



Honey & Blanckenberg

Established 1893



200 Herbert Chitepo Avenue
Harare, Zimbabwe
Landline +263-24-2251331, 2251334, 2251339
Fax +263-4-790013, 792537
Mobile +263 - 733436165
Website <https://www.honeyb.co.zw/>



TRADE MARK EXAMINATION: CASE STUDIES AND PRACTICAL EXERCISES

- LORRAINE TAKAENDESA



COMMON PRACTICES AND MISTAKES BY EXAMINERS



- **INSUFFICIENT SEARCH SCOPE**
- **MISAPPLYING THE TEST FOR DISTINCTIVENESS**
- **UNNECESSARY DISCLAIMERS**
- **ARTIFICIAL DISSECTION OF TRADE MARKS**
- **DECEPTIVE TRADE MARKS**
- **MARKS WHICH ARE CONTRARY TO PUBLIC POLICY AND OR MORALITY**
- **WELL-KNOWN MARKS**



INSUFFICIENT SEARCH SCOPE

- the purpose of a search is to determine the existence of conflicting marks on the Register



- obvious variations – ROLEX, BOLEX, ROLIX
- plurals – ROLEXES
- partial matches – ROLEXSTER
- misspellings and variations – ROLEKS, ROLECS, ROWLEX, ROLECKS, ROLUX
 - IKI = DASHIKI
 - WASHA = WASHER
- vowel substitutions DOON, DUNE
- word, number letter substitutions
FREE2BU, EZ, 4EVA, 8TER



HITET

TM NO. 205/1989

HI-TET

TM NO. 508/2009



MISAPPLYING THE TEST FOR DISTINCTIVENESS



Distinctiveness is the fundamental requirement for a sign to be registered as a trade mark.

What is the test for distinctiveness?

- the sign must be capable of distinguishing goods and services in the course of trade.



apple tree

class 32 in respect of mineral and aerated waters; fruit beverages
and fruit juices





in class 9 in respect of computers, computer hardware and mobile
telephones



Orange sip

class 32 in respect of mineral and aerated waters; fruit beverages
and fruit juices





in class 38 in respect of telecommunications



Orange sip

in class 25 in respect of clothing



apple tree

in class 36 in respect of insurance services



UNNECESSARY DISCLAIMERS



WHAT IS THE PURPOSE OF A DISCLAIMER?

- a disclaimer denies the trade mark registrant the exclusive right to a portion of the mark which is non-distinctive



COMMON DISCLAIMED WORDS

- SUPERIOR
- QUALITY
- EXCELLENT
- MEGA
- BEST
- PERFECTO



apple tree
EXCELLENCE THROUGH QUALITY



power star

in class 9 in respect of batteries

What is a battery?

“a container consisting of one or more cells, in which chemical energy is converted into electricity and used as a source of power.”



ARTIFICIAL DISSECTION OF TRADE MARKS



Eco

an adjective which means not harming the environment



ecogas in class 4

ecoclean in class 3 in respect of detergents



Brecol

in class 3



HYUNDAI SANTA FE in class 12



DECEPTIVE TRADE MARKS



A trade mark is deceptive if its use in relation to the goods or services claimed in the application would be likely to deceive the public.

The deception can be in respect of the following:

- a characteristic of the goods or services
- the quantity or quality of the goods or services
- the geographical origin of the goods or services
- the intended use or purpose of the goods or services



TEST FOR DECEPTIVENESS

- is there a false implication?
 - WOOLIE in class 25
 - WOODLITE in class 20
 - COLORADO SPRING WATER in class 32



- are the prospective purchasers likely to believe in the false statement?
 - the nature of the goods – are they readily inspectable
 - the nature of the ordinary person making the purchase
 - BUFFALO WINGS in class 29



MARKS WHICH ARE CONTRARY TO PUBLIC POLICY AND MORALITY



PUBLIC POLICY

PUBLIC POLICY

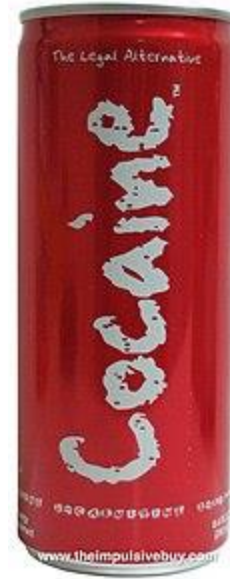
- this refers to the general legal framework of a state and to the rationale and purpose of that legal framework.

MORALITY

- this is a set of socially recognized principles that determine practices and rules of conduct within a particular community.



in respect of energy drinks



(image from www.amazon.com)





in class 25

(image from www.etsy.com)



WELL KNOWN MARKS

- well known marks are marks which are commonly recognized by the relevant domestic customers





 iPhone







(image from www.babolat.com)

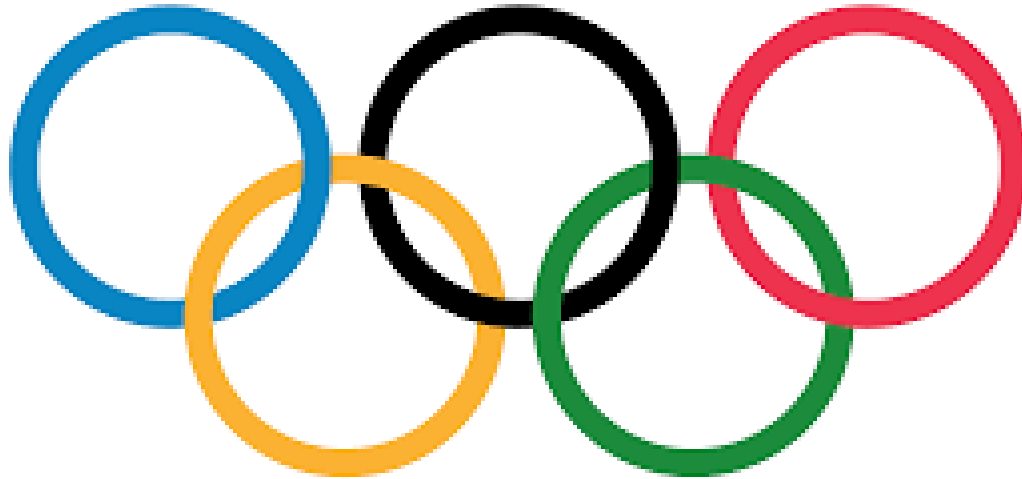






(image from www.tyr.com)







TIPS FOR AVOIDING OFFICIAL ACTIONS AND DELAYS



TRADE MARK SEARCH FOR PRIOR MARKS

Tip: conduct a comprehensive trade mark search

- limit goods specification
- cancellation for non-use
- limitation of wide specification
- requesting consent from the other party
- going back to the drawing board and reformulating a new mark



CORRECT CLASSIFICATION

Tip: correctly classify the goods/services

- refusal
- amendments
- new application
- delays
- additional costs
- no trade mark protection



DESCRIPTIVE MARKS

Tip: avoid descriptive marks

- **SUPER RICE in class 29**
- **SUPA RICE in class 29**
- **KLEEN MASTER in class 3**
- **SPIK ‘N SPAN in class 3**
- **PURE SWEETNESS in class 29 in respect of sugar**

Disclaim elements of the mark when filing the application.



DECEPTIVE MARKS

Tip: avoid deceptive marks

deceptively refer to:

- a characteristic of the goods or services
- the quantity or quality of the goods or services
- the geographical origin of the goods or services
- the intended use or purpose of the goods or services



- is there a false implication?
- are the prospective purchasers likely to believe in the false statement?



- limit the goods specification to goods actually made of the product, WOODLITE in class 20 in respect of furniture made of wood
- prospective purchasers are not likely to believe in the false statement. KOALA BUTCHERY in class 29



WELL KNOWN MARKS

Tip: avoid well known marks



LACK OF CONSIDERATION FOR CONNOTATIVE MEANINGS

Tip: consider connotative meanings

disclose connotative meanings





in respect of beer

(image from www.beercrank.ca)



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Established 1893

- Fart Bar -- a candy bar whose name means “lucky bar” in Poland.
- Barf -- an Iranian detergent meaning “snow” in Iran.
- Lumia -- a smart phone named with the slang word for “prostitute” in Spanish.
- P’zone -- a pizza whose name may be pronounced “pezón,” meaning “nipple” in Spanish.



MARKS WHICH ARE CONTRARY TO PUBLIC POLICY AND OR MORALITY

Tip: avoid marks which are contrary to public policy and or morality

- not contrary to public morality



QUESTIONS



BREAKOUT SESSION

**DISCUSS HOW YOU WOULD EXAMINE THE MARKS
FILL IN THE GOOGLE FORM**





GOLDEN CRUST

Class 30: pies



GEMINI



Class 45: Dating services, including online dating services



UUME
Applicant : Udaipur University for Medical Education
Class 41: education, providing of training



ARENA
Applicant: Arena S.p.A.
Class 25: Clothing, Footwear, Headgear



YU'KNEEK
in class 3 in respect of cosmetics



LACTOGEN
Applicant: Nestle
Class 29: Class heading



UNAWARE

Class 3: fragrances



. THANK YOU

