



PRACTICE NOTE 3 OF 2021

**TRADE MARK REQUESTS FOR EXTENSION OF TIME TO PROSECUTE
TRADE MARK APPLICATIONS**

**SECTION 20(2) AND REGULATION 15(5)
OF THE TRADE MARKS ACT, ACT 194 OF 1993**

TRADE MARKS DIVISION

COMPANIES AND INTELLECTUAL PROPERTY COMMISSION (CIPC)

Kindly take note that on **Monday 1 March 2021** the Trade Marks Division of CIPC will be introducing a new electronic filing functionality (e-filing) in respect of the **submission of requests for extensions of time to prosecute trade mark applications (i.e. extensions of the prosecution term)**.

The e-filing functionality can be accessed at <https://iponline.cipc.co.za>.

The **operational requirements** in respect of this new e-filing functionality are detailed in the annexure to this notice.

IMPORTANT NOTE: As from 1 March 2021 the Trade Marks Division will **no longer accept nor process** any requests for the extension of the prosecution term which are **not** submitted via this e-filing functionality.

**RORY VOLLER (MR)
COMMISSIONER: CIPC
.24.. February 2021**

**OPERATIONAL REQUIREMENTS
TRADE MARK REQUESTS FOR EXTENSION OF THE PROSECUTION TERM**

**SECTION 20(2) AND REGULATION 15(5)
OF THE TRADE MARKS ACT, ACT 194 OF 1993**

**TRADE MARKS DIVISION
COMPANIES AND INTELLECTUAL PROPERTY COMMISSION (CIPC)**

A. INTRODUCTION

To utilise this e-filing functionality, you need to:-

1. Be **based in the Republic of South Africa;** OR
2. Be an **authorised representative** (based in South Africa) in order to use this functionality on behalf of trade mark applicants and/or proprietors; AND
3. Be registered as a CIPC customer; AND
4. Upon registration as a CIPC customer, select from the IP e-Services suite, the IP Online option in order to access the IP e-filing functionalities you would wish to make use of; AND
5. Use your CIPC username and password to log in.

It is further strongly recommended that before using this e-filing functionality, you:-

1. Familiarise yourself with the **CIPC e-Filing T&C's** of this e-filing functionality, as published in IP Online on the CIPC website; and
2. Familiarise yourself with the **important notice on authorised representatives** as reflected in IP Online; and
3. Review the e-filing user administration guide as made available in IP Online on the CIPC website; and
4. Review the user guide for **e-filing of extensions of the prosecution term in respect of trade mark applications** as made available in IP Online on the CIPC website.

B. LODGING

This e-filing facility in IP Online only caters only for **single submissions*** of requests for extensions of the prosecution term to prosecute trade mark applications.

** for series applications – i.e. exact same trade mark in the name of the exact same proprietor lodged in different classes – a request for extension of the prosecution term on a series of applications can be lodged and will be processed as a single submission.*

The steps that have to be followed to make use of this e-filing functionality are outlined here below:-

1. Access the CIPC Website at <http://www.cipc.co.za>;
2. Register as a CIPC Customer by clicking **ONLINE TRANSACTING** on the homepage, then click on **e-SERVICES**, and follow the instructions under **REGISTER AS A CUSTOMER**;
3. When a customer enters their CIPC customer code into the CIPC e-Filing system, any document lodged thereafter shall be deemed to have been duly signed by the person whose signature is required in terms of the Trade Marks Act (Act 194 of 1993), for the purposes of lodging such a document;
4. Log in to IP Online using your CIPC customer login credentials.
 - i. On initial login to IP Online, you need to set your account preferences so as to have access to the new e-filing functionalities on the IP Online platform.
 - ii. Select to view your account settings by clicking the “Settings” options next to your account name.
 - iii. Select the “Account Preferences” on the left side menu options and then tick the option that you prefer to add.
 - iv. Click the “Save” button.
 - v. Note - you will be required to login again for the changes to be effected.
5. Follow the process outlined in the user guide for filing the request for extension of the prosecution term;
6. For assistance or if experiencing technical difficulties in using the functionality, kindly log a call on the CIPC Online Enquiries System (QRS), available on the CIPC website, by selecting the following categories:
 - i. Department: Intellectual Property
 - ii. Category: E-Filing IP
 - iii. Sub category: IP Trade Marks

C. WHEN IS A SUBMITTED REQUEST FOR AN EXTENTION OF THE PROSECUTION TERM DEEMED TO HAVE BEEN RECEIVED AND PROCESSED BY THE TRADE MARKS DIVISION

A request for an extension of the prosecution term lodged via the IP Online e-filing interface, is deemed to have been received and processed by the Trade Marks Division when the applicant receives a system generated (automated) **confirmatory e-mail** from the IP e- filing system clearly stating that (i) the requested extension of the prosecution term has been granted, and (ii) the date of expiry of the prosecution term as granted.

The date on the confirmatory e-mail (above) will be deemed to be the filing date of the request for the extension of the prosecution term.

D. BUSINESS RULES APPLICABLE FOR SUCCESSFUL PROCESSING OF AN APPLICATION FOR EXTENSION OF THE PROSECUTION TERM

In view of the fact that this is a fully automated e-filing functionality with no human intervention or manual processing, it is imperative for users to familiarise themselves with the business rules applicable to this e-filing functionality.

1. The extension request must be submitted within a 3-month period from :-

- (i) the date on which the official action was issued, or from
- (ii) the expiry date of the previous extension*

* *in respect of ALL 1st time applications for requests for the extension of the prosecution term ONLY, the party applying for the 1st extension will be able to insert the expiry date of the current prosecution term in the field as provided.*

For all subsequent applications for the extension of the prosecution term, the e-filing platform will automatically insert the expiry date of the current prosecution term, from where the following 3-month prosecution term will automatically be calculated by the e-filing platform.

* In this regard users of this functionality are reminded of the provisions of Sections 60 and 61 of the Trade Marks Act as it relates to the making of false entries in any register or making of false statements for purposes of deceiving.

2. The request for the extension of the prosecution term must be lodged while there is still a valid prosecution term in place, i.e. before the expiry date of the current prosecution term, in line with the provisions of Section 20(2) of the Trade Marks Act.
3. Only the recorded address for service or the trade mark applicant itself may apply for a request for the extension of the prosecution term.
4. The expiry date of the prosecution term as applied for will automatically be calculated by the e-filing platform for 3-months at a time.
5. Upon a successful application for an extension of the prosecution term, the user will receive an automated e-mail notification confirming that (i) the request for an extension of the prosecution term has been granted and (ii) the expiry date of the prosecution term as granted.
6. At the same time an automated entry will be made under "Last Proceedings" in the Register sheet of the particular trade mark application to the effect that an extension of the prosecution term has been granted, and what the expiry date of the prosecution term is.

When can an application for extension of the prosecution term NOT be lodged or when will an application for an extension of the prosecution term NOT be successfully processed and granted.

1. An application for an extension of the prosecution term cannot be lodged after the expiry date of a prosecution term; and
2. An application for an extension of the prosecution term cannot be lodged in respect of a trade mark where the status is reflected as "abandoned", "withdrawn", "cancelled", "invalid", "under opposition", "registered", "advertised", "unpaid", "removed".