

# Beyond registration - 8 tips to enforcing your trade mark

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Trade mark protection does not end at registration, and trade mark enforcement does not need to involve lengthy litigation or extensive legal fees for brand owners. Having a good trade mark enforcement strategy is essential in ensuring that a brand owner's trade mark not only remains proprietary to them, but that it also does not become vulnerable to genericism.



Source: Le Mbal Olivier – [123RF.com](#)

There are a number of things brand owners can do to actively enforce their trade marks, and by implementing some or all of the suggestions listed below, a brand owner can quickly develop an effective enforcement protocol and create clear brand usage guidelines for its staff and advertising / PR service providers, all of which will ensure the longevity of the trade mark and the ultimate success of the brand.

## Top tips

Brand owners should: -

1. Always use the <sup>TM</sup> or ® symbol whenever they use or refer to their trade mark in relation to their goods and/or services, including on any marketing materials. This shows third parties that the brand owner deems the trade mark to be proprietary thus acting as a good deterrent for unscrupulous third parties thinking about adopting the same (or a potentially confusingly similar) trade mark, lest they feel the wrath of a possible infringement or passing off claim.

2. Never use the ® symbol if the trade mark is not registered. If registration is still pending, rather use the ™ symbol.
3. Avoid using the trade mark as a verb. Sounds silly, right? But just “google” it and you’ll see what I mean. Opening the door to generic use of a brand might seem like a great way to get that brand trending on social media (after all, who doesn’t want their brand to be popular and relevant in this digital day and age?), but once the proverbial door has been opened, it’s potentially fair game for all.
4. Make sure the trade mark is used within five years of securing registration. In South Africa, if a registered trade mark has not been used in this time it may be vulnerable to cancellation on the basis of non-use by any interested party (and this includes a competitor).
5. Remember that it’s up to the brand owner to enforce its rights. No one is going to police the market for you, so don’t sit back idly and wait for someone to start infringing your trade mark before you react. Actively monitoring the marketplace is essential to prevent the unauthorised use of a trade mark and the earlier this is done, the better.
6. Understand that enforcement does not just mean actively monitoring the marketplace. It also means actively monitoring the Trade Marks Register, the Companies Register and the World Wide Web (for domain names and social media pages or handles which may make unauthorised use of the trade mark). It also means actively securing registrations of, for example, defensive company names or various domain name iterations and extensions.
7. Send out suitable cease and desist letters, or a less litigious (but equally effective) notice of rights to infringers or potential infringers. Doing so sooner rather than later may avoid court action. In addition, being an “active enforcer” shows potential infringers that you mean business - another great deterrent.
8. Always obtain legal advice from a qualified trade mark attorney when seeking to both protect and enforce one’s rights. Using the services of a qualified trade mark attorney may also mean that a brand owner benefits from that attorney’s monitoring service - often a complimentary add-on service. One obvious benefit is that a brand owner does not have to hire additional internal resources to actively scour the web or monitor various registers for possible (or existing) infringements - your attorney can do that for you.

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