



TOP TEN REASONS TO REGISTER YOUR TRADE MARKS

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The significance of registering trade marks should never be underestimated by any business with countless reasons as to why you should do so.

In this article we discuss the top 10 reasons why.

1. ADDING VALUE TO YOUR BUSINESS

- > Trade mark registrations add value to your business as they can be transferred in the case of the sale of your business or a unit or licensed to third parties in exchange for royalties.

2. INFRINGEMENT

- > On registration, you can prevent third parties from infringing your mark by using the identical or similar mark for the same or similar goods or services.
- > The certificate of registration can prove to be an effective and more cost efficient means to resolve disputes.

3. SOCIAL MEDIA COMPLAINTS

- > Social media platforms such as Facebook, Instagram and Twitter have trade mark complaint procedures to stop third parties employing username squatting tactics or using the trade marks in other unlawful ways.
- > We find that these social media platforms react sooner on the production of a certificate of registration.

4. DOMAIN NAME COMPLAINTS

- > A registered trade mark can also be used to lodge a domain name dispute which is done via the South African Institute of Intellectual Property Law in the case of .co.za domains and with the World Intellectual Property Organisation in the case of other top level domain names such as .com, .net and .org.
- > These bodies have been appointed as accredited service providers in these disputes.
- > Although rights of use can also be relied upon, a certificate of registration is rather handy in these types of proceedings.

5. TRADE MARKS APPEARING IN SEARCH ENGINE ADVERTS

- > A trade mark registration can also be used to stop the use of trade marks in sponsored links which result from the purchasing of keywords from search engines including Google Adwords.
- > Trade mark complaint procedures for such use is just as effective with a certificate of registration going a long way to ensure that the search engine removes the use of the mark, if used illegitimately.

6. SECURITISATION

- > Trade mark registrations can be used as security for purposes of raising capital.
- > This can only be done in relation to registered trade marks.

7. DEFENCE TO INFRINGEMENT CLAIMS

- > You can rely on your registered trade mark if you are threatened with trade mark infringement proceedings.

8. DETENTION OF COUNTERFEIT GOODS

- > Registered trade marks can be registered with customs in terms of the Counterfeit Goods Act ("CGA") which is a means to curb counterfeit goods from entering our borders.
- > Once registered, customs officials contact us to advise of any shipments of goods which feature the mark concerned.
- > Steps can then be taken as provided in the CGA to ensure the seizure of the goods and eventual destruction thereof.

9. USE OF ®

- > Only once the trade mark is registered can the ® symbol be used which is a clear indication to the outside world that the mark is registered.
- > The symbol could serve to dissuade third parties infringing upon the mark.

10. COSTS

- > The costs to register trade marks are not excessive, especially if the benefits are taken into account.
- > If a trade mark registration is properly maintained by the payment of renewal fees every 10 years, the trade mark registration can last forever.
- > It is therefore highly recommended that the registration of your brands not be overlooked.

Trade marks are territory specific so it is important to consider registration in South Africa and in other countries in which you use or propose to use your trade marks.

The Werksmans IP team has extensive experience in this regard and can be contacted to formulate your trade mark strategy and management thereof together with providing cost estimates for the registration of your marks to ensure that you too can enjoy the full benefits of registration.

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Janine Hollesen is a director in the Intellectual Property practice of Werksmans Attorneys, having joined the firm in 2009. She specialises in all aspects of Intellectual Property (IP) law, including trade mark clearance searches and registration, the protection and enforcement of IP rights, IP litigation, unlawful competition, counterfeit goods and domain name disputes.

Janine also advises on commercial matters. These include securitisation and due diligence investigations and the protection of plant breeders' rights - including the commercialisation of new varieties and related litigation.

Her expertise extends to advising clients in relation to copyright law and matters concerned with advertising, including dealing with complaints before the Advertising Standards Authority.

She is a fellow of the South African Institute of Intellectual Property Law (SAIIPL) and a member of the International Trade Mark Association (INTA) and the Plant Breeders' Rights Committee. Janine is named as a leading lawyer in Intellectual Property by *Chambers Global: The World's Leading Lawyers for Business* (2011 and 2012); and as a highly recommended lawyer in Intellectual Property by the Legal 500 (2010 – 2017).

She holds BA LLB and LLM degrees from the University of Stellenbosch and University of South Africa, respectively.

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