

Rooibos: the name to defend

By [Rowan Forster](#)

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Rooibos certainly does make the headlines. That soothing cup of tea that so many of us enjoy was big news a few years back when an American company announced that it had a US trade mark registration for the name Rooibos, and that it would be able to block South African exporters of rooibos tea from using the name in the US.

It subsequently transpired that a South African entrepreneur who had been at the forefront of rooibos exports to the US had, in fact, obtained the US registration way back in 1994 (at a time when the name was practically unknown outside of South Africa), and subsequently sold it to the US company. The South African government entered the fray and, at one stage, things became a bit ugly. Legal proceedings to cancel the registration were filed in the US and the owner eventually agreed that it would not claim exclusive rights to the word.

A similar story has unfolded in France, where a French company has applied to register Rooibos as a trade mark for beverages. Once again the government has stepped in, with Trade & Industry Minister Rob Davies talking of the "capture of the intellectual property associated with Rooibos". Davies went on to say that "the DTI stands ready to defend South Africa's trade and intellectual property interests vigorously", adding that his department had lodged an objection with the French Embassy in South Africa and the European Commission Delegation in Pretoria. But Davies did intimate that things are not exactly clear when it comes to the legal position of rooibos: "The issues in this particular matter will require an urgent assessment of the legal options to strengthen protection of the Rooibos name in South Africa."

What are the legal issues?

So just what are the legal issues here? Well, the first point worth noting is that rooibos is the name of a type of tea - one that is derived from a particular plant - rather than a brand of tea, which makes rooibos a generic name and one that cannot be monopolised by a single party. The second is that the plant that rooibos tea is derived from is only to be found in a particular region of the Western Cape, which means that, although there is no place called Rooibos, the word does have a certain geographical significance.

In certain parts of the world it is possible to get legal protection for a geographic indication in cases in which a certain quality is ascribable to the source. The Europeans are particularly big on this and in the European Union it's possible to register a name as a "Protected Designation of Origin" (PDO) in cases in which all stages of production occur in the area or, alternatively, as a "Protected Geographical Indication" (PGI) in cases in which only one stage of the production cycle occurs in the area. As a result, a large number of names are off limits in the EU. Obvious and well-known examples include Champagne, Port, Sherry and Feta.

Some of these names are off limits outside the EU too. That's because the Europeans have been known to use their economic muscle to persuade weaker trading partners to agree to prohibit the use of certain names in their countries, which is why, for example, the name Champagne is verboten in South Africa.

No protection for geographical indications in SA law

South African law, however, does not have any protection for geographical indications. As a result of this lack of protection at home, foreign authorities like those in the EU won't grant protection to South African names like rooibos. This problem, says the government, will be solved once the Intellectual Property Laws Amendment Act 2007 - or the "Traditional Knowledge Act" (TKA) as it is better known - becomes law. But is this really the case?

The TKA is controversial and, although it has been approved by parliament, it hasn't yet been signed by the State President. I'm not going to be examining the controversy in this article, but it is worth noting that the TKA makes provision for the protection of a "geographical indication", which is defined as "an indication which identifies goods as originating in the territory of the Republic or in a region or locality in that territory, and where a particular quality, reputation or other characteristic of the goods is essentially attributable to the geographic origin of the goods, including natural and human factors". The TKA says that a geographical indication can be registered as a certification trade mark or a collective trade mark.

So, if and when the TKA comes into force, it will be possible for a name like rooibos to be registered as a certification trade mark or a collective trade mark. And, once that happens, it may be possible to convince the authorities like those in the EU to grant protection to the name there, in which case no single party will be able to monopolise it through a trade mark registration. Problem solved!

So what exactly are certification and collective trade marks? A certification trade mark is one that certifies that any product bearing the mark is of a particular kind or quality, or that it has a particular characteristic, or that it comes from a particular region. In the case of rooibos, the name would presumably be registered in the name of an industry body that could certify that the tea was the real deal. A collective trade mark is slightly different in that it indicates that the person applying the trade mark to the product belongs to a particular industry body. In the case of both types of mark, it's necessary to lodge fairly detailed information showing how the certification or membership works.

Both these forms of protection are already available under the Trade Marks Act, so there is no reason to wait for the TKA to become law. It's not really clear why no industry body has managed to get a certification or collective trade mark registration for Rooibos, although news reports do suggest that some steps were taken, but that the process wasn't completed. Meanwhile, a professor of intellectual property law has suggested that the authorities should declare Rooibos a prohibited mark in terms of Section 15 of the Merchandise Marks Act, following which it will be out of bounds completely. Once that happens, they should try to persuade foreign authorities, like those in the EU, to protect the term on the basis of this form of South African protection. In fact, the professor claims that he and others advised the government to do this years ago when rooibos became an issue in the US, and that this advice was ignored.

It does look very much as if the rooibos issue has been sadly neglected by the various role players, which is why it's now such a mess!

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