

Frequent Procedural Mistakes in the Prosecution of Trademark Applications

Presented by Nancy Samuriwo

THEME: GETTING IT RIGHT -THE FIRST TIME

- ▶ You have to learn the rules of the game. And then you have to play better than anyone else.

- ▶ *Albert Einstein*

THEME: GETTING IT RIGHT -THE FIRST TIME



Warm up....understanding your playground

- ▶ Basic principles of the trade mark system established under the Banjul Protocol
- ▶ **Complementarity** in a largely non-homogeneous legal framework
- ▶ Rule 2 - **principle of independence** of marks
- ▶ Geographic **dispersion** of designable states



Warm up ...understanding your playground cont'd

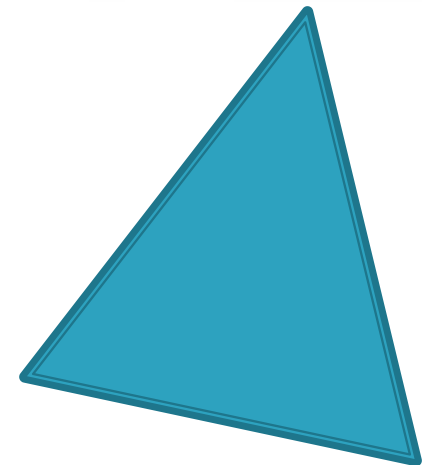
- ▶ Registration equates to a **bundle of national registrations** – consider matters of **scope** and **feasibility** of ensuing national protection.




- ▶ *“In love the foolish may fall; in life the shrewd will prevail”*

Get Set..... Flexing your muscles and check-listing and review of Form. M1

- ▶ Which states to designate? – Substantively (9/19-1) and Strategically.... And then there was the “Bermuda Triangle”
- ▶ SOUTH AFRICA IS NOT SOUTHERN AFRICA
- ▶ How is the subject matter defined each of the Protocol States of interest?



Get Set..... Cont'd

- ▶ What constitutes “ a mark”?
 - ▶ Can be represented graphically and cable of distinguishing?
 - ▶ Goods /service marks in terms of the Nice Classification
 - ▶ Position on single colour marks;
- 

Get Set..... Cont'd

fcuk[®]

▶ Sound and smell marks;

▶ Shapes and containers

▶ Series marks

▶ **Offensive/Negative connotations ... ah...
those ones!!!**



A great trademark is
appropriate, dynamic,
distinctive, memorable and
unique.

Primo Angeli



What I am is easy to see.
Who I am is complicated

Is your trademark a PIP, a
PIMP or a PEEP?

“SMALL HOUSE” A domestic
dwelling of limited
proportion or a PERSON

I'm a shocker. I like to create controversy. It's my trademark.

Brenda Fassie



....Ma Brrr, we loved you but ever heard of registrability... IP monetisation???

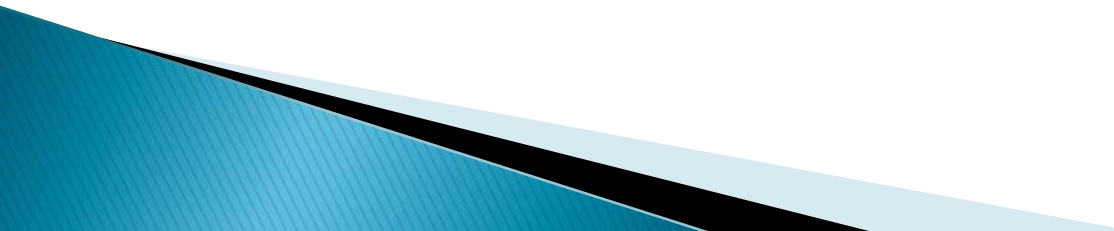
GO.....

- ▶ Prepare M1 – in “English” – avoid “Unintellectual Language”
- ▶ Notice is hereby given of the **erection** of a base station along Samora Machel Avenue so that those who would like to watch the **erection** may be provided with transport to view the **erection**

GO.....

- ▶ Set number of designated states
- ▶ Calculate fees properly (even if you struggled to pass Maths 😊 Use Tables if you have to. (Countries x 1st class and 2nd class x country)
- ▶ Supporting PoA (M2) General or Specific
 - note 2 months filing deadline to avoid incurring charges

GO.....cont'd

- ▶ Claiming **priority** of one or more applications – 3 months filing deadline
 - ▶ **Translation** of priority document required – note 6 months filing deadline.
 - ▶ **Reproduction** /image of mark required ?
 - ▶ **Declaration of Use** Clarify is use applies to all designated states (bundle of national registrations remembered)
- 

GO.....cont'd

- ▶ Endorsements... here and now?? Optional
- ▶ Foolhardy or shrewd????
- ▶ Invented words
- ▶ Disclaim non-distinctive elements



To the Lighthouse....

- ▶ Delivering applications to ARIPO
- ▶ **Section 2 of Protocol** – file either directly or with the Industrial Property Office of a Contracting State



To the Lighthouse....(cont)

- ▶ Fones 4U case – a good practice to confirm that application dispatched to ARIPO under cover of Form M 5 (issued by the Receiving Office). Insist on your Form M6
- ▶ 2015 – **e-filing** here we come!

Post filing actions

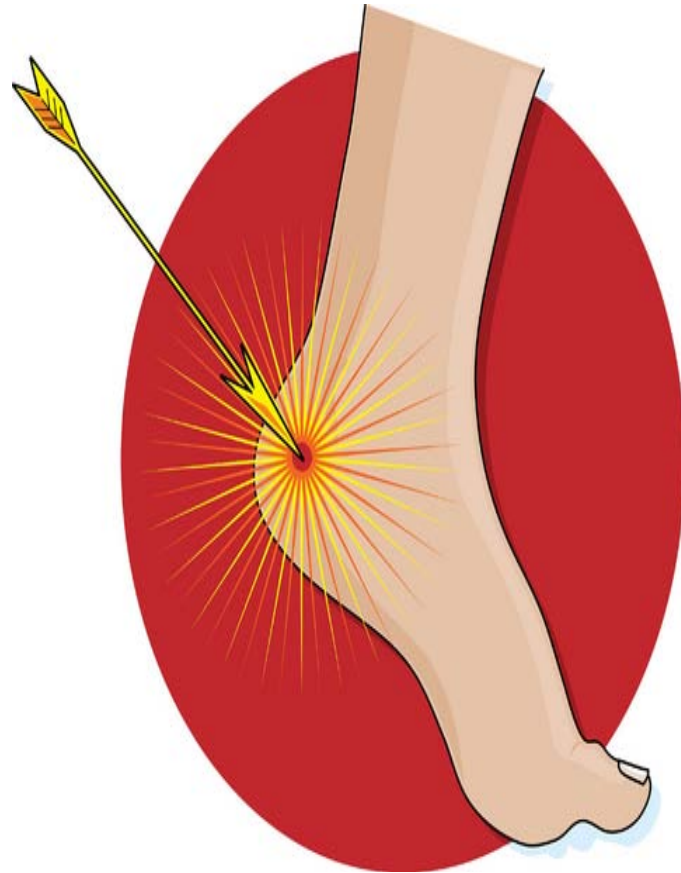
- ▶ Diarise file appropriately for Follow up on filing certificate Form M 5B, and receipt confirming payment of official fees.
- ▶ Check notice of filing advertisement in Marks Journal
- ▶ Then diarise file appropriately for Form M8– Notice of Transmittal, deadline for response from D/Ss, advertisement for opposition, sealing

Special Applications

- ▶ Conversion of Protocol application into a national application Rule 6:3- acquit Form M7 specifying the States in which the national route has been taken.
- ▶ Later designation applications – apply to States that were not Contracting Parties to the protocol when application was filed. Prefixed LD/ – new filing date and renewal date apply.

Oppositions

- ▶ The Achilles heel of the ARIPO trade mark system?



Oppositions

- ▶ Divergence on opposition terms and procedures; enforcement issues, problems of geographical dispersion ... a potential costly minefield
- ▶ So what shall we say of these challenges.... **Mariah Carey... “Make it happen”!**

Oppositions Con't

- ▶ **Proposition** – two-step approach
- ▶ File notice and Statement of grounds through ARIPO and request transmittal to the States of interest.
- ▶ Depending on outcome – enter into “national phase” of opposition, without “**toy soldiers**” 😊”



Thank You

Let your love for trade marks
“adorn” you!!.....

Miguel



Questions... Comments???

