

PRACTICE NOTICE
RE: BUSINESS NAMES

Introduction

The practice of the Trade Mark Registry over the years has varied in relation to the registration of trade marks by business names. There is also a lack of understanding sometimes among the general public regarding the law as it relates to business names. This has caused a lack of clarity in relation to the procedure to be followed by persons wishing to register trade marks in the name of business names. This Practice Notice therefore seeks to clarify the procedure to be followed by applicants and their agents who wish to apply to register trade marks in the name of a business or partnership as proprietor.

Background

As Section 4(1) of the Trade Marks Act 1999 clearly states, “The registration of a trade mark under this Act confers a property right on the proprietor of the trade mark who is entitled to the rights and remedies provided by this Act.”

Only legally recognized persons can own property. This means either individuals and/or incorporated entities which have separate legal personality. Business names, whether registered at the Office of the Registrar of Companies or unregistered, do not have separate legal personality and therefore cannot in law own property. Therefore, in the absence of legally registered entities with separate legal personality, such as a company, persons who wish to register trade marks in the name of business names will have to do so in their individual capacities (either as sole traders or partners).

Procedure

Therefore it is important that the application form TM1 is completed in the name of the individual or individuals who are applying for the registration of the trade mark. The application will not be accepted if it is made in the name of the business name alone. If the applicant(s) wish, they may also include the business name after the names of the individual(s). An example is: ‘Tom Brown and Jane Black trading as B&B Productions’. It is also required that the completed Form TM1 is signed by each of the individuals who are applying for the registration of the trade mark.

The Certificate of Registration, if and when issued, will therefore be issued in the names of the individuals with or without the business name, as reflected on the completed Form TM1.

Joint Ownership Rights

Section 6 of the Trade Marks Act 1999 provides that joint proprietors of a trade mark are entitled to an equal undivided share in the registered trade mark, unless there is an agreement to the contrary. Therefore, in the absence of a partnership agreement or other agreement between the joint proprietors of a trade mark, the trade mark will be owned equally. Section 6 of the Trade Marks Act also stipulates that a joint proprietor shall not grant a licence to use the registered trade mark or assign or charge his share in the registered trade mark without the consent of the other joint proprietor(s).

Any subsequent applications for changes to be made to the register or for the registration of subsequent transactions under the Trade Marks Act 1999 or Trade Marks Rules 2001 will have to be signed by all joint proprietors of the registered trade mark or their duly appointed Attorney-at-Law/trade mark agent.

