

NOTES ON TRADEMARK SEARCHES

Written by Ron Wheeldon

Wednesday, 21 December 2011 18:51 - Last Updated Wednesday, 21 December 2011 21:28

Searching is an art, not an exact science and absolute accuracy in assessing the availability of a mark is not guaranteed. We bring 25 years' experience to the task and our assessments are generally correct, but we accept no liability if other parties, or a court, disagree with them.

- The trade mark search has been conducted at the Trade Marks Office and is naturally subject to the accuracy of the official records. A delay of several weeks – sometimes months - occurs between the physical filing of an application and the capture of the data onto the official records. The official records have definite shortcomings, including missing data and inaccuracies do occur. We cannot accept any liability for them.

- South Africa is a member of the Paris Convention. This permits an applicant in a convention country to lodge an application up to six months after the filing date in his own country and the application will be treated as if filed in that other country on the home filing date (called "the priority date"). Such a right, not yet claimed by filing in South Africa, will obviously not be disclosed by a local search.

- Marks which lapsed or were refused registration prior to computerisation were not captured onto the database and, along with those for which no application was filed, will not be disclosed by our search. Such marks may nevertheless be in use and protected at common law. Consequently it is wise, before actually launching a new product, to conduct a thorough investigation of the marketplace to see whether any conflicting marks are in use.

- A mark which is registered but which has not been the subject of *bona fide* use for five years or longer is vulnerable to removal from the register on grounds of such non use. There can also be other grounds of removal and, where any such grounds exist, it is often possible to negotiate the cancellation or transfer of an existing registration. Thus, what appears to be an impediment or complete bar to the use and registration of a proposed trade mark may be less of a problem than it first appears to be.

- Business and corporate names are not the concern of the Registrar of Trade Marks and our trade mark search will not disclose business, company or CC names incorporating your proposed trade mark or similar words. It is wise to conduct a company name search in the companies register and we will undertake such an investigation on request, at a nominal additional cost.

- "Well-known" marks may be protected in South Africa even though such marks are not registered or used in this country. Our investigation will obviously not disclose these. Moreover, a registered mark in a class not related to the search may enjoy "dilution" protection and give rise to unexpected difficulty. We are happy to provide detailed advice on dilution issues on request.

- Trade mark searches do not extend to domain names. We recommend that such searches are conducted and will undertake such searching at nominal additional cost.

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