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MAKING A MARK

Intellectual Property
for Business Series 1|4

An Introduction to Trade marks for Small and Medium-sized Enterprises

Copies of all publications in this series are available from:

The Department of Trade and Industry (DTI)

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the dti

Department:
Trade and Industry
REPUBLIC OF SOUTH AFRICA

MAKING A MARK

An Introduction to Trade marks
for Small and Medium-sized
Enterprises



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Intellectual Property
for Business Series

1 | 4

PUBLICATIONS IN THE “INTELLECTUAL PROPERTY FOR BUSINESS” SERIES:

- 1. Making a Mark: An Introduction to Trade marks for Small and Medium-sized Enterprises.**
- 2. Looking Good: An Introduction to Aesthetic Designs for Small and Medium-sized Enterprises.**
- 3. Inventing the Future: An Introduction to Patents and Functional Designs for Small and Medium-sized Enterprises.**
- 4. Creative Expressions: An Introduction to Copyright for Small and Medium-sized Enterprises.**

All publications in the series are available from the Department of Trade and Industry at:
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PREFACE

This is the first in a series of guides developed under a World Intellectual Property Organisation (WIPO) development agenda project to assist small and medium sized enterprises (SMEs) to navigate and optimally utilise the intellectual property right system. The guide provides a user friendly overview and explanation of South African trade mark law. It makes use of practical examples to illustrate how trade mark protection operates in South Africa. SMEs are encouraged to utilise the guide in order to incorporate trade marks into their business strategy and to ensure their rights are protected.

The guide has been adapted to the national context by the Department of Trade and Industry (DTI).

Readers are invited to contact the DTI or the WIPO SME Section for further information on the use of intellectual property rights:

Department of Trade and Industry (DTI)

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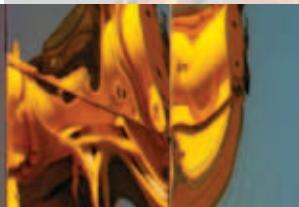
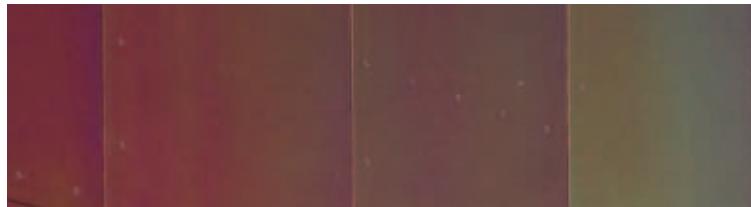
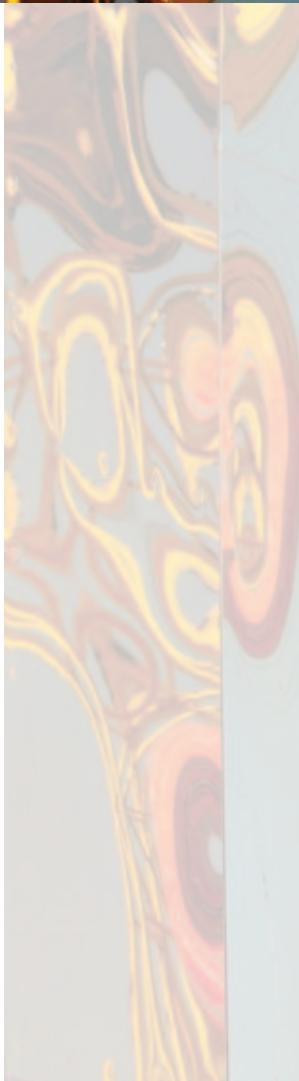
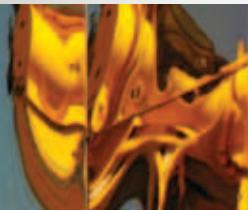


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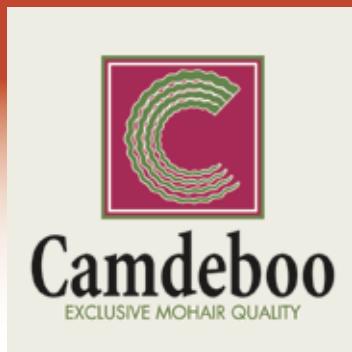
1. TRADE MARKS

Any **words, letters, numerals, drawings, pictures, shapes, colours, logos, labels**, or combinations of these which are used to distinguish goods or services may be considered a trade mark. A **logo** can be any distinctive picture or symbol. Distinctive **slogans** or short phrases are also capable of being registered as a trade mark in South Africa. A slogan is typically used in conjunction with a trade marked word and/or logo.

South Africa also allows for the registration of less traditional forms of trade marks, such as **single colours, three-dimensional signs** (shapes of products or packaging), audible signs (**sounds**) or olfactory signs (**smells**). However, only signs that are visually perceptible or that can be represented graphically can be protected as a trade mark.

WHAT IS A TRADE MARK?

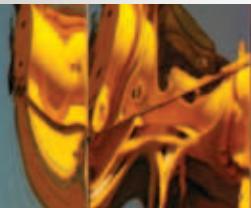
Trade marks are signs used or proposed to be used by a person in relation to goods or services for the purpose of distinguishing the goods or services in relation to which the mark is used or proposed to be used from the same kind of goods or services connected in the course of trade with any other person.



Example: The trade mark on the left consists of a combination of a letter, word and slogan (*courtesy of the Camdeboo Mohair Company*)



Example: The trade mark on the left is an example of a word mark used in combination with a logo (*courtesy of Proudly South African*)



2. WHAT ARE TRADE MARKS FOR?

The main function of a trade mark is to enable consumers to **identify a product** (whether a good or a service) of a particular business so as to **distinguish it from other identical or similar products** provided by competitors.

Consumers who are satisfied with a given product are likely to buy or use the product again in the future. For this, they need to be able to distinguish easily between identical or similar products. By enabling businesses to differentiate themselves

THE VALUE OF TRADE MARKS

Due to their role in building consumer goodwill, trade marks have the potential to become valuable business assets. For some businesses, it may be the most valuable asset they own. Estimates of the value of some of the world's most famous trade marks such as Coca-Cola or IBM exceed billions of Rands. This is because consumers value trade marks, their reputation, their image and a set of desired qualities they associate with the mark, and are willing to pay more for a product bearing a trade mark that they recognize and which meets their expectations. Therefore, the very ownership of a trade mark with a good image and reputation provides a business with a competitive edge.

and their products from those of the competition, trade marks play a pivotal role in the **branding and marketing strategies** of businesses, contributing to the definition of the **image**, and **reputation** of the business's products in the eyes of consumers. The image and reputation of a business create **trust** which is the basis for establishing a **loyal clientele** and enhancing a business's **goodwill**. Consumers often develop an emotional attachment to certain trade marks, based on a set of desired qualities or features embodied in the products bearing such trade marks. Trade marks also provide an incentive for businesses to invest in maintaining or improving the quality of their products in order to ensure that products bearing their trade mark have a positive reputation.

TRADE MARKS:

- Ensure that consumers can distinguish between products
- Enable a business to differentiate its products
- Are a marketing tool and the basis for building a brand image and reputation
- May be licensed to provide a direct source of revenue through royalties
- Are a crucial component of franchising agreements
- May be a valuable business asset
- Encourage companies to invest in maintaining or improving product quality
- May be useful for obtaining financing



3. PROTECTING TRADE MARKS

Why should your business protect its trade mark?

While most businesses realise the importance of using trade marks to differentiate their products from those of their competitors, not all realize the importance of protecting them through **registration**. Registration under Trade Marks Act 194 of 1993 gives your company the **exclusive right to prevent others from marketing identical or similar products under the same or a confusingly similar mark**. Without trade mark registration, your investments in marketing a product may become wasteful as competitors may use the same or a confusingly similar trade mark for identical or similar products. If a competitor adopts a similar or identical trade mark, customers could be misled into buying the competitor's product thinking it is your business's product. This could not only decrease your company's profits and confuse your customers, but may also damage the reputation and image of your business, particularly if the rival product is of inferior quality. Given the value of trade marks and the importance that a trade mark may have in determining the success of a product in the marketplace, it is critical to make sure that it is registered in the relevant market(s). In addition, it is much

easier to license a registered trade mark to other businesses, thus providing an additional source of revenue for your business, or it may be the basis for a franchising agreement. On occasion, a registered trade mark with a good reputation among consumers may also be used to obtain funding from financial institutions that are increasingly aware of the importance of brands for business success.

How can your business protect its trade mark(s)?

Trade mark protection can be obtained through registration in terms of the Trade Marks Act 194 of 1993. Unregistered trade marks are protected through use under common law. Even where trade marks can be protected through use, you are well advised to register the trade mark by filing the appropriate application form at the Companies and Intellectual Property Rights Commission (CIPC). The trade mark application form is called a **TM1** and is available online at http://www.cipc.co.za/TradeMarks_Forms.aspx. Registering a trade mark will provide stronger protection, particularly in case of conflict with an identical or a confusingly similar trade mark. The services of a trade mark agent are often very useful although they are not compulsory for registration of a trade mark in South Africa.

Is the registration of the trade name of your company sufficient?

Many people believe that by registering their business and its trade name at the CIPC, this name would also be automatically protected as a trade mark. This is a rather common misconception. It is important to understand the difference between trade names and trade marks. A trade name is the full name of your business, for example “South African Breweries Ltd”. It often ends with (Pty) Ltd or Ltd to denote the legal character of the business. **A trade mark, however, is the sign that distinguishes the product(s) of your business.** A business may have various trade marks. For instance, Pioneer Foods (Pty) Ltd may sell one of its products as BOKOMO but another as SASKO. Businesses may use a specific trade mark to identify all their products, a particular

Example:

Different trade marks owned by Pioneer Foods (Pty) Ltd and used in relation to the company's different product offerings
(courtesy of Pioneer Foods (Pty) Ltd)



range of products or one specific type of product. Some businesses may also use their trade name, or a part of it, as a trade mark. They should, in that case, register it as a trade mark.

Who is authorized to apply for trade mark registration?

In general, any person who intends to use a trade mark or to have it used by third parties can apply for registration. It can either be an individual or a legal entity.

Is it compulsory to register a business's trade mark(s)?

While registration is not necessary to establish rights, it provides numerous advantages including for example:

- **Nation-wide exclusivity:** The registered owner of a trade mark has the **exclusive right** to commercially use the trade mark **anywhere in the country** where registration was obtained. In contrast, unregistered trade mark rights may be limited to the part of the country where the trade mark is actually in use and has acquired a reputation through such use.
- **Easier to enforce:** The registration of a trade mark usually carries a presumption that you are the owner of the trade mark and, therefore, have the right to prevent the use of that trade mark by others. This **reduces the burden of proof** in court proceedings; that is, you don't have to prove that the trade mark is valid, that you are its owner or that there is goodwill associated with the trade mark.

- **Deterrence:** Firstly, registration enables you to **use the symbol © after the trade mark**, which alerts others to the fact that it is registered. Secondly, a registered trade mark will most likely appear in the search report conducted by another business that may want to register an identical or deceptively similar trade mark; this will discourage the other business from doing so. Thirdly, the South African trade mark office will automatically refuse to register a trade mark for goods/services which it considers to be confusingly similar to your registered trade mark in that same class.
- **Valuable asset:** It is **easier to sell or license** a registered trade mark and usually at a **higher price**. In addition, registration makes it simpler to use a trade mark in a franchising agreement or in merchandising.
- **Funds:** On occasion, a registered trade mark with a good reputation may also be used to **obtain funding or a mortgage** from financing institutions that are increasingly aware of the importance of brands for business success.
- **Prevent importation:** Many countries including South Africa have put in place systems that enable the owner of a registered trade mark to enlist the trade mark with the customs authorities for a fee. The purpose is to enable the customs authorities to inspect and seize counterfeit goods that infringe your registered trade mark. Unregistered trade marks generally do not receive such assistance from the customs authorities.

What are the requirements for a registrable trade mark?

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. A mark is considered to be capable of distinguishing 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 of the mark. The key requirement for a mark to be capable of registration is therefore **distinctiveness**.

What are the main reasons for rejecting an application?

While selecting a trade mark it is helpful to know which categories of signs are usually not acceptable for registration. In South Africa applications for the following types of marks will be rejected and you should therefore NOT select a trade mark which:

- does not constitute a trade mark as defined in the Trade Marks Act;
- is not capable of distinguishing in the course of trade the goods and/or services of a business from that of its competitors. This may include:

Generic terms: For example, if your company intends to register the trade mark CHAIR to sell chairs, the mark would be rejected since “chair” is the generic term for the product.

Descriptive terms: These are words that are usually used in trade to describe the product in question. For example, the mark SWEET is likely to be rejected for marketing chocolates as it is descriptive of the goods.

In fact, it would be considered unfair to give any single chocolate manufacturer exclusivity over the word “sweet” for marketing its products. Similarly, qualitative or laudatory terms such as RAPID, BEST, CLASSIC or INNOVATIVE are likely to give rise to similar objections

unless they are part of an otherwise distinctive mark. In such cases, it may be necessary to include a disclaimer clarifying that no exclusivity is sought for that particular part of the mark;

- 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;

Example:

24 HOURS cannot be registered as a trade mark, since the expression is reasonably required for use by other traders. Should the mark be registered, the proprietor would acquire the exclusive right to use this phrase and thereby prevent all other traders from using it. This cannot be allowed.

- the applicant has no real claim to proprietorship;
- the applicant for registration has no real 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;
- 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 which results from the nature of the goods themselves;
- is a reproduction, imitation or translation of a well known trade mark 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;

Example:

COCA-COLA will be considered a well known trade mark. It will therefore not be possible to register the mark KOKA-KOLA for any soft drinks (identical goods) or juices (similar goods).

- the application for registration is made in bad faith for example to derive unfair benefit from or harm the reputation of your competitor;
- contains any word, letter or device indicating State patronage;
- contains any mark specified in the regulations as being a prohibited mark;
- 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;
- is inherently deceptive or the use of which would be likely to deceive or cause confusion, be contrary to law, be contrary to the values of society, or be likely to give offence to any class of persons;

Example:

It will not be possible to register the mark LEATHERINE in relation to products made of synthetic materials as the mark will be considered inherently deceptive.

- as a result of the manner in which it has been used, would be likely to cause deception or confusion;

- is identical to a registered trade mark belonging to a different proprietor or an earlier application and which is so similar that its use on goods or services for which it is sought to be registered and which are the same as or similar to the goods or services for which such trade mark is registered, would be likely to deceive or cause confusion, unless the proprietor or prior applicant consents to the registration of such mark;
- is the subject of an earlier application, if the registration of that mark is contrary to existing rights of the person making the later application for registration;
- 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, even if there is no deception or confusion, unless the proprietor of such trade mark consents to the registration of such mark.

What should be kept in mind when selecting or creating a trade mark?

Selecting or creating an appropriate trade mark is a critical step, as it is an important element of the marketing strategy of your business. So what is an appropriate trade mark for your product(s)? Evidently, there are no hard and fast rules. But the five-point checklist on the next page may be useful.

While selecting your trade mark you should also take into consideration the implications of selecting certain types of words:

FIVE POINT CHECKLIST FOR SELECTING A TRADE MARK

- Check that your trade mark of choice meets all the **legal requirements** for registration (see the section below on reasons for rejecting applications).
- Do a **trade mark search** to make sure that it is not identical or confusingly similar to existing trade marks (see page 24).
- Make sure the trade mark is **easy to read, write, spell and remember** and is suitable to all types of advertising media.
- Make sure the mark does not have any **undesired connotations** in your own language or in any of the languages of potential export markets.
- Check that the corresponding **domain name** (i.e. Internet address) is available for registration (for more on the relationship between trade marks and domain names see page 36).

Coined or “fanciful” words.

These are invented words without any intrinsic or real meaning. Coined words have the advantage of being easy to protect, as they are more likely to be considered inherently distinctive. On the negative side, however, they may be more difficult to remember.

Arbitrary marks

These are words that have a meaning that has no relation to the product they advertise. While these types of marks will also be easy to protect, they may also require heavy advertising to create the association between the mark and the product in the minds of consumers.



Example:

Arbitrary Mark: Using the trade mark LION to market matches.

Suggestive marks

These are marks that hint at one or some of the attributes of the product. The appeal of suggestive marks is that they act as a form of advertising. A slight risk, however, is that a suggestive mark may be considered too descriptive of the product.

Example:

The trade mark SUNNY for marketing electric heaters would hint at the fact that the product is meant to radiate heat and keep your house warm. However, some trade mark registries may find the mark too descriptive and thus may not register it.

Irrespective of the type of mark you choose, it is important to avoid imitating existing trade marks. A slightly altered competitor's trade mark or a misspelt well-known or famous mark is unlikely to be registered.

Example:

EASY WEAR is a registered trade mark for teenage clothing. It would be unwise to try to sell the same or similar products using the trade mark EEZYWARE as it would probably be considered confusingly similar to the existing mark and is unlikely to be registered.

Registering a trade mark - Step by step

The Applicant

As a first step, the applicant has to send or hand in a duly completed trade mark application form (**TM1**) at the CIPC.

This form will include the contact details of your business, a graphic illustration of the mark, a description of the goods and services and/or class(es) for which your business wishes to obtain trade mark registration. An example of a completed trade mark application can be viewed at http://www.cipc.co.za/Trademarks_files/Sample_TM1_v1.pdf.

You have to file a separate trade mark application for each international class of goods or services for which you would like to use your trade mark. To identify the correct class for goods or services, view the International Classification of Goods and Services as explained in the box on page 25. For example, if you manufacture and also sell cars, you have to lodge two trade mark applications:

- One in class 12 for manufacturing of motor vehicles; and
- One in class 35 for selling of motor vehicles

An **application fee** of R590.00 is payable for every class in respect of which an application is lodged. For more information on the trade mark application process, applicants can contact the CIPC.

The Trade Marks Office (CIPC)

Formal examination: On receipt of an application, the CIPC will examine the application to ensure that it complies with the administrative requirements or formalities (i.e. whether the application fee has been paid and the application form is

properly filled in). If all administrative requirements have been met, the application will be allocated an application date and an official application number.

Substantive examination: The trade mark application is then examined to determine whether it complies with the substantive requirements of a mark. This would include whether the mark meets the legal requirements for a mark and whether the trade mark is in conflict with an existing mark on the register in the relevant class(es).

Publication and opposition: If the examiner accepts the application, the trade mark is published in the Patent Journal. Third parties then have 3 months from date of publication to oppose its registration.

Registration: If no opposition is entered, the mark will proceed to registration. A registration certificate is issued which is valid for 10 years.

Renewal: The renewal date is determined from the date of application. A trade mark can be renewed indefinitely for subsequent periods of 10 years, upon payment of the prescribed renewal fees. To renew a trade mark, a **TM5** form needs to be completed. The registration may be cancelled entirely or for certain goods or services if the trade mark has not been used for a continuous period of 5 years.

How long does it take to register a trade mark?

The time required for the registration of a trade mark in South Africa varies, but can range from 18 months to 3 years depending, among other things, on the number of applications the CIPC receives within a certain period.

While it takes time to obtain registration, the rights in a mark are back dated to the date of submission of the trade mark application. It is advisable however to apply for registration of a trade mark well in advance so that its registration is secured in time for its use in the advertising and marketing of the relevant products.

What are the costs associated with trade mark creation, protection and use?

It is important to keep in mind, and properly budget, the costs related to trade mark creation and registration:

There may be costs associated with the creation of a logo or word to be used as a trade mark, as many companies outsource this task.

There may be costs for conducting a trade mark search (see below).

There are costs associated with the registration process, which vary depending on the number of countries and the categories of products (or trade mark classes, see above). The CIPC will provide you with the detailed costs of trade mark registration in South Africa.

Businesses choosing to use a professional trade mark agent to assist in the registration process would face additional costs but would probably save significant time and energy in following the registration process.

How can you find out if your chosen trade mark might conflict with other registered trade marks? What is a trade mark search?

Before submitting an application for registering a trade mark, you should ensure that a proper trade mark search has been carried out. This is done to make sure that the trade mark you intend to use, or a similar one, is not already registered by another company for identical or similar products.

You can either conduct a preliminary trade mark search yourself or hire the services of a trade mark agent. Either of you can do the search through the CIPC. A fee of R190 is charged for a preliminary trade mark search. In order to request a preliminary search, a **TM2** form needs to be completed. The CIPC does not currently offer a free online trade mark database, as is available in some countries. A list of trade mark databases is available on WIPO's website www.arbiter.wipo.int/trade mark/.

In whatever manner it is done, bear in mind that any such trade mark search is only preliminary. It may be difficult to make sure that your trade mark of choice is not “confusingly similar” to existing validly-registered trade marks. This is why the guidance of an experienced trade mark agent, who is familiar with the practice of the trade mark office and court decisions, may be very helpful.

A WELL CLASSIFIED SYSTEM

When filling in your trade mark application form you are required to indicate the goods and/or services for which you wish to register your trade mark and to group them according to classes.

The trade mark classification system allows for the storage of data on registered trade marks in an orderly manner in relation to the types of goods or services. This makes it easier to retrieve information from trade mark databases. It is critical to register your trade mark in all classes in which you intend to use your trade mark.

The most widely used classification system is the International Trade Mark Classification system (the Nice Agreement concerning the International Classification of Goods and Services), which has 34 classes for goods and a further 11 for services. For more information see Annex III or www.wipo.int/classifications/nice/en/. The Vienna system establishes a classification for marks which consist of, or contain, figurative elements (it has 29 categories). See <http://www.wipo.int/classifications/vienna/en/faq.html>.

Example: If your company is producing knives and forks, then your trade mark application should be made for the corresponding goods in class 8. If, however, you wish to market other kitchen utensils (such as containers, pans or pots) using the same trade mark you will also have to register the mark for the corresponding goods in class 21. In South Africa you would have to make a separate application for each class of product whereas in some other countries you may cover a number of classes with a single application.

Do you need a trade mark agent to file a trade mark application?

South Africa does not require trade mark applicants to hire a trade mark agent to file an application; you may file the application yourself. However, the services of a trade mark agent skilled in conducting trade mark searches and familiar with the detailed procedure for trade mark registration may be used to save time, ensure that you apply for protection in the appropriate trade mark class(es) and avoid refusal on absolute grounds.

If you apply for trade mark registration abroad you may be required to have a trade mark agent who is resident in the relevant country. The relevant IP office (see Annex II) will be able to advise you on the need, if any, to be represented by an agent and provide you with a list of officially approved trade mark agents.

For how long is your registered trade mark protected?

Registered trade marks are protected for 10 years in South Africa. Registration may be renewed indefinitely (usually, for consecutive periods of 10 years) provided renewal fees are paid in time. Make sure that someone in your business is made responsible for ensuring timely renewal of trade mark registrations in all countries of continuing interest to your business.

Is trade mark registration in your home country valid internationally?

The legal rights arising out of a trade mark registration are normally limited to the territory to which they pertain; so, ordinarily, valid registration of a trade mark in South Africa only gives you rights in South Africa unless your mark is considered to be a well-known mark. (For information on well-known marks see page 33).

Should you consider protecting your trade mark abroad?

All the main reasons for registering your trade mark in South Africa also apply to the commercialization of your products in foreign markets. It is, therefore, highly advisable to register your trade mark abroad if you wish to grant a license to use in other countries. Exporting goods bearing a distinctive trade mark will enable your products to be recognized in foreign markets, allowing your company to build a reputation and image among foreign consumers, which may result in higher profits.

OUTSOURCING TRADE MARK CREATION

Designing a trade mark is a creative process. In South Africa a creator automatically owns the copyright over creative or artistic works, such as the artwork of a trade mark. Therefore, when the creation of a trade mark is outsourced, it is usually best to clarify issues of copyright ownership in the original agreement and/or to make sure the copyright over the trade mark is formally assigned to your business.

How can you register the trade mark of your company abroad?

Once you have registered the trade mark of your business in South Africa (home country) there are three main ways to register the trade mark in other countries:

The National Route: your business may apply to the trade mark office of each country in which it is seeking protection by filing the corresponding application in the required language and paying the required fees. As indicated earlier, a country may require you to use the services of a locally-based trade mark agent for this purpose.

ADVANTAGES OF USING THE MADRID SYSTEM

The principal advantages of using the Madrid system are that the trade mark owner can register his trade mark in all the countries party to the system by filing:

- a single international application
- in one language
- subject to one set of fees and deadlines.

Thereafter, the international registration can be maintained and renewed through a single procedure. You can find more information on international registration of marks either at the CIPC (www.cipc.co.za) or on the WIPO website: www.wipo.int/madrid/.

A list of the Member countries of the Madrid system is available in Annex IV.

The Regional Route: if you wish to apply for protection in countries which are members of a regional trade mark system you may apply for registration, with effect in the territories of all Member countries, by filing an application at the relevant regional office. The regional trade mark offices are:

- The African Regional Industrial Property Office (ARIPO)
- Benelux Office for Intellectual Property (BOIP)
- The Office for the Harmonization of the Internal Market of the European Union (OHIM)
- The Organisation Africaine de la Propriété Intellectuelle (OAPI).

The International Route: South Africa is a member of the Madrid system which means that if your trade mark has been registered or applied for in or with effect in South Africa, you may use the Madrid system (administered by WIPO) to register your trade mark in the more than 92 countries that are party to the system.



4. TYPES OF TRADE MARKS

Trade marks	Marks used to distinguish certain goods as those produced by a specific enterprise.
Service marks	Marks used to distinguish certain services as those provided by a specific enterprise.
Collective marks	Marks used to distinguish goods or services produced or provided by members of an association.
Certification marks	Marks used to distinguish goods or services that comply with a set of standards and have been certified by a certifying authority
Well known marks	Marks that are considered to be well-known in the market and as a result benefit from stronger protection.

What are service marks?

A service mark is very similar in nature to a trade mark. Both are distinctive signs; trade marks distinguish the goods of one enterprise from those of others, while service marks fulfil the same function in relation to services. Services may be of any kind, such as financial, banking, travel, advertising or catering, to name a few. Service marks can be registered, renewed, cancelled, assigned

and licensed under the same conditions as trade marks. South Africa does not provide for service marks as a separate category of trade marks as some other countries do. These marks are protected in South Africa under the trade marks category.

What are collective marks?

A collective mark is 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. Collective marks are owned by an association or cooperative whose members may use the collective mark to market their products. The association generally establishes a set of criteria for using the collective mark (e.g. quality standards) and permits individual businesses to use the mark if they comply with such standards. Collective marks may be an effective way of jointly marketing the products of a group of enterprises which may find it more difficult for their individual marks to be recognized by consumers and/or handled by the main distributors. Geographical names or other indications of geographical origin may be registered as collective trade marks in South Africa.



Example: The logo of the wine route and grapes on the left is an example of a collective mark (courtesy of South African Wine Routes, brand partner of American Express®)

What are certification marks?

A certification mark is 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 the rendering of the services, from goods or services not so certified.

Certification marks are given for compliance with defined standards, but are not confined to any membership. They may be used by anyone whose products meet certain established standards. The main difference between collective marks and certification marks is that the former may only be used by a specific group of enterprises (e.g. members of an association), while certification marks may be used by anybody who complies with the standards defined by the owner of the certification mark.

An important requirement for certification marks is that the entity which applies for registration is considered “competent to certify” the products concerned.

Example: The mark on the right is a certification mark used to certify meat originating from the Karoo region
(courtesy of the Karoo Development Foundation)



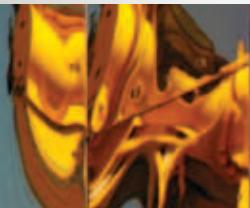
What are well-known marks?

Well-known marks are marks that are considered to be well-known by the competent authority of the country where protection for the mark is sought. Well-known marks generally benefit from stronger protection. For example, well-known marks may be protected even if they are not registered (or have not even been used) in a given territory.

In addition, while marks are generally protected against confusingly similar marks only if used for identical or similar products, well-known marks are protected against confusingly similar marks for even dissimilar products, if certain conditions are met. The main purpose of this stronger protection is to prevent businesses from free-riding on the reputation of a well-known mark and/or causing damage to its reputation or goodwill.

Example:

Let us assume that WONDERCOLA is the famous trade mark of a soft drink. Wondercola Inc. would then benefit from automatic protection in those countries where well-known marks enjoy stronger protection and where the mark is well-known for soft drinks. The protection would also be available for unrelated goods and services. That is to say that if another business decides to market other products, ranging from T-shirts to sunglasses, using the WONDERCOLA mark, it will have to seek the authorization of Wondercola Inc. or risk being sued for infringement of trade mark rights.



5. USING TRADE MARKS

Can you register a trade mark without having used it?

You may apply for registration before you have used the trade mark. But you must at the time of application have an honest intention to use the mark, either personally or by permitting use by others through licencing of the mark. A trade mark that has not been used for a continuous period of five years following issue of the registration certificate may be taken off the trade mark register. This means that you could lose your rights in your trade mark.

How should you use a trade mark in advertising?

If your mark is registered with a specific design or font, make sure that the trade mark is used exactly as it is registered. Monitor its use closely as it is crucial for the image of your business. It is also important to avoid using the trade mark as a verb or noun so that it does not come to be perceived by consumers as a generic term.

Can your business use the same trade mark for different products?

Different trade marks may be used for the different product lines of a business. Depending on its branding strategy, each business will decide whether to use the same trade mark for its products, extending the brand every time a new product is released, or to use a different mark for each product line.

Extending an existing brand to new products enables the new product to benefit from the image and reputation of the mark. However, the use of a new mark, more specific and relevant to the new product, may also prove advantageous and enable the company to target the new product to a specific customer group (e.g. children, teenagers, etc.) or to create a specific image for the new product line. Many businesses also choose to use a new brand in conjunction with an existing brand (for example Pro-Active®, a more recent brand used together with the existing brand Flora® margarine).

TM OR ®?

The use of ®, TM or equivalent symbols next to a trade mark is not a requirement and generally provides no further legal protection.

Nevertheless, it may be a convenient way of informing others that a given sign is a trade mark, thus warning possible infringers and counterfeiters.

The ® symbol is used once the trade mark has been registered, whereas TM denotes that a given sign is a trade mark. SM is used in some countries to show that it is a service mark, but this symbol is not used in South Africa. Note that it is an offence to create the impression that a trade mark is a registered mark if it is not. This includes using the word “registered” or the abbreviation °.

Different businesses adopt different strategies. Whatever your choice, you should make sure that your trade mark is registered for all categories of goods and/or services for which it is, or will be, used.

What should be kept in mind when using trade marks on the Internet?

The use of trade marks on the Internet has raised a number of controversial legal problems with no easy or uniform solution. One important problem stems from the fact that trade mark rights are territorial (that is, they are only protected in the country or region where the mark has been registered or used), whereas the reach of the Internet is global. This creates problems when it comes to settling disputes between persons or businesses legitimately owning identical or confusingly similar trade marks for identical or similar goods or services in different countries. Legislation in this area is still developing and treatment may differ from one country to another.

What is a domain name and how does it relate to trade marks?

An important problem concerns the conflict between trade marks and domain names. Domain names are Internet addresses, and are commonly used to find websites. For example, the domain name 'fnb.co.za' is used to locate the First National Bank website at www.fnb.co.za.

Over time, domain names have come to constitute business identifiers thus often coming into conflict with trade marks. Often national laws, or courts, treat the registration of the trade mark of another company or person as a domain

name as trade mark infringement, popularly known as cybersquatting. If this happens, then, your business may not only have to transfer or cancel the domain name, but it may also have to pay damages or a heavy fine.

Therefore, it is important that you choose a domain name which is not the trade mark of another business, particularly a well-known trade mark. In order to find out whether a particular trade mark is already protected in South Africa, you can directly contact the CIPC. Many other national and regional trade mark offices operate Internet searchable trade mark databases. A list of such databases is available on WIPO's website: <http://www.wipo.int/amc/en/trade%20mark/output.html>

On the other hand, if the trade mark of your business is being used in a domain name or is being cyber squatted by another individual or company then you may take action to stop such misuse/infringement of the rights of your business. In such a case, one option would be to use WIPO's very popular online administrative procedure for domain name dispute resolution at: www.wipo.int/amc/en.

This WIPO website includes a model complaint as well as a legal index to the thousands of WIPO domain name cases that have already been decided.

Can you license your trade mark to other companies?

Trade marks can be licensed to other businesses. In such cases, the trade mark owner retains ownership and merely agrees to the use of the trade mark by one or more businesses. This is usually done on payment of royalties and involves the consent of the trade mark owner, which is usually specified

in a formal licensing agreement. Depending on the nature of the agreement, the licensor often retains some degree of control over the licensee to guarantee that a certain quality is maintained.

In practice, trade mark licenses are frequently granted within broader licensing agreements, for example, franchising agreements or agreements including the licensing of other intellectual property rights such as patents, know-how and some degree of technical assistance for the production of a given product.

What does a franchising agreement have to do with trade marks?

The licensing of a trade mark is central to a franchising agreement. In franchising agreements the degree of control of the trade mark owner over the franchisee is generally greater

Example:

A restaurant selling chicken meals operates under the trade mark NANDO'S. It has developed a system for preparing and selling these products, which are sold in large volumes and in a uniform manner. The system includes various factors that contribute to the success of NANDO'S restaurants, including recipes and methods of preparing meals that result in a product of consistent quality, the design of employees' uniforms, the design of the buildings, the design of packaging, and management and accounting systems. NANDO'S imparts its knowledge and experience to its franchisees and retains the right to supervise and control local franchises. As a crucial component of the franchising agreement the franchisees will also be authorized and obliged to use the NANDO'S trade mark.

than is the case for standard trade mark licensing agreements. In the case of franchising, the franchiser allows another person (the franchisee) to use his way of doing business (including trade marks, know-how, customer service, software, shop decoration, etc.) in accordance with a set of prescriptions and in exchange for compensation or royalty.

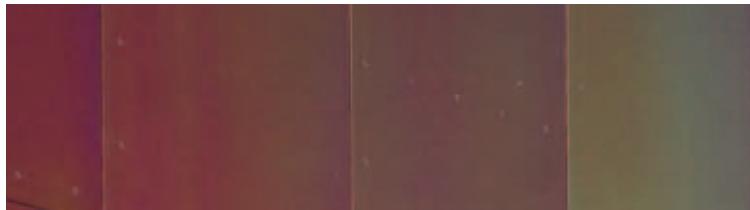
Is there any restriction in selling or assigning the trade mark of your business to another business?

It is possible to sell or assign a trade mark independently from the business that currently owns it. The sale or assignment of a trade mark is regulated by section 39 and 40 of the Trade Marks Act. An assignment **must be in writing** and the deed of assignment must be signed by the assignor (previous proprietor) and the assignee (new proprietor). The person who becomes entitled to the trade mark by assignment must apply on the prescribed form (TM6) to the CIPC to be registered as the proprietor of the trade mark. There is a cost of R150.00 for assignment of the first trade mark and R26.00 for any additional assignments. The deed of assignment must be lodged at the CIPC within 12 months from the effective date of the assignment, failing which a penalty fee of R48.00 is payable for every 12 months following the expiration of the prescribed 12 months period.

Do you need to register all small modifications to your trade mark?

Many trade marks, including some of the most famous, have slightly changed or evolved over the years in order to modernize the image of a business or adapt to new advertising

media. Marks may be changed or adapted, but your business will have to be careful and consult with the CIPC in South Africa or the trade mark office in the other relevant countries or a competent trade mark agent as to whether a specific change will require the submission of a new application and payment of relevant fees.



6. ENFORCING TRADE MARKS

What should your business do if its trade mark is being used by others without authorization?

The burden of enforcing a trade mark is mainly on the trade mark owner. It is up to your business as a trade mark owner to identify any infringement and to decide what measures should be taken to enforce trade mark rights. It is always useful to seek expert advice if you believe that someone is infringing your trade mark. An intellectual property lawyer would be the right person to give you information on the existing options in South Africa and, presumably, also in neighbouring countries to initiate action against counterfeiting and infringement and will provide you with advice on how to enforce your rights.

If you are faced with infringement of your trade mark rights, then you may choose to begin by sending a letter (commonly known as a “**letter of demand**”) to the alleged infringer informing him/her of the possible existence of a conflict. In writing such a letter, the assistance of a trade mark lawyer is recommended.

If your business considers the infringement to be wilful and knows the location of the infringing activity, then it may wish to take surprise action by obtaining, with the help of a trade



mark lawyer, a **search and seize order** (obtained from a High Court judge in chambers or a magistrate within the area of jurisdiction where the suspected offence is committed) to conduct a raid without prior notice to the allegedly offending company/person. The infringer may be compelled by the judicial authorities to inform you of the identity of persons involved in the production and distribution of the infringing goods or services and their channels of distribution. As an effective deterrent to infringement, the judicial authorities may order, upon your request, that infringing goods and materials be destroyed or disposed of outside the channels of commerce without compensation of any sort.

In order to prevent the importation of counterfeit trade mark goods, measures at the international border are available to trade mark owners in South Africa through the national customs authorities. As a trade mark owner, your company may seek the assistance of the customs authorities at the border, that is, before the counterfeit goods have been distributed in the country concerned. It is important to note that Customs will only assist trade mark proprietors who have filed an application in terms of section 15 of the Counterfeit Goods Act 37 of 1997 and whose application has been accepted by the Commissioner for Customs and Excise. For assistance with this procedure it is recommended that trade mark proprietors enlist the help of a trade mark lawyer.

In some instances, an effective way of dealing with infringement is through **arbitration** or **mediation**. Arbitration generally has the advantage of being a less formal, shorter and cheaper procedure than court proceedings, and an arbitral award is more easily enforceable internationally.

An advantage of mediation is that the parties remain in control of the dispute resolution process. As such, it can help to preserve good business relations with another enterprise with which your business may like to collaborate in the future. For more information on arbitration and mediation, see the website of the WIPO Arbitration and Mediation Centre at: www.wipo.int/amc/en.

ANNEX I – USEFUL WEBSITES

For more information see:

- Intellectual property issues from a business perspective
www.wipo.int/sme
- Trade marks in general
www.wipo.int/about-ip
www.inta.org (International Trademark Association)
- For practical aspects relating to the registration of trade marks see Annex II or
www.wipo.int/directory/en/urls.jsp
- Madrid system for the International Registration of Marks
www.wipo.int/madrid
- International Classification of Goods and Services for the Purposes of the Registration of Marks under the Nice Agreement
<http://www.wipo.int/classifications/nice/en/>
- International Classification of the Figurative Elements of Marks under the Vienna Agreement
<http://www.wipo.int/classifications/vienna/en/>
- The conflict between trade marks and domain names and on alternative dispute resolution procedures for domain names
www.wipo.int/amc/en
- A list of the online trade mark databases maintained by industrial property offices throughout the world is available at:
www.wipo.int/amc/en/trademark/output/html

ANNEX II – NATIONAL OFFICES

Afghanistan	http://moic.gov.af/en
Albania	http://www.alpto.gov.al/home.asp?l=en
Algeria	http://www.inapi.org/
Andorra	http://www.ompa.ad/
Angola	http://www.mingmi.gov.ao/
Antigua and Barbuda	http://www.antigua.gov.ag/
Argentina	http://www.inpi.gov.ar/templates/index.asp
Armenia	http://www.aipa.am/hy/
Australia	http://www.ipaustralia.gov.au/
Austria	http://www.patentamt.at/
Azerbaijan	http://www.azstand.gov.az/
Bahamas	http://www.bahamas.gov.bs/rgd/
Bahrain	http://www.moic.gov.bh/moic/en/
Bangladesh	http://www.dpdt.gov.bd/
Barbados	http://www.caipo.gov.bb/site/index.php
Belarus	http://www.belgospatent.org.by/
Belgium	http://economie.fgov.be/en/enterprises/Intellectual property
Belize	http://www.belipo.bz/
Benin	See OAPI regional office below
Bhutan	http://www.ipbhuutan.gov.bt/aboutus.aspx
Bolivia	http://www.senapi.gob.bo/
Bosnia and Herzegovina	http://www.ipr.gov.ba/en/
Botswana	http://www.mti.gov.bw
Brazil	http://www.inpi.gov.br/
Brunei Darussalam	http://www.agc.gov.bn/
Bulgaria	http://www.bpo.bg/
Burkina Faso	http://www.commerce.gov.bf/
Burundi	http://www.commerceetindustrie.gov.bi/
Cambodia	http://www.moc.gov.kh/
Cameroon	See OAPI regional office below
Canada	http://www.cipo.ic.gc.ca/eic/site/cipointernet-internetopic.nsf/eng/Home
Cape Verde	URL not available
Central African Republic	See OAPI regional office below

Chad	See OAPI regional office below
Chile	http://www.inapi.cl/portal/institucional/600/w3-channel.html
China	http://sbj.saic.gov.cn/
Columbia	http://www.sic.gov.co/
Comoros	URL not available
Congo	See OAPI regional office below
Costa Rica	http://www.mjp.go.cr/
Cote d'Ivoire	See OAPI regional office below
Croatia	http://www.dziv.hr/
Cuba	http://www.ocpi.cu/
Cyprus	http://www.mcit.gov.cy
Czech Republic	http://www.upv.cz/cs.html
Democratic People's Republic of Korea	http://www.dprkorea-trade.com/patents/rspatent.htm
Democratic Republic of the Congo	See OAPI regional office
Denmark	http://www.dkpto.org/
Djibouti	http://www.mci.dj/
Dominica	URL not available
Dominican Republic	http://onapi.gob.do/
Ecuador	http://www.iepi.gob.ec/
Egypt	http://www.mfti.gov.eg/
El Salvador	http://www.cnr.gob.sv/
Equatorial Guinea	See OAPI regional office below
Eritrea	URL not available
Estonia	http://www.patentinfo.ee/
Ethiopia	http://www.eipo.gov.et/
Fiji	http://www.ag.gov.fj/
Finland	http://www.prh.fi/
France	http://www.inpi.fr/
Gabon	http://cepig.net/
Gambia	See OAPI regional office below
Georgia	http://www.sakpatenti.org.ge/
Germany	http://www.dpma.de/
Ghana	See OAPI regional office below
Greece	URL not available. See OHIM regional office below
Grenada	URL not available

Guatemala	https://www.rpi.gob.gt/
Guinea	See OAPI regional office below
Guinea Bissau	See OAPI regional office below
Guyana	URL not available
Haiti	URL not available
Holy See	http://www.vaticanstate.va/FR/homepage.htm
Honduras	http://www.digepih.webs.com/
Hungary	http://www.hipo.gov.hu/English/
Iceland	http://www.els.is/
India	http://www.ipindia.nic.in/
Indonesia	http://merek-indonesia.dgip.go.id/
Iran (Islamic Republic of)	http://iripo.ssaa.ir/
Iraq	URL not available
Ireland	http://www.patentsoffice.ie/
Israel	http://index.justice.gov.il/
Italy	http://www.uibm.gov.it/
Jamaica	http://www.jipo.gov.jm/
Japan	http://www.jpo.go.jp/
Jordan	http://www.mit.gov.jo/
Kazakhstan	http://www.kazpatent.kz/
Kenya	http://www.kipi.go.ke/
Kiribati	URL not available
Kuwait	URL not available
Kyrgyzstan	http://patent.kg/en
Lao Peoples Democratic Republic	http://www.stea.la.wipo.net/index.html
Latvia	http://www.lrpv.lv/
Lebanon	http://www.economy.gov.lb/
Lesotho	URL not available
Liberia	URL not available
Libya	URL not available
Liechtenstein	http://www.awv.llv.li/
Lithuania	http://www.vpb.lt/
Luxembourg	http://www.eco.public.lu/
Madagascar	http://www.omapi.mg/
Malawi	See ARIPO regional office below
Malaysia	http://www.myipo.gov.my/

Maldives	http://www.trade.gov.mv/
Mali	See OAPI regional office below
Malta	https://secure2.gov.mt/IPO/default.aspx?ct=2&date=22022013111244
Mauritania	See OAPI regional office
Mauritius	http://www.gov.mu/portal/site/mfasite/menuitem.d26b8c9d73facdfda4522e10a0208a0c/
Mexico	http://www.impi.gob.mx/
Monaco	http://en.gouv.mc/Government-Institutions/The-Government/Ministry-of-Finance-and-Economy/Business-Development-Agency
Mongolia	http://www.ipom.mn/
Montenegro	http://www.ziscg.me/
Morocco	http://www.ompic.org.ma/
Mozambique	http://www.ipi.gov.mz/
Myanmar	URL not available
Namibia	URL not available
Nauru	URL not available
Nepal	http://doind.gov.np/index.php
Netherlands	http://www.agentschapnl.nl/en
New Zealand	http://www.iponz.govt.nz/cms
Nicaragua	http://rpi.mific.gob.ni/
Niger	See OAPI regional office below
Nigeria	See OAPI regional office below
Norway	http://www.patentstyret.no/
Oman	http://www.mocioman.gov.om/
Pakistan	http://www.ipo.gov.pk/
Palau	URL not available
Panama	http://www.digerpi.gob.pa/
Papua New Guinea	http://www.ipopng.gov.pg/
Paraguay	http://www.mic.gov.py/v1/index.php
Peru	http://www.indecopi.gob.pe/0/home.aspx?PFL=0&ARE=0
Philippines	http://www.ipophil.gov.ph/index.php
Poland	http://www.uprp.pl/strona-glowna/Menu01,9,0,index,pl/
Portugal	http://www.marcaspatentes.pt/index.php?section=1
Qatar	URL not available
Republic of Korea	http://www.kipo.go.kr/

Republic of Moldova	http://www.agepi.md/
Romania	http://www.osim.ro/
Russian Federation	http://www.rupto.ru/en_site/index_en.htm
Rwanda	http://org.rdb.rw/
Saint Kitts and Nevis	URL not available
Saint Lucia	URL not available
Saint Vincent and Grenadines	http://www.cipo.gov.vc/
Samoa	http://www.mcil.gov.ws/
San Marino	URL not available
Sao Tome and Principe	http://senapi-stp.net/spip.php?rubrique1
Saudi Arabia	URL not available
Senegal	See OAPI regional office below
Serbia	http://www.zis.gov.rs/pocetna.1.html
Seychelles	URL not available
Sierra Leone	URL not available
Singapore	http://www.ipo.gov.sg/
Slovakia	http://www.upv.sk/
Slovenia	http://www.uil-sipo.si/
Solomon Islands	URL not available
Somalia	URL not available
South Africa	http://www.cipc.co.za/
Spain	http://www.oepm.es/
Sri Lanka	http://www.nipo.gov.lk/
Sudan	URL not available
Suriname	URL not available
Swaziland	http://www.gov.sz/index.php?option=com_content&view=article&id=228&Itemid=306
Sweden	http://www.prv.se/
Switzerland	https://www.ige.ch/
Syrian Arab Republic	http://www.spo.gov.sy/
Tajikistan	http://www.ncpi.tj/index2.php
Thailand	http://www.ipthailand.go.th/iphailand/index.php?lang=en
The former Yugoslav Republic of Macedonia	http://www.ippo.gov.mk/
Timor-Leste	http://www.mj.gov.tl/
Togo	See OAPI regional office below

Tonga	http://www.mlci.gov.to/?page_id=1042
Trinidad and Tobago	http://www.legalaffairs.gov.tt/ipo/
Tunisia	http://www.innorpi.tr/Fra/accueil_46_4
Turkey	http://www.turkpatent.gov.tr/
Turkmenistan	URL not available
Tuvalu	URL not available
Uganda	See ARIPO regional office below
Ukraine	http://sips.gov.ua/en/index.html
United Arab Emirates	http://www.economy.gov.ae/Arabic/Pages/default.aspx
United Kingdom	http://www.ipo.gov.uk/
United Republic of Tanzania	See ARIPO regional office below
United States of America	http://www.uspto.gov/
Uruguay	http://www.dnpi.gub.uy/
Uzbekistan	http://www.ima.uz/ru/
Vanuatu	URL not available
Venezuela (Bolivarian Republic of)	http://www.sapi.gob.ve/
Vietnam	http://www.noip.gov.vn/
Yemen	http://www.yipo.gov.ye/
Zambia	http://www.pacra.org.zm/
Zimbabwe	See ARIPO regional office below

Regional Offices

African Intellectual Property Organization (OAPI)	http://www.oapi.int/
African Regional Intellectual Property Organization (ARIPO)	http://www.aripo.org/
Benelux Office for Intellectual Property (BOIP)	http://www.boip.int
Office for Harmonization in the Internal Market (OHIM)	http://oami.europa.eu/ows/rw/pages/index.en.do

ANNEX III – NICE CLASSIFICATION

International Classification of Goods and Services for the Purposes of the Registration of Marks under the Nice Agreement

GOODS:

Class	Goods
1	Chemicals used in industry, science and photography, as well as in agriculture, horticulture and forestry; unprocessed artificial resins, unprocessed plastics; manures; fire extinguishing compositions; tempering and soldering preparations; chemical substances for preserving foodstuffs; tanning substances; adhesives used in industry.
2	Paints, varnishes, lacquers; preservatives against rust and against deterioration of wood; colorants; mordents; raw natural resins; metals in foil and powder form for painters, decorators, printers and artists.
3	Bleaching preparations and other substances for laundry use; cleaning, polishing, scouring and abrasive preparations; soaps; perfumery, essential oils, cosmetics, hair lotions; dentifrice
4	Industrial oils and greases; lubricants; dust absorbing, wetting and binding compositions; fuels (including motor spirit) and illuminants; candles and wicks for lighting.
5	Pharmaceutical and veterinary preparations; sanitary preparations for medical purposes; dietetic substances adapted for medical use, food for babies; plasters, materials for dressings; material for stopping teeth, dental wax; disinfectants; preparations for destroying vermin; fungicides, herbicides
6	Common metals and their alloys; metal building materials; transportable buildings of metal; materials of metal for railway tracks; non-electric cables and wires of common metal; ironmongery, small items of metal hardware; pipes and tubes of metal; safes; goods of common metal not included in other classes; ores.
7	Machines and machine tools; motors and engines (except for land vehicles); machine coupling and transmission components (except for land vehicles); agricultural implements other than handoperated; incubators for eggs.
8	Hand tools and implements (hand-operated); cutlery; side arms; razors

9	Scientific, nautical, surveying, photographic, cinematographic, optical, weighing, measuring, signaling, checking (supervision), life-saving and teaching apparatus and instruments; apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling electricity; apparatus for recording, transmission or reproduction of sound or images; magnetic data carriers, recording discs; automatic vending machines and mechanisms for coin-operated apparatus; cash registers, calculating machines, data processing equipment and computers; fireextinguishing apparatus.
10	Surgical, medical, dental and veterinary apparatus and instruments, artificial limbs, eyes and teeth; orthopedic articles; suture materials.
11	Apparatus for lighting, heating, steam generating, cooking, refrigerating, drying, ventilating, water supply and sanitary purposes.
12	Vehicles; apparatus for locomotion by land, air or water.
13	Firearms; ammunition and projectiles; explosives; fireworks
14	Precious metals and their alloys and goods in precious metals or coated therewith, not included in other classes; jewellery, precious stones; horological and chronometric instruments
15	Musical instruments
16	Paper, cardboard and goods made from these materials, not included in other classes; printed matter; bookbinding material; photographs; stationery; adhesives for stationery or household purposes; artists' materials; paint brushes; typewriters and office requisites (except furniture); instructional and teaching material (except apparatus); plastic materials for packaging (not included in other classes); printers' type; printing blocks.
17	Rubber, gutta-percha, gum, asbestos, mica and goods made from these materials and not included in other classes; plastics in extruded form for use in manufacture; packing, stopping and insulating materials; flexible pipes, not of metal.
18	Leather and imitations of leather, and goods made of these materials and not included in other classes; animal skins, hides; trunks and travelling bags; umbrellas, parasols and walking sticks; whips, harness and saddlery
19	Building materials (non-metallic); non-metallic rigid pipes for building; asphalt, pitch and bitumen; non-metallic transportable buildings; monuments, not of metal.
20	Building materials (non-metallic); non-metallic rigid pipes for building; asphalt, pitch and bitumen; non-metallic transportable buildings; monuments, not of metal.

21	Household or kitchen utensils and containers (not of precious metal or coated therewith); combs and sponges; brushes (except paint brushes); brush-making materials; articles for cleaning purposes; steelwool; unworked or semi-worked glass (except glass used in building); glassware, porcelain and earthenware not included in other classes
22	Ropes, string, nets, tents, awnings, tarpaulins, sails, sacks and bags (not included in other classes); padding and stuffing materials (except of rubber or plastics); raw fibrous textile materials.
23	Yarns and threads, for textile use.
24	Textiles and textile goods, not included in other classes; bed and table covers.
25	Clothing, footwear, headgear
26	Lace and embroidery, ribbons and braid; buttons, hooks and eyes, pins and needles; artificial flowers.
27	Carpets, rugs, mats and matting, linoleum and other materials for covering existing floors; wall hangings (non-textile).
28	Games and playthings; gymnastic and sporting articles not included in other classes; decorations for Christmas trees.
29	Meat, fish, poultry and game; meat extracts; preserved, dried and cooked fruits and vegetables; jellies, jams, compotes; eggs, milk and milk products; edible oils and fats.
30	Coffee, tea, cocoa, sugar, rice, tapioca, sago, artificial coffee; flour and preparations made from cereals, bread, pastry and confectionery, ices; honey, treacle; yeast, baking-powder; salt, mustard; vinegar, sauces (condiments); spices; ice.
31	Agricultural, horticultural and forestry products and grains not included in other classes; live animals; fresh fruits and vegetables; seeds, natural plants and flowers; foodstuffs for animals, malt.
32	Beers; mineral and aerated waters and other non-alcoholic drinks; fruit drinks and fruit juices; syrups and other preparations for making beverages.
33	Alcoholic beverages (except beers).
34	Tobacco; smokers' articles; matches.

SERVICES:

Class	Services
35	Advertising; business management; business administration; office functions
36	Insurance; financial affairs; monetary affairs; real estate affairs.
37	Building construction; repair; installation services

38	Telecommunications
39	Transport; packaging and storage of goods; travel arrangement
40	Treatment of materials
41	Education; providing of training; entertainment; sporting and cultural activities
42	Scientific and technological services and research and design relating thereto; industrial analysis and research services; design and development of computer hardware and software; legal services.
43	Services for providing food and drink; temporary accommodation
44	Medical services; veterinary services; hygienic and beauty care for human beings or animals; agriculture, horticulture and forestry services.
45	Personal and social services rendered by others to meet the needs of individuals; security services for the protection of property and individuals.

In February 2013, 83 states were party to the Nice Agreement. They have adopted and apply the Nice Classification for the purposes of the registration of marks.

Note: For up-to-date information visit:

www.wipo.int/classifications/fulltext/nice8/enmain.htm and
www.wipo.int/madrid/en/contact.html

ANNEX IV - MEMBERS OF THE MADRID UNION

(As of 15 January 2013)

Albania (A&P)	France (A&P)
Algeria (A)	Georgia (P)
Antigua and Barbuda (P)	Germany (A&P)
Armenia (A&P)	Ghana (P)
Australia (P)	Greece (P)
Austria (A&P)	Hungary (A&P)
Azerbaijan (A&P)	Iceland (P)
Bahrain (P)	Iran (Islamic Republic of) (A&P)
Belarus (A&P)	Ireland (P)
Belgium* (A&P)	Israel (P)
Bhutan (A&P)	Italy (A&P)
Bosnia and Herzegovina (A&P)	Japan (P)
Botswana (P)	Kazakhstan (A&P)
Bulgaria (A&P)	Kenya (A&P)
China (A&P)	Kyrgyzstan (A&P)
Columbia (P)	Latvia (A&P)
Croatia (A&P)	Lesotho (A&P)
Cuba (A&P)	Liberia (A&P)
Cyprus (A&P)	Liechtenstein (A&P)
Czech Republic (A&P)	Lithuania (P)
Democratic People's Republic of Korea (A&P)	Luxembourg* (A&P)
Denmark (P)	Madagascar (P)
Egypt (A&P)	Mexico (P)
Estonia (P)	Monaco (A&P)
European Union (P)	Mongolia (A&P)
Finland (P)	Montenegro (A&P)
	Morocco (A&P)

Mozambique (A&P)	Slovenia (A&P)
Namibia (A&P)	Spain (A&P)
Netherlands* (A&P)	Sudan (A&P)
New Zealand (P)	Swaziland (A&P)
Norway (P)	Sweden (P)
Oman (P)	Switzerland (A&P)
Philippines (P)	Syrian Arab Republic (A&P)
Poland (A&P)	Tajikistan (A&P)
Portugal (A&P)	The former Yugoslav Republic of Macedonia (A&P)
Republic of Korea (P)	Turkey (P)
Republic of Moldova (A&P)	Turkmenistan (P)
Romania (A&P)	Ukraine (A&P)
Russian Federation (A&P)	United Kingdom (P)
San Marino (A&P)	United States of America (P)
Sao Tome and Principe (P)	Uzbekistan (P)
Serbia (A&P)	Viet Nam (A&P)
Sierra Leone (A&P)	Zambia (P)
Singapore (P)	
Slovakia (A&P)	

(A) indicates a party to the Agreement

(P) indicates a party to the Protocol

* Protection may not be requested separately for Belgium, Luxembourg or the Netherlands, but only for all three countries as a whole (Benelux), subject to payment of a single complementary or individual fee.

Note: For up-to-date information, visit: www.wipo.int/madrid/en/members/