strategy for maximising the likelihood of success. This search is 95% exhaustive.	R 3,500
Marketplace search + full registrability search	We conduct a full search of the South African Trade Marks Register and marketplace investigations for unregistered identical and similar marks in South Africa. We provide a full opinion on the mark's registrability and your risk of claims of infringement in view of other marks in use.	R 8,500

**** All charges include official search costs.**

DISCLAIMER: Please note that our search report is subject to the accuracy and completeness of the online records of the relevant Trade Marks Office. It does not cover trade mark applications filed for registration which have not yet been captured in the database at the Trade Marks Office. Our search does not deal with trade marks which may be in use but for which no trade mark registration or application exists (common law trade marks). In addition, our search does not include a search for trade mark applications filed in any other foreign jurisdictions, the CIPC register for South African company or closed corporation names incorporating or consisting of the proposed trade mark, domain names incorporating or consisting of the proposed trade mark, well-known trade marks that enjoy a reputation in the relevant jurisdiction and are afforded protection under the applicable law (even though the proprietor has not filed a trade mark application), trade mark applications filed subsequent to this search whereby priority is claimed from a foreign application filed up to six months earlier, or the proposed trade mark filed in any other language.

We can also conduct searches of foreign registers (including the European Union (EU), the United Kingdom (UK), the United States (US), Canada and Australia). Please enquire with us about the charges in the respective jurisdictions.

If you have been using your mark for a very long time and you are certain there is nothing similar in the marketplace, you could take a chance and file without a search. However, this is generally not recommended.

Filing Costs

Our charges for preparing and filing a trade mark application in South Africa are:

Trade Mark Application	Price
Trade mark application (per class)	R 2,990

**** Please note that we can also file applications to register trade marks in other countries via our trusted network of agents. As these fees change with the exchange rate and updated charges from our agents, please enquire with us about a costing.*

There may be additional costs on examination, but we can only determine what these costs will be when the mark is examined approximately 7-10 months after filing. In a straightforward case, if no further action is required by the examiner, no conditions are imposed, and the application is not opposed by a third party, no further costs apply.

If further action is required by the examiner and we need to respond, the following costs may apply:

Responding to an Examiner Office Action	Price
Drafting and sending a letter responding to the examiner (first class)	R 1,650
Drafting and sending a letter responding to the examiner (per additional class)	R 600
Entering a required disclaimer, endorsement or association (first class)	R 900
Entering a required disclaimer, endorsement or association (additional class)	R 350
Arguing against a provisional refusal (time based – per hour)	R 1,350 – R 1,950

Procedure

The registration procedure is as follows:

1. The application is lodged at the Trade Marks Office and allocated an application number and a filing date within three (3) days of filing.
2. The application is examined approximately 7-10 months later and the examiner will issue their examination report. They can accept the application unconditionally, or require us to comply with certain conditions for final acceptance, or they will refuse it.
3. If the application is refused, there are various ways to argue against the refusal. We will provide more information on possible further actions and associated costs if it gets to this point.
4. If the application is accepted, and once any necessary conditions have been complied with, the application is advertised for opposition purposes in the South Africa Patents Journal. Interested parties then have three (3) months to lodge an objection to the registration of your mark.
5. If no opposition is lodged, the trade mark will proceed to registration and the registration certificate will be issued.

The entire registration process, from filing to registration, takes up to 24 months in a straightforward case. If further action is required or the mark is opposed, it will take longer.

Please note that once the trade mark is registered, it is protected from the initial filing date (and not the ultimate registration date) for renewable periods of ten (10) years.

Requirements - What We Need from You

Before we can proceed, we require the following information from you:

1. whether you would like us to conduct a search of the register first, and the type of search you require;
2. the trade mark(s) (in word format or an electronic format if you want to file a stylised word mark or logo) and class(es) in which you would like to register.
3. the name of the applicant for the mark and a physical address for that person, partnership or entity; and
4. contact details (address, phone number, P.O. box address, VAT number, etc.) for our correspondence and invoices.

To file the application(s) on your behalf, we require a power of attorney authorising us to do so. We will send you a suitable document once your instructions to file have been confirmed. By lodging the power of attorney, we would also record ourselves as your address for service for any processes and documents related to the mark(s). This will allow us to administer the trade mark registration(s) (deal with renewals, oppositions, renewals, etc.) going forward.

SCHEDULE 3

LIST OF CLASSES OF GOODS AND SERVICES

NICE CLASSIFICATION

11TH EDITION – VERSION 2019

CLASS HEADINGS

GOODS

- Class 1* Chemicals for use in industry, science and photography, as well as in agriculture, horticulture and forestry; unprocessed artificial resins, unprocessed plastics; fire extinguishing and fire prevention compositions; tempering and soldering preparations; substances for tanning animal skins and hides; adhesives for use in industry; putties and other paste fillers; compost, manures, fertilizers; biological preparations for use in industry and science
- Class 2* Paints, varnishes, lacquers; preservatives against rust and against deterioration of wood; colorants, dyes; inks for printing, marking and engraving; raw natural resins; metals in foil and powder form for use in painting, decorating, printing and art
- Class 3* Non-medicated cosmetics and toiletry preparations; non-medicated dentifrices; perfumery, essential oils; bleaching preparations and other substances for laundry use; cleaning, polishing, scouring and abrasive preparations
- Class 4* Industrial oils and greases, wax; lubricants; dust absorbing, wetting and binding compositions; fuels and illuminants; candles and wicks for lighting
- Class 5* Pharmaceuticals, medical and veterinary preparations; sanitary preparations for medical purposes; dietetic food and substances adapted for medical or veterinary use, food for babies; dietary supplements for human beings and animals; plasters, materials for dressings; material for stopping teeth, dental wax; disinfectants; preparations for destroying vermin; fungicides, herbicides
- Class 6* Common metals and their alloys, ores; metal materials for building and construction; transportable buildings of metal; non-electric cables and wires of common metal; small items of metal hardware; metal containers for storage or transport; safes
- Class 7* Machines, machine tools, power-operated tools; motors and engines, except for land vehicles; machine coupling and transmission components, except for land vehicles; agricultural implements, other than hand-operated hand tools; incubators for eggs; automatic vending machines
- Class 8* Hand tools and implements, hand-operated; cutlery; side arms, except firearms; razors
- Class 9* Scientific, research, navigation, surveying, photographic, cinematographic, audiovisual, optical, weighing, measuring, signalling, detecting, testing, inspecting, life-saving and teaching apparatus and instruments; apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling the distribution or use of electricity; apparatus and instruments for recording, transmitting, reproducing or processing sound, images or data; recorded and

- downloadable media, computer software, blank digital or analogue recording and storage media; mechanisms for coin-operated apparatus; cash registers, calculating devices; computers and computer peripheral devices; diving suits, divers' masks, ear plugs for divers, nose clips for divers and swimmers, gloves for divers, breathing apparatus for underwater swimming; fire-extinguishing apparatus
- Class 10* Surgical, medical, dental and veterinary apparatus and instruments; artificial limbs, eyes and teeth; orthopaedic articles; suture materials; therapeutic and assistive devices adapted for the disabled; massage apparatus; apparatus, devices and articles for nursing infants; sexual activity apparatus, devices and articles
- Class 11* Apparatus and installations for lighting, heating, cooling, steam generating, cooking, drying, ventilating, water supply and sanitary purposes
- Class 12* Vehicles; apparatus for locomotion by land, air or water
- Class 13* Firearms; ammunition and projectiles; explosives; fireworks
- Class 14* Precious metals and their alloys; jewellery, precious and semi-precious stones; horological and chronometric instruments
- Class 15* Musical instruments; music stands and stands for musical instruments; conductors' batons
- Class 16* Paper and cardboard; printed matter; bookbinding material; photographs; stationery and office requisites, except furniture; adhesives for stationery or household purposes; drawing materials and materials for artists; paintbrushes; instructional and teaching materials; plastic sheets, films and bags for wrapping and packaging; printers' type, printing blocks
- Class 17* Unprocessed and semi-processed rubber, gutta-percha, gum, asbestos, mica and substitutes for all these materials; plastics and resins in extruded form for use in manufacture; packing, stopping and insulating materials; flexible pipes, tubes and hoses, not of metal
- Class 18* Leather and imitations of leather; animal skins and hides; luggage and carrying bags; umbrellas and parasols; walking sticks; whips, harness and saddlery; collars, leashes and clothing for animals
- Class 19* Materials, not of metal, for building and construction; rigid pipes, not of metal, for building; asphalt, pitch, tar and bitumen; transportable buildings, not of metal; monuments, not of metal
- Class 20* Furniture, mirrors, picture frames; containers, not of metal, for storage or transport; unworked or semi-worked bone, horn, whalebone or mother-of-pearl; shells; meerscham; yellow amber
- Class 21* Household or kitchen utensils and containers; cookware and tableware, except forks, knives and spoons; combs and sponges; brushes, except paintbrushes; brush-making materials; articles for cleaning purposes; unworked or semi-worked glass, except building glass; glassware, porcelain and earthenware
- Class 22* Ropes and string; nets; tents and tarpaulins; awnings of textile or synthetic materials; sails; sacks for the transport and storage of materials in bulk; padding, cushioning and stuffing materials, except of paper, cardboard, rubber or plastics; raw fibrous textile materials and substitutes therefor
- Class 23* Yarns and threads for textile use
- Class 24* Textiles and substitutes for textiles; household linen; curtains of textile or plastic
- Class 25* Clothing, footwear, headwear

- Class 26* Lace, braid and embroidery, and haberdashery ribbons and bows; buttons, hooks and eyes, pins and needles; artificial flowers; hair decorations; false hair
- Class 27* Carpets, rugs, mats and matting, linoleum and other materials for covering existing floors; wall hangings, not of textile
- Class 28* Games, toys and playthings; video game apparatus; gymnastic and sporting articles; decorations for Christmas trees
- Class 29* Meat, fish, poultry and game; meat extracts; preserved, frozen, dried and cooked fruits and vegetables; jellies, jams, compotes; eggs; milk, cheese, butter, yoghurt and other milk products; oils and fats for food
- Class 30* Coffee, tea, cocoa and artificial coffee; rice, pasta and noodles; tapioca and sago; flour and preparations made from cereals; bread, pastries and confectionery; chocolate; ice cream, sorbets and other edible ices; sugar, honey, treacle; yeast, baking-powder; salt, seasonings, spices, preserved herbs; vinegar, sauces and other condiments; ice (frozen water)
- Class 31* Raw and unprocessed agricultural, aquacultural, horticultural and forestry products; raw and unprocessed grains and seeds; fresh fruits and vegetables, fresh herbs; natural plants and flowers; bulbs, seedlings and seeds for planting; live animals; foodstuffs and beverages for animals; malt
- Class 32* Beers; non-alcoholic beverages; mineral and aerated waters; fruit beverages and fruit juices; syrups and other non-alcoholic preparations for making beverages
- Class 33* Alcoholic beverages, except beers; alcoholic preparations for making beverages
- Class 34* Tobacco and tobacco substitutes; cigarettes and cigars; electronic cigarettes and oral vaporizers for smokers; smokers' articles; matches

SERVICES

- Class 35* Advertising; business management; business administration; office functions
- Class 36* Insurance; financial affairs; monetary affairs; real estate affairs
- Class 37* Building construction; repair; installation services
- Class 38* Telecommunications
- Class 39* Transport; packaging and storage of goods; travel arrangement
- Class 40* Treatment of materials
- Class 41* Education; providing of training; entertainment; sporting and cultural activities
- Class 42* Scientific and technological services and research and design relating thereto; industrial analysis and industrial research services; design and development of computer hardware and software
- Class 43* Services for providing food and drink; temporary accommodation
- Class 44* Medical services; veterinary services; hygienic and beauty care for human beings or animals; agriculture, horticulture and forestry services
- Class 45* Legal services; security services for the physical protection of tangible property and individuals; personal and social services rendered by others to meet the needs of individuals