

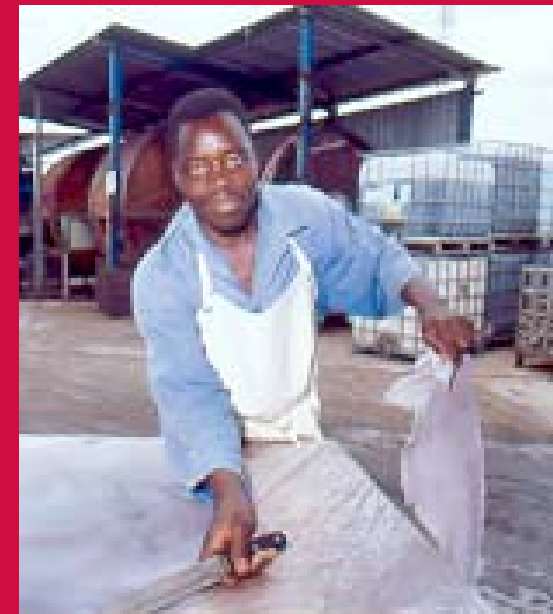
meerscham, celluloid, substitutes for all these materials, or of plastics.

21. Small domestic utensils and containers (not of precious metal or coated there with); combs and sponges; brushes (other than paint brushes); brush-making materials; instruments and material for cleaning purposes; steel wool; glassware, porcelain and earthenware, not included in other classes.
22. Ropes, string, nets, tents, awnings, tarpaulins, sails, sacks; padding and stuffing materials (hair, capoc, feathers, seaweed, etc.); raw fibrous textile materials.
23. Yarns, threads.
24. Tissues (piece goods); bed and table covers; textile articles not included in other classes.
25. Clothing, including boots, shoes and slippers.
26. Lace and embroidery, ribbon and braid; buttons, press buttons, hooks and eyes, pins and needles; artificial flowers.
27. Carpets, rugs, mats and matting; linoleums and other materials for covering floors; wall hangings (non-textile).
28. Games and playthings; gymnastic and sporting articles (except clothing); ornaments and decorations for Christmas trees.
29. Meat, fish, poultry and game; meat extracts; preserved, dried and cooked fruits and vegetables; jellies, jams; eggs, milk and other dairy products; edible oils and fats; preserves, pickles.
30. Coffee, tea, cocoa, sugar, rice, tapioca, sago, coffee substitutes; flour and preparations made from cereals; bread, biscuits, cakes, pastry and confectionery, ices; honey, treacle; yeast, baking-powder; salt, mustard; pepper, vinegar, sauces, spices; ice.
31. Agricultural, horticultural and forestry products and grains not included in other classes; living animals; fresh fruits and vegetables; seeds; live plants and flowers; foodstuffs for animals, malt.
32. Beer, ale and porter; mineral and aerated waters and other non-alcoholic drinks; syrups and other preparations for making beverages.
33. Wines, spirits and liqueurs.
34. Tobacco, raw or manufactured; smokers' articles; matches.

#### **SERVICES**

35. Advertising and business.
36. Insurance and financial.
37. Construction and repair.
38. Communication.
39. Transportation and storage.
40. Material treatment.
41. Education and entertainment.
42. Miscellaneous.

# **HOW TO REGISTER TRADEMARKS IN NAMIBIA**



**Companies and Patents Registration Office**

**A Directorate of the Ministry of Trade and Industry**

## FOREWORD

New inventions (patents), designs, ideas and techniques (trade marks) are continuously being developed to improve for example machinery used in the industry and to promote sales in commerce.

Owners of these new ideas need protection of their rights. These rights are generally referred to as Industrial Property.

In this booklet, you will find information regarding the protection of trademarks in the Republic of Namibia, explained in simple terms.

It is important to note that the main objectives of the trademarks office are to protect the rights of owners of trademarks through a regulatory process; by providing registration facilities thereby guarding against the possible infringement by others, to protect the general public against possible confusion in the trade, to guard against registration of false, misleading or misdescriptive trademarks and to prohibit the use of certain emblems, marks, words and letters for use in the trade.

  
HON. NYAMU  
MINISTER OF TRADE AND INDUSTRY

- plasters, material for bandaging; material for stopping teeth, dental wax; disinfectants; preparations for killing weeds and destroying vermin.
6. Unwrought and partly wrought common metals and their alloys; anchors, anvils, bells, rolled and cast building materials; rails and other metallic materials for railway tracks; chains (except driving chains for vehicles); cables and wires (non-electric); locksmiths' work: metallic pipes and tubes; safes and cash boxes; steel balls; horseshoes; nails and screws; other goods in non-precious. A metal not included in other classes; ores.
  7. Machines and machine tools; motors (except for land vehicles); machine couplings and belting (except for land vehicles); large size agricultural implements; incubators.
  8. Hand tools and instruments; cutlery, forks and spoons; side arms.
  9. Scientific, nautical, surveying and electrical apparatus and instruments (including wireless), photographic, cinematographic, optical, weighing, measuring, signalling, checking (supervision), life-saving and teaching apparatus and instruments; coin or counter-freed apparatus, talking machines; cash registers; calculating machines; fire-extinguishing apparatus.
  10. Surgical, medical, dental and veterinary instruments and apparatus (including artificial limbs, eyes and teeth).
  11. Installations 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; explosive substances; fireworks.
  14. Precious metals and their alloys and goods in precious metals or coated therewith (except cutlery, forks and spoons); jewellery, precious stones, horological and other chronometric instruments.
  15. Musical instruments (other than talking machines and wireless apparatus).
  16. Paper and paper articles, cardboard and cardboard articles; printed matter, newspapers and periodicals, books; book-binding material; photographs; stationery, adhesive materials (stationery); artists' materials; paint brushes; typewriters and office requisites (other than furniture); instructional and teaching material (other than apparatus); playing cards; printers' type and cliches (stereotype).
  17. Gutta percha, india rubber, balata and substitutes, articles made from these substances and not included in other classes; plastics in the form of sheets, blocks and rods, being for use in manufacture; materials for packing, stopping or insulating; asbestos, mica and their products; hose pipes (non-metallic).
  18. Leather and imitation of leather, and articles made from these materials and not included in other classes; skins, hides; trunks and travelling bags; umbrellas, parasols and walking sticks; whips, harness and saddlery.
  19. Building materials, natural and artificial stone, cement, lime, mortar, plaster and gravel; pipes of earthenware or cement; road-making materials; asphalt, pitch and bitumen; portable buildings; stone monuments; chimney pots.
  20. Furniture, mirrors, picture frames; articles (not included in other classes) of wood, cork, reeds, cane, wicker, horn, bone, ivory, whalebone, shell, amber, mother-of-pearl,

## **INFRINGEMENT OF A REGISTERED TRADE MARK**

The usual infringement situation is where a third party adopts and makes unauthorised use of a trade mark identical or confusingly similar to a registered trade mark in relation to the precise goods or services covered by the registration in question.

## **PROTECTION IN OTHER COUNTRIES**

A Namibian trade mark registration is effective only for the territory of the Republic of Namibia. If trade mark protection is required in other countries, separate trade mark applications have to be filed in those countries.

## **GENERAL**

This pamphlet only sets out a brief summary of the provisions of the Namibia Trade Marks Act and any person requiring further details is advised to consult a Patent Attorney or Patent Agent.

Similar pamphlets relating to patents and registered designs can also be obtained from the Registrar of Trade Marks

## **The address of the Registrar of Trade Marks is:**

**PO Box 21214**

**Windhoek**

**Namibia**

## **NAMES OF THE CLASSES**

### **GOODS**

1. Chemical products used in industry, science, photography, agriculture, horticulture, forestry; artificial and synthetic resins; plastics in the form of powders, liquids or pastes, for industrial use; manures (natural and artificial); fire extinguishing compositions; tempering substances and chemical preparations for soldering; chemical substances for preserving foodstuffs, tanning substances; adhesive substances used in industry.
2. Paints, varnishes, lacquers; preservatives against rust and against deterioration of wood; colouring matters, dye-stuffs; mordants; natural resins; metals in foil and powder form for painters and decorators.
3. Bleaching preparations and other substances for laundry use; cleaning, polishing, scouring and abrasive preparations; soaps; perfumery, essential oils, cosmetics, hair lotions; dentifrices.
4. Industrial oils and greases (other than edible oils and fats and essential oils); lubricants; dust laying and absorbing compositions; fuels (including motor spirit) and illuminants; candles, tapers, night-lights and wicks.
5. Pharmaceutical veterinary and sanitary substances; infants' and invalids' foods;

The registration of trade marks in Namibia is governed by the Trade Marks Act No. 48 of 1973 as amended.

## **NATURE OF A TRADE MARK**

A trade mark is a means of identification for goods or services. It is a symbol which a person uses in the course of trade to distinguish his products or services from those of others.

It also serves as a guarantee of consistent quality, particularly where the trade mark is being used by persons other than the registered proprietor, under licence.

A trade mark may consist of, inter alia, a device, label, name, signature, word, letter, numeral or any combination thereof, or a container for goods.

## **SELECTION OF A TRADE MARK**

From the marketing aspect a trade mark should look and sound appealing and have an agreeable image or connotation. It must, however, be remembered that what is commercially attractive is not always legally acceptable. A trade mark should be distinctive or at least capable of becoming distinctive through use.

**In order to comply with the provisions of the Trade Marks Act a trade mark should NOT be:**

- (a) a word or other mark reasonably required by other traders in the relevant field for use in connection with their goods or services;
- (b) descriptive of the character or quality of the goods or services;
- (c) a term or epithet laudatory of the goods or services;
- (d) a geographic term, a name or surname, although in given circumstances such marks may be registerable;
- (e) identical or confusingly similar to a trade mark already registered or in use by another in respect of the goods, or services of interest, or similar goods or services;
- (f) inherently deceptive, confusing, immoral or offensive;
- (g) a mark including the arms, seal or national flag of the Republic or indicating State patronage.

## **AVAILABILITY OF A SELECTED TRADE MARK FOR USE AND REGISTRATION**

This can be partly ascertained by conducting a search through the records at the Trade Marks Office. Such a search should preferably be conducted by trade mark specialists. The search would be in respect of all trade marks which might be considered confusingly similar to the actual trade mark of interest and should cover not only the goods or services directly involved but also related goods or services.

Only investigations in trade circles will disclose whether anyone is using the same or a confusingly similar trade mark.

#### **HOW TRADE MARK RIGHTS ARISE**

There are two ways in which such rights arise:

- (a) by using the particular trade mark in the course of trade for a period of time;
- (b) By registration.

#### **REGISTRATION OF A TRADE MARK**

Registration is effected by filing an application in the prescribed form at the Trade Marks Office in Windhoek.

The trade mark application must be made in a particular class or classes of goods or services. The prescribed classification of goods and services is annexed hereto and correct classification and definition of the goods or services is extremely important. For instance, too narrow a specification of goods could result in very limited rights being obtained.

#### **ADVANTAGES OF REGISTRATION**

*Although it is possible to acquire trade mark rights through use (so called common law rights), there are several good reasons why registration should be obtained:-*

- (a) it enables proceedings for infringement to be brought which are easier, less time consuming and less costly than proceedings for passing-off under the common law;
- (b) it can form the basis of objections by the Registrar to the registration of the same or a confusingly similar trade mark for the same or similar goods or services by others;
- (c) it makes it easier for the trade mark proprietor to object to the registration of the same or a similar trade mark by another party;
- (d) it acts as a deterrent to potential infringers;
- (e) it can, generally, be secured more quickly than rights acquired through use.
- (f) it allows for the effective appointment of licensees or “Registered Users” to use the trade mark and eliminates certain difficulties in appointing licensees or users of unregistered marks;
- (g) the fact of registration (in part “A” of the Trade Marks Register) allows the proprietor to register his trade mark defensively in other classes for goods or services in relation to which he has no intention of actually using his trade mark, but wishes to be able to prevent such use by others;
- (h) it may be assigned to third parties without the assignment necessarily carrying with it the goodwill of the particular business concerned;
- (i) a Namibian trade mark registration, in certain cases, can be of assistance in obtaining registration abroad.

#### **THE APPLICANT FOR REGISTRATION**

As a general rule, only the person (natural or legal) who is using or genuinely intends to use the trade mark, may validly seek to register it.

#### **DURATION OF A TRADE MARK REGISTRATION**

Registration endures initially for a period of ten years and, subject to the payment of a fee, may be renewed indefinitely every ten years. Renewal is effected by making application to the Registrar of Trade Marks in Windhoek.

#### **USE OF A REGISTERED TRADE MARK**

For a trade mark registration to remain valid and unassailable, the trade mark should be used in the course of the trade and in a genuine (not token) manner at least every five years.

#### **REGISTERED USERS**

The registered proprietor of a trade mark may also authorise, subject to appropriate control measures, a third party to use the trade mark. In such cases it is highly advisable to have the appointed user recorded as a “Registered User”.

Even where the proprietor of a trade mark is a member of a group of companies and the user is another member of that group (whether a parent or a subsidiary) it is necessary to have the appointed user recorded as a “Registered User”. If the proprietor allows a licensee who is not recorded as a registered user to use his mark, the mark may be vitiated.

#### **CORRECT USAGE OF A REGISTERED TRADE MARK**

If a trade mark is misused by, for instance, allowing it to be used in a generic sense or in a manner calculated to deceive as to the origin of the goods, the registration can be invalidated.

A trade mark becomes generic when it has become generally recognised by the public as the only practicable name or description for any article or substance or service and is commonly being so used by other traders.

The following are a few pointers to correct trade mark usage for word marks:

- (a) a trade mark is an adjective and should NOT be used as a noun or verb;
- (b) a trade mark should be followed immediately by the generic name of the product e.g. a Xerox copying machine;
- (c) a trade mark should be displayed in a special form. For instance, use capitals, quotation marks, a distinctive type face, contrasting colours or a combination of these; (d) if registered, use the legend “Registered Trade Mark” or an abbreviation thereof.