

Intellectual Property
for Business Series | Number:

1

MAKING A MARK

An Introduction to Trademarks for
Small and Medium-sized Enterprises
in Malawi

Publications in the “Intellectual Property for Business” series:

1. Making a Mark: An Introduction to Trademarks for Small and Medium-sized Enterprises in Malawi. Department of Registrar General, publication No. 001.
2. Looking Good: An introduction to Industrial Designs for Small and Medium-sized Enterprises in Malawi. Department of Registrar General, publication No. 002.
3. Inventing the Future: An introduction to Patents for Small and Medium-sized Enterprises in Malawi. Department of Registrar General, publication No. 003.
4. Creative Expression: An introduction to Copyright for Small and Medium-sized Enterprises in Malawi. Department of Registrar General, publication No. 004.

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Preface

Until recently, Intellectual Property has been viewed as luxury by industry and in particular, by the Small and Medium-sized Enterprises (SMEs). Every business has some valuable intangible property worth protecting. The SMEs need to be abreast of the latest information on Intellectual Property Rights (IPRs) systems so that they are able to protect their IP assets. Ignorance in Intellectual Property issues may lead to loss of SME's valuable rights or expensive litigation or both.

This customized version of 'Trademark' discusses basics of trademark and benefits to be derived from their protection and use. The effort of getting trademark protection is complex. However, the long-term benefits from the protection of trademark are huge and far outweigh the efforts and investment.

I commend the efforts of the Department of Registrar General's team comprising Mr Joseph K. Chintolo, Mr P. M. Chimteya and Mr A. Nyirenda during production of this book. In particular, I commend Mr Chintolo for providing guidance and legal input. In a special way, I commend the tireless efforts, expertise and technical know-how of Mr H.Y. Mateche, the Consultant, in customising, developing and producing this book. Finally, I thank the World Intellectual Property Organisation (WIPO) for its financial support for producing this book.

G. E. Nkhata
DEPUTY REGISTRAR GENERAL



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1. Trademarks

What is a Trademark?

A trademark is generally defined as a sign capable of distinguishing goods or services produced or provided by one enterprise from those provided by other enterprises.

The Malawi Trademark Act defines a trademark as “a mark used or proposed to be used in relation to goods for the purpose of indicating, or so as to indicate, the connection between goods and some person having the right either as a proprietor or as registered user to use the mark, whether with or without any indication of the identity of that person, and means, in relation to a certification trademark, mark registered or deemed to have been registered under Section 42 of the Act.

According to the Act, a trademark includes a device, brand, heading, label, ticket, name, signature, word, letter, numeral or any combination thereof”.

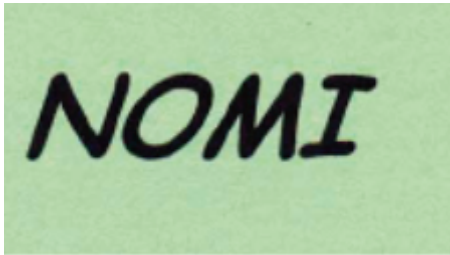
The Malawi Trademark Act allows registration of single colours, three dimensional signs, logotypes and combination of letters but does not allow registration of slogans, smells and sounds.



Example of combination of letters



Example of a word



What are trademarks for?

The main function of a trademark is to enable consumers to identify a product (whether goods or services) of a particular company so as to distinguish it from other identical or similar products provided by other competing companies. Consumers who are satisfied with a given product are likely to buy or use it again in future. For this reason, consumers need to be able to distinguish easily between identical or similar products. By enabling companies to differentiate themselves and their products from those of competing companies, trademarks play a pivotal

role in branding and marketing strategies of companies, thereby contributing to the definition of the image, and reputation of the company's products in the eyes of consumers. The image and reputation of a company create trust which is the basis for establishing a loyal clientele and enhancing a company's goodwill. Consumers often develop an emotional attachment to certain trademarks, based on a set of desired qualities or features embodied in the products bearing such trademarks.

Trademarks also provide an incentive for companies to invest in maintaining or improving the quality of their products in order to ensure the products bearing their trademark have a positive reputation.

The Value of Trademarks

A carefully selected and nurtured trademark is a valuable business asset for most companies. For some, it may be the most valuable asset they own. Trademarks are important for the success of a product in a market. A company with a good trademark has a competitive edge over other competitors. Consumers tend to buy products or get services of a company if its trademark is of quality and it meets their expectations. For instance, in Malawi, consumers are eager and willing to buy a drink bearing the trademark of "Cocacola" because they value the trademark, its reputation, its

value the trademark, its reputation, its image and its qualities. Customers tend to associate with the trademark and are thus willing to pay for the drink bearing the trademark. Therefore, if a company owns a trademark with a good image and reputation it will have a competitive edge on the market.

Why should your company protect its trademark(s)?

While most businesses realize the importance of using trademarks to differentiate their products from those of their competitors, not all realize the importance of protecting trademarks through registration.

Registering a trademark under the Malawi Trademark Act gives your company the exclusive right to prevent others from marketing identical or similar products under the same or a confusingly similar trademark.

Without trademark registration, your investment in marketing a product may become wasteful as rival companies may use the same or a confusingly similar trademark for an identical or similar product. If a competitor adopts a similar or identical trademark, customers could be misled into buying the competitor's product thinking it is your company's product. This may not only decrease your company's profits and confuse your customers, but it may also damage the reputation and image of

your company, particularly if the rival product is of inferior quality.

Given the value of trademarks and the importance that a trademark may have in determining the success of a product in the marketplace, it is critical to make sure that it is registered in the relevant market(s). Also, it is much easier to license a registered trademark to other companies and this may provide an additional source of revenue for your company. Licencing a trademark may be a basis for a franchising agreement.

Sometimes, a registered trademark with a good reputation among consumers may also be used to obtain funding from financial institutions that are aware of the importance of brands for business success.

Trademarks: Summary

To sum up, trademarks are important for the success of a business because they:

- enable consumers to distinguish between products;
- enable companies to differentiate their products;
- are a marketing tool and the basis for building a brand image and reputation;
- may be licensed to provide a direct source of revenue through royalties;
- are a crucial component of franchising agreements;
- may be a valuable business asset;

maintaining or improving product quality;

- may be useful for obtaining financial assistance.

2. Protecting Trademarks

How can your company protect its trademark(s)?

In Malawi, trademark protection is obtained through registration at the Office of Registrar of Trademarks in the Department of the Registrar General. To apply for registration of a trademark, an applicant must fill in Form TM. No.2. A registered trademark gets stronger protection when there are conflicts: if other people use similar or identical trademarks. The services of a trademark agent are often very useful although not compulsory to help in the registration of a trademark.

Is the registration of the trade name of your company sufficient?

Many people believe that by registering their business and its trade name at the business registry, the name would also be automatically protected as a trademark. This is a rather common misconception. It is important to understand the difference between trade names and trade marks.

A trade name is the full name of your business, such as “Southern Bottlers Ltd”. A trade name often ends with Ltd or other similar abbreviations that denote the legal character of the company.

A trademark, however, is a sign that distinguishes the product(s) of your company from those of the other companies. A company may have several products. For instance, in Malawi, Southern Bottlers Ltd sells CocaCola as one of its products and also sells Fanta as another product. Companies may use a specific trademark to identify all their products, a particular range of products or one specific type of product. Some companies may also use their trade name, or a part of it, as a trademark.

Who is authorized to apply for trademark registration?

According to the Malawi Trademark Act, an application for Trademark registration must be made by a person who claims to be the proposed proprietor of the Trademark.

A person who intends to use the trade mark, or a trademark agent employed by the proprietor may also make an application for Trademark registration. The proprietor of the Trademark can be either an individual or a company.

Is it compulsory to register a company's trademarks?

In Malawi, it is not compulsory to register a Trademark. However, it is advisable to register your Trademark in order for it to enjoy legal protection. When you register your Trademark, you get exclusive rights to use the Trademark for particular

goods and to prevent others from using the Trademark without prior authorisation.

What are the main reasons for rejecting an application?

While selecting a trademark it is helpful to know which categories of signs are usually not acceptable for registration. In Malawi, applications for trademark registration are usually rejected on what are commonly referred to as “absolute grounds” in the following cases:

- Prohibited words in Marks. The word “Anzac” may not appear on a trademark for whose registration an application is being made.
- Deceptive matter. It is not lawful to register as a trademark or part of a trademark any matter which is likely to deceive or cause confusion and is contrary to the law or morality, or any scandalous design.
- Identical and resembling designs are prohibited for registration.
- The words “Patent,” “patented,” “Registered,” “Registered Design,” “Copyright,” “Entered at Stationed Hall,” “To conterfeit this is forgery.”
- A representation of the President or any colourable imitations thereof.
- The words “Red Cross” or “Geneva

Cross”, and the representations of the Geneva and other crosses in red, or of the Swiss Federal cross in white or red ground or silver or on a red ground, or such representations in a similar colour or colours.

- Flags, armorial bearings, insignia, orders of chivalry, decorations official hallmarks and emblems of states, cities, borough, town, place, society, body corporate, institution or person.

Applications for registration of trademarks are also rejected on “relative grounds”. This is when the trademark conflicts with prior trademark rights. Having two identical (or very similar) trademarks for the same type of product could cause confusion among consumers. The Malawi Trademark Office in the Department of the Registrar General checks for conflict with existing marks, including unregistered well-known marks as a regular part of the registration process. If the trademark is considered to be identical or confusingly similar to an existing one for identical or similar products, it will be rejected or cancelled.

What should be kept in mind when selecting or creating a trademark?

Selecting or creating an appropriate trademark is a critical step as it is an important element of the marketing strategy of your business. So what is

an appropriate trademark for your product(s)? The following five-point checklist may be useful when selecting or creating your trademark.

Five Point Checklist for Selecting Your Trademark

- Check that your trademark of choice meets all the legal requirements for registration.



- Do a trademark search to make sure that it is not identical or confusingly similar to existing trademarks.
- Make sure the trademark is easy to read, write, spell and remember and is suitable to all types of advertising media.
- Make sure that the trademark does not have any undesired connotations in your own language or in any of the languages of potential export markets.
- Check that the corresponding domain name (i.e. Internet address)

is available for registration.

Registering a Trademark - Step by Step

The Applicant

A person who claims to be the proposed proprietor of a Trademark and wishes to register a Trademark must make a written application to the Registrar of Trademarks at the Department of Registrar General. The applicant must fill in Form TM No. 2. The application should include contact details of your company, a graphic illustration of the Trademark and a description of the goods and services and/or class(es) for which the company wishes to obtain Trademark registration. Also, the applicant must pay the prescribed registration fees.

The Trademark Office

When the Office of Registrar of Trademarks receives the application for registration of a trademark, it allocates an application number.

Formal examination: the Office of the Registrar of Trademarks examines the application to make sure that it complies with the administrative requirements or formalities. The Office of Registrar of Trademarks checks whether the application fee has been paid and the application form has been filed in the prescribed manner.

Substantive examination: the Office of the Registrar of Trademarks examines

the application to verify whether it complies with all the substantive requirements. The Registrar of Trademarks checks whether the Trademark belongs to a category which is excluded from registration by the Malawi Trademark Act and whether the Trademark is in conflict with an existing Trademark on the register in the relevant class(es). The Registrar also checks whether the application form has been filled in the prescribed manner and whether prescribed application fees have been paid.

Publication and opposition: Once the Registrar of Trademarks accepts the Trademark, the applicant then sends the mark for advertising in the Malawi Government Gazette for 3 months. If there is no opposition within the three months, or if the opposition is overcome, the applicant applies for registration using Form TM No. 10 and the Registrar of Trademarks issues a certificate of registration Form TM No. 11.

Registration: Registration for a trademark is for 7 years and the effective date is the date of application for registration.

Renewal: the Trademark may be renewed by filling a renewal Form TM No. 12 after paying renewal fees. Renewal is valid for 14 years.

How long does it take to register a trademark?

Registration for trademark protection in

Malawi is expected to be completed within twelve months from the date of application. If the applicant defaults, the Registrar may, after giving notice of non-completion to the applicant in writing, treat the application as abandoned, unless it is completed within the time prescribed in the notice.

What are the costs associated with trademark creation, protection and use?

There are a number of costs associated with creation, protection and use of a Trademark. These costs are listed below.

- There are costs for creating a logo or word to be used as a Trademark..
- There are costs for conducting a Trademark search.
- There are costs for registering a Trademark which vary depending on the category of products. The Malawi Trademark Office will provide you with the detailed costs for registering a Trademark.
- There are costs for paying a Trademark Agent who may be hired to assist you in the registration process.

How can you find out if your chosen trademark might conflict with other registered trademarks? What is a trademark search?

After receiving an application for the registration of a Trademark for specific goods, the Registrar of Trademarks will direct that a search be conducted amongst the registered marks pending applications in order to ascertain

applications in order to ascertain whether there are on the register identical or similar Trademarks.

You can do a trademark search yourself, or you can hire a Trademark Agent. Remember that such a trademark search is preliminary. At this stage, it may not be possible to know that your trademark is not confusingly similar to existing registered trademarks. This is why it is important to get guidance of an experienced trademark agent.

Before you go to a Trademark Agent, check with the Trademark Office as part of your preliminary trademark search. There are a number of costs associated with the creation, protection and use of a Trademark.. These costs are listed below. The costs have been presented in the preceding section of this chapter of this book.

A Well-classified System

Trademarks are grouped into “classes” according to the type of goods or services they serve to identify. The classification system is in Annex III of this book. You may therefore begin your Trademark search by familiarizing yourself with the 45 different trademark classes.

The Malawi Trademark Act requires that when filling in your Trademark application form, you must indicate the

goods and/or services for which you wish to register your trademark and to group them according to classes. The trademark classification system allows for the orderly storage of data on registered trademarks according to the types of goods or services. This makes it easier to retrieve information from trademark databases. It is critical to register your trademark in all classes in which you intend to use your trademark.

The classification system used in Malawi is the International Trademark Classification system (called Nice system for classification of word marks), which has 34 classes for goods and 11 classes for services. Detailed information about the Nice classification system is in Annex III of this book. You can also get more information from the Registrar of Trademarks at the Department of Registrar General.



Do you need a trademark agent to file a trademark application?

It is not a requirement to hire a Trademark Agent to file an application for registration of a trademark. An application for registration of a trademark may be filed by a proprietor or a registered user himself. However, the proprietor or registered user of a trademark may appoint a Trademark Agent to act for him on any issues concerning trademark including filing a Trademark application Form TM No. 1 for registration. When a proprietor appoints an agent, he will sign and send to the Registrar of Trademarks a written authority. The Trademark Agent may sign all documents, may make all communication between the applicant and the Registrar of Trademarks at The Department of Registrar General, and may represent the applicant at all meetings. The Registrar of Trademarks at The Department of Registrar General will advise you if you need to be represented by a Trademark Agent and will give you a list of approved and registered trademark agents in Malawi.

For how long is your registered trademark protected?

In Malawi, registered trademarks are protected for a period of seven (7) years, and may be renewed from time to time. Registration of the trademark may be renewed for a period of 14 years from the date of expiration of the original registration or the date of the last renewal of registration.



Outsourcing Trademark Creation

Designing a trademark is a creative process. Therefore, when the creation of a trademark is outsourced, it is usually best to clarify issues of copyright ownership in the original agreement and make sure that the copyright over the trademark is formally assigned to your company.

Is trademark registration in Malawi valid internationally?

The legal rights arising out of a trademark registration is limited to the territory to which they pertain. So, ordinarily, valid registration of a trademark in Malawi gives you rights only in Malawi. According to the Malawi Trademark Act, the legal protection and rights arising out of a trademark registration apply within Malawi territory only. This means that valid registration of a trademark in Malawi gives you rights in Malawi only except where the trademark is a well-known trademark. A well-known trademark is considered to be well-known by the authority where you want to register the trademark. Well-known marks are considered protected even if they not

considered protected even if it is not registered in a given country.

Should you consider protecting your trademark abroad?

All the main reasons for registering your trademark in your home country also apply to the commercialization of your products in foreign markets. It is therefore highly advisable to register your trademark abroad if you wish to grant a license to use the trademark in those countries. Exporting goods bearing a distinctive trademark will enable your products to be recognized in foreign markets, allowing your company to build a reputation and image among foreign consumers, which may result in higher profits.

How can you register the trademark of your company abroad?

Once you have registered the trademark of your company in Malawi, there are three main ways to register the trademark in other countries:

The National Route: you may apply to the Office of the Registrar of Trademarks at The Department of Registrar General for trademark protection. As indicated earlier, the Registrar of Trademarks may require you to use the services of a locally-based trademark agent for this purpose.



The Regional Route: if you wish to apply for protection in countries which are members of a regional trademark system you may apply for registration in member countries by filing an application at the Office of Registrar of Trademarks at the Department of Registrar General. The regional trademark offices are:

- The African Regional Industrial Property Office
- The Benelux Trademark Office
- The Office for the Harmonization of the Internal Market of the European Union
- The *Organisation Africaine de la Propriété Intellectuelle*.

The International Route: Malawi is a member of the Madrid system. If you register or apply for your trademark registration in Malawi, you may use the Madrid system (administered by WIPO) to register your trademark in more than 70 countries that are party to the system.



3. Types of Trademarks

What are trademarks

We have learnt that trademarks are symbols used to distinguish goods or services of one enterprise from those of the other. There are three types of trademarks namely: service marks, collective marks and certification marks.

What are service marks?

A service mark is very similar in nature to a trademark. Both are distinctive signs. A Trademark distinguishes goods of one enterprise from those of others, while a service mark fulfils the same function in relation to services. Services may be of any kind, such as financial, banking, travel, advertising or catering. Service marks can be registered, renewed, cancelled, assigned and licensed under the same conditions as trademarks.

What are collective marks?

A collective mark is owned by an association or cooperative whose members may use the collective mark to market their products. Collective marks are used to distinguish goods or services produced or provided by members of an association. Collective marks may be an effective way of jointly marketing products of a group of enterprises which may find it more difficult for their individual marks to be recognized by consumers and/or handled by the main distributors.

Advantages of using the Madrid system

The principal advantages of using the Madrid system are that the trademark owner can register his trademark in all the countries that are party to the system by filing:

- a single international application;
- one application in one language;
- an application subject to one set of fees and deadlines.

Thereafter, the international registration can be maintained and renewed through a single procedure. You can find more information on international registration of marks either at the Trademark Office or on the WIPO website: www.wipo.int/madrid/. A list of the Member countries of the Madrid system is available in Annex IV of this book.

What are certification marks?

Certification marks are given for compliance with defined standards, but are not confined to any membership. They may be used by anyone whose products meet certain established standards. In Malawi, certification marks are issued by the Malawi Beareu of Standards to companies and organisations that meet certain set quality standards for their products.



Courtesy: The Woolmark Company

The Beareu of Standards is an entity set up by Government of Malawi to certify” products of companies before they go on the market. Thus, the MBS symbol means that the product is certified for quality to go on the market. Another examble is the Woolmark symbol which is a registered trade (certification) mark of the Woolmark Company. The Woolmark is a quality assurance symbol denoting that the products on which it is applied, are made from 100% new wool and comply with strict performance specifications set down by the Woolmark Company. The company is

registered in over 140 countries and is licensed to manufacturers who are able to meet these quality standards in 65 countries.

What are well-known marks?

Well-known marks are marks that are considered to be well-known by the Trademark Office. Well-known marks benefit from stronger protection. Well-known marks may be protected even if they are not registered. While marks are protected against confusingly similar marks if used for *identical or similar* products, well-known marks are protected against confusingly similar marks as well for *dissimilar* products, if certain conditions are met. The main purpose of this stronger protection is to prevent companies from free-riding on the reputation of a well-known mark and/or causing damage to its reputation or goodwill.

As an example, let us assume that COCACOLA is the famous trademark of a soft drink. Wondercola Ltd would then benefit from automatic protection in Malawi where well-known marks enjoy stronger protection and where the mark is well-known for soft drinks. The protection would also be available for unrelated goods and services. If another company decides to market other products ranging from T-shirts to sunglasses, using the COCACOLA mark, it will have to seek authorization of Wondercola Ltd or risk being sued for infringement of trademark rights.

4. Using Trademarks

Can you register a trademark without having used it?

The Trademark Act in Malawi requires that you should apply for registration of a trademark before you have used it. In addition, the trademark may be removed from the register if it has not been used for one month before the date of the application and up to five years after registration. When a trademark is removed from the register, you automatically lose your rights in your trademark.

TM or ®?

The use of ®, TM, SM or equivalent symbols next to a trademark is not a requirement in Malawi and generally provides no further legal protection. Nevertheless, it may be a convenient way of informing others that a given sign is a trademark, thus warning possible infringers and counterfeiters. The ® symbol is used once the trademark has been registered, whereas “TM” denotes that a given sign is a trademark. The “SM” symbol is sometimes used for service marks.

How should you use trademarks in advertising?

If your mark is registered with a specific design or font, make sure that the trademark is used exactly as it is registered. You should closely monitor the use of your mark as it is crucial for the image of your company's products.

Can your company use the same trademark for different products?

Different trademarks may be used for different products lines of a company. Depending on its branding strategy, each company will decide whether to use the same trademark for its products, extending the brand every time a new product is released, or to use a different mark for each product line. For example, Carlsburg is a trademark for Carlsburg Company in Malawi. However, the trademark is also used to brand a number of products for the company namely: Carlsburg Green, Carlsburg Elephant, Carlsburg Stout etc. Extending an existing brand to new products enables the new product to benefit from the image and reputation of the mark. However, the use of a new mark, may also prove advantageous and may enable the company to target a specific customer group or to create a specific image for the new product line.

Whatever strategy you choose, make sure that your trademark is registered for all categories of goods and/or services for which it is, or will be used.

What should be kept in mind when using trademarks on the Internet?

The use of trademarks on the Internet has raised a number of controversial legal problems with no easy or uniform solution. One big problem stems from the fact that trademark rights are territorial and thus are only protected in the country or region where the mark

has been registered, whereas the reach of the Internet is global. This creates problems when it comes to settling disputes between persons or companies legitimately owning identical or confusingly similar trademarks for identical or similar goods or services in different countries. Legislation in this area is still developing in Malawi.

What is a domain name and how does it relate to trademarks?

Domain names are not the same as trademarks. Domain names are Internet addresses, and are commonly used to find websites. For example, the domain name 'wipo.int' is used to locate the WIPO website at www.wipo.int. Over time however, domain names have come to constitute business identifiers thus often coming into conflict with trademarks. The Trademark Act treats registration of the trademark of another company or person as a domain name only to transfer or to cancel it later.



Therefore, it is important that you choose a domain name which is not the trademark of another company. In particular, do not choose a well-known trademark. In order to find out whether a particular trademark is already protected, you can directly contact the Trademark Office or regional trademark offices. A list of databases for regional trademark offices is available on WIPO's website at:

www.arbiter.wipo.int/trademark/.

If the trademark of your company is being used as a domain name or is being cybersquatted by another individual or company then you may take action to stop misuse/infringement of the rights of your company. One option would be to use WIPO's online administrative procedure for domain name dispute resolution at: www.arbiter.wipo.int/domains/. The WIPO website includes a model complaint as well as a legal index to the thousands of WIPO domain name cases that have already been decided.

Can you license your trademark to other companies?

The Malawi Trademark Act provides for licensing of a trademark to other companies. Licensing a trademark has advantages. It enables you to enter some markets and provides you or your company with additional sources or revenue for your business. When a trademark is licensed to other people, the trademark owner still retains ownership and merely agrees to the use

ownership of the trademark and merely agrees to the use of the trademark by other people or companies. This is usually done on payment of royalties and the consent of the trademark owner is usually specified in a formal licensing agreement. Depending on the nature of the agreement, the licensor often retains some degree of control over the licensee to guarantee or maintain quality assurance.

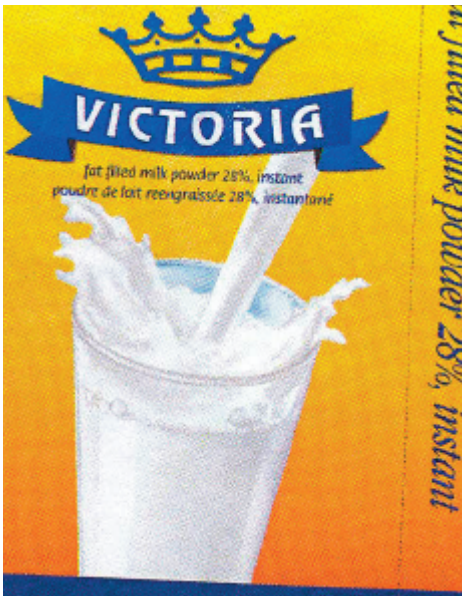
In practice, trademark licenses are frequently granted within broader licensing such as franchising agreements or agreements involving licensing of intellectual property rights namely patents and know-how. Trademark licences are also granted for technical assistance for production of a particular product.

What does a franchising agreement have to do with trademarks?

The licensing of a trademark is central to a franchising agreement. In franchising agreements the degree of control of the trademark owner over the franchisee is generally greater than is the case for standard trademark licensing agreements. In Franchising, the franchiser allows another person (the franchisee) to use his way of doing business (including trademarks, know-how, customer service, software, shop decoration, etc.) in accordance with a set of prescriptions and in exchange for compensation or royalty.



Courtesy: Nando's Group Holdings Ltd



For example a restaurant selling chicken meals operates in Malawi under the trademark NANDO'S. It has developed a system for preparing and selling these products which are sold in large volumes and in a uniform manner. The system includes various factors that contribute to the success of NANDO'S restaurants including recipes and methods of preparing meals that result in a product of consistent quality,

the design of employees' uniforms, the design of the buildings, the design of packaging, and management and accounting systems. NANDO'S imparts its knowledge and experience to its franchisees and retains the right to supervise and control local franchises. As a crucial component of the franchising agreement, the franchisees will also be authorized and obliged to use the NANDO'S trademark.

Is there any restriction in selling or assigning the trademark of your company to another company?

The Malawi Trademark Act does not impose any restriction on selling or assigning your trademark. The Act states that a registered trademark is always regarded as having been assignable and transmissible. A proprietor seeking to assign a trademark should submit an application to the Registrar of Trademarks on Form TM. No. 16. If there is no objection, the proprietor should apply using Form TM No. 40 for a certificate of assignment.

Do you need to register all small modifications to your trademark?

Many trademarks, including some of the most famous, have slightly changed or evolved over the years in order to modernize the image of a company or to adapt to new advertising media. The Trademark Act in Malawi allows changes or adaptations to be made to a trademark. The proprietor

of a trademark can apply for registration of small modifications to his trademark that do not substantially affect the identity of the trademark. A proprietor wishing to apply for modifications to a trademark must use Form TM. No. 46 for amendments. The Registrar of Trademarks may accept or refuse the application for registration for small modifications to a registered trademark. You must consult the Trademark Office or a competent trademark agent as to whether a specific change will require submission of a new application and payment of relevant fees.

5. Enforcing Trademarks

What should your business do if its trademark is being used by others without authorization?

The responsibility of enforcing a trademark is mainly on the trademark owner. It is up to a trademark owner to identify any infringement and to decide what measures to take in order to enforce trademark rights.

It is important to seek expert advice if you believe that someone is infringing your trademark. You should seek advice and information from an intellectual property lawyer on existing options in Malawi and neighboring countries to initiate action against counterfeiting and infringement. The lawyer will advise you on how to

enforce your Trademark rights.

If there is an infringement of your trademark rights, you may begin to enforce your Trademark rights by sending a letter to the alleged infringer informing him/her of the possible existence of a conflict. A trademark lawyer should assist you in writing such a letter.

If you think that the infringement is wilful and you know the location where it occurred, you may take a surprise action by obtaining, with the help of a trademark lawyer, a search and seize order from the Malawi High Court or from the Malawi Police to conduct a raid without prior notice to the alleged offender. The infringer may be compelled by the courts to inform you of the identity of persons involved in the production and distribution of the infringing goods or services and their channels of distribution. The courts may order, upon your request, that infringing goods and materials be destroyed or thrown away without any compensation.

There are measures at the borders that can be used to prevent importation of counterfeit trademark goods. The trademark owner must seek help of the customs authorities at the border before the counterfeit goods are distributed in the country concerned. You are required to pay prescribed fees, to get assistance of customs authorities.

In some instances, an effective way of dealing with infringement is through arbitration or mediation out of court. The advantage of arbitration is that it is less formal, it is shorter and cheaper than court proceedings.

ANNEX II – Internet Addresses

National and Regional Intellectual Property Offices

African Intellectual Property Organization	www.oapi.wipo.net
Algeria	www.inapi.org
Albania	www.alpto.gov.al
Andorra	www.ompa.ad
Argentina	www.inpi.gov.ar
Armenia	www.armpatent.org
Australia	www.ipaustralia.gov.au
Austria	www.patent.bmvit.gv.at
Bahrain	www.gulf-patent-office.org.sa/bahrainframe.htm
Barbados	www.caipo.org
Belarus	www.belgospatent.org/english/about/history.html
Belgium	www.mineco.fgov.be
Belize	www.belipo.bz
Benelux	www.boip.int
Benin	www.oapi.wipo.net
Bolivia	www.senapi.gov.bo
Botswana	www.aripo.org
Brazil	www.inpi.gov.br
Bulgaria	www.bpo.bg
Burkina Faso	www.oapi.wipo.net
Burundi	www.oapi.wipo.net
Cambodia	www.moc.gov.kh
Cameroon	www.oapi.wipo.net
Canada	www.opic.gc.ca
Central African Republic	www.oapi.wipo.net
Chad	www.oapi.wipo.net
Chile	www.dpi.cl
China	www.sipo.gov.cn
China (Hong Kong -SAR)	www.ipd.gov.hk
China (Macao)	www.economia.gov.mo
China (Marks)	www.saic.gov.cn
Colombia	www.sic.gov.co
Congo	www.oapi.wipo.net
Costa Rica	www.registracional.go.cr

Côte d'Ivoire	www.oapi.wipo.net
Croatia	www.dziv.hr
Cuba	www.ocpi.cu
Cyprus	www.mcit.gov.cy/mcit/drcor/drcor.nsf
Czech Republic	www.upv.cz
Democratic Republic of the Congo	www.oapi.wipo.net
Denmark	www.dkpto.dk
Dominican Republic	www.seic.gov.do/onapi
Egypt	www.egypo.gov.eg
El Salvador	www.cnr.gobs.sv
Estonia	www.epa.ee
Eurasian Patent Office	www.eapo.org
European Union (Office for Harmonization in the Internal Market – OHIM)	www.oami.eu.int
Finland	www.prh.fi
France	www.inpi.fr
Gabon	www.oapi.wipo.net
Gambia	www.aripo.org
Georgia	www.sakpatenti.org.ge
Germany	www.dpma.de
Ghana	www.aripo.org
Greece	www.obl.gr
Honduras	www.sic.gob.hn/pintelec/indice.htm
Hungary	www.mszh.hu/english/index.html
Iceland	www.patent.is/focal/webguard.nsf/key2/indexeng.html
India	www.ipindia.nic.in
Indonesia	www.dgip.go.id
Ireland	www.patentsoffice.ie
Israel	www.justice.gov.il
Italy	www.uibm.gov.it
Jamaica	www.jipo.gov.jm
Japan	www.jpo.go.jp
Jordan	www.mit.gov.jo
Kazakhstan	www.kazpatent.org/english
Kenya	www.aripo.org
Kuwait	www.gulf-patent-office.org.sa

Serbia	www.yupat.sv.gov.yu
Sierra Leone	www.aripo.org
Singapore	www.ipos.gov.sg
Slovak Republic	www.indprop.gov.sk
Slovenia	www.uil-sipo.si/Default.htm
Somalia	www.aripo.org
South Africa	www.cipro.gov.za
Spain	www.oepm.es
Sudan	www.aripo.org
Swaziland	www.aripo.org
Sweden	www.prv.se
Switzerland	www.ige.ch
Syrian Arab Republic	www.himaya.net
Tajikistan	www.tipat.org
Thailand	www.ipthailand.org
The Former Yugoslav Republic of Macedonia	www.ippo.gov.mk
Togo	www.oapi.wipo.net
Trinidad and Tobago	www.ipso.gov.tt/home.asp
Tunisia	www.inorpi.ind.tn
Turkey	www.turkpatent.gov.tr
Turkmenistan	www.eapo.org
Uganda	www.aripo.org
Ukraine	www.sdip.gov.ua
United Arab Emirates	www.gulf-patent-office.org.sa
United Kingdom	www.patent.gov.uk
United Republic of Tanzania	www.aripo.org
United States	www.uspto.gov
Uruguay	www.dnpi.gub.uy
Uzbekistan	www.patent.uz
Venezuela	www.sapi.gov.ve
Yemen	www.most.org.ye
Zambia	www.aripo.org
Zimbabwe	www.aripo.org

Annex I – Useful websites

For more information on:

- intellectual property issues from a business perspective
www.wipo.int/sme
- trademarks in general
www.wipo.int/about-ip
www.inta.org (International Trademark Association)
- the practical aspects relating to the registration of trademarks see Annex II or
www.wipo.int/directory/en/urls.jsp
- Madrid system for the International Registration of Marks
www.wipo.int/madrid
- International Classification of Goods and Services for the Purposes of the Registration of Marks under the Nice Agreement
www.wipo.int/classifications (under Nice Agreement)
- International Classification of the Figurative Elements of Marks under the Vienna Agreement
www.wipo.int/classifications (under Vienna Agreement)
- the conflict between trademarks and domain names and on alternative dispute resolution procedures for domain names
www.arbiter.wipo.int/domains
www.icann.org.

A list of the online trademark databases maintained by industrial property offices throughout the world is available at www.arbiter.wipo.int/trademark

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Andorra	www.ompa.ad
Argentina	www.inpi.gov.ar
Armenia	www.armpatent.org
Australia	www.ipaustralia.gov.au
Austria	www.patent.bmvit.gv.at
Bahrain	www.gulf-patent-office.org.sa/bahrainframe.htm
Barbados	www.caipo.org
Belarus	www.belgospatent.org/english/about/history.html
Belgium	www.mineco.fgov.be
Belize	www.belipo.bz
Benelux	www.boip.int
Benin	www.oapi.wipo.net
Bolivia	www.senapi.gov.bo
Botswana	www.aripo.org
Brazil	www.inpi.gov.br
Bulgaria	www.bpo.bg
Burkina Faso	www.oapi.wipo.net
Burundi	www.oapi.wipo.net
Cambodia	www.moc.gov.kh
Cameroon	www.oapi.wipo.net
Canada	www.opic.gc.ca
Central African Republic	www.oapi.wipo.net
Chad	www.oapi.wipo.net
Chile	www.dpi.cl
China	www.sipo.gov.cn
China (Hong Kong -SAR)	www.ipd.gov.hk
China (Macao)	www.economia.gov.mo
China (Marks)	www.saic.gov.cn
Colombia	www.sic.gov.co
Congo	www.oapi.wipo.net
Costa Rica	www.registracional.go.cr

Côte d'Ivoire	www.oapi.wipo.net
Croatia	www.dziv.hr
Cuba	www.ocpi.cu
Cyprus	www.mcit.gov.cy/mcit/drcor/drcor.nsf
Czech Republic	www.upv.cz
Democratic Republic of the Congo	www.oapi.wipo.net
Denmark	www.dkpto.dk
Dominican Republic	www.seic.gov.do/onapi
Egypt	www.egypo.gov.eg
El Salvador	www.cnr.gobs.sv
Estonia	www.epa.ee
Eurasian Patent Office	www.eapo.org
European Union (Office for Harmonization in the Internal Market – OHIM)	www.oami.eu.int
Finland	www.prh.fi
France	www.inpi.fr
Gabon	www.oapi.wipo.net
Gambia	www.aripo.org
Georgia	www.sakpatenti.org.ge
Germany	www.dpma.de
Ghana	www.aripo.org
Greece	www.obj.gr
Honduras	www.sic.gob.hn/pintelec/indice.htm
Hungary	www.mszh.hu/english/index.html
Iceland	www.patent.is/focal/webguard.nsf/key2/indexeng.html
India	www.ipindia.nic.in
Indonesia	www.dgip.go.id
Ireland	www.patentsoffice.ie
Israel	www.justice.gov.il
Italy	www.uibm.gov.it
Jamaica	www.jipo.gov.jm
Japan	www.jpo.go.jp
Jordan	www.mit.gov.jo
Kazakhstan	www.kazpatent.org/english
Kenya	www.aripo.org
Kuwait	www.gulf-patent-office.org.sa

Lao People's Democratic Republic	www.stea.la.wipo.net
Latvia	www.lrv.lv
Lebanon	www.economy.gov.lb
Lesotho	www.aripo.org
Liechtenstein	www.european-patent-office.org
Lithuania	www.vpb.lt
Luxembourg	www.etat.lu/ec
Malawi	www.aripo.org
Malaysia	www.mipc.gov.my
Mali	www.oapi.wipo.net
Mexico	www.impi.gob.mx
Monaco	www.european-patent-office.org/patlib/country/monaco
Montenegro	www.yupat.sv.gov.yu
Morocco	www.ompic.org.ma
Mozambique	www.aripo.org
Namibia	www.aripo.org
Nepal	www.ip.np.wipo.net
Netherlands	www.octrooicentrum.nl
New Zealand	www.iponz.govt.nz
Niger	www.oapi.wipo.net
Norway	www.patentstyret.no
Oman	www.gulf-patent-office.org.sa
Panama	www.digerpi.gob.pa
Peru	www.indecopi.gob.pe
Philippines	www.ipophil.gov.ph
Poland	www.business.gov.pl/Intellectual,property,protection,90.html
Portugal	www.inpi.pt
Qatar	www.gulf-patent-office.org.sa
Republic of Korea	www.kipo.go.kr
Republic of Moldova	www.agepi.md
Romania	www.osim.ro
Russian Federation	www.rupto.ru
Saint Vincent and the Grenadines	196.1.161.62/govt/cipo/index.asp
Saudi Arabia	www.gulf-patent-office.org.sa
Senegal	www.oapi.wipo.net

Serbia	www.yupat.sv.gov.yu
Sierra Leone	www.aripo.org
Singapore	www.ipos.gov.sg
Slovak Republic	www.indprop.gov.sk
Slovenia	www.uil-sipo.si/Default.htm
Somalia	www.aripo.org
South Africa	www.cipro.gov.za
Spain	www.oepm.es
Sudan	www.aripo.org
Swaziland	www.aripo.org
Sweden	www.prv.se
Switzerland	www.ige.ch
Syrian Arab Republic	www.himaya.net
Tajikistan	www.tipat.org
Thailand	www.ipthailand.org
The Former Yugoslav Republic of Macedonia	www.ippo.gov.mk
Togo	www.oapi.wipo.net
Trinidad and Tobago	www.ipo.gov.tt/home.asp
Tunisia	www.inorpi.ind.tn
Turkey	www.turkpatent.gov.tr
Turkmenistan	www.eapo.org
Uganda	www.aripo.org
Ukraine	www.sdip.gov.ua
United Arab Emirates	www.gulf-patent-office.org.sa
United Kingdom	www.patent.gov.uk
United Republic of Tanzania	www.aripo.org
United States	www.uspto.gov
Uruguay	www.dnpi.gub.uy
Uzbekistan	www.patent.uz
Venezuela	www.sapi.gov.ve
Yemen	www.most.org.ye
Zambia	www.aripo.org
Zimbabwe	www.aripo.org

Note:

For up-to-date information visit website at the following urls:

www.wipo.int/members/en/ and

www.wipo.int/directory/en/urls.jsp

Note:

For up-to-date information visit website at the following urls: www.wipo.int/members/en/
and
www.wipo.int/directory/en/urls.jsp

Annex III – Nice Classification

International Classification of Goods and Services for the Purposes of the Registration of Marks under the Nice Agreement

Goods

1. Chemicals used in industry, science and photography, as well as in agriculture, horticulture and forestry; unprocessed artificial resins, unprocessed plastics; manures; fire extinguishing compositions; tempering and soldering preparations; chemical substances for preserving foodstuffs; tanning substances; adhesives used in industry.
2. Paints, varnishes, lacquers; preservatives against rust and against deterioration of wood; colorants; mordents; raw natural resins; metals in foil and powder form for painters, decorators, printers and artists.
3. Bleaching preparations and other substances for laundry use; cleaning, polishing, scouring and abrasive preparations; soaps; perfumery, essential oils, cosmetics, hair lotions; dentifrice.
4. Industrial oils and greases; lubricants; dust absorbing, wetting and binding compositions; fuels (including motor spirit) and illuminants; candles and wicks for lighting.
5. Pharmaceutical and veterinary preparations; sanitary preparations for medical purposes; dietetic substances adapted for medical use, food for babies; plasters, materials for dressings; material for stopping teeth, dental wax; disinfectants; preparations for destroying vermin; fungicides, herbicides.
6. Common metals and their alloys; metal building materials; transportable buildings of metal; materials of metal for railway tracks; non-electric cables and wires of common metal; ironmongery, small items of metal hardware; pipes and tubes of metal; safes; goods of common metal not included in other classes; ores.
7. Machines and machine tools; motors and engines (except for land vehicles); machine coupling and transmission components (except for land vehicles); agricultural implements other than hand-operated; incubators for eggs.

8. Hand tools and implements (hand-operated); cutlery; side arms; razors.
9. Scientific, nautical, surveying, photographic, cinematographic, optical, weighing, measuring, signaling, checking (supervision), life-saving and teaching apparatus and instruments; apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling electricity; apparatus for recording, transmission or reproduction of sound or images; magnetic data carriers, recording discs; automatic vending machines and mechanisms for coin-operated apparatus; cash registers, calculating machines, data processing equipment and computers; fire-extinguishing apparatus.
10. Surgical, medical, dental and veterinary apparatus and instruments, artificial limbs, eyes and teeth; orthopedic articles; suture materials.
11. Apparatus 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; explosives; fireworks.
14. Precious metals and their alloys and goods in precious metals or coated therewith, not included in other classes; jewelry, precious stones; horological and chronometric instruments.
15. Musical instruments.
16. Paper, cardboard and goods made from these materials, not included in other classes; printed matter; bookbinding material; photographs; stationery; adhesives for stationery or household purposes; artists' materials; paint brushes; typewriters and office requisites (except furniture); instructional and teaching material (except apparatus); plastic materials for packaging (not included in other classes); printers' type; printing blocks.
17. Rubber, gutta-percha, gum, asbestos, mica and goods made from these materials and not included in other classes; plastics in extruded form for use in manufacture; packing, stopping and insulating materials; flexible pipes, not of metal.
18. Leather and imitations of leather, and goods made of these materials and not included in other classes; animal skins, hides; trunks and travelling bags; umbrellas, parasols and walking sticks; whips, harness and saddlery.

19. Building materials (non-metallic); non-metallic rigid pipes for building; asphalt, pitch and bitumen; non-metallic transportable buildings; monuments, not of metal.
20. Furniture, mirrors, picture frames; goods (not included in other classes) of wood, cork, reed, cane, wicker, horn, bone, ivory, whalebone, shell, amber, mother-of-pearl, meerschaum and substitutes for all these materials, or of plastics.
21. Household or kitchen utensils and containers (not of precious metal or coated therewith); combs and sponges; brushes (except paint brushes); brush-making materials; articles for cleaning purposes; steelwool; unworked or semi-worked glass (except glass used in building); glassware, porcelain and earthenware not included in other classes.
22. Ropes, string, nets, tents, awnings, tarpaulins, sails, sacks and bags (not included in other classes); padding and stuffing materials (except of rubber or plastics); raw fibrous textile materials.
23. Yarns and threads, for textile use.
24. Textiles and textile goods, not included in other classes; bed and table covers.
25. Clothing, footwear, headgear.
26. Lace and embroidery, ribbons and braid; buttons, hooks and eyes, pins and needles; artificial flowers.
27. Carpets, rugs, mats and matting, linoleum and other materials for covering existing floors; wall hangings (non-textile).
28. Games and playthings; gymnastic and sporting articles not included in other classes; decorations for Christmas trees.
29. Meat, fish, poultry and game; meat extracts; preserved, dried and cooked fruits and vegetables; jellies, jams, compotes; eggs, milk and milk products; edible oils and fats.
30. Coffee, tea, cocoa, sugar, rice, tapioca, sago, artificial coffee; flour and preparations made from cereals, bread, pastry and confectionery, ices; honey, treacle; yeast, baking-powder; salt, mustard; vinegar, sauces (condiments); spices; ice.

31. Agricultural, horticultural and forestry products and grains not included in other classes; live animals; fresh fruits and vegetables; seeds, natural plants and flowers; foodstuffs for animals, malt.
32. Beers; mineral and aerated waters and other non-alcoholic drinks; fruit drinks and fruit juices; syrups and other preparations for making beverages.
33. Alcoholic beverages (except beers).
34. Tobacco; smokers' articles; matches.

Services

35. Advertising; business management; business administration; office functions.
36. Insurance; financial affairs; monetary affairs; real estate affairs.
37. Building construction; repair; installation services.
38. Telecommunications.
39. Transport; packaging and storage of goods; travel arrangement.
40. Treatment of materials.
41. Education; providing of training; entertainment; sporting and cultural activities.
42. Scientific and technological services and research and design relating thereto; industrial analysis and research services; design and development of computer hardware and software; legal services.
43. Services for providing food and drink; temporary accommodation.
44. Medical services; veterinary services; hygienic and beauty care for human beings or animals; agriculture, horticulture and forestry services.
45. Personal and social services rendered by others to meet the needs of individuals; security services for the protection of property and individuals.

In January 2006, 73 states were party to the Nice Agreement. They have adopted and apply the Nice Classification for the purposes of the registration of marks.

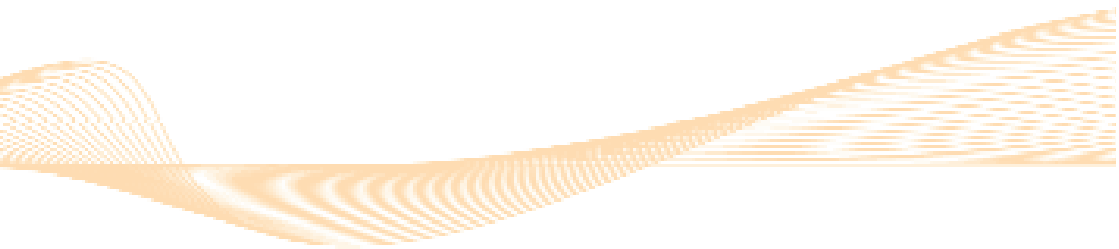


Note:

For up-to-date information, visit website at the following urls:

[www.wipo.int/classifications/fulltext/nice8/](http://www.wipo.int/classifications/fulltext/nice8/enmain.htm)

[enmain.htm](http://www.wipo.int/madrid/en/contact.html) and www.wipo.int/madrid/en/contact.html



Republic of Moldova (A&P)
Romania (A&P)
Russian Federation (A&P)
San Marino (A)
Serbia (A&P)
Sierra Leone (A&P)
Singapore (P)
Slovakia (A&P)
Slovenia (A&P)
Spain (A&P)
Sudan (A)
Swaziland (A&P)
Sweden (P)
Switzerland (A&P)
Syrian Arab Republic (A&P)

Tajikistan (A)
The former Yugoslav Republic of
Macedonia (A&P)
Turkey (P)
Turkmenistan (P)
Ukraine (A&P)
United Kingdom (P)
United States of America (P)
Uzbekistan (A)
Viet Nam (A)
Zambia (P)

(A) indicates a party to the Agreement
(P) indicates a party to the Protocol

* Protection may not be requested separately for Belgium, Luxembourg or the Netherlands, but only for all three countries as a whole (Benelux), subject to payment of a single complementary or individual fee.

Note :

For up-to-date information, visit website at the following url:
www.wipo.int/madrid/en/members/

For more information contact the
World Intellectual Property Organization

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34, chemin des Colombettes
P.O. Box 18
CH-1211 Geneva 20
Switzerland

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+41 22 338 91 11

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or its New York Coordination Office at:

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New York, N.Y. 10017
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