WERKSMANS
ATTORNEYS

INTELLECTUAL PROPERTY

Five reasons to register trade marks beyond your home territory

9 October 2018 *3 min read*

In our September 2017 edition of Legal Werks, the top ten reasons to register trade marks were identified notably the significant value and extensive protection trade mark registration provides – https://werksmans.com/legal-briefs-view/top-ten-reasons-to-register-your-trade-marks/.

This article highlights five reasons why territory specific trade mark registrations are vital.

Protection is Territory Specific

- A trade mark registration in your home territory does not infer trade mark protection in another country. Trade marks are, therefore, not only class specific – depending on the goods and services of relevance – but also country specific.
- Various systems are available allowing one trade mark registration to cover several countries including OAPI (covering all seventeen West African countries), ARIPO (allowing the designation of up to ten African countries) and the European Union Trade Mark (covering all member countries of the European Union), proving to be both cost and time efficient.

Diversify

- The internet, social media platforms and ease of travel make brand names even more global. Favourable exchange rates further encourage export.
- Some countries allow both single and multi-class registrations meaning that several classes can be covered by applying to register one trade mark. A trade mark covering multiple classes can provide wider protection across a range of classes in a cost effective manner.

Exercise Control Over Agents and Distributors

- There is a growing trend for agents and distributors in foreign territories to register trade marks in their own capacity without authorisation. It is imperative that brand owners retain control and ownership of their trade marks and secure trade mark registration at the outset.
- Newly appointed agents may also be reluctant to act because another party has registered the mark, albeit in bad faith. Trade mark registration by the true proprietor in that country can provide the necessary assurances.

Customs and Regulatory Clearances

- Many countries allow brand owners to record trade mark registrations with customs authorities. Some countries, such as Mauritius, also allow the registration of authorised importers with customs, detaining unauthorised imports and notifying the rightful owner.
- Certain products may also require national regulatory clearances such as Nigeria's National Agency for Food and Drug Administration (NAFDAC) in terms of which a trade mark registration in Nigeria is required.

Protect and Defend

- Although a trade mark may be vulnerable to cancellation for non-use if it has not been used for a certain period of time (usually three or five years post registration depending on the country), cancellation on the basis of non-use is not by default as such an action would need to be pursued by an interested third party.
- The presence of a trade mark on the register presents a deterrent to unauthorised parties, therefore trade mark registration in all relevant countries is recommended, even if the mark is not always used.

If you would like to learn more about Intellectual Property please visit our practice area page.

DOWNLOAD PDF



Donvay Wegierski

Director

View Profile