

# LET'S TALK... BUSINESS!

## INTELLECTUAL PROPERTY



### A DAY IN THE LIFE OF A TRADE-MARKS EXAMINER

*"Life's a box of chocolates – you never know what you're gonna get."*

*- Spoken by the character Mrs. Gump in the movie "Forrest Gump"*

When I was finishing up my training a number of years ago, we trainees were privileged to be able to have a look at some of the first volumes of the register for trade-marks. Apparently this country was founded on trade in tobacco and whisky. Examining trade-marks today, one gets a clear picture of the variety and scope of our society and trade today and the possibilities of the future of our country. It's history in the making, and what could be better than that?

On paper, the main portion of the official job description for trade-marks examiner reads something along the lines of "examine applications for registration of trade-marks to ensure they are in compliance with the Rules and Regulations of the Trade-marks Act". How very dry.

In fact, I think working on a stack of new files really is more like opening a box of chocolates – you never do know what you're going to get. In a typical day, an examiner conducts initial examinations of new files, and deals with on-going correspondence and telephone calls for files that are works in progress. This may involve searching the database for confusing trade-marks, proofreading files and discussions with clients and colleagues on cut and dried requirements, points of law, or the semantics of words and phrases. Any given day may see files as diverse as those seeking registration for new pharmaceutical products, electronic sensors, oil rig equipment, insurance services, telecommunications devices, up and coming game software, home electronics, scientific research in genomics, restaurant services, pet food, cosmetics and even space vehicles cross my desk. The marks may be punny word-marks, interesting designs, or marks so close to already famous brands that they need a second look. My job is to make sure that the proposed trade-mark is not contrary to the Act and therefore unregistrable because it is clearly descriptive of the wares and services, primarily merely a name, or so similar that it is confusing with another registered or earlier entitled trade-mark, and that the application is in order. In practice, I

conduct large amounts of Internet research into anything and everything under the sun to satisfy those requirements. Today I may research wine regions in Australia, new cancer pharmaceuticals being developed, or new car names coming down the line. Tomorrow may be a satellite radio station day.

The greatest challenge, and perhaps the greatest reward, comes from dealing with individuals who chose to file their own applications, rather than using the services of a trade-mark agent. In some cases, the individual applicants are not clear on the procedures or the requirements, and require extra assistance and information to successfully complete the process. For example, one particular applicant had created a product and was applying for trade-mark protection. However, he thought his product was such a good idea, and he was so concerned about the possibility of someone stealing it before he obtained his registration, that trying to determine exactly what the product was resulted in a game of "20 questions" between the applicant and the examiner. Occasionally an applicant may provide information in such a way that it is, in fact, obviously contrary to the regulations; explaining the ins and outs of an acceptable application requires tact, and hopefully, provides a way to reach a satisfactory solution to the problem.

Like most jobs, some workdays are routine, some days are so challenging they make my head hurt, but in the Examination section, I find the days are never boring. Registrations from a few years ago may cover such wares and services as typewriters, gramophone records, foods such as cheese and jam, and radio broadcasts. Today, they are more likely to be for software, CD-Roms, cappuccinos and thai curry dishes and the provision of downloadable music. Tomorrow, it could be a new kind of chocolate all together.

- Joy Loubert