

**TRADE MARKS ACT
NO. 194 OF 1993**

[ASSENTED TO 22 DECEMBER, 1993]
[DATE OF COMMENCEMENT: 1 MAY, 1995]

(Afrikaans text signed by the State President)

This Act has been updated to <i>Government Gazette</i> 37148 dated 10 December, 2013.

as amended by

Intellectual Property Laws Amendment Act, No. 38 of 1997

Companies Act, No. 71 of 2008
[with effect from 1 May, 2011]

pending amendment by

Intellectual Property Laws Amendment Act, No. 28 of 2013
(provisions not yet proclaimed)

ACT

To provide for the registration of trade marks, certification trade marks and collective trade marks; and to provide for incidental matters.

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PART I

INTRODUCTION

1. Division of Act into parts.—This Act is divided into 18 parts, which relate to the following matters respectively:

- PART I Introduction (sections 1 to 4)
- PART II Administration (sections 5 to 8)
- PART III Registrable Trade Marks (sections 9 to 15)

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(sections 43A to 43L)

(Pending amendment: S. 1 to be amended by s. 7 of Act No. 28 of 2013 and comes into operation on a date fixed by the President by proclamation in the *Gazette* – date not determined.)

(Date of commencement to be proclaimed)

PART XIII	Powers and Duties of Registrar (sections 44 to 48)
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2. Definitions.—(1) In this Act, unless the context otherwise indicates—

“**agent**” means any person whose name has been entered in the register referred to in section 8 (2), or a patent agent or an attorney;

“**assignment**” means assignment by act of the parties concerned, and “**assign**” or “**assignable**” has a corresponding meaning;

“**certification trade mark**” means a mark registered or deemed to have been registered under section 42;

“**collecting society**” means a collecting society created by the Copyright Act, this Act, or by agreement and which amongst others—

- (a) manages matters related to rights in trade marks;
 - (b) negotiates for and collects licence fees and benefits on behalf of its members; and
 - (c) distributes licence fees and benefits to trade mark owners;
- (Pending amendment: Definition of “collecting society” to be inserted by s. 8 (a) of Act No. 28 of 2013 and comes into operation on a date fixed by the President by proclamation in the *Gazette* – date not determined.)

(Date of commencement to be proclaimed)

“**collective trade mark**” means a mark registered under section 43;

“**community protocol**” means a protocol developed by an indigenous community that describes the structure of the indigenous community and its claims to indigenous cultural expressions or knowledge and indigenous terms or expressions or geographical indications, and provides procedures for prospective users of such indigenous cultural expressions or knowledge or indigenous terms or expressions or geographical indications, to seek the community’s prior informed consent, negotiate mutually agreed terms and benefit-sharing agreements;

(Pending amendment: Definition of “community protocol” to be inserted by s. 8 (b) of Act No. 28 of 2013 and comes into operation on a date fixed by the President by proclamation in the *Gazette* – date not determined.)

(Date of commencement to be proclaimed)

"Commission" means the Companies and Intellectual Property Commission, established by section 185 of the Companies Act, 2008;

[Definition of "Commission" inserted by s. 224 (2) of Act No. 71 of 2008.]

"convention country" means any country or group of countries in respect of which there is in force a proclamation under section 63 declaring such country or group of countries to be a convention country or convention countries for the purposes of this Act;

"Copyright Act" means the Copyright Act, 1978 (Act No. 98 of 1978);
(Pending amendment: Definition of "Copyright Act" to be inserted by s.8 (c) of Act No. 28 of 2013 and comes into operation on a date fixed by the President by proclamation in the *Gazette* – date not determined.)

(Date of commencement to be proclaimed)

"Council" means the National Council for Indigenous Knowledge as defined in section 1 of the Copyright Act;
(Pending amendment: Definition of "Council" to be inserted by s. 8 (c) of Act No. 28 of 2013 and comes into operation on a date fixed by the President by proclamation in the *Gazette* – date not determined.)

(Date of commencement to be proclaimed)

"court" means the Transvaal Provincial Division of the Supreme Court of South Africa, but in relation to any claim or counter-claim for removal, amendment or variation of, or other relief affecting any entry in, the register arising from or forming part of proceedings instituted in any other division of the said Supreme Court having jurisdiction in relation to the proceedings, includes that division in respect of such claim or counter-claim;

"database" means the relevant section of the National Database for Indigenous Knowledge as defined in section 1 of the Copyright Act;
(Pending amendment: Definition of "database" to be inserted by s. 8 (d) of Act No. 28 of 2013 and comes into operation on a date fixed by the President by proclamation in the *Gazette* – date not determined.)

(Date of commencement to be proclaimed)

"deed of security" means a written instrument signed by the proprietor of a registered trade mark hypothecating the registered trade mark;

"derivative indigenous term or expression" means any term or expression forming the subject of this Act, applied to any form of indigenous term or expression recognised by an indigenous community as having an indigenous or traditional origin, and a substantial part of which was derived from indigenous cultural expressions or knowledge irrespective of whether such derivative indigenous term or expression was derived before or after the commencement of the Intellectual Property Laws Amendment Act, 2013;
(Pending amendment: Definition of "derivative indigenous term or expression" to be inserted by s. 8 (e) of Act No. 28 of 2013 and comes into operation on a date fixed by the President by proclamation in the *Gazette* – date not determined.)

(Date of commencement to be proclaimed)

"device" means any visual representation or illustration capable of being reproduced upon a surface, whether by printing, embossing or by any other means;

"Fund" means the National Trust Fund for Indigenous Knowledge as defined in section 1 of the Copyright Act;
(Pending amendment: Definition of "fund" to be inserted by s. 8 (f) of Act No. 28 of 2013 and comes into operation on a date fixed by the President by proclamation in the *Gazette* – date not determined.)

(Date of commencement to be proclaimed)

“geographical indication” in as far as it relates to indigenous cultural expressions or knowledge, means an indication which identifies goods or services as originating in the territory of the Republic or in a region or locality in that territory, and where a particular quality, reputation or other characteristic of the goods or services is attributable to the geographical origin of the goods or services, including natural and human factors;

(Pending amendment: Definition of “geographical indication” to be inserted by s. 8 (f) of Act No. 28 of 2013 and comes into operation on a date fixed by the President by proclamation in the *Gazette* – date not determined.)

(Date of commencement to be proclaimed)

“indigenous community” means any recognisable community of people originated in or historically settled in a geographic area or areas located within the borders of the Republic, as such borders existed at the date of commencement of the Intellectual Property Laws Amendment Act, 2013, characterised by social, cultural and economic conditions which distinguish them from other sections of the national community, and who identify themselves and are recognised by other groups as a distinct collective;

(Pending amendment: Definition of “indigenous community” to be inserted by s. 8 (f) of Act No. 28 of 2013 and comes into operation on a date fixed by the President by proclamation in the *Gazette* – date not determined.)

(Date of commencement to be proclaimed)

“indigenous cultural expressions or knowledge” means any form, tangible or intangible, or a combination thereof, in which traditional culture and knowledge are embodied, passed on between generations, and tangible or intangible forms of creativity of indigenous communities, including, but not limited to—

- (a) phonetic or verbal expressions, such as stories, epics, legends, poetry, riddles and other narratives, words, signs, names and symbols;
- (b) musical or sound expressions, such as songs, rhythms, and instrumental music, the sounds which are the expression of rituals;
- (c) expressions by action, such as dances, plays, ceremonies, rituals, expressions of spirituality or religion, sports, traditional games, puppet performances, and other performances, whether fixed or unfixed; and
- (d) tangible expressions, such as material expressions of art, handicrafts, architecture, or tangible spiritual forms, or expressions of sacred places;

(Pending amendment: Definition of “indigenous cultural expressions or knowledge” to be inserted by s. 8 (f) of Act No. 28 of 2013 and comes into operation on a date fixed by the President by proclamation in the *Gazette* – date not determined.)

(Date of commencement to be proclaimed)

“indigenous term or expression” means a literary, artistic or musical term or expression with an indigenous or traditional origin and a traditional character, including indigenous cultural expressions or knowledge which was created by persons who are or were members, currently or historically, of an indigenous community and which is regarded as part of the heritage of the community;

(Pending amendment: Definition of “indigenous term or expression” to be inserted by s. 8 (f) of Act No. 28 of 2013 and comes into operation on a date fixed by the President by proclamation in the *Gazette* – date not determined.)

(Date of commencement to be proclaimed)

“limitation” means any limitation of the exclusive right to the use of a trade mark given by the registration thereof, including a limitation of that right as to the mode of use, as to use in relation to goods to be sold, or otherwise traded in, or as to services to be performed, in any place within the Republic, or as to use in relation to goods to be exported from the Republic;

"mark" means any sign capable of being represented graphically, including a device, name, signature, word, letter, numeral, shape, configuration, pattern, ornamentation, colour or container for goods or any combination of the aforementioned;

"Minister" means the Minister of Trade and Industry;

"National Trust" means the National Trust for Indigenous Knowledge established by section 28I of the Copyright Act and which functions as the National Trust for traditional terms or expressions in terms of section 43G;

(Pending amendment: Definition of "National Trust" to be inserted by s. 8 (g) of Act No. 28 of 2013 and comes into operation on a date fixed by the President by proclamation in the *Gazette* – date not determined.)

(Date of commencement to be proclaimed)

"Paris Convention" means the Paris Convention on the Protection of Industrial Property of 20 March 1883 as revised or amended from time to time and as acceded to by the Republic;

"patent agent" means a patent agent registered or deemed to be registered as such under the Patents Act, 1978 (Act No. 57 of 1978);

"prescribed" means prescribed by regulation;

"register" means the register of trade marks kept at the trade marks office in terms of section 22;

"registered trade mark" means a trade mark registered or deemed to be registered under this Act;

"registered user" means a person who is for the time being registered as such under section 38;

"registrar" means the Commissioner, appointed in terms of section 189 of the Companies Act, 2008; [Definition of "registrar" substituted by s. 224 (2) of Act No. 71 of 2008.]

"regulation" means any regulation made under this Act;

"repealed Act" means the Trade Marks Act, 1963 (Act No. 62 of 1963);

"services" includes the offering for sale or the sale of goods in the retail or wholesale trade;

"this Act" includes the regulations;

"trade mark", other than a certification trade mark or a collective trade mark, means a mark used or proposed to be used by a person in relation to goods or services for the purpose of distinguishing the goods or services in relation to which the mark is used or proposed to be used from the same kind of goods or services connected in the course of trade with any other person;

"traditional term or expression" includes an indigenous term or expression and a derivative indigenous term or expression;

(Pending amendment: Definition of "traditional term or expression" to be inserted by s. 8 (h) of Act No. 28 of 2013 and comes into operation on a date fixed by the President by proclamation in the *Gazette* – date not determined.)

(Date of commencement to be proclaimed)

"trade marks office" means the office of the Commission;

[Definition of "trade marks office" inserted by s. 224 (2) of Act No. 71 of 2008.]

"transmission" means transfer by operation of law, not being assignment, and **"transmit"** and **"transmissible"** have corresponding meanings.

(2) References in this Act to the use of a mark shall be construed as references to—

- (a) the use of a visual representation of the mark;
- (b) in the case of a container, the use of such container; and
- (c) in the case of a mark which is capable of being audibly reproduced, the use of an audible reproduction of the mark.

(3) (a) References in this Act to the use of a mark in relation to goods shall be construed as references to the use thereof upon, or in physical or other relation to, such goods.

(b) References in this Act to the use of a mark in relation to services shall be construed as references to the use thereof in any relation to the performance of such services.

(4) The use or proposed use of a registered trade mark shall include the use or proposed use of the trade

mark in accordance with the provisions of section 38, whether for the purposes of this Act or at common law.

3. Application of Act to trade marks registered under repealed Act.—(1) Subject to the provisions of section 70, this Act shall apply to all trade marks registered or deemed to be registered under the repealed Act, whether in Part A or Part B of the register kept under that Act.

(2) All applications and proceedings commenced under the repealed Act shall be dealt with in accordance with the provisions of that Act as if it had not been repealed.

4. Act binds State.—This Act shall bind the State.

PART II ADMINISTRATION

5.

[S. 5 repealed by s. 224 (2) of Act No. 71 of 2008.]

6. Registrar of trade marks.—(1) The Commission—

(a) may exercise the powers and must perform the duties conferred or imposed upon the registrar by this Act; and

(b) is responsible for the administration of the trade marks office.

[Sub-s. (1) substituted by s. 224 (2) of Act No. 71 of 2008.]

(2)

[Sub-s. (2) repealed by s. 224 (2) of Act No. 71 of 2008.]

(3) The Minister may appoint, whenever he may deem it necessary, a judge as defined in section 1 (1) of the Judges' Remuneration and Conditions of Employment Act, 1989 (Act No. 88 of 1989), or a judge who has been discharged from active service in terms of section 3 of the said Act, or an advocate or an attorney of the Supreme Court of South Africa, to exercise any power or to perform any duty conferred or imposed upon the registrar in terms of this Act, and for the purposes of this Act the exercise of such power or the performance of such duty shall be deemed to have been done by the registrar.

(4)

[Sub-s. (4) repealed by s. 224 (2) of Act No. 71 of 2008.]

7. Seal of trade marks office.—There shall be a seal of the trade marks office, and the impression of the seal shall be judicially noticed.

8. Unauthorized persons not to act in trade mark matters.—(1) The registrar shall permit an agent to perform on behalf of the person for whom he is agent, any act in connection with registration under this Act or any proceedings relating thereto, and shall not permit a person other than an agent so to act.

(2) There shall be kept at the trade marks office a register in which shall be entered the full names and addresses of all persons whose names and addresses were entered in the register referred to in section 8 (2) of the repealed Act.

PART III REGISTRABLE TRADE MARKS

9. Registrable trade marks.—(1) In order to be registrable, a trade mark shall be capable of distinguishing the goods or services of a person in respect of which it is registered or proposed to be registered from the goods or services of another person either generally or, where the trade mark is registered or proposed to be registered subject to limitations, in relation to use within those limitations.

(2) A mark shall be considered to be capable of distinguishing within the meaning of subsection (1) if, at the date of application for registration, it is inherently capable of so distinguishing or it is capable of distinguishing by reason of prior use thereof.

10. Unregistrable trade marks.—The following marks shall not be registered as trade marks or, if registered, shall, subject to the provisions of sections 3 and 70, be liable to be removed from the register:

(1) A mark which does not constitute a trade mark;

(2) a mark which—

(a) is not capable of distinguishing within the meaning of section 9; or

(b) consists exclusively of a sign or an indication which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin or other characteristics of the

goods or services, or the mode or time of production of the goods or of rendering of the services;
or

(c) consists exclusively of a sign or an indication which has become customary in the current language or in the *bona fide* and established practices of the trade;

- (3) a mark in relation to which the applicant for registration has no *bona fide* claim to proprietorship;
- (4) a mark in relation to which the applicant for registration has no *bona fide* intention of using it as a trade mark, either himself or through any person permitted or to be permitted by him to use the mark as contemplated by section 38;
- (5) a mark which consists exclusively of the shape, configuration, colour or pattern of goods where such shape, configuration, colour or pattern is necessary to obtain a specific technical result, or results from the nature of the goods themselves;

[Para. (5) substituted by s. 59 (a) of Act No. 38 of 1997.]

- (6) subject to the provisions of section 36 (2), a mark which, on the date of application for registration thereof, or, where appropriate, of the priority claimed in respect of the application for registration thereof, constitutes, or the essential part of which constitutes, a reproduction, imitation or translation of a trade mark which is entitled to protection under the Paris Convention as a well-known trade mark within the meaning of section 35 (1) of this Act and which is used for goods or services identical or similar to the goods or services in respect of which the trade mark is well-known and where such use is likely to cause deception or confusion;

[Para. (6) substituted by s. 59 (b) of Act No. 38 of 1997.]

- (7) a mark the application for registration of which was made *mala fide*;
- (8) (a) mark which consists of or contains the national flag of the Republic or a convention country, or an imitation from a heraldic point of view, without the authorization of the competent authority of the Republic or convention country, as the case may be, unless it appears to the registrar that use of the flag in the manner proposed is permitted without such authorization;
- (b) a mark which consists of or contains the armorial bearings or any other state emblem of the Republic or a convention country, or an imitation from a heraldic point of view, without the authorization of the competent authority of the Republic or convention country, as the case may be;
- (c) a mark which consists of or contains an official sign or hallmark adopted by the Republic or a convention country, or an imitation from a heraldic point of view, and which indicates control and warranty, in relation to goods or services of the same or a similar kind as those in relation to which it indicates control and warranty, without the authorization of the competent authority of the Republic or convention country, as the case may be;
- (d) a mark which consists of or contains the flag, the armorial bearings or any other emblem, or an imitation from a heraldic point of view, or the name, or the abbreviation of the name, of any international organization of which one or more convention countries are members, without the authorization of the organization concerned, unless it appears to the registrar that use of the flag, armorial bearings, other emblem or imitation or the name or abbreviation in the manner proposed, is not such as to suggest to the public that a connection exists between the organization and the mark, or is not likely to mislead the public as to the existence of a connection between the organization and the proprietor of the mark:

Provided that—

- (i) paragraphs (b), (c) and (d) shall apply to a state emblem and an official sign or hallmark of a convention country and an emblem, the name, or the abbreviation of the name, of an international organization only if and to the extent that—
- (aa) the convention country or international organization, as the case may be, has notified the Republic in accordance with Article 6ter of the Paris Convention that it desires to protect that emblem, official sign or hallmark, name or abbreviation, as the case may be;
- (bb) such notification remains in force; and
- (cc) the Republic has not objected to it in accordance with Article 6ter of the Paris Convention or any such objection has been withdrawn;
- (ii) paragraph (b), (c) or (d) shall apply only in relation to applications for registration made more than two months after receipt of the notification referred to in paragraph (i) (aa);
- (iii) paragraph (b) or (c) shall not prevent the registration of a trade mark by a citizen of any country who is authorized to make use of a state emblem or official sign or hallmark of that country, notwithstanding the fact that it is similar to that of another country;

[Para. (8) substituted by s. 59 (c) of Act No. 38 of 1997.]

- (9) a mark which contains any word, letter or device indicating State patronage;

- (10) a mark which contains any mark specified in the regulations as being for the purposes of this section a prohibited mark;
- (11) a mark which consists of a container for goods or the shape, configuration, colour or pattern of goods, where the registration of such mark is or has become likely to limit the development of any art or industry;
- (12) a mark which is inherently deceptive or the use of which would be likely to deceive or cause confusion, be contrary to law, be *contra bonos mores*, or be likely to give offence to any class of persons;
- (13) a mark which, as a result of the manner in which it has been used, would be likely to cause deception or confusion;
- (14) subject to the provisions of section 14, a mark which is identical to a registered trade mark belonging to a different proprietor or so similar thereto that the use thereof in relation to goods or services in respect of which it is sought to be registered and which are the same as or similar to the goods or services in respect of which such trade mark is registered, would be likely to deceive or cause confusion, unless the proprietor of such trade mark consents to the registration of such mark;
- (15) subject to the provisions of section 14 and paragraph (16), a mark which is identical to a mark which is the subject of an earlier application by a different person, or so similar thereto that the use thereof in relation to goods or services in respect of which it is sought to be registered and which are the same as or similar to the goods or services in respect of which the mark in respect of which the earlier application is made, would be likely to deceive or cause confusion, unless the person making the earlier application consents to the registration of such mark;
- (16) a mark which is the subject of an earlier application as contemplated in paragraph (15), if the registration of that mark is contrary to existing rights of the person making the later application for registration as contemplated in that paragraph;
- (17) a mark which is identical or similar to a trade mark which is already registered and which is well-known in the Republic, if the use of the mark sought to be registered would be likely to take unfair advantage of, or be detrimental to, the distinctive character or the repute of the registered trade mark, notwithstanding the absence of deception or confusion, unless the proprietor of such trade mark consents to the registration of such mark:

[Para. (17) substituted by s. 59 (d) of Act No. 38 of 1997.]

Provided that a mark shall not be refused registration by virtue of the provisions of paragraph (2) or, if registered, shall not be liable to be removed from the register by virtue of the said provisions if at the date of the application for registration or at the date of an application for removal from the register, as the case may be, it has in fact become capable of distinguishing within the meaning of section 9 as a result of use made of the mark.

11. Registration to be in respect of particular goods or services.—(1) A trade mark shall be registered in respect of goods or services falling in a particular class or particular classes in accordance with the prescribed classification: Provided that the rights arising from the registration of a trade mark shall be determined in accordance with the prescribed classification applicable at the date of registration thereof.

(2) Where a trade mark has, either before or after the commencement of this Act, been registered as contemplated in subsection (1) and, during the subsistence of that registration, the prescribed classification in accordance with which the trade mark was registered as aforesaid is revised or is replaced by a new classification, the proprietor of the trade mark may, at any time, apply in the prescribed manner for revision, in accordance with the revised or new classification, of the class or classes in which the trade mark is registered.

[Sub-s. (2) substituted by s. 60 of Act No. 38 of 1997.]

(3) If the revised or new classification referred to in subsection (2) results in two or more identical trade marks owned by the same proprietor which were under the previous registration registered in separate classes, falling within a single class, such marks shall, if they have the same registration date, be consolidated as one registration in the revised or new class, or if as a result of the revised or new classification a trade mark is required to be recorded in more than one class, such mark shall be deemed to be separately registered in each such class and shall be treated as a separate trade mark for the purposes of renewal thereof in each class.

12. Name or representation of person.—Where application is made for registration of a trade mark which consists of or includes the name or representation of a person, the registrar may require the applicant to furnish him with the consent of that person or, where such person is deceased, of his legal representative, to the name or representation appearing in the trade mark.

13.

[S. 13 repealed by s. 61 of Act No. 38 of 1997.]

14. Honest concurrent use.—(1) In the case of honest concurrent use or of other special circumstances which may make it proper to do so, the registrar may, on application in the prescribed manner, register, subject to such conditions and limitations, if any, as he may think fit to impose, a trade mark the registration of which would otherwise offend against the provisions of paragraph (6), (14), (15) or (17) of section 10.

(2) In the case of a trade mark which is sought to be removed from the register on the ground that it offends against the provisions of paragraph (6), (14), (15) or (17) of section 10, the court or the registrar, as the case may be, may, in the case of honest concurrent use or of other special circumstances which make it proper to do so, refuse to remove the trade mark from the register.

15. Registration subject to disclaimer.—If a trade mark contains matter which is not capable of distinguishing within the meaning of section 9, the registrar or the court, in deciding whether the trade mark shall be entered in or shall remain on the register, may require, as a condition of its being entered in or remaining on the register—

- (a) that the proprietor shall disclaim any right to the exclusive use of all or any portion of any such matter to the exclusive use of which the registrar or the court holds him not to be entitled; or
- (b) that the proprietor shall make such other disclaimer or memorandum as the registrar or the court may consider necessary for the purpose of defining his rights under the registration:

Provided that no disclaimer or memorandum on the register shall affect any rights of the proprietor of a trade mark except such as arise out of the registration of the trade mark in respect of which the disclaimer is made.

PART IV APPLICATION FOR REGISTRATION

16. Application for registration.—(1) An application for registration of a trade mark shall be made to the registrar in the prescribed manner.

(2) Subject to the provisions of this Act, the registrar shall—

- (a) accept;
- (b) accept, subject to such amendments, modifications, conditions or limitations, as he may deem fit;
- (c) provisionally refuse; or
- (d) refuse,

the application.

(3) The registrar shall advise an applicant for registration in writing within a reasonable period from the date of the application of his decision in terms of subsection (2).

(4) In the case of an acceptance in terms of subsection (2) (b) or a refusal in terms of subsection (2) (d), the registrar shall, on application by the applicant in the prescribed manner, state in writing the grounds for his decision.

(5) The registrar or the court, as the case may be, may at any time, whether before or after acceptance of the application, correct any error in or in connection with the application, or may permit the applicant to amend his application upon such conditions as the registrar or the court, as the case may be, may think fit.

17. Advertisement of accepted application.—When an application for registration of a trade mark has been accepted, the applicant shall, as soon as may be after acceptance, cause the application as accepted to be advertised in the prescribed manner.

18. Registration of parts of trade marks.—(1) Where the proprietor of a trade mark claims to be entitled to the exclusive use of any part thereof separately, he may apply to register the whole and any such part as separate trade marks.

(2) Each such separate trade mark must satisfy all the requirements for registration of a trade mark under this Act and shall for all purposes be a registered trade mark.

19. Proposed use of trade mark by body corporate to be established.—(1) No application for the registration of a trade mark in respect of any goods or services shall be refused, nor shall acceptance thereof be withheld, on the ground only that the applicant does not use or propose to use the trade mark, if the registrar is satisfied that a body corporate is about to be established and that the applicant intends to assign the trade mark to the body corporate with a view to the use thereof in relation to those goods or services by the body corporate: Provided that the trade mark shall only be registered once the registrar has been placed in a position to register the assignment in terms of section 40 simultaneously with the registration of the trade mark.

(2) For the purposes of subsection (1) (a) of section 27 the intention referred to in that subsection shall, in relation to a trade mark registered by virtue of subsection (1) of this section, be an intention on the part of the applicant that the trade mark be used by the body corporate concerned.

20. Non-completed applications.—(1) If, by reason of default on the part of the applicant, after acceptance of the application, the registration of a trade mark has not been completed within six months from the date of such acceptance, the registrar shall give notice of the non-completion to the applicant, and, if at the expiration of two months from that notice or of such further time as the registrar may allow, the registration is not completed, the application shall be deemed to have been abandoned.

(2) If the application is refused or is conditionally accepted and the applicant, having been advised of the

registrar's objection to the application, or of his conditions for acceptance, fails to take such steps as are available to him under this Act within three months of the date of such advice, or such further time as the registrar may allow, the application shall be deemed to have been abandoned.

PART V OPPOSITION

21. Opposition to registration.—Any interested person may, within three months from the date of the advertisement of an application in terms of section 17 or within such further time as the registrar may allow, oppose the application in the manner prescribed.

PART VI REGISTER OF TRADE MARKS

22. Register.—(1) There shall be kept at the trade marks office a register of trade marks, in a form decided by the registrar, in which shall be entered the prescribed particulars.

(2) The register kept under the repealed Act and existing at the commencement of this Act shall be incorporated with and form part of the register kept under this Act.

(3) The register shall comprise all trade marks which are registered or are deemed to be registered under this Act.

(4) The register shall be open at all convenient times during office hours to inspection by the public.

(5) A certified copy of an entry in the register shall be given to any person who applies for such a copy in the prescribed manner.

23. Amendment of register.—(1) The registrar may correct any error in the register made by an official of his office.

(2) The registrar may, on request made in the prescribed manner by the registered proprietor of a trade mark, amend or alter the register by—

- (a) correcting any error in the name or address of the registered proprietor of the trade mark or any error in the register relating to such trade mark;
- (b) altering the name or address or address for service of the registered proprietor who has changed his name or address or address for service;
- (c) cancelling the registration of the trade mark;
- (d) deleting any goods or services or classes of goods or services from those in respect of which the trade mark is registered; or
- (e) entering a disclaimer or memorandum relating to the trade mark which does not in any way extend the rights given by the registration of the trade mark.

(3) The registrar may, on request made in the prescribed manner by the registered proprietor or a registered user of a trade mark, enter in the register any change in the name or address of such registered user.

24. General power to rectify entries in register.—(1) In the event of non-insertion in or omission from the register of any entry, or of an entry wrongly made in or wrongly remaining on the register, or of any error or defect in any entry in the register, any interested person may apply to the court or, at the option of the applicant and subject to the provisions of section 59, in the prescribed manner, to the registrar, for the desired relief, and thereupon the court or the registrar, as the case may be, may make such order for making, removing or varying the entry as it or he may deem fit.

(2) The court or the registrar, as the case may be, may in any proceedings under this section decide any question that may be necessary or expedient to decide in connection with the rectification of the register.

(3) In the event of the registrar being satisfied that any entry relating to the registration, assignment or transmission of a trade mark has been secured *mala fide* or by misrepresentation or that any such entry was wrongly made or wrongly remains on the register, he shall also have *locus standi* to apply to the court under the provisions of this section.

25. Alteration of registered trade mark.—(1) The registered proprietor of a trade mark may apply in the prescribed manner to the registrar for leave to add to or alter the trade mark in any manner not substantially affecting the identity thereof, and the registrar may refuse leave or may grant it on such terms and subject to such limitations as he may think fit.

(2) (a) The registrar shall require the applicant to advertise the grant of the application in the prescribed manner.

(b) Any interested person may, within three months from the date of the advertisement or such further period as the registrar may allow, object in the prescribed manner, to the grant of the application.

26. Power to remove or vary registration for breach of condition.—(1) Any interested person may apply for the removal from the register, or a variation, of a registered trade mark if its proprietor or any person permitted to use it in terms of section 38 fails to comply with any condition entered in the register in relation to its registration.

(2) Such application may be made to the court or to the registrar.

(3) The registrar has *locus standi* to make such application to the court.

(4) The registrar or the court may make such order for removing or varying the registration of the trade mark as he or it may deem fit.

27. Removal from register on ground of non-use.—(1) Subject to the provisions of section 70 (2), a registered trade mark may, on application to the court, or, at the option of the applicant and subject to the provisions of section 59 and in the prescribed manner, to the registrar by any interested person, be removed from the register in respect of any of the goods or services in respect of which it is registered, on the ground either—

(a) 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 that 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;

(b) that up to the date three months before the date of the application, a continuous period of five years or longer has elapsed from the date of issue of the certificate of registration during which the trade mark was registered 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

(c) 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 was 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.

[Sub-s. (1) amended by s. 62 (a) of Act No. 38 of 1997.]

(2) The registrar or the court may refuse an application made under paragraph (c) of subsection (1) in relation to any goods or services if it is shown that the trade mark is used or proposed to be used in relation to such goods or services by a successor in title of the registered proprietor.

(3) In the case of an application in terms of paragraph (a) or (b) of subsection (1) the onus of proving, if alleged, that there has been relevant use of the trade mark shall rest upon the proprietor thereof.

(4) An applicant shall not be entitled to rely for the purposes of paragraph (b) of subsection (1) on any non-use of a trade mark 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.

(5) Subsection (1) (a) and (b) does not apply to a trade mark in respect of which protection may be claimed under the Paris Convention as a well-known trade mark within the meaning of section 35 (1) of this Act.

[Sub-s. (5) added by s. 62 (b) of Act No. 38 of 1997.]

28. Date of removal and partial removal.—(1) Any order granted by the registrar or the court in relation to any entry in or omission from the register shall be deemed to operate from—

(a) the date of the application for such order; or

(b) if the registrar or the court, as the case may be, is satisfied that grounds for such order existed at an earlier date, that date.

(2) Where under this Act any grounds for the removal of the registration of a trade mark exist in respect of only some of the goods or services for which the trade mark is registered, the removal shall relate to those goods or services only.

PART VII REGISTRATION AND ITS EFFECTS

29. Registration.—(1) When an application for registration of a trade mark has been accepted and advertised in the prescribed manner and either—

(a) the application has not been opposed and the time for notice of opposition has expired; or

(b) the application has been opposed and has been granted,

the registrar shall register the trade mark as on the date of the lodging of the application for registration, and that date shall, subject to the provisions of section 63, for the purposes of this Act be deemed to be the date of registration: Provided that where it appears to the registrar, having regard to matters which came to his notice

after acceptance of an application, that the trade mark has been accepted in error, he may withdraw the acceptance and proceed as if the application had not been accepted.

(2) On the registration of a trade mark, the registrar shall issue to the applicant a certificate in the prescribed form of the registration thereof sealed with the seal of the trade marks office.

30. Certain trade marks to be associated so as to be assignable and transmissible as a whole only.—

(1) Where a trade mark that is registered or is the subject of an application for registration so resembles another trade mark that is registered or is the subject of an application for registration in the name of the same proprietor that the use of both such trade marks by different persons in relation to goods or services in respect of which they are respectively registered or proposed to be registered would be likely to deceive or cause confusion, the registrar may at any time require that the trade marks be entered in the register as associated trade marks.

(2) Where a trade mark and any part or parts thereof are, by virtue of subsection (1) of section 18, registered as separate trade marks in the name of the same proprietor, they shall be deemed to be, and shall be registered as, associated trade marks.

(3) Any association of a trade mark with any other trade mark registered in the name of the same proprietor shall be deemed to be an association with all trade marks associated with that other trade mark.

[Sub-s. (3) substituted by s. 63 of Act No. 38 of 1997.]

(4) Trade marks that are registered as, or that are deemed by virtue of this Act to be, associated trade marks shall only be assignable or transmissible together and not separately, but they shall for all other purposes be deemed to have been registered as separate marks.

(5) On application made in the prescribed manner by the registered proprietor of two or more trade marks registered as associated trade marks, the registrar may dissolve the association as regards any of them if he is satisfied that there would be no likelihood of deception or confusion being caused if that trade mark were used by another person in relation to any of the goods or services in respect of which it is registered, and may amend the register accordingly.

31. Use of one associated or substantially identical trade mark equivalent to use of another.—(1) When under the provisions of this Act use of a registered trade mark is required to be proved for any purpose, the registrar or the court, as the case may be, may, if and so far as he or it deems fit, accept proof of the use of an associated registered trade mark or of the trade mark with additions or alterations not substantially affecting its identity, as equivalent to proof of the use required to be proved.

(2) The use of the whole of a registered trade mark shall for the purposes of this Act be deemed to be the use also of any registered trade mark being a part thereof and registered in the name of the same proprietor by virtue of subsection (1) of section 18.

32. Limitation of trade mark as to particular colours.—(1) A trade mark may be limited in whole or in part to a particular colour or colours, and in case of any application for the registration of a trade mark the fact that the trade mark is so limited shall be taken into consideration in deciding whether it is capable of distinguishing.

(2) If and in so far as a trade mark is registered without limitation of colour, it shall be deemed to be registered for all colours.

PART VIII
INFRINGEMENT

33. Registration a condition precedent to an action for infringement.—No person shall be entitled to institute any proceedings under section 34 in relation to a trade mark not registered under this Act: Provided that nothing in this Act shall affect the rights of any person, at common law, to bring any action against any other person.

34. Infringement of registered trade mark.—(1) The rights acquired by registration of a trade mark shall be infringed by—

- (a) the unauthorized use in the course of trade in relation to goods or services in respect of which the trade mark is registered, of an identical mark or of a mark so nearly resembling it as to be likely to deceive or cause confusion;
- (b) the unauthorized use of a mark which is identical or similar to the trade mark registered, in the course of trade in relation to goods or services which are so similar to the goods or services in respect of which the trade mark is registered, that in such use there exists the likelihood of deception or confusion;
- (c) the unauthorized use in the course of trade in relation to any goods or services of a mark which is identical or similar to a trade mark registered, if such trade mark is well known in the Republic and the use of the said mark would be likely to take unfair advantage of, or be detrimental to, the distinctive character or the repute of the registered trade mark, notwithstanding the absence of confusion or deception: Provided that the provisions of this paragraph shall not apply to a trade mark referred to in section 70 (2).

(2) A registered trade mark is not infringed by—

- (a) any *bona fide* use by a person of his own name, the name of his place of business, the name of any of his predecessors in business, or the name of any such predecessor's place of business;
- (b) the use by any person of any *bona fide* description or indication of the kind, quality, quantity, intended purpose, value, geographical origin or other characteristics of his goods or services, or the mode or time of production of the goods or the rendering of the services;
- (c) the *bona fide* use of the trade mark in relation to goods or services where it is reasonable to indicate the intended purpose of such goods, including spare parts and accessories, and such services;
- (d) the importation into or the distribution, sale or offering for sale in the Republic of goods to which the trade mark has been applied by or with the consent of the proprietor thereof;
- (e) the *bona fide* use by any person of any utilitarian features embodied in a container, shape, configuration, colour or pattern which is registered as a trade mark;
- (f) the use of a trade mark in any manner in respect of or in relation to goods to be sold or otherwise traded in, or services to be performed, in any place, or in relation to goods to be exported to any market, or in any other manner in relation to which, having regard to any conditions or limitations entered in the register, the registration does not extend;
- (g) the use of any identical or confusingly or deceptively similar trade mark which is registered:

Provided that paragraph (a) shall not apply to the name of any juristic person whose name was registered after the date of registration of the trade mark: Provided further that the use contemplated in paragraph (a), (b) or (c) is consistent with fair practice.

(3) Where a trade mark registered in terms of this Act has been infringed, any High Court having jurisdiction may grant the proprietor the following relief, namely—

- (a) an interdict;
- (b) an order for removal of the infringing mark from all material and, where the infringing mark is inseparable or incapable of being removed from the material, an order that all such material be delivered up to the proprietor;
- (c) damages, including those arising from acts performed after advertisement of the acceptance of an application for registration which, if performed after registration, would amount to infringement of the rights acquired by registration;
- (d) in lieu of damages, at the option of the proprietor, a reasonable royalty which would have been payable by a licensee for the use of the trade mark concerned, including any use which took place after advertisement of the acceptance of an application for registration and which, if taking place after registration, would amount to infringement of the rights acquired by registration.

[Sub-s. (3) amended by s. 64 (a) of Act No. 38 of 1997. Para. (d) substituted by s. 64 (b) of Act No. 38 of 1997.]

(4) For the purposes of determining the amount of any damages or reasonable royalty to be awarded under this section, the court may direct an enquiry to be held and may prescribe such procedures for conducting such enquiry as it may deem fit.

(5) Before a person institutes proceedings in terms of this section he shall give notice in writing of his intention to do so to every user concerned whose name is recorded in the register, and any such registered user shall be entitled to intervene in such proceedings and to recover any damages he may have suffered as a result of the infringement.

35. Protection of well-known marks under Paris Convention.—(1) References in this Act to a trade mark which is entitled to protection under the Paris Convention as a well-known trade mark, are to a mark which is well known in the Republic as being the mark of—

- (a) a person who is a national of a convention country; or
- (b) a person who is domiciled in, or has a real and effective industrial or commercial establishment in, a convention country,

whether or not such person carries on business, or has any goodwill, in the Republic.

(1A) In determining for the purposes of subsection (1) whether a trade mark is well-known in the Republic, due regard shall be given to the knowledge of the trade mark in the relevant sector of the public, including knowledge which has been obtained as a result of the promotion of the trade mark.

[Sub-s. (1A) inserted by s. 65 (a) of Act No. 38 of 1997.]

(2) A reference in this Act to the proprietor of such a mark shall be construed accordingly.

(3) The proprietor of a trade mark which is entitled to protection under the Paris Convention as a well-known trade mark is entitled to restrain the use in the Republic of a trade mark which constitutes, or the essential part of which constitutes, a reproduction, imitation or translation of the well-known trade mark in relation to goods or services which are identical or similar to the goods or services in respect of which the trade mark is well known and where the use is likely to cause deception or confusion.

(4) Where, by virtue of section 10 (8), the authorization of the competent authority of a convention country or an international organization is required for the registration of a mark as a trade mark, such authority or organization is entitled to restrain the use in the Republic of such a mark without such authorization.

[Sub-s. (4) added by s. 65 (b) of Act No. 38 of 1997.]

36. Saving of vested rights.—(1) Nothing in this Act shall allow the proprietor of a registered trade mark to interfere with or restrain the use by any person of a trade mark identical with or nearly resembling it in respect of goods or services in relation to which that person or a predecessor in title of his has made continuous and *bona fide* use of that trade mark from a date anterior—

- (a) to the use of the first-mentioned trade mark in relation to those goods or services by the proprietor or a predecessor in title of his; or
- (b) to the registration of the first-mentioned trade mark in respect of those goods or services in the name of the proprietor or a predecessor in title of his,

whichever is the earlier, or to object (on such use being proved) to the trade mark of that person being registered in respect of those goods or services under section 14.

(2) Nothing in this Act shall allow the proprietor of a trade mark entitled to protection of such trade mark under the Paris Convention as a well-known trade mark, to interfere with or restrain the use by any person of a trade mark which constitutes, or the essential parts of which constitute, a reproduction, imitation or translation of the well-known trade mark in relation to goods or services in respect of which that person or a predecessor in title of his has made continuous and *bona fide* use of the trade mark from a date anterior to 31 August 1991 or the date on which the trade mark of the proprietor has become entitled, in the Republic, to protection under the Paris Convention, whichever is the later, or to object (on such use being proved) to the trade mark of that person being registered in relation to those goods or services under section 14.

PART IX DURATION AND RENEWAL OF REGISTRATION

37. Duration and renewal of registration.—(1) The registration of a trade mark shall be for a period of 10 years, but may be renewed from time to time in accordance with the provisions of this section.

(2) The registrar shall, on application made by the registered proprietor of a registered trade mark in the prescribed manner and within the prescribed period, renew the registration of the trade mark for a period of 10 years from the date of expiration of the original registration or of the last renewal of registration, as the case may be, which date is in this section referred to as “the expiration of the last registration”: Provided that, in the case of an application made in terms of section 63, the date of the original registration shall, for the purposes of this subsection, be deemed to be the date of lodgement of the application at the trade marks office.

(3) At the prescribed time before the expiration of the last registration of a trade mark, the registrar shall send notice in the prescribed manner to the registered proprietor at his address for service of the date of expiration and the conditions as to payment of fees and otherwise upon which a renewal of registration may be obtained, and, if at the expiration of the time prescribed those conditions have not been duly complied with, the registrar may remove the trade mark from the register subject to such conditions, if any, as to its restoration to the register as may be prescribed.

(4) Where a trade mark has been removed from the register for non-payment of the fee for renewal, it shall, nevertheless, for the purpose of any application for the registration of a trade mark during one year next following the date of the expiration of the last registration, be deemed to be a trade mark that is already on the register: Provided that the foregoing provisions of this subsection shall not have effect where the registrar is satisfied that there has been no *bona fide* use of the trade mark that has been removed during the two years immediately preceding the date of the expiration of the last registration.

PART X PERMITTED USE AND REGISTERED USERS

38. Permitted use and registered users.—(1) Where a registered trade mark is used by a person other than the proprietor thereof with the licence of the proprietor, such use shall be deemed to be permitted use for the purposes of subsection (2).

(2) The permitted use of a trade mark referred to in subsection (1) shall be deemed to be use by the proprietor and shall not be deemed to be use by a person other than the proprietor for the purposes of section 27 or for any other purpose for which such use is material under this Act or at common law.

(3) Subject to the provisions of this section, a person, other than the proprietor of a registered trade mark, who uses such trade mark with the licence of the proprietor, may be registered as a registered user thereof in respect of all or any of the goods or services in respect of which the trade mark is registered.

(4) Subject to any agreement subsisting between the parties, a registered user of a registered trade mark shall be entitled to call upon the proprietor thereof to institute infringement proceedings, and, if the proprietor refuses or neglects to do so within two months after being so called upon, the registered user may institute proceedings, as contemplated in section 34, in his own name as if he were the proprietor, citing the proprietor as a co-defendant, but a proprietor so cited shall not be liable for any costs unless he enters an appearance and takes

part in the proceedings.

(5) In all proceedings relating to a registered trade mark, the registration of a person as a registered user shall be *prima facie* evidence that the use of the registered trade mark by him is permitted use as contemplated by subsection (1).

(6) Where it is proposed that a person shall be registered as a registered user of a trade mark, the proprietor shall apply in writing to the registrar in the prescribed manner giving particulars of—

- (a) the name and address of the proposed registered user;
- (b) the relationship, existing or proposed, between the proprietor and the proposed registered user; and
- (c) the goods or services in respect of which the person is to be registered as a registered user of the trade mark.

(7) When the requirements of subsection (6) have been complied with, the registrar shall register the proposed registered user as a registered user in respect of the relevant goods or services.

(8) Without derogating from the provisions of section 24, the registration of a person as a registered user—

- (a) may be cancelled or varied by the registrar on application in writing in the prescribed manner by the registered proprietor or by such registered user or by any other registered user of the trade mark;
- (b) shall be cancelled by the registrar where the trade mark in respect of which such person has been registered has been assigned and application has in terms of section 40 been made for registration of the assignment, unless the subsequent proprietor registered in terms of the said section requests the registrar in the prescribed manner not to cancel any such registration and furnishes the registrar with the particulars referred to in paragraph (b) of subsection (6).

(9) The registrar may at any time cancel the registration of a person as a registered user of a trade mark, in respect of any goods or services in respect of which the trade mark is no longer registered.

(10) The provisions of this section shall also apply to all trade marks registered under the repealed Act.

PART XI ASSIGNMENT AND HYPOTHECATION

39. Powers of, and restrictions on, assignment and transmission.—(1) Subject to any rights appearing from the register, a registered trade mark is assignable and transmissible, either in connection with or without the goodwill of the business concerned in the goods or services in respect of which it has been registered.

(2) A registered trade mark is assignable and transmissible in respect of all or some of the goods or services in respect of which it is registered.

(3) The assignment or transmission of a registered trade mark shall be subject to any deed of security hypothecating it.

(4) If, as a result of the assignment or transmission of a registered trade mark, the use of the trade mark by different persons in the Republic or elsewhere would give rise to the likelihood of deception or confusion, section 10 (13) shall apply.

[Sub-s. (4) substituted by s. 66 (a) of Act No. 38 of 1997.]

(5) Notwithstanding anything to the contrary contained in subsections (1) and (2) and subject to the provisions of subsection (4), where a trade mark which is the subject of a pending application for registration has subsequent to the date of the application been assigned or transmitted, the registrar may, on application in the prescribed manner, and subject to such conditions as he may deem necessary, allow the person entitled to such trade mark by reason of such assignment or transmission, to be substituted as applicant for registration of the trade mark.

(6)

[Sub-s. (6) deleted by s. 66 (b) of Act No. 38 of 1997.]

(7) No assignment of a registered trade mark or a trade mark which is the subject of an application for registration shall be of any force or effect unless it is in writing and signed by or on behalf of the assignor.

40. Registration of assignments and transmissions.—(1) Where a person becomes entitled by assignment or transmission to a registered trade mark, he shall make application on the form prescribed to the registrar to register his title, and the registrar shall on receipt of the application and of proof of title to his satisfaction, register him as the proprietor of the trade mark and shall cause particulars of the assignment or transmission to be entered in the register.

(2) Every application to register an assignment or transmission in terms of subsection (1) shall recite the effective date of such assignment or transmission, and if application is made more than 12 months after such date, the applicant shall be liable to pay such penalty as may be prescribed.

41. Hypothecation and attachment.—(1) A registered trade mark may be hypothecated by a deed of security.

(2) A registered trade mark may be attached to found or confirm jurisdiction for the purposes of any

proceedings before the Transvaal Provincial Division of the Supreme Court of South Africa or the magistrate's court for the district of Pretoria and may be attached and sold in execution pursuant to an order of any such court.

(3) (a) Where a deed of security has been lodged with the registrar in the prescribed manner, the registrar shall endorse the register to that effect.

(b) Such endorsement shall record the name and address of the person in whose favour the deed of security has been granted and the nature and duration thereof.

(4) A deed of security in respect of which an endorsement has been made in accordance with the provisions of subsection (3) shall have the effect of a pledge of the trade mark to the person or persons in whose favour the deed of security has been granted.

(5) An assignment or transmission of a registered trade mark in respect of which a deed of security has been endorsed in terms of subsection (3) shall not, without the written consent of the person in whose favour the deed of security has been granted, be registered by the registrar in terms of section 40.

(6) Where the debt or obligation secured by a deed of security in respect of which the register has been endorsed in terms of subsection (3) has been discharged, any person may apply to the registrar in the prescribed manner for the removal from the register of any endorsement in relation thereto made under subsection (3).

PART XII CERTIFICATION TRADE MARKS AND COLLECTIVE TRADE MARKS

42. Certification trade marks.—(1) A mark capable of distinguishing, in the course of trade, goods or services certified by any person in respect of kind, quality, quantity, intended purpose, value, geographical origin or other characteristics of the goods or services, or the mode or time of production of the goods or of rendering of the services, as the case may be, from goods or services not so certified, shall, on application in the prescribed manner, be registrable as a certification trade mark in respect of such first-mentioned goods or services, in the name, as proprietor thereof, of that person: Provided that a mark may not be so registered in the name of a person who carries on a trade in the goods or services in respect of which registration is sought.

(2) Subject to the provisions of this section, the provisions of this Act shall, except in so far as is otherwise provided, and in so far as they can be applied, apply to a certification trade mark.

43. Collective trade marks.—(1) A mark capable of distinguishing, in the course of trade, goods or services of persons who are members of any association from goods or services of persons who are not members thereof, shall, on application in the manner prescribed and subject to the provisions of this section, be registrable as a collective trade mark in respect of such first-mentioned goods or services in the name of such association as the proprietor thereof.

(2) Geographical names or other indications of geographical origin may be registered as collective trade marks.

(3) Subject to the provisions of this section, the provisions of this Act shall, except in so far as is otherwise provided, and in so far as they can be applied, apply to a collective trade mark.

PART XIII CERTIFICATION TRADE MARKS AND COLLECTIVE TRADE MARKS (Pending amendment: Part XIII to be inserted by s. 9 of Act No. 28 of 2013 and comes into operation on a date fixed by the President by proclamation in the *Gazette* – date not determined.)

(Date of commencement to be proclaimed)

43A. Application to traditional terms and expressions and geographical indications.—(1) Subject to Part XIII, the provisions of this Act shall, except in so far as is otherwise provided in the said Part XIII, and in so far as they can be applied, apply to traditional terms and expressions and geographical indications.

(2) Nothing in the sections contemplated in subsection (1) shall be construed as conferring any rights on any person in respect of intellectual property which is not a traditional term or expression.

(Pending amendment: S. 43A to be inserted by s. 9 of Act No. 28 of 2013
and comes into operation on a date fixed by the President by proclamation in
the *Gazette* – date not determined.)

(Date of commencement to be proclaimed)

43B. Registrable traditional trade marks.—(1) Subject to this section and subject to any rights in respect of a traditional term or expression acquired by any person prior to the commencement of the Intellectual Property Laws

Amendment Act, 2013, a traditional term or expression shall not be capable of constituting a trade mark.

(2) A traditional term or expression shall be capable of constituting—

- (a) a certification trade mark or a collective trade mark; or
- (b) a geographical indication.

(3) In order to be registrable as a certification or collective trade mark, a traditional term or expression shall be capable of distinguishing the goods or services of an indigenous community in respect of which it is registered or proposed to be registered, from the goods or services of another community or person, either generally or where the traditional term or expression is registered or proposed to be registered subject to limitations, in relation to use within those limitations.

(4) Geographical indications or other marks of geographical origin may be registered as certification marks: Provided that the registrars of patents, copyright, trade marks and designs shall clearly indicate in the register that the certification mark is a geographical indication.

(5) Geographical indications or other marks of geographical origin may be registered as collective trade marks: Provided that the registrars of patents, copyright, trade marks and designs shall clearly indicate in the register that the collective mark is a geographical indication.

(6) No right in respect of a derivative indigenous term or expression or knowledge provided for in the Intellectual Property Laws Amendment Act, 2011, shall be eligible for registration unless—

- (a) prior informed consent has been obtained from the relevant authority or indigenous community;
- (b) disclosure of the indigenous cultural expressions or knowledge has been made to the Commission; and
- (c) a benefit-sharing agreement between the applicant and the relevant authority or indigenous community has been concluded.

(7) If an indigenous community has established a community protocol, the interaction with the indigenous community contemplated in subsection (6) must take such community protocol into account.

(8) A traditional term or expression or geographical indication shall only be registrable as per this section if—

- (a) the traditional term or expression or geographical indication is a derivative indigenous term or expression or geographical indication and was created on or after the date of commencement of the Intellectual Property Laws Amendment Act, 2013, and the community from which the term or expression, or a substantial part thereof originated, is or was an indigenous community when the term or expression was created; or
- (b) the traditional term or expression or geographical indication was passed down from a previous generation.

(Pending amendment: S. 43B to be inserted by s. 9 of Act No. 28 of 2013 and comes into operation on a date fixed by the President by proclamation in the *Gazette* - date not determined.)

(Date of commencement to be proclaimed)

43C. Unregistrable traditional trade marks.—(1) The following traditional terms and expressions and geographical indications shall not be registrable as trade marks, or, if registered, shall, subject to any rights in respect of a traditional term or expression acquired by any person prior to the commencement of the Intellectual Property Laws Amendment Act, 2013, and subject to the provisions of sections 3 and 70, be liable for removal from the register:

- (a) subject to sections 42 and 43, marks that consist exclusively of a sign or an indication which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, or other characteristics of the goods or services, or mode or time of production of the goods or of rendering of the services; or
- (b) subject to section 43B (3), marks that consist exclusively of a traditional term or expression and which in the *bona fide* and

established practices of the trade has become indicative of or is generally associated with the goods or services in respect of which the mark is sought to be registered.

(Pending amendment: S. 43C to be inserted by s. 9 of Act No. 28 of 2013 and comes into operation on a date fixed by the President by proclamation in the *Gazette* – date not determined.)

(Date of commencement to be proclaimed)

43D. National Database.—(1) The National Database for Indigenous Knowledge contemplated in section 28C of the Copyright Act shall constitute and function as a sub-register within the register of trade marks in respect of traditional terms and expressions and geographical indications for purposes of this Act, in the manner provided for in the said section 28C of the Copyright Act.

(2) Traditional terms and expressions or geographical indications—

- (a) contained in applications referred to the Council and accepted in terms of subsection (14); and
- (b) contained in applications accepted in terms of sections 42, 43 or 43D, shall be recorded in the database.

(3) For the purposes of this Act, an indigenous community is deemed to be a juristic person.

(4) Any—

- (a) natural person who created the traditional terms and expressions or geographical indications;
- (b) natural or juristic person authorised to act on behalf of an indigenous community, or on behalf of an individual; or
- (c) person appointed by the Minister in the manner prescribed, to act on behalf of an indigenous community which is no longer in existence,

may submit to the registrars of patents, copyright, trade marks and designs a request together with the appropriate information as prescribed for a traditional term or expression or geographical indication to be registered in the database, whereupon the provisions of the said section 28C of the Copyright Act shall, with necessary changes, apply.

(5) The applicant for registration and the proprietor shall be—

- (a) where—
 - (i) the originator of the traditional term or expression or the geographical indication cannot be determined;
 - (ii) the originator of the traditional term or expression or the geographical indication, is an indigenous community which is no longer in existence; or
 - (iii) where the indigenous terms or expressions or geographical indication developed in such a manner that proprietorship cannot be shared amongst indigenous communities,
the National Trust;
- (b) in all other instances related to indigenous terms or expressions, a person authorised to act on behalf of the indigenous community or indigenous communities or on behalf of an individual;
- (c) in all other instances related to geographical indications, a person authorised to act on behalf of the indigenous community or indigenous communities or the relevant member of the indigenous community; and
- (d) in all other instances related to derivative traditional terms or expressions, the relevant member of the indigenous community.

(6) If the applicant for registration is an indigenous community, the request referred to in subsection (4) shall include a community protocol setting out relevant information about the community, including—

- (a) identification of the indigenous community and its acknowledged structure;

- (b) full details of the appointed representative of the indigenous community in whose name the traditional term or expression or the geographical indication must be registered;
- (c) if the representative is a juristic person, full details of registration of such juristic person;
- (d) the indigenous term or expression or geographical indication that is being registered and the justification for the community claiming rights to it;
- (e) whether such indigenous term or expression or geographical indication is sacred, or should for any other reason, which must be provided, be kept confidential; and
- (f) a written undertaking by the representative of the indigenous community to the effect that he or she will hold the right to the indigenous term or expression or geographical indication on behalf of the indigenous community.

(7) The Council must assist the indigenous community to ensure that the community protocol corresponds with the structure of the indigenous community.

(8) The community protocol must be kept with the registration of the indigenous term or expression or geographical indication.

(9) Section 22 (4) shall apply, with necessary changes, in relation to a database for traditional terms or expressions or geographical indications.

(10) The Commission may determine which information recorded in the database must be treated confidentially: Provided that if the community protocol indicates that the information is sacred or must be kept in confidence, the Commission must treat the information confidentially.

(11) Any person contemplated in subsection (4), or a third party who has an interest in a traditional term or expression or geographical indication may submit to the registrars of patents, copyright, trade marks and designs a request together with the appropriate information as prescribed, for the amendment or removal of a traditional term or expression or geographical indication in the database, whereupon the provisions of section 28C (13) of the Copyright Act shall, with necessary changes, apply.

(12) If it appears to the registrars of patents, copyright, trade marks and designs that the mark sought to be registered—

- (a) consists exclusively of, or an essential part thereof constitutes, a traditional term or expression or geographical indication as contemplated in section 43B; and
- (b) is registrable in terms of section 42, 43 or 43B,

the registrars of patents, copyright, trade marks and designs shall accordingly register the mark.

(13) Save for as otherwise provided in this section, parts IV and V specifically shall apply, with necessary changes, in relation to the registration of a traditional term or expression.

(14) (a) If it appears to the registrars of patents, copyright, trade marks and designs that the mark sought to be registered—

- (i) consists exclusively of, or an essential part thereof constitutes, a traditional term or expression or geographical indication as contemplated in section 43B; and
- (ii) is not registrable in terms of section 42, 43 or 43B,

he or she shall provisionally refuse the application and refer the application to the Council for its advice.

(b) The Council shall consider such application and advise the registrars of patents, copyright, trade marks and designs within three months of receipt of the referral whether or not, in its opinion, the mark can be registered.

(c) Upon receipt of the advice of the Council, the registrars of patents, copyright, trade marks and designs shall accept or refuse the application.

(15) The registrars of patents, copyright, trade marks and designs shall advise an applicant for registration in writing, within a reasonable period from the date of the application, of his or her decision in terms of this section.

(16) In the case of—

- (a) an acceptance in terms of subsections (2), (12) or (14) (c);
- (b) a refusal in terms of subsection (14) (c); or
- (c) a provisional refusal or refusal in terms of subsection (14) (a),

the registrars of patents, copyright, trade marks and designs shall, on application by the applicant in the prescribed manner, state in writing the grounds for his or her decision.

(17) (a) In the case of an acceptance of a traditional term or expression or geographical indication for registration as a certification trade mark or a collective trade mark, the registrars of patents, copyright, trade marks and designs shall notify the Council accordingly and in the prescribed manner.

(b) In the case of an acceptance of a geographical indication as—

- (i) a certification trade mark in terms of section 42; or
- (ii) a collective trade mark in terms of section 43,

the registrars of patents, copyright, trade marks and designs shall notify the Director-General of the department responsible for Agriculture in the prescribed manner.

(18) Section 27 (1) (a) and (b) does not apply to a traditional term, expression or geographical indication.

(Pending amendment: S. 43D to be inserted by s. 9 of Act No. 28 of 2013 and comes into operation on a date fixed by the President by proclamation in the *Gazette* – date not determined.)

(Date of commencement to be proclaimed)

43E. Term of protection.—(1) Save for as otherwise provided in this section, section 37 shall apply, with necessary changes, in relation to the duration and renewal of registration of derivative traditional terms or expressions and geographical indications as set out in section 43B (8) (a).

(2) The duration of registration in the case of indigenous term or expression or geographical indication as set out in section 43B (8) (b) shall be in perpetuity.

(Pending amendment: S. 43E to be inserted by s. 9 of Act No. 28 of 2013 and comes into operation on a date fixed by the President by proclamation in the *Gazette* – date not determined.)

(Date of commencement to be proclaimed)

43F. Infringement of traditional mark, exceptions, licence fees and benefits.—(1) Notwithstanding the provisions of section 34 (1), the proprietor of a trade mark in respect of a traditional term or expression shall not be entitled to interfere with or restrain a person referred to in section 35 or a person who commenced using a mark in the course of trade in the manner contemplated in section 34 (1) at a date prior to the commencement of the Intellectual Property Laws Amendment Act, 2013, and has continued to make *bona fide* use of such mark: Provided that if any commercial benefit is derived from any such use after the date of registration of the traditional term or expression or geographical indication in terms of section 43D, a licence fee, a benefit, or both such licence fee and benefit, shall be paid by such person to the proprietor as provided for in subsection (4).

(2) Any person who has acquired rights as contemplated in subsection (1) must comply with section 43B (6) (b) and (c), within 12 months after the commencement of the Intellectual Property Laws Amendment Act, 2013: Provided that—

- (a) the rights of the indigenous community to licence fees or benefits or both such licence fees and benefits shall start on the commencement of the Intellectual Property Laws Amendment Act, 2013; and
- (b) save for the obligations contemplated in this subsection and subsection (1), such person shall continue to hold his or her right in

the manner he or she has done prior to the commencement of the Intellectual Property Laws Amendment Act, 2013.

(3) Any person who intends to acquire rights pertaining to use of the indigenous term or expression or geographical indication after the commencement of the Intellectual Property Laws Amendment Act, 2013, must comply with section 43B (6).

(4) The amount or value of the licence fee, benefit, or to both such licence fee and benefit, contemplated in subsection (1) or negotiated for in the benefit sharing agreement contemplated in subsection (3), shall be determined—

- (a) by agreement between the person who is the user of the mark and the owner of the mark;
- (b) by one or more collecting societies representing either or both of these parties; or
- (c) in the absence of agreement as contemplated in paragraph (a) or (b) being reached, the amount or value of the licence fee, benefit, or both such licence fee and benefit, by—
 - (i) an institution accredited by the Commission as contemplated in section 43I (1); or
 - (ii) arbitration in terms of the Arbitration Act, 1965 (Act No. 42 of 1965):

Provided that if the persons referred to in subsection (4) (a) or (b) cannot agree on which referral to follow in terms of this subsection within a reasonable period, any of the persons may refer these disputes for resolution in terms of section 43I.

(5) Agreements concluded in terms of subsections (2), (3) or (4) (a) or (b) must be submitted to the Council, who shall—

- (a) scrutinise the agreement for compliance with intellectual property laws, including this Act and the community protocol; and

- (b) where any clause within the contract is regarded as not being to the benefit of the indigenous community or member of the indigenous community concerned, require renegotiation of said clause and provide the necessary advice.

(6) The owner of a certification or collective trade mark in a derivative indigenous term or expression or geographical indication shall pay a licence fee or benefit, agreed to as set out in this section, to the owner or owners of certification or collective trade marks in the indigenous term or expression or geographical indication from which the derivative indigenous term or expression or geographical indication was derived.

(7) Any person deriving commercial benefit from the use of a traditional term or expression or geographical indication, which commercial benefit is less than the prescribed value shall be excluded from the requirements of sections 43B (6), 43F (2) and (3) and from the requirement to pay licence fees and benefits as contemplated in section 43F (1).

(8) A traditional term or expression or geographical indication may be used without obtaining prior consent of the trade mark proprietor, if it is for the purpose of—

- (a) private study or private use;
- (b) professional criticism or review;
- (c) reporting on current events;
- (d) education;
- (e) scientific research;
- (f) legal proceedings; or
- (g) the making of recordings and other reproductions of indigenous cultural expressions or knowledge for purposes of their inclusion in an archive, inventory, dissemination for non-commercial cultural heritage safeguarding purposes and incidental uses: Provided that only such portions as is reasonably required for such use are made and that the trade mark owner's name is acknowledged.

(Pending amendment: S. 43F to be inserted by s. 9 of Act No. 28 of 2013)

and comes into operation on a date fixed by the President by proclamation in the *Gazette* – date not determined.)

(Date of commencement to be proclaimed)

43G. National Trust and Fund for Indigenous knowledge.—(1) The National Trust and the Fund, as the case may be, shall constitute and function as a National Trust and Fund in respect of traditional terms and expressions and geographical indications for purposes of this Act, and the provisions of section 28I of the Copyright Act shall, with necessary changes, apply.

(2) All monies payable in respect of the use of an indigenous term or expression or geographical indication registered under this Act and owned by the National Trust shall be paid into the Fund contemplated in subsection (1) and shall be applied for the benefit of indigenous communities in the manner prescribed in section 28I of the Copyright Act.

(Pending amendment: S. 43G to be inserted by s .9 of Act No. 28 of 2013 and comes into operation on a date fixed by the President by proclamation in the *Gazette* – date not determined.)

(Date of commencement to be proclaimed)

43H. Assignment and licences.—(1) Save for—

- (a) assignment of an indigenous term or expression or geographical indication to a collecting society, or
 - (b) transfer to a duly appointed representative of the community,
- the certification or collective trade marks in an indigenous term or expression or geographical indication shall not be transmissible by assignment, testamentary disposition or operation of law, but the doing of any act may be licensed.

(2) Should the certification or collective trade mark referred to in subsection (1) vest in a representative of an indigenous community, the indigenous community may—

- (a) upon the death or liquidation of the said representative, as the case may be; or
 - (b) prior to the death or liquidation of the said representative,
- by agreement as set out in the community protocol, transfer such certification or collective trade mark to a person, as the indigenous community may decide.

(3) Should the certification or collective trade mark referred to in subsection (1), vest in a representative of an indigenous community, such certification or collective trade mark shall automatically upon the death of the last living member of such indigenous community transfer to the National Trust.

(Pending amendment: S. 43H to be inserted by s. 9 of Act No. 28 of 2013 and comes into operation on a date fixed by the President by proclamation in the *Gazette* – date not determined.)

(Date of commencement to be proclaimed)

43I. Dispute.—(1) The Commission must accredit certain institutions which have the necessary capacity, to adjudicate any dispute arising from the application of the Intellectual Property Laws Amendment Act, 2013.

(2) Any dispute arising from the application of the Intellectual Property Laws Amendment Act, 2013, must first be instituted in an institution accredited as contemplated in subsection (1).

(3) No person appearing in proceedings before an institution contemplated in subsection (1) shall have the right to legal representation unless—

- (a) the adjudicator and all other parties consent; or
- (b) the adjudicator, after considering—

- (i) the nature of the questions of law raised by the dispute;
- (ii) the relative complexity and importance of the dispute; and
- (iii) the comparative ability of the parties to represent themselves in the adjudication,

concludes that it would be unreasonable to expect a party to deal with the adjudication without legal representation.

(4) Any adjudication must take into account existing customary dispute resolution mechanisms.

(5) The decision of the institution referred to in subsection (1) may be served, executed and enforced as if it was an order of the High Court.

(6) Any party to proceedings before an institution referred to in subsection (1) may appeal to a court of law against any decision of such institution, and the appeal must be noted and dealt with in the manner prescribed by law for appeals against a civil order or decision of a single judge.

(7) The Minister shall prescribe the fees, processes and formalities relating to the institution and adjudication of a dispute.

(Pending amendment: S. 43L to be inserted by s. 9 of Act No. 28 of and comes into operation on a date fixed by the President by proclamation in the *Gazette* – date not determined.)

(Date of commencement to be proclaimed)

43J. National Council.—The Council must advise the registrars of patents, copyright, trade marks and designs on the registration of traditional terms and expressions under this Act.

(Pending amendment: S. 43J to be inserted by s. 9 of Act No. 28 of 2013 and comes into operation on a date fixed by the President by proclamation in the *Gazette* – date not determined.)

(Date of commencement to be proclaimed)

43K. Compliance with international agreements.—(1) The Minister may by notice in the *Gazette* provide that any provision of this Act specified in such notice shall in the case of any country so specified apply so that—

- (a) a community recognised in the specified country as an indigenous community shall be deemed to be an indigenous community as defined in this Act; and
- (b) traditional terms and expressions and geographical indications recognised in the specified country as traditional terms and expressions and geographical indications shall be deemed to be traditional terms and expressions and geographical indications as defined in this Act.

(2) The Minister may in the notice in subsection (1) make the provisions of this Act applicable, in respect of a country listed in the notice—

- (a) to its citizens or subjects;
- (b) to persons who at material times are domiciled or resident in the listed country and who are members of an indigenous community in that country; and
- (c) to juristic persons incorporated under the laws of the specified country and representing indigenous communities of that country.

(3) The notice referred to in subsection (1) may—

- (a) include exceptions or modifications to the application of the Act in respect of a specified country;
- (b) provide for general application of the Act; or
- (c) limit application of the Act to such types of traditional terms and expressions and geographical indications as may be specified.

(4) No notice shall be issued under this section in respect of any country

which is not a party to a convention relating to trade marks to which the Republic is also a party, unless the Minister is satisfied that, in respect of the class of traditional terms and expressions and geographical indications to which the notice relates, provision has been or will be made under the laws of that country whereby adequate protection will be given to owners of traditional trade marks under this Act.

(5) Section 35 shall, with the necessary changes required by the context, apply in respect of traditional terms or expressions.

(Pending amendment: S. 43K to be inserted by s. 9 of Act No. 28 of 2013 and comes into operation on a date fixed by the President by proclamation in the *Gazette* – date not determined.)

(Date of commencement to be proclaimed)

PART XIII POWERS AND DUTIES OF REGISTRAR

44. Venue of proceedings.—Any proceedings before the registrar under this Act shall be heard and disposed of by him at the trade marks office: Provided that if it be made to appear to him by any party that the proceedings may more conveniently or fitly be heard and disposed of in another place, he may hear and dispose of the proceedings in such other place.

45. General powers of registrar.—(1) The registrar shall, in connection with any proceedings before him, have all such powers and jurisdiction as are possessed by a single judge in a civil action before the Transvaal Provincial Division of the Supreme Court.

(2) Where no provision is contained in this Act on any matter of procedure, the registrar shall apply the rules governing procedure in the Transvaal Provincial Division of the Supreme Court.

(3) Whenever by this Act any time is specified within which any act is to be performed or thing is to be done by any person, the registrar may, on application by that person and unless otherwise expressly provided, extend the time either before or after its expiration.

(4) Where any party to any proceedings before the registrar neither resides nor carries on business in the Republic, the registrar may order him to give security for the costs of the proceedings and, in default of such security being given, may dismiss the application or opposition, as the case may be.

46. Power of registrar to allow amendment of document.—(1) The registrar may at any time before the registration of a trade mark permit the amendment of any document relating to any application or proceedings before him on such terms as to costs or otherwise as he may think just.

(2) If rights in a trade mark which is the subject of a pending application, have been acquired by a body corporate subsequent to the date of application, the registrar may, on good cause shown, permit amendment of the application by the substitution of the name of the body corporate as applicant for registration, notwithstanding that such body corporate was not in existence as at the date of the application.

47. Duty of registrar in exercising discretionary power to give opportunity to applicant of being heard.—Whenever any discretionary power is by this Act given to the registrar, he shall not exercise that power adversely to any person without giving that person an opportunity of being heard personally or by his agent.

48. Taxation of costs awarded by registrar.—Any costs awarded by the registrar shall be taxed by a taxing officer of the Transvaal Provincial Division of the Supreme Court and payment thereof may be enforced in the same manner as if they were costs allowed by a judge of that division.

48A. List of emblems of convention countries and international organizations.—(1) The registrar shall keep a list of—

- (a) all state emblems and official signs and hallmarks of convention countries; and
- (b) all emblems, names and abbreviations of names of international organizations,

which are protected in terms of the Paris Convention by virtue of notification to the Republic in accordance with Article 6^{ter} of the Convention.

(2) The list referred to in subsection (1) shall be open at all convenient times during office hours to inspection by the public.

[S. 48A inserted by s. 67 of Act No. 38 of 1997.]

PART XIV EVIDENCE

49. Register to be *prima facie* evidence.—Any register kept under this Act shall be *prima facie* evidence of any matters directed or authorized by this Act to be inserted in that register.

50. Certificate of registrar to be *prima facie* evidence.—(1) A certificate purporting to be under the hand of the registrar as to any entry, matter or thing which he is authorized by this Act to make or do, shall be *prima facie* evidence of the entry having been made and of the contents thereof and of the matter or thing having been done or left undone.

(2) Printed or written copies or extracts purporting to be copies of or extracts from any register or book or document relating to trade marks and kept in the trade marks office and certified by the registrar and sealed with the seal of that office, shall be admitted in evidence in all courts and proceedings without further proof or production of the originals.

51. Registration to be *prima facie* evidence of validity.—In all legal proceedings relating to a registered trade mark (including applications under section 24) the fact that a person is registered as the proprietor of the trade mark shall be *prima facie* evidence of the validity of the original registration of the trade mark and of all subsequent assignments and transmissions thereof.

[S. 51 substituted by s. 68 of Act No. 38 of 1997.]

52. Certification of validity.—(1) If in any proceedings the validity of any registration of a trade mark is in issue, the court finding that registration to be valid, may certify to that effect.

(2) If in any subsequent proceedings the validity of that registration is unsuccessfully attacked by any party, that party shall, unless the court otherwise directs, pay to the other party his full costs, charges and expenses as between agent or attorney and client so far as that registration is concerned.

PART XV APPEALS TO AND POWERS OF COURT

53. Recourse to court, and appeals.—(1) Without derogating from the provisions of subsection (2), any person aggrieved by any decision or order of the registrar may, within a period of three months after the date of any such decision or order, apply to the Transvaal Provincial Division of the Supreme Court for relief, and the said court shall have the power to consider the merits of any such matter, to receive further evidence, and to make any order as it may deem fit.

(2) Any party to any opposed proceedings before the registrar may appeal to the Transvaal Provincial Division of the Supreme Court against any decision or order pursuant to such proceedings.

(3) In addition to any other powers conferred upon it by this Act, the Transvaal Provincial Division of the Supreme Court may in relation to such appeal—

- (a) confirm, vary or reverse the order or decision appealed against, as justice may require;
- (b) if the record does not furnish sufficient evidence or information for the determination of the appeal, remit the matter to the registrar with instructions in regard to the taking of further evidence or the setting out of further information;
- (c) order the parties or either of them to produce at some convenient time in the said court such further proof as shall to it seem necessary or desirable; or
- (d) take any other course which may lead to the just, speedy and as far as may be possible inexpensive settlement of the case; and
- (e) make such order as to costs as justice may require.

(4) Every appeal to the Transvaal Provincial Division of the Supreme Court from a decision or order of the registrar shall be noted and prosecuted in the manner prescribed by law for appeals to that division against a civil order or decision of a single judge of that division, save that—

- (a) no leave to appeal to the said division shall be necessary;
- (b) the period within which such appeal shall be noted shall be three months after the date of the decision or order;
- (c) the appeal shall be prosecuted within six weeks from the date upon which it was noted:

Provided that the said division may, on application and on good cause shown, allow such extension of time for noting or prosecuting the appeal as it may deem necessary.

(5) The parties to proceedings before the registrar shall be deemed to be parties to civil proceedings for the purposes of the Supreme Court Act, 1959 (Act No. 59 of 1959).

(6) Every appeal to the Appellate Division of the Supreme Court by virtue of subsection (5) shall be governed by the Supreme Court Act, 1959, and shall be noted and prosecuted in the manner prescribed by law for appeals to the said division in civil proceedings.

54. Power to order production of certificate of registration.—In addition to any other powers conferred

upon it by this Act, the court may in relation to any application or appeal under this Act order any party to deliver to the court or to the registrar the certificate of registration of any trade mark.

55. Notice to registrar of application to court.—Before any application is made to the court for an order involving the performance of any act by the registrar or affecting any entry in the register, the applicant shall in the manner prescribed give the registrar at least 14 days' notice before the hearing of such application: Provided that the registrar may, in his discretion, waive such notice or accept such shorter notice as he may in the circumstances deem sufficient.

56. Registrar's appearance in proceedings involving rectification of register.—(1) In any legal proceeding in which the relief sought includes alteration or rectification of the register, the registrar shall have the right to appear and be heard, and shall appear if so directed by the court.

(2) Unless otherwise directed by the court, the registrar, in lieu of appearing and being heard, may submit to the court a statement in writing signed by him, giving particulars of the proceedings before him in relation to the matters in issue or of the grounds of any decision given by him affecting such matters or of the practice of the trade marks office in like cases or of such other matters relevant to the issues and within his knowledge as registrar, as he thinks fit, and the statement shall be deemed to form part of the evidence in the proceedings.

57. Court's power to review registrar's decision.—The Transvaal Provincial Division of the Supreme Court shall have power to review any decision or ruling of the registrar made under this Act.

58. Discretion of court in appeals.—In any appeal to the court under this Act against a decision of the registrar, the court shall have power to exercise the same discretionary powers as under this Act are conferred upon the registrar.

59. Procedure in cases of option to apply to court or registrar.—(1) Where under any provision of this Act an applicant has an option to make an application either to the court or to the registrar—

- (a) if proceedings concerning the trade mark in question are pending before the court, the application must be made to the court;
- (b) if in any other case the application is made to the registrar, he may, at any stage of the proceedings, refer the application to the court, or he may, after hearing the parties, determine the question between them.

(2) Where proceedings in terms of section 21, 24, 26, 27 or 38 (8) are pending before the registrar, the registrar may in his discretion refer the proceedings to the court, and shall refer the proceedings to the court on written application of all the parties to such proceedings.

PART XVI OFFENCES

60. Penalties for fraud in relation to registers.—Any person who—

- (a) makes or causes to be made a false entry in any register kept under this Act;
- (b) makes or causes to be made a writing falsely purporting to be a copy of an entry in any such register; or
- (c) produces or tenders or causes to be produced or tendered as evidence any such entry or copy thereof knowing it to be false,

shall be guilty of an offence and liable on conviction to a fine, or to imprisonment for a period not exceeding 12 months.

61. Penalty for making false statements for purpose of deceiving or influencing registrar or other officer.—Any person who—

- (a) for the purpose of deceiving the registrar or any officer in the execution of the provisions of this Act; or
- (b) for the purpose of procuring or influencing the doing or omission of anything in relation to this Act or any matter thereunder,

makes a false statement or representation knowing it to be false, shall be guilty of an offence and liable on conviction to a fine, or to imprisonment for a period not exceeding 12 months.

62. Penalty for falsely representing trade mark as registered.—(1) Any person who makes a representation—

- (a) with respect to a mark not being a registered trade mark, to the effect that it is a registered trade mark;

- (b) with respect to a part of a registered trade mark not being a part separately registered as a trade mark, to the effect that it is so registered;
- (c) to the effect that a registered trade mark is registered in respect of any goods or services in respect of which it is not registered; or
- (d) to the effect that the registration of a trade mark gives an exclusive right to the use thereof in any circumstances in which, having regard to limitations entered in the register, the registration does not give that right,

shall be guilty of an offence and liable on conviction to a fine, or to imprisonment for a period not exceeding 12 months.

(2) For the purposes of this section, the use in the Republic in relation to a trade mark of the word "registered" or of any abbreviation thereof or of any other word or letter which might reasonably be construed as referring to registration, including the symbol R, shall be deemed to import a reference to registration in the register except—

- (a) where that word, abbreviation, letter or symbol is used in physical association with other words delineated in characters at least as large as those in which that word, abbreviation, letter or symbol is delineated and indicating that the reference is to registration as a trade mark under the laws of a country outside the Republic being a country under the laws of which the registration referred to is in fact in force;
- (b) where that word (being a word other than the word "registered"), abbreviation, letter or symbol is of itself such as to indicate that the reference is to such registration as is referred to in paragraph (a); or
- (c) where the word, abbreviation, letter or symbol is used in relation to a mark registered as a trade mark under the laws of a country outside the Republic and in relation to goods to be exported to that country.

PART XVII INTERNATIONAL ARRANGEMENTS

63. International arrangements.—(1) The State President may, with a view to the fulfilment of a treaty, convention, arrangement or engagement, by proclamation in the *Gazette* declare that any country or group of countries specified in the proclamation is a convention country or are convention countries for the purposes of all or any of the provisions of this Act.

(2) For the purposes of subsection (1) every territory for whose international relations another country is responsible shall be deemed to be a country in respect of which a declaration may be made under that subsection.

(3) Any person who has applied for registration of a trade mark in a convention country, or his legal representative or assignee, shall, in priority to other applicants, be entitled to registration of the trade mark under this Act, and the registration shall have the same date as the date of the first application in the convention country: Provided that—

- (a) application is made within six months after the date on which the application was made in the convention country; and
- (b) nothing in this section contained shall entitle the proprietor of the trade mark to recover damages for infringements happening prior to the actual date on which the application was first advertised in the prescribed manner.

(4) Where applications have been made for the registration of a trade mark in two or more convention countries, the period of six months referred to in subsection (1) shall be reckoned from the date on which the earliest of those applications was made.

(5) Where a person has applied for protection for a trade mark by an application which—

- (a) in accordance with the terms of a treaty subsisting between any two or more convention countries, is equivalent to an application duly made in any one of those convention countries; or
- (b) in accordance with the law of any convention country, is equivalent to an application duly made in that convention country,

he shall be deemed for the purposes of this section to have applied in any of those convention countries or in that convention country.

(6) The registration of a trade mark shall not be invalidated by reason only of the use of the trade mark in the Republic during the period specified in this section as that within which application may be made.

(7) The application for the registration of a trade mark under this section shall be made in the same manner as an ordinary application under this Act, except that proof of application in a convention country shall be established in the manner prescribed.

(8) A right to priority as contemplated in subsection (3) may be assigned or otherwise transmitted.

PART XVIII
MISCELLANEOUS

64. Use of trade mark for export trade.—The application of a trade mark in the Republic to goods to be exported from the Republic and any other act performed in the Republic in relation to goods to be so exported which, if performed in relation to goods to be sold or otherwise traded in within the Republic, would constitute use of a trade mark therein, shall be deemed to constitute use of the trade mark in relation to those goods for any purpose for which such use is material under this Act or at common law.

65. Payment of prescribed fee to be made before acts performed or documents issued.—Whenever under this Act any prescribed fee is payable in respect of any application, registration, matter or document, the registrar may refuse to perform the act or to receive or to issue the document, as the case may be, until the fee payable in respect thereof is paid.

66. Address for service.—(1) With every application or notice of opposition under this Act, the applicant or objector, as the case may be, shall furnish a comprehensive address (not being a post box or private bag number) within the Republic as an address for service, which shall, for all purposes of the application or the notice of opposition, be deemed to be the address of the applicant or of the objector, as the case may be, and all documents in relation to the application or notice of opposition may be served by leaving them at or sending them to the address for service of the applicant or of the objector, as the case may be.

(2) The address for service furnished by an applicant in terms of this section shall be deemed to be the *domicilium citandi et executandi* of such applicant for the purposes of proceedings relating to any entry made in the register in pursuance of the application.

(3) Any address for service may be changed by notice to the registrar on the form prescribed.

67. Calculation of periods of time.—(1) Any period of time specified by this Act as running from the performance of any act shall be reckoned as commencing on the day next following the performance of that act.

(2) Whenever the last day on which, in terms of this Act, any act may or is required to be performed or any document may or is required to be lodged, falls on a day on which the trade marks office is closed, that act may be performed or that document may be lodged on the next following day on which the trade marks office is open for the transaction of business.

68. Persons under disability.—If any person is, by reason of minority, lunacy or other disability, incapable of making any declaration or performing any act required or permitted by this Act, then the guardian, curator or other legal representative (if any) of such person or, if there be none, any person appointed by the court upon application on behalf of the person under disability or on behalf of any other person interested in the making of such declaration or performing such act may make the declaration or a declaration as nearly corresponding thereto as circumstances permit, and perform the act in the name and on behalf of the person under disability, and all acts performed by such substitute shall, for the purposes of this Act, be as effectual as if performed by the person for whom he is substituted.

69. Fees, regulations, forms and classification of goods.—(1) The Minister may prescribe a tariff of the fee which shall be payable to the registrar in respect of any application, registration, matter or document, and the fee shall be payable as so prescribed.

(2) The Minister may also make regulations, not inconsistent with this Act, as to all matters, including forms and a schedule of classification of goods or services, which by this Act are required or permitted to be prescribed or which are necessary or convenient for giving effect to the provisions of this Act or for the conduct of any business relating to the trade marks office established by this Act.

(3) If Parliament resolves within 30 days after any such tariff or regulation has been laid on the Table thereof in accordance with law, that any item of the tariff or that the regulation be disallowed, such item or regulation shall thereupon become of no effect, without prejudice to the validity of anything done in the meanwhile thereunder or to the power to make a new tariff or regulation.

(4) The Minister may make regulations providing for the fees, processes and formalities related to the submission and adjudication of a dispute set out in section 43I.

(Pending amendment: Sub-s. 4 to be inserted by s. 10 of Act No. 28 of 2013 and comes into operation on a date fixed by the President by proclamation in the *Gazette* – date not determined.)

(Date of commencement to be proclaimed)

(5) The Minister may make regulations in consultation with the Minister of Finance, providing for the establishment, composition, funding and functions of collecting societies contemplated in section 43F, and any other matter that it may

be necessary or expedient to regulate for the proper functioning of such societies.

(Pending amendment: Sub-s. 5 to be inserted by s. 10 of Act No. 28 of 2013 and comes into operation on a date fixed by the President by proclamation in the *Gazette* – date not determined.)

(Date of commencement to be proclaimed)

(6) The Minister may make regulations providing for the appointment of a person to act on behalf of an indigenous community which is no longer in existence.

(Pending amendment: Sub-s. 6 to be inserted by s. 10 of Act No. 28 of 2013 and comes into operation on a date fixed by the President by proclamation in the *Gazette* – date not determined.)

(Date of commencement to be proclaimed)

(7) The Minister may prescribe the value of a commercial benefit contemplated in section 43F (7).

(Pending amendment: Sub-s. 7 to be inserted by s. 10 of Act No. 28 of 2013 and comes into operation on a date fixed by the President by proclamation in the *Gazette* – date not determined.)

(Date of commencement to be proclaimed)

(8) The Minister may issue guidelines on any aspect of the Intellectual Property Laws Amendment Act, 2013, including—

- (a) protection of traditional terms and expressions and geographical indications;
- (b) examples and other measures to identify traditional terms and expressions and geographical indications;
- (c) the database, in so far as it relates to traditional terms and expressions and geographical indications;
- (d) the National Trust and Fund, in so far as it relates to traditional terms and expressions and geographical indications;
- (e) the Council, in so far as it relates to traditional terms and expressions and geographical indications; and
- (f) the dispute process as set out in section 43I.

(Pending amendment: Sub-s. 8 to be inserted by s. 10 of Act No. 28 of 2013 and comes into operation on a date fixed by the President by proclamation in the *Gazette* – date not determined.)

(Date of commencement to be proclaimed)

70. Transitional provisions.—(1) Subject to the provisions of section 3, and except as expressly otherwise provided in this Act, the validity of the original entry of a trade mark on the register of trade marks existing at the commencement of this Act shall be determined in accordance with the laws in force at the date of such entry.

(2) A trade mark which has been validly registered in terms of the provisions of section 53 of the repealed Act shall, from the date of commencement of this Act, be deemed to be a trade mark registered in terms of this Act, but shall not be removed from the register in terms of the provisions of paragraph (4) of section 10 or of section 27 within a period of 10 years from the date of commencement of this Act.

71. Repeal of laws.—The following laws are hereby repealed:

- (1) The Trade Marks Act, 1963 (Act No. 62 of 1963);
- (2) the Trade Marks Amendment Act, 1971 (Act No. 46 of 1971);
- (3) the Trade Marks Amendment Act, 1979 (Act No. 37 of 1979);
- (4) the expression “62 of 1963”, and the words and expressions opposite thereto, appearing in the First Schedule to the Transfer of Powers and Duties of the State President Act, 1986 (Act No. 97 of 1986); and
- (5) the Trade Marks Amendment Act, 1991 (Act No. 65 of 1991).

72. Short title and commencement.—This Act shall be called the Trade Marks Act, 1993, and shall come into operation on a date fixed by the State President by proclamation in the *Gazette*.