



# Zimbabwe – trade mark prosecution: pre-filing Searches

## Background

An Italian company applied to register a trade mark for the name of its pasta sauce. The application was filed on a 'proposed to be used' basis because the company had not yet started importing its trade marked goods into Zimbabwe.

The Zimbabwe national IP office examines trade mark applications to check if they comply with the law and that they are not in conflict with the prior rights of other proprietors.

After its initial examination, the IP office objected to the registration of the Italian company's trade mark on two grounds.

1. The trade mark was likely to cause confusion in the market with the name of a registered local company.
2. The image (device) that was included in the trade mark was similar to that of a trade mark of another trade mark proprietor for similar goods.

## Action undertaken

The Italian company instructed its lawyers to obtain the details of the cited local company. It also instructed its lawyers to advise on possible ways of overcoming the challenges posed by the similar device of the cited conflicting trade mark.

The lawyers established that the cited company name was problematic. Its name was similar and the company was in the same field of activity in which the Italian company wished to register its trade mark, that is to say, the food industry. Therefore, the Italian company would have to seek written consent from the cited company to proceed with the registration of its trade mark.

The lawyers also established that the device that was used in the Italian company's trade mark was similar to that of the cited trade mark. They recommended an amendment of the Italian company's trade mark to include a different device.

The Italian company's trade mark was eventually registered after 18 months of seeking consent from the cited local company and amending its trade mark to include a new device.

The Italian company had to delay its plan to market its goods in Zimbabwe until the trade mark registration had been secured. Therefore, it lost an early opportunity to commercialise its product in a new market due to legal processes that could have been avoided – see lessons learned below.





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## Lessons learned

- The company should have conducted pre-filing clearance searches to establish if the trade mark was available. The searches would also have revealed the company name challenge.
- The searches would have avoided the various expensive and time-consuming actions that were taken by the company register its trade mark.

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