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SUMMARY

This thesis investigates the role of prior use in common and statutory trade mark law. In the United States a pertinent requirement is priority of use. In the United Kingdom and South Africa, a reputation must be present. In the United Kingdom a plaintiff is required to have goodwill in the country, but in the United States and South Africa it is not required.

The conception of a mark does not qualify for protection. It is not required that a business must have actually entered the market. In the United States the general approach is that a plaintiff will not receive protection in a remote area, but regard must be had to zones of natural expansion. British and South African law is the same, and protection may be obtained in areas where there is no trading. Where a dual reputation exists, neither party will be able to act against the other. The mere fact that the user of a mark was aware of the use thereof by another person, does not exclude protection.

A trade mark application can be opposed on the basis of another application, combined with use of a mark, or on the ground of prior use. In some instances the fact that a mark has been filed will influence the burden of proof. In general, a registration can be expunged on the same grounds as would constitute grounds of opposition.

The concurrent use of a mark can form the basis for the registration of a mark. In the United States, the use must have taken place prior to the filing date of the other party, but in the United Kingdom and South Africa, prior to the own filing date. In the latter two countries, knowledge of a mark is not necessarily exclusionary.

Prior use is generally accepted as a defence to an infringement action. It is, however, noted that in various countries, it is only use prior to the relevant date that will be protected, and there is not necessarily a right to extend the scope of use concerned.

KEY TERMS

Trade marks; unlawful competition; common law trade marks; prior use; geographical priority; honest concurrent use; user rights; subjective rights; distinctive marks; reputation; intellectual property.