

DEPARTMENT OF TRADE AND INDUSTRY

Notice no. R578, Government Gazette no. 16373 of 21 April 1995

TRADE MARKS ACT NO. 194 OF 1993

Trade Mark Regulations

The Minister of Trade and Industry has, in terms of section 69 of the Trade Marks Act, 1993 (Act no.194 of 1993), made the regulations and prescribed the tariff set forth hereunder:

Definitions

1. In these regulations, unless the context otherwise indicates, any expression to which a meaning has been assigned in the Trade Marks Act 1993 (Act no. 194 of 1993), bears a meaning so assigned, and -
 - 'the Act' means the Trade Marks Act, 1993 (Act no. 194 of 1993);
 - 'Patent Journal' means the official journal of patents, designs, trade marks and copyright in cinematograph films of the Republic of South Africa;
 - 'Office' means the Trade Marks Office referred to in section 5 of the Act;
 - 'send' includes give;
 - 'specification' means the designation of goods or services in respect of which a trade mark is registered or proposed to be registered.

Fees

[Sections 65 and 69(1)]

- 2.(1) The fees to be paid in pursuance of the Act shall be the fees specified in Schedule 1 to these regulations.
- (2) All such fees shall, subject to such conditions as the Registrar may impose, be payable by means of revenue stamps or in such other manner as the Registrar may direct.
- (3) For the purposes of this regulation, the word 'stamp' shall bear the meaning assigned to it by section 1 of the Stamp Duties Act, 1968 (Act no. 77 of 1968), as amended.

Forms

[Section 69 (2)]

- 3.(1) The forms referred to in these regulations are the forms contained in Schedule 2, and such forms shall be used in all cases to which they are applicable, but may be modified or amended to the extent necessary in the circumstances of a particular case.
- (2) Any request, notification or application to the Registrar for which no specific form is prescribed in these regulations shall be made on Form TM2 quoting the section of the Act or the regulation or both in terms of which the request, notification or application is made.

Classification of goods and services

[Sections 11 and 69 (2)]

- 4.(1) For the purposes of trade mark, certification mark and collective mark applications made under the Act, goods and services are classified in accordance with Schedule 3 to these regulations.

- (2) For the purposes of classifying goods and services in accordance with Schedule 3 to these regulations and of interpreting this Schedule, reference shall be had to the 6th Edition of the International Classification of Goods and Services for the purposes of the registration of marks under the Nice Agreement of 15 June 1957 (as revised) published by the World Intellectual Property Organisation in 1992, including the explanatory notes and lists of goods and services published therein.
- (3) In the event of the aforesaid 6th Edition of the International Classification of Goods and Services, 1992, being amended by the World Intellectual Property Organisation at any future stage, the Registrar shall publish such amendments in the Patent Journal and shall, to the extent that such amendments necessitate an amendment of Schedule 3 to these regulations, so amend Schedule 3 and publish such amendment.
- (4) If any doubt arises as to the class in which any particular description of goods or services belongs, the matter shall be determined by the Registrar.

Documents

[Section 69 (2)]

5. Subject to any directions that may be given by the Registrar, all documents required by the Act or by these regulations to be filed with the Registrar shall be typewritten, lithographed or printed in one of the official languages of the Republic in legible roman characters with black ink upon strong paper, on one side of the paper only, of A4 standard size and shall have on the left hand side a margin of at least 35 mm.

Service of documents

[Section 66]

- 6.(1) Any document to be filed with the Registrar may be sent through the post. Any such document so sent shall not be deemed to have been duly sent until it is received by the Registrar.
- (2) Any document to be served on any person other than the Registrar may be sent by registered post. Any document so sent shall be deemed to have been delivered in the ordinary course of post, and in proving such service or sending it shall be sufficient to prove that such document was properly addressed and put into the post and registered.
- (3) Any affidavit to be filed with the Registrar or served on any other person in terms of regulations 19 and 52(2) may be sent by facsimile transmission. Such transmitted copy shall be received and accepted by the Registrar and any such other person and shall be deemed to be in compliance with these regulations: Provided that the original version of such affidavit is filed with the Registrar before noon on the court day but one preceding the day upon which the matter is to be heard, or within 15 court days of the date of signature of the document, whichever is the earlier.
- (4) Any other document or copy to be filed with the Registrar or served on any other person in terms of the Act may be filed or served by facsimile transmission or by means of electronic transfer: Provided that the original document or copy, as the case may be, is filed or served within 15 court days of the date of signature thereof.
- (5) All documents relating to an entry in the register to be served on the proprietor of the trade mark shall be served at his address for service.
- (6) All documents to be sent to or served on a registered user or assignee shall be sent to or served on the registered user or assignee of the trade mark at his address for service as recorded with the Registrar.
- (7) Whenever the Registrar is not satisfied as to the effectiveness of service, he may order such further steps to be taken as to him seems meet.

Address for service

[Section 66]

- 7.(1) An address for service shall in all cases be in the Republic and shall include a street address.
- (2) Where an address for service is in an area where there is no street, the address given shall contain such further indications as the Registrar may deem necessary to find the exact location of such address.
- (3) An address for service may, in addition, contain a post office box number and a facsimile transmission number.

Alteration of address and address for service

[Sections 23 and 66(3)]

- 8.(1) Any person who alters his address or address for service may apply to the Registrar on Form TM2 to record such alteration on the relevant documents and on the register and the Registrar shall act accordingly.
- (2) Any party to any proceedings under the Act who alters his address or address for service shall forthwith -
 - (a) apply to the Registrar on Form TM2 to record such alteration on the notice of opposition or other documents or the register, and the Registrar shall act accordingly; and
 - (b) give notice of such alteration to every other person who is a party to the proceedings.

Agents

[Section 8]

- 9.(1) All communications to the Registrar relating to trade marks or trade mark applications may be signed by and all attendances upon the Registrar may be made by or through an agent practising in the Republic and duly authorised to the satisfaction of the Registrar. In any particular case the Registrar may, if he thinks fit, require the personal signature of an applicant, objector or other person.
- (2) Service upon such agent shall be deemed to be service upon the person so appointing him and all communications directed to be made to such person may be addressed to such agent.
- (3) Where the address of an agent has been used as the address for service in respect of any entry in the register and such agent changes his address, he shall forthwith apply to the registrar on Form TM2 for the form of advertisement of the change of address for publication in the Patent Journal.

Unregistrable marks

[Section 10 (8)-(10)]

- 10.(1) Subject to the provisions of any other law, the Registrar may refuse to accept any application upon which any of the following appear:
 - (a) The words 'patent', 'patented', 'by letters patent', 'registered', 'registered trade mark', 'registered design', 'copyright', 'certified', 'guaranteed' or words to like effect;
 - (b) the letters ®, © or similar combinations which may be construed to import a reference to registration.
- (2) Where a representation of arms, insignia, a decoration or a flag appears on a mark, the Registrar may call for such justification, including such consent as he may deem necessary as the circumstances of the case may require.

Application for registration

[Section 16]

- 11.(1) An application for a trade mark registration shall be made on Form TM1.
- (2) The application shall be dated and signed by the applicant(s) or his/their duly authorised agent.

- (3) The application shall be in triplicate and a separate and distinct application is required for each class of goods or services and for each separate mark.
- (4) If the application is made by a firm or partnership it may be signed in the name or for and on behalf of the firm or partnership by any one or more members or partners thereof.
- (5) If the application is made by a body corporate it may be signed by any authorised person.

Convention applications

[Section 63]

12. If the applicant claims convention priority under section 63 of the Act, by reason of an application made or deemed to have been made to register the trade mark in a convention country as defined in section 2 of the Act, the applicant shall, within three months of the date of the application in the Republic, lodge with the Registrar a copy of the application in the convention country duly certified, to the satisfaction of the Registrar, by the Trade Marks Office of such country. If such application is in a language other than one of the official languages of the Republic, it shall be accompanied by a translation into one of the official languages of the Republic, verified to the satisfaction of the Registrar.

Representation of marks

- 13.(1) Every application for the registration of a trade mark shall contain a representation, suitable for reproduction, affixed to it in the space provided on Form TM1 for this purpose.
- (2) A representation shall not exceed 8,5 cm in width and 10 cm in length.
- (3) Where the trade mark applied for is not a word, letter, numeral or combination thereof (but a mark represented in a special or particular manner) there shall be sent with every application for the registration of the trade mark a representation of the mark annexed to Form TM1 and -
 - (a) two additional unmounted representations of the mark exactly corresponding to the mark affixed to Form TM1; and
 - (b) such additional representations of the mark as the Registrar may deem necessary.
- (4) All representations of the marks shall be of a durable nature and on one side of the paper only. Letters, figures and lines shall be clear and distinct. If, in the opinion of the Registrar, the representations of the mark are not satisfactory, he may at any time require other representations, satisfactory to him, to be substituted before proceeding with the application.
- (5) Where a representation cannot be given in the manner aforesaid, a specimen or copy of the trade mark may be sent either of full size or on a reduced scale and in such form as the Registrar may think most convenient.
- (6) The Registrar may also call for a deposit in the office of a specimen or copy of any trade mark which cannot conveniently be shown by a representation, and may refer to it in the register in such manner as he may think fit.

Translation of languages

- 14.(1) Where a trade mark or application contains a word or numeral in other than roman characters, there shall be endorsed on Form TM1 a transliteration and/or translation to the satisfaction of the Registrar of each such word or numeral.
- (2) Where a trade mark contains a word in a language other than an official language of the Republic the Registrar may ask for a translation thereof, and if he so requires, such translation shall be endorsed on Form TM1.

Procedure on receipt of application

- 15.(1) On or after the receipt of any application for the registration of a trade mark, the Registrar shall furnish the applicant with an acknowledgement thereof. Such acknowledgement shall contain the official number and date of the application.
- (2) The Registrar shall after receipt of the application for the registration of the trade mark cause a search to be made amongst registered marks and pending applications for the purpose of ascertaining whether there are on record any marks for goods or services which may conflict with the trade mark forming the subject of the application in terms of section 10.
- (3) If after such search and a consideration of the application the Registrar considers that there is no objection to the mark being registered, he shall accept it absolutely or subject to conditions, modifications or amendments which he shall communicate to the applicant or his agent.
- (4) If after such search and consideration of the application any objections exist, a statement of those objections shall be sent to the applicant, in writing, and unless within three months of the date of the statement the applicant submits arguments, in writing, or applies for a hearing or an extension of time, the application shall be deemed to have been abandoned.
- (5) If the Registrar accepts an application subject to any conditions, modifications or amendments, and the applicant objects to such conditions, modifications or amendments, he shall within three months from the date of the notice of conditional acceptance submit arguments in writing or apply for a hearing or for an extension of time. If he does not do so the application shall be deemed to have been abandoned. If the applicant does not object to such conditions, modifications or amendments, he shall within three months so notify the Registrar, in writing, or apply for an extension of time and, if he fails to do so, the application shall be deemed to have been abandoned.

Application for registration of a trade mark to be used by body corporate to be established
[Section 19]

16. An application in terms of section 19 of the Act, shall be supported by an affidavit to the effect that a body corporate is about to be established and that the applicant intends to assign the trade mark to that body corporate with a view to its use by the body corporate in relation to the goods or services in question.

Honest concurrent user and other special circumstance applications
[Section 14]

17. An application in terms of the provisions of section 14(1) of the Act shall be made on Form TM1 accompanied by a statement of case and an affidavit in support of it.

Advertisement of application
[Section 17]

- 18.(1) Every application for registration of a trade mark shall be advertised once in the Patent Journal by the applicant, in the form and wording required by the Registrar.
- (2) In respect of any other application or notice the provisions of subregulation (1) shall *mutatis mutandis* apply.

Proceedings before the Registrar
[Sections 21, 24, 26, 27 and 45]

- 19.(1) All proceedings brought before the Registrar in terms of section 21, 24, 26 and 27 of the Act shall be brought on notice of opposition or notice of rectification, as the case may be, supported by an affidavit as to the facts upon which the applicant relies for relief.
- (2) (a) A notice of opposition in terms of section 21 shall be brought on or as near as may be in accordance with Form TM3 of the second schedule.

- (b) A notice of rectification in terms of sections 24, 26 and 27 shall be brought on or as near as may be in accordance with Form TM3 of the second schedule.
 - (c) A copy of such notice, and all annexures to it, shall be served upon every interested party.
 - (d) In the notice the applicant shall appoint an address for service in terms of regulation 7(1) at which he will accept notice and service of all documents in such proceedings, and shall set forth a day, not less than one month after service of it on the respondent, on or before which such respondent is required to notify the applicant and the Registrar, in writing, whether he intends to defend such application, and the notice shall further state that if no such notification is given, the application will be set down for hearing on a stated date, being not less than 10 days after expiry of the one-month period referred to above.
 - (e) If the respondent does not, on or before the day mentioned for that purpose in such notice, notify the applicant and the Registrar of his intention to defend, the applicant may set the matter on the roll for hearing by giving the Registrar notice of set-down before noon on the court day but one preceding the day upon which the matter is to be heard.
 - (f) Any person opposing the grant of an order sought shall -
 - (i) within the time stated in the said notice, give the applicant notice in writing on Form TM4 that he intends to oppose the application;
 - (ii) appoint an address for service in terms of regulation 7(1) at which he will accept notice and service of all documents;
 - (iii) within two months of notifying the applicant of his intention to oppose the application, deliver his answering affidavit, if any; and
 - (iv) if he intends to raise any question of law only, deliver notice of his intention to do so within the time stated in the preceding subparagraph, setting forth such question.
 - (g) Within one month of the service upon him of the affidavit and documents referred to in subregulation (2)(f) (ii) the applicant may deliver a replying affidavit. The Registrar may in his discretion permit the filing of further affidavits.
 - (h) Where no answering affidavit, or notice in terms of subregulation 2(f) (iii) is delivered within the period referred to in subregulation 2(f) (ii), the applicant may within 10 court days of its expiry apply to the Registrar to allocate a date for the hearing of the application. Where an answering affidavit is delivered the applicant may apply for such allocation within 10 court days of the delivery of his replying affidavit or, if no replying affidavit is delivered, within 10 court days of the expiry of the period referred to in paragraph (g) and where such notice is delivered the applicant may apply for such allocation within 10 court days after delivery of such notice. If the applicant fails to apply to the Registrar to allocate a date within the appropriate period aforesaid, the respondent may do so immediately upon its expiry. Notice of set-down in writing of the date allocated by the Registrar shall forthwith be given by the applicant or respondent, as the case may be, to the opposite party.
 - (i) Where an application cannot properly be decided on affidavit, the Registrar may refer the matter to the High Court or make such order as to him seems meet with a view to ensuring a just and expeditious decision.
 - (j) On notice the Registrar may order to be struck out from any affidavit any matter which is scandalous, vexatious or irrelevant, with an appropriate order as to costs, including costs as between attorney and client. The Registrar shall not grant the application unless he is satisfied that the applicant will be prejudiced in his case should it not be granted.
- (3)** (a) Notwithstanding the foregoing subregulations, an interlocutory or other application incidental to pending proceedings or a pending application, including an application for an extension of time and condonation, may be brought on notice supported by such affidavits as the case may require and be set down at a time assigned by the Registrar.

- (b) If the applicant in such an application wishes to rely on particular facts not apparent from the official record, an affidavit must be filed at the Office at least 10 court days before the hearing. In the event that the applicant does not file an affidavit, it shall be presumed that he intends to rely on those facts which are properly before the Registrar. At any time within the period allowed for the filing of such an affidavit by the applicant, he may give written notification to the other party and to the Registrar that he intends to rely on the facts which are properly before the Registrar.
 - (c) After the applicant has filed his affidavit, the other party may file an answering affidavit at least seven court days before the hearing. In the event that the applicant does not file an affidavit in support of his application, the other party may file an affidavit at least seven court days before the hearing, setting out such facts as he may consider relevant.
 - (d) At least four court days before the hearing, the applicant may file an affidavit replying to any facts set out in the answering affidavit.
 - (e) A copy of an affidavit filed with the Registrar in accordance with the foregoing shall be delivered to the other party to the proceedings at its appointed address for service.
 - (f) A notice of set-down shall be served upon every party to whom notice of it is to be given at least 10 court days prior to the hearing and both parties shall pay the prescribed hearing fee on Form TM2 prior to the hearing date.
 - (g) Failure to comply with these provisions shall result in the matter being struck off the roll, and an appropriate award of costs shall be made by the Registrar.
- (4) (a) In any opposed proceedings before the Registrar in terms of this regulation which result in a hearing before the Registrar, both parties to the matter shall file heads of argument at the Office of the Registrar not later than two court days before the date which has been set down for the hearing.
- (b) Such heads of argument shall consist of a concise and succinct statement of the main points (without elaboration) intended to be argued. A list of authorities relied upon in support of each point shall also be supplied.

Non-completion

[Section 20]

20. The Registrar shall give notice in writing to the applicant on Form 0.1 of the non-completion of the registration of the trade mark.

Entry in the register

[Section 22 (1)]

- 21.(1) As soon as practicable after the expiration of three months from the date of the advertisement in the *Patent Journal* of any application, the Registrar shall, subject to the provisions of regulation 52(1) and 52(5) and subject to the provisions of section 29(1)(b) of the Act and the provisions thereto, enter the trade mark in the register and record the date of issue of the certificate of registration.

- (2) There shall be entered in the register particulars of -
- (a) all applications to register trade marks and all registrations of trade marks with the names and addresses for service of the proprietors and all registered users together with the date of registration, the date of any renewal of the registration and the date of its expiration;
 - (b) disclaimers, and conditions of registrations;
 - (c) endorsements of deeds of security and other endorsements;
 - (d) notifications of assignments, transmissions and attachments;
 - (e) any other matters relating to registered trade marks which are prescribed;
 - (f) such other particulars as the Registrar may deem necessary.

Associated marks

[Section 31]

- 22.(1)** Where a mark is registered as associated with any other mark or marks, the Registrar shall note in the register in connection with such mark the numbers of the marks with which it is associated and shall also note in the register in connection with each of the associated marks the number of the newly registered mark as being an associated mark with each of them.
- (2)** An application by a registered proprietor in terms of section 30(5) of the Act to the Registrar to dissolve the association between two or more associated trade marks shall be made on Form TM2 and shall include a statement of the grounds of the application. The registration fee for recording such dissolution shall be paid on lodgement.

Certificate of registration

[Section 29]

- 23.** Upon the registration of a trade mark the Registrar shall, as required by section 29(2) of the Act, issue to the applicant a certificate on Form 0.2.

Renewal

[Sections 11 and 37]

- 24.(1)** The notice under section 37(3) of the Act shall be sent by the Registrar not less than six months prior to the expiration of the last registration. The notice shall be on Form 0.3.
- (2)** If trade marks having the same date of registration and owned by the same proprietor and which were previously registered in different classes fall, for whatever reason, in the same class, such marks shall on renewal be consolidated into one registration having one distinguishing number and shall, for the purposes of these regulations, be deemed to be a single trade mark.
- (3)** On renewal, the Registrar shall be required to make any entries or amendments in the register in order to record changes resulting from a revised or replaced classification resulting from whatever reason.

Application for renewal by proprietor

[Sections 11 and 37]

- 25.(1)** An application to the Registrar for the renewal of the registration of a trade mark, including a variation of the class, in terms of section 11 of the Act, shall be made on Form TM5 within the period commencing six months prior to the expiration of the last registration and ending six months after the said expiration.
- (2)** Failure to pay the renewal fee before the expiration of the last registration shall attract an additional fee; and failure to pay within the time limit of regulation 25(1) shall attract a further additional fee.
- 26.** If the renewal fee has not been paid before the expiry of the period referred to in regulation 25(1) the Registrar shall advertise the fact forthwith in the *Patent Journal*. If within one month of such expiration the renewal fee upon Form TM5, together with the additional fees, is received, he may renew the registration without removing the mark from the register.
- 27.** Whenever after the expiry of the said period of one month such fees have not been paid, the Registrar may remove the mark from the register as of the date of the expiration of the last registration, but may upon payment of the renewal fee upon Form TM5, together with the additional fee, restore the mark to the register if satisfied that it is just so to do and upon such conditions as he may think fit to impose.
- 28.** Where the application for the renewal of the trade mark is not made by the registered proprietor, the Registrar, before taking any further steps, may require the applicant to

furnish within two months evidence at his authority to make such application and in the absence of such evidence may return the application and treat it as not having been received.

29. Where a trade mark has been removed from the register, the Registrar shall cause to be entered in the register a record of such removal and its cause and shall advertise the fact in the *Patent Journal*.
- 30.(1) Upon the renewal of the registration, notice on Form TM5 to that effect shall be sent to the registered proprietor at his registered address or at the address given on Form TM5, as the case may be.
(2) Thereafter, the renewal shall be advertised forthwith by the Registrar in the *Patent Journal*.

Assignment or transmission

[Sections 39 and 40]

31. Where a person becomes entitled by assignment or transmission to a registered trade mark, he may make application to the Registrar on Form TM6 to register his title and if the application is not made to register the assignment or transmission within 12 months of its effective date, a penalty specified in Schedule 1 to these regulations shall be payable in respect of each period of 12 months or portion thereof following the expiration of 12 months from the effective date.
32. An application in terms of regulation 31 shall contain the name and address of the applicant and the name and address of the person claiming to be so entitled, and in the case of a body corporate, the state or country under whose law it is incorporated, together with particulars of the instrument or a copy thereof, if any, under which he claims.
33. Where in the case of an application on Form TM6 the person applying for registration of his title does not claim under any document or instrument which is capable in itself of furnishing proof of his title, he shall, unless the Registrar otherwise directs with the application, file a statement of case setting out the facts upon which he claims to be the proprietor of the trade mark.
34. The Registrar may call on any person who applies to be registered as proprietor of a registered trade mark for such proof of title as he may require.
35. When the Registrar is satisfied as to the title of the person claiming to be registered, he shall cause him to be registered as proprietor of the trade mark in respect of the relevant goods or services and shall enter in the register his name, address and particulars of the assignment or transmission and the effective date of assignment.
36. Where pursuant to an application under regulation 31 and as the result of a division and separation of the goods or services or a division and separation of places or markets, different persons become registered separately under the same official number as subsequent proprietors of a trade mark, each of the resulting separate registrations in the name of those different persons shall be deemed to be a separate registration for the purposes of the Act and each such registration shall be given a distinguishing number by the Registrar.
37. Any person who desires to obtain the Registrar's certificate under section 39(6) of the Act shall send to the Registrar with his application on Form TM2 a statement of case in duplicate setting out the circumstances and a copy of any instrument or proposed instrument effecting the assignment or transmission. The Registrar may call for any evidence that he may consider necessary and the statement of case, if required, shall be verified by an affidavit. The Registrar may hear the applicant and any other interested

person. The Registrar shall consider the matter and issue a certificate thereon or a notification in writing of disapproval thereof, as the case may be. The Registrar shall bind and seal a copy of the statement of case to the certificate or notification.

Substitution of applicants

[Sections 39 or 46 (2)]

- 38.(1)** Notwithstanding anything contained in these regulations and subject to section 39(5) of the Act, any person may apply on Form TM6 for a substitution of applicant in respect of a trade mark which is the subject of a pending application for registration; and the Registrar may, if satisfied that there is good reason to grant the application, approve of the substitution subject to such conditions as he deems necessary.
- (2)** The application to substitute a body corporate in terms of section 46(2) of the Act for another applicant in the case of a pending application shall likewise be made on Form TM6 and dealt with in terms of subregulation (1) of this regulation.

Registered users

[Section 38]

- 39.** An application to the Registrar for the registration under section 38(6) of the Act of a person as a registered user of a registered trade mark, shall be made by the registered proprietor on Form TM7 and shall be accompanied by -
- (a) an affidavit executed by or on behalf of the proprietor confirming the particulars set out in Form TM7; or
 - (b) a certified copy of the licence agreement regulating the use of the trade mark and the relationship between the parties.
- 40.** The date of an entry of a registered user in the register shall be the date on which the application for registration as a registered user was made. In addition to the address of the registered user, the application shall include the address for service of the registered user which may be the same, or different to, that of the registered proprietor. A notification, in writing, of the registration of a registered user shall be sent to the registered proprietor of the trade mark, and shall be inserted in the *Patent Journal*.
- 41.** An application in terms of section 38(8)(a) shall be made on Form TM7 and shall be accompanied by a statement of the grounds on which it is made. If the application is made by the registered proprietor a copy of the Form TM7 and the supporting statement shall be sent to any registered user recorded against the trade mark and, if the application is made by a registered user, copies shall likewise be sent to the registered proprietor and to any other registered user.
- 42.** An application by the registered proprietor in terms of section 38(8)(b) to maintain the entry of registered user on assignment shall be made on Form TM7 and shall be accompanied by -
- (a) an affidavit confirming the facts set out in the Form TM7; or
 - (b) a certified copy of the licence agreement or agreements between the parties which regulates their relationship.

Attachment and hypothecation

[Section 41]

- 43.(1)** An attachment order in respect of a registered trade mark shall be made on Form TM6 and served on the Registrar for endorsement in the register, and copies of the order shall be served on the registered proprietor at his address for service. Proof of service on the registered proprietor shall be furnished to the satisfaction of the Registrar.

- (2) An endorsement of attachment may be removed from the register on a request made to the Registrar on Form TM6, accompanied by proof to the satisfaction of the Registrar that the attachment may so be removed. Copies of the order and Form TM6 shall be served on all interested parties appearing from the register.
- (3) The hypothecation of a registered trade mark by a deed of security shall be endorsed in the register by application on Form TM6, accompanied by the deed of security. The application shall be served on the registered proprietor and any other person recorded in the register as having an interest in the trade mark, and proof of service shall be furnished to the satisfaction of the Registrar.
- (4) The endorsement of the hypothecation may be removed from the register on application to the Registrar on Form TM6, accompanied by such proof of the termination of the hypothecation as the Registrar may require. Copies of the Form TM6 and said proof shall be served on all interested parties appearing from the register.

Amendment of register of application

[Section 16(5) or 23 or 46(1)]

- 44.(1) Applications under section 16 (5) or 46 (1) or 23 of the Act, as the case may be, to the Registrar may be made by the applicant, or the registered proprietor or registered user or, where the registered proprietor or registered user is a company in liquidation, by the liquidator and in other cases by such person as the Registrar may decide to be entitled to act in the name of the registered proprietor or the registered user. The application may be made on Form TM2.
- (2) Where such application is made, the Registrar may require any evidence on affidavit or sworn declaration or otherwise as he may think fit as to the circumstances in which the application is made.
- (3) An application to the Registrar under section 23 of the Act for the correcting of any entry in the register shall, if so required by the Registrar, be accompanied by a statement of case setting out fully the nature of the applicant's interest, the facts upon which he based his case and the relief which he seeks.
- (4) Where application is made to enter a disclaimer or memorandum relating to a trade mark, the Registrar, before deciding upon such application, may direct that the application be advertised once in the Patent Journal in order to enable any person desiring so to do to object thereto. The provisions of section 21 and the regulations relating thereto shall mutatis mutandis apply.

Alteration of mark

[Section 25]

45. Where a person desires to apply under section 25 of the Act to alter or add to a trade mark, he shall make his application, in writing, on Form TM2 and shall furnish the Registrar with two copies of the mark as it will appear when altered.
46. Before proceeding with such application, the Registrar shall direct that the application be advertised once in the Patent Journal in order to enable any person desiring so to do to object thereto. The provisions of section 21 and the regulations relating thereto shall mutatis mutandis apply.

Search

47. The Registrar, if requested so to do in writing upon form TM2, shall cause a search to be made in any class to ascertain whether any marks are on record at the date of such search which may conflict with any mark in terms of section 1 sent to him by the person requesting such search and may cause that person to be informed of the result of such search.

Caveat

- 48.(1)(a)** Any person may apply to the Registrar by lodging Form TM2 for notice to be given by the Registrar of any proceedings relating to the publication of the acceptance of a trade mark application, the registration of a trade mark or of any application for the marking of any entry in the register of trade marks which take place from the date of lodgement of Form TM2 until the date of issue of the certificate of registration of the trade mark.
- (b) Any person may apply to the Registrar by lodging Form TM2 for notice to be given by the Registrar of any proceedings relating to a registered trade mark or of any application for the making of an entry in the register of trade marks in respect of a registered trade mark which take place within 12 months from the date of lodgement of Form TM2.
- (2)** As soon as may be practicable after any such procedures are taken and in the case of an application for making an entry, before such entry is made, the Registrar shall give notice of any such proceedings to such person.

Inspection of documents

- 49.** Subject to the provisions of section 48(7) of the repealed Act, all documents filed with the Registrar pursuant to the Act, including all correspondence and notifications to or from the Registrar shall, subject to payment of the prescribed fees, be open to inspection an interested person during office hours. Any interested person may request the Registrar to furnish copies of any such documents subject to the payment of the prescribed fee.

Office hours

[Section 22(4)]

- 50.(1)** From Mondays to Fridays the Office will be open to the public from 09:00 to 15:30, except on the following days:
- (a) All days which are public holidays in terms of section 1 of the Public Holidays Act or which have been proclaimed public holidays in terms of section 2 of that Act; and
- (b) days which may from time to time be notified by the Registrar by displaying a notice in a conspicuous place at the Office.
- (2)** Whenever the last day fixed by the Act or by these regulations for doing anything shall fall on a day when the Office is not open to the public it shall be lawful to do any such thing on the day next following such excluded day or days if two or more of them occur consecutively.

Discretionary powers

[Section 47]

- 51.** Where under these regulations any person is required to do any act or thing or to sign any documents or to make any affidavit on behalf of himself or of any body corporate or any document or evidence is required to be produced to or left with the Registrar or at the Office and it is shown to the satisfaction of the Registrar that for any reasonable cause such person is unable to do such act or thing or to sign such document or make such affidavit or that such document or evidence cannot be produced or left as aforesaid, it shall be lawful for the Registrar and upon the production of such other evidence and subject to such terms as he may think fit, to dispense with any such act or thing, document, affidavit or evidence.

Extension of time and condonation

[Section 45 (3)]

- 52.(1)** Any person interested in opposing a trade mark application may request the Registrar, on written notice before the expiry of the term in which the enter opposition to the application in terms of section 21, not to issue the certificate of registration for a period of three months from the date of expiry of the aforementioned term, and the Registrar shall not do so.
- (2)** In the absence of an agreement between the parties the Registrar may, upon application on notice in terms of regulation 19 (4) and on good cause shown, make an order extending or abridging any time prescribed by these regulations or by an order of the Registrar or fixed by an order extending or abridging any time for doing any act or taking any step in connection with any proceedings of any nature whatsoever upon such terms as to him seems meet.
- (3)** Any such extension may be ordered although the application is not made until after the expiry of the time prescribed or fixed, and the Registrar, when ordering any such extension, may make such order as to the recalling, varying or cancelling of the results flowing from the terms of any order or from these regulations.
- (4)** The registrar may, on good cause shown, condone any non-compliance with these regulations.
- (5)** Where an extension has been agreed to between the parties, prior to the filing of opposition, the Registrar shall be informed by the party seeking the extension of the extension and the Registrar shall not issue the certificate of registration within the agreed extended period.

Discovery, inspection and production of documents

- 53.(1)** Any party to any proceedings before the Registrar may, at any time before the hearing of the proceedings, deliver a notice to any party in whose affidavits or sworn declarations reference is made to any document or tape recording to produce such document or tape recording for his inspection and to permit him to make a copy or transcription. Any party failing to comply with such notice shall not, save with the leave of the Registrar, use such document or tape recording in such proceedings: Provided that any other party may use such document or tape recording.
- (2)** The provisions of the rules governing procedure in the Transvaal Provincial Division of the High Court relating to discovery shall mutatis mutandis apply, in so far as the Registrar may direct, to opposed proceedings before the Registrar.

Registrar's written reasons and appeals

- 54.(1)** When any person objects to any order or decision of the Registrar he may apply on Form TM2, within three months of the date of the Registrar's order or decision, or such further time as the Registrar may allow, requiring the Registrar to state in writing the grounds of his decision and the date used by him in arriving at it. The date of such statements shall be deemed to be the date of the Registrar's order or decision for the purpose of appeal.
- (2)** All written reasons for decisions and judgements of the Registrar shall be published in the Patent Journal within three months from the date of signing by the Registrar if the Registrar so directs.

Applications to and orders of the court

- 55.(1)** Where an order has been made by the court in any matter under the Act, the person in whose favour such order has been made or such one of them, if more than one, as the Registrar may direct, shall forthwith leave at the office a copy of such order. Thereupon, the register, if necessary, shall be rectified or altered by the Registrar.
- (2)** Whenever an order is made by the court under the Act, the Registrar may, if he thinks that such order should be made public, publish it in the Patent Journal at the expense of the person in whose favour such order has been made.
- (3)** Any addition to or alteration or correction of the register shall be advertised by the Registrar (save where otherwise expressly provided) once in the Patent Journal.

Certification marks

[Section 42]

- 56.(1)** An application for the registration of a certification mark under the provisions of section 42 of the Act shall be made on Form TM1 and the provisions of regulations 11 to 14 shall mutatis mutandis apply to such application.
- (2)** In further proceedings relating to an application for the registration of a certification mark the provisions of regulation 15 shall mutatis mutandis apply.
- (3)** The application for the registration of a certification mark shall be accompanied by a statement by the applicant that he does not carry on a trade in the goods or services in respect of which registration is sought and by rules governing the use of the mark. The rules shall specify the conditions for the use of the mark, the circumstances in which the proprietor is to certify the goods or services and in respect of which characteristics of the goods or services or other aspects referred to in section 42 (1) the applicant will certify the goods or services.
- (4)** The Registrar shall consider whether the requirements mentioned in this regulation have been complied with. If, after such consideration, the Registrar accepts the application for the mark he shall notify the applicant accordingly, in writing, and thereafter the application shall mutatis mutandis proceed as an ordinary application. If it appears to the Registrar that those requirements are not met, he shall inform the applicant accordingly, in writing, and thereafter the provisions of regulation 15 (4) shall mutatis mutandis apply.
- (5)** An application for the amendment of the rules of a registered certification mark or the rules accompanying an application for the registration of a certification mark shall be made on Form TM2. The amendment sought shall be indicated by showing in square brackets all words that are to be omitted; and by underlining all words that are to be added. The applicant shall file a copy of the amended rules within one month of the approval of the rules by the Registrar. If the applicant fails to file a copy of the amended rules within the time stipulated, the application for amendment shall be deemed to have been abandoned.

Collective marks

[Section 43]

- 57.(1)** An application for the registration of a collective mark under the provisions of section 43 of the Act shall be made on Form TM1 and the provisions of regulations 11 to 14 shall mutatis mutandis apply to such application.
- (2)** In further proceedings relating to an application for the registration of a collective mark the provisions of regulation 15 shall mutatis mutandis apply.
- (3)** An application for the registration of a collective mark shall be accompanied by rules governing the use of the mark. The rules shall specify the persons authorised to use the mark, the conditions of membership of the association and, when applicable, the conditions of the use of the mark, including any sanctions against misuse.
- (4)** The Registrar shall consider whether the requirements mentioned in this regulation have been complied with. If, after such consideration, the Registrar accepts the application for the mark he shall notify the applicant accordingly, in writing, and thereafter the application shall mutatis mutandis proceed as an ordinary application. If it appears to the Registrar that those requirements are not met, he shall inform the applicant accordingly, in writing, and thereafter the provisions of regulation 15 (4) shall mutatis mutandis apply.
- (5)** An application for the amendment of the rules of a registered collective mark or the rules accompanying an application for the registration of a collective mark shall be made on Form TM2. The amendment sought shall be indicated by showing in square brackets all words that are to be omitted; and by underlining all words that are to be added. A copy of the application shall be sent to all persons authorised to use the mark. The applicant shall file a copy of the amended rules within one month of the approval of the rules by the

Registrar. If the applicant fails to file the copy of the amended rules within the time stipulated, the application for amendment shall be deemed to have been abandoned.

Certificates

[Section 22]

- 58.(1)** The Registrar, when required otherwise than under section 29 of the Act to give a certificate as to any entry, matter or thing which he is authorised by the Act or any of these regulations to make or do, may on receipt of a request, in writing, on Form TM2 give such a certificate.
- (2)** The following certificates shall be issued in respect of matters set out in the title to the forms enumerated:
- Certificate of Assignment Form: 0.4;
 - Certificate of Registration of Registered User: Form 0.3;
 - Certificate of Change of Name: Form 0.6;
 - Certificate of Extract from Register: Form 0.7;
- and the certificates may be amended as directed by the Registrar to meet any contingency.

Authentication of affidavits executed outside the Republic for use within the Republic

- 59.(1)** Any affidavit executed in any place outside the Republic shall be deemed to be sufficiently authenticated for the purposes of use in the Republic if it is duly authenticated at such foreign place by the signature and seal of office of a notary public.
- (2)** Notwithstanding anything in this regulation contained, the Registrar may accept as sufficiently authenticated any affidavit which is shown to the satisfaction of the Registrar to have been actually signed by the person purporting to have signed such affidavit.
- (3)** No document required to be filed with the Registrar in terms of these regulations shall be required to be authenticated unless the Registrar specifically otherwise directs in any particular instance.
- 60.** These regulations shall be called the Trade Mark Regulations, 1995, and shall come into operation on 1 May 1995.