

## **Protect your name by using it**

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Once your trade mark searches have been conducted and the results are positive, you can immediately start using your trade marks. Due to the function of trade marks, trade marks are primarily used in advertising materials. Use of trade marks in advertising materials can certainly strengthen the exclusive rights in the mark, as it can acquire reputation through extensive use.

Technological mediums of advertising further makes it easy to cover large geographical areas, such as mobile and internet marketing which can be accessed nationally, and even internationally, with little effort albeit extra expense.

While your trade mark application is still pending, you are not entitled to the statutory infringement provisions and remedies (unless your trade mark is internationally well-known). The best way to strengthen your rights and obtain access to common law remedies in your mark, pending your registration, is to use it extensively. A trade mark registration will give you statutory rights in your mark for the whole of South Africa. However, should another trader adopt the same or similar trade mark for use in a different province, before or around the same time you applied for registration of your trade mark, without having knowledge of your trade mark rights, such a trader may have a basis to continue to co-exist in that specific geographical area, and even have grounds to oppose registration of your trade mark.

There are some do's and don'ts to using trade marks effectively in advertising. This is to ensure that use thereof strengthens your exclusive rights in your trade mark. If a trade mark becomes the common name for a product, the exclusive rights in such terms may be lost in the mind of the consumer. If so, such marks become generic terms which registrations can be attacked by competitors on the basis that the terms became generic and should be available for anyone in the trade. Examples of terms which used be trade marks once, and became generic terms, include ASPIRIN, ESCALATOR, HOOVER and CELLOPHANE.

Essentially, it is advertising which creates the meaning of a trade mark in trade in first place. Likewise, it is advertising which can change the meaning of the trade mark into a generic word, or further preserve the exclusive rights in the mark, depending on how it is used in trade.

When introducing a trade mark for a new kind of product, for which the description is not yet common, establishing the meaning of such new trade mark may require a process of consumer education. This would be to ensure the trade mark does not become the noun for describing the product, thus making it vulnerable to become a generic term.

An example of such advertising is the overseas campaign by the Caterpillar Tractor Company some years ago which used a series of cartoons showing a man who insists that his correct name is Mr Mark Wayne, although he is introduced first as Mr Mark Twain, then Mark Layne, and finally as Mr Chain. The contents of the advertisement further included the following texts: "It's frustrating when someone misuses your name or confuses you with somebody else. We, too, feel badly when our name is misused- in connection with equipment we don't build. For instance, people sometimes call all track-type vehicles by the names Caterpillar and Cat. This presents a problem. You see, Caterpillar and Cat are not

common nouns.... They are names denoting the manufacturer ... Your help in correctly using our trade marks to refer only to our products, will be appreciated.”

When a trade mark is attacked for becoming generic, advertising can assist and is necessary to rectify such a perception in the mind of the public. A local example is the use of the registered SHUTTERPRUFE trade mark in relation to windscreens for vehicles which do not shatter when they break. An extensive television and radio campaign was launched a few years ago, spelling out the last syllabus of the word, namely “P-R-U-F-E”, placing emphasis on the special spelling which distinguishes the mark from the generic and descriptive “shatterproof” term which is allowed to be used by manufactures merely in a bona fide descriptive manner and not on the windscreen products itself. The SHUTTERPRUFE trade mark was the subject of such trade mark expungement (cancellation) proceedings around 2005, and the extensive marketing of the special spelling of the SHATTERPRUFE mark, in my view, effectively saved it from expungement. However, in my opinion, whether the SHATTERPRUFE mark continue to remain to be distinctive in the minds of the public, will depend on how well the manufacturer continues to market and consistently use and police misuse of its trade mark.

Companies which manufacture a range of products often connect their name to the family of products. For example, when TOYOTA launches a new vehicle range, they may use the phrase TOYOTA COROLLA, instead of COROLLA on its own. Especially pharmaceutical and cosmetic companies use marketing campaigns expressly telling consumers that they are the parent companies for a range of products. Examples of such campaigns were launched by Adcock Ingram and Johnson & Johnson in the past.

Sometimes, not only word products are used in marketing. Many multi-visual mediums can assist in marketing pictures and symbols as effective trade marks. An example which comes to mind is Investec’s use of the representation of a Zebra and PPC’s use of the Elephant photo. In the case of Investec’ marketing, the use of the Zebra as main symbol was adopted after the apartheid years in South Africa, and use of the Zebra is coupled with the phrase DISTINCTIVELY DIFFERENT, as black and white stripes on wild animals are not common. The use of the Elephant by PPC is clearly to advertise how their cement products contribute to build strong and big structures. Representations of pictures and photos which serve a trade mark function, should of course also be registered as separate trade marks on the Trade Marks Register to obtain proper protection and exclusive rights in such representations in relation to the specific products or services of interest.

Grammatically, a trade mark should not be used as a noun, but rather as an adjective. It is also advisable to type the trade marks in capitals, or at least the initial letter. The trade mark can also be accompanied by the TM symbol if it is still subject to a pending trade mark application and the R in a circle symbol (namely: ®), which is the international symbol for registered trade marks, in super script. (It is an offence in terms of the Trade Marks Act to use the R in a circle symbol in conjunction with a mark which is not yet registered on the Trade Marks Register.) It is further important to use trade marks consistently in this manner. Such measures could assist in maintaining the validity of the trade mark.

It is said that when William Shakespeare wrote, “What’s in a name? That which we call a rose by any other name would smell as sweet”, he was not running down the value of the word, but merely pointing out the symbolic nature of the name applied to any object.

However, he also wrote, "Who steals my purse, steals trash:... But he that filches from me my good name robs me of that which not enriches him, and makes me poor indeed".

The loss of exclusive rights in a trade mark, when it turns into a generic word, can be financially devastating, similar to the moral devastation suffered by Shakespeare's character. It should be evident from the above that the correct use of trade marks in advertising can be very helpful in preserving exclusive rights in trade marks.

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