

Non Use

1. Statutory provisions

1.1 In terms of Section 27 of the Trade Marks Act, a trade mark registration may be removed from the register for any goods or services on the ground -

1.1.1 that the trade mark was registered without any bona fide intention on the part of the applicant for registration that it should be used in relation to those goods or services by him or any person permitted to use the trade mark as contemplated by Section 38, and there has in fact been no bona fide use of the trade mark in relation to those goods or services by any proprietor thereof or any person so permitted for the time being up to the date three months before the date of the application; or

1.1.2 that up to the date three months before the date of the application a continuous period of five years or longer elapsed from the date of issue of the certificate of registration during which the trade mark was a registered trade mark and during which there was no bona fide use thereof in relation to those goods or services by any proprietor thereof or any person permitted to use the trade mark as contemplated in Section 38 during the period concerned; or

1.1.3 subject to such notice as the Court or the Registrar, as the case may be, shall direct, and subject to the provisions of the regulations, that, in the case of a trade mark registered in the name of a body corporate or in the name of a natural person, such body corporate has been dissolved or such natural person died not less than two years prior to the date of the application and that no application for registration of an assignment of such trade mark has been made in terms of Section 40.

1.2 Proceedings for cancellation may be instituted before the Registrar of Trade Marks at the Trade Marks Office or the High Court, at the option of the applicant for cancellation, except in cases where proceedings (eg infringement proceedings) concerning the trade mark in question are pending before the court, in which case application must be made to the court.

2. Partial cancellation

The Registrar has a discretion as to whether or not to cancel a registration in respect of some of the goods or services in any registration even if the trade mark is used in relation to other goods or services protected by the registration.

3. Who may apply

To institute cancellation proceedings, an applicant must be an "interested person". The meaning of "interested person" is not defined in the Act. The applicant for cancellation is, it seems, interested if it has a genuine interest in the trade concerned and in the trade mark, for example because the trade mark registration is being relied on in infringement or opposition proceedings, because its trade mark application has been refused by the Registrar on the basis of the earlier registration, because its trade is hampered by the existence of the registration, or because it has a bona fide intention to use and register a trade mark which conflicts with the registration.

4. Onus

The onus of proving use in cancellation proceedings rests on the proprietor as only the proprietor of a trade mark has full knowledge of its use. If the applicant for cancellation alleges non-use, the court or the Registrar will require the proprietor to rebut the allegation of non-use.

5. Type of use required to defend a registration

5.1 There is a statutory requirement in Section 27 of the Trade Marks Act that the use must be bona fide use by the proprietor of the trade mark.

5.2 Bona fide use has been defined as use by the proprietor of his registered trade mark in connection with the particular goods or services in respect of which it is registered with the object or intention primarily of protecting, facilitating and furthering his trade in such goods or services, and

not for some other, ulterior object. Use merely to protect the trade mark from cancellation without the proprietor having any intention of trading in the goods or services in respect of which it was registered would not be bona fide because that would constitute an ulterior purpose.

- 5.3 The sale of a very limited number of items could meet the user requirement if the sale were bona fide and not made for ulterior purposes. However, token use simply for the purpose of meeting user requirements would not be sufficient.
- 5.4 In terms of Section 38 of the Trade Marks Act, the use of a registered trade mark by a permitted user in relation to the relevant goods or services in the course of trade is deemed to be use by the proprietor.
- 5.5 The use of a mark need not be in a form identical to the form in which the mark is registered for the purpose of meeting user requirements. Section 31(1) of the Trade Marks Act states that the Registrar or the Court, as the case may be, may accept proof of the use of an associated mark or of the trade mark with additions or alterations not substantially affecting its identity as equivalent to proof of use of the registered mark. This is a matter of discretion.

6. Curing non-use

Even after non-use for a period of more than five years, any use prior to a date three months before the date of the application for cancellation can be relied on, provided that it meets with the normal requirements for use.

7. Special Circumstances in the Trade

Section 27(4) of the Trade Marks Act states that an applicant for cancellation shall not be entitled to rely on any non-use that is shown to have been due to special circumstances in the trade and not to any intention not to use or to abandon the trade mark in relation to the goods or services to which the application relates. The special circumstances are not defined.

8. Defensive registrations

Where under the previous Act a trade mark was used only in relation to specific goods or services and the proprietor had developed a reputation in respect of those goods or services, it was possible to obtain a defensive registration in respect of other goods and services. This applied where a trade mark registered in part A of the register would, if used in relation to goods or services other than goods or services in respect of which it is registered, have been likely to be taken as indicating a connection in the course of trade between the first mentioned goods or services and the proprietor of the registered trade mark. Such a defensive registration is not open to attack on the ground of non-use for a period of ten years from 1 May 1995, whether or not the proprietor does use its trade mark in respect of goods or services for which it is registered defensively.

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