

24 February 2025

Dear SAIPL Members,

SUMMARY OF DISCUSSION POINTS RAISED WITH REGISTRAR MS F COETZEE

Herewith an update on the recent discussion between the Liaison Committee and the Office of the Registrar of Trade Mark on points raised by some member firms. Below is a summary of the points and response received from Ms F Coetzee.

1. Long-outstanding Matters:

Several firms have raised concerns regarding long-outstanding matters, most of which have been pending for over four years. These matters almost exclusively relate to cases examined by a specific examiner. Despite efforts to communicate using the prescribed process for addressing such matters, firms have asked if there is an alternative approach that could expedite the resolution.

Response: Ms Coetzee has confirmed that this matter is under continual review, and monitoring is ongoing to address these delays. It would appear that there is action being taken to address that examiner's matters.

2. Offers of Assistance from Firms:

Some firms have offering their assistance to the Trade Marks Office, ranging from providing commentary to physical assistance such as file scanning. While most of us understand the constraints around the Trade Marks Office accepting such offers, I thought it prudent to raise the question of whether these offers might be of any use in the current context of delays and digitisation within the Trade Marks Office.

Response: Ms Coetzee has graciously declined these offers, noting that the CIPC requires no assistance from other firms at this time.

3. CIPC Digitisation Project:

We are aware that CIPC is undergoing a digitisation initiative, primarily in the Patents Office, but it is expected to impact the Trade Marks Office as well. I have inquired whether there is any way to share information on this with firms, especially in relation to the Trade Marks Office. Additionally, some firms have offered assistance when physical scanning and capturing of documents begins.

Response: The physical scanning of CIPC records has commenced, led by a dedicated team, and Ms Coetzee is on the steering committee for this long-term, multi-year project. As for trade mark-specific initiatives, plans include:

- AI image search functionality for IP Online;

- eFiling for amendment of registered marks;
- Automation of notices of non-completion (01's); and
- Automation of abandonment of applications in cases where stipulated timeframes are not met.

4. Mergers and Acquisitions of Firms:

Two firms raised concerns about the steps involved in mergers or acquisitions of firms, particularly when large numbers of trade marks need to be transferred to a new firm, and the previous firm's communication channels are closed. The challenge is that obtaining power of attorney from clients for thousands of trade marks could be administratively burdensome, and the risk of missing official correspondence is significant.

Response: Ms Coetzee shared specific information outlining the process for mergers and acquisitions, which was sent to the specific firms, reiterating that this is a recurring query. The full procedure can be requested from myself.

5. Extensions of Time in Prosecution:

Some firms continue to seek clarification on whether extensions of time are necessary in cases where a trade mark application has been conditionally accepted and where a response has already been submitted to meet the requested conditions. These firms indicated that they have received conflicting feedback from CIPC.

Response: Ms Coetzee affirmed that extensions are advisable until a notice of acceptance is received. She emphasized that using the free eFiling platform to request an extension is a quick and efficient process. Firms are advised to maintain an open prosecution term until final acceptance to avoid delays caused by pending or misfiled communications.

6. Issues Relating to Renewals and Recordal Applications:

Multiple concerns were raised regarding the renewal and recordal process, specifically – I will elaborate on each point below:

- Renewal applications "queued" until recordal is completed, leading to a temporary removal status on the register.
- Difficulty accessing filed documents on CIPC's new Cuba platform, causing delays and potential removal of marks.
- Problems with filing renewals for marks registered before 2000, where record-keeping errors prevent timely filing.

6.1. Renewal and Recordal Queue:

Concern was expressed that renewal applications remain queued while awaiting recordal completion, affecting the mark's status. This has led to significant administrative follow-ups with CIPC.

Response: Ms Coetzee advised that submitting both renewal and recordal applications simultaneously should be avoided, as this was a previous concession. She suggested separating the filings into distinct transactions to streamline processing.

6.2. CUBA Document Accessibility:

Issues were raised with the ability to access documents on the Cuba platform. This has caused delays and sometimes resulted in marks being "permanently referred" or removed due to inaccessible documents.

Response: Ms Coetzee stated that recordal applications are not lodged via Cuba unless part of a renewal. She also noted that improvements will be made to the system, including increased pre-assessment of documents by Sword, to reject problematic lodgements before they enter the processing queue.

6.3. Pre-2000 Marks and Database Issues:

A third issue was raised concerning renewal applications for marks filed before the year 2000, where incorrect dates or numbering cause delays and unnecessary late fees.

Response: Ms Coetzee clarified that renumbering only occurred for marks from former homelands (Part B marks under the old Act), and any errors in registration dates should have been addressed earlier. She emphasized that applicants are responsible for ensuring the accuracy of their records and for notifying the office of any discrepancies.

To conclude, it appears (and is promising to note) that several initiatives are underway to improve the functionality and efficiency of the Trade Marks Office, including automation and digitisation. As always, the Registrar encourages firms to follow the prescribed procedures and utilise available resources, such as the eFiling platform, to manage ongoing matters.

Should there be any further points of clarification, or follow-up queries based on the above, please share those with me to raise with Ms Coetzee in the next liaison meeting.

Kind regards,

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