

**ACT 664****TRADEMARKS ACT, 2004**

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*Registration of Trademarks*

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**ACT 664****TRADEMARKS ACT, 2004<sup>1</sup>**

**AN ACT to provide for the protection of trademarks and for related matters.**

*Registration of Trademarks***1. Meaning of trademark**

Trademark means a sign or combination of signs capable of distinguishing the goods or services of one undertaking from the goods or services of any other undertakings including words such as personal names, letters, numerals and figurative elements.

**2. Meaning of collective mark**

A collective mark is a visible sign capable of distinguishing the origin or any other common characteristic including the quality of goods or services of different enterprises which use the sign under the control of a registered owner from the goods or services of any other enterprises.

**3. Registration of trademark**

Registration of a trademark by a person confers an exclusive right to the use of the trademark on that person.

**4. Application for registration**

(1) An application for the registration of a trademark shall be filed with the Registrar and is subject to the payment of the prescribed fee.

(2) The application shall be accompanied with a reproduction of the trademark and a list of the goods or services for which the registration of the trademark is requested using the International Classification.

(3) The application may contain a declaration claiming the priority of an earlier national or regional application filed by the applicant or the predecessor in title of the applicant as provided for in article 4 of the Paris Convention set out in the First Schedule

(a) in or for a state party to the Convention, or

(b) in or for a member of the World Trade Organisation,

and the Registrar may require the applicant to provide within the prescribed time a copy of the earlier application certified as correct by the office with which it was filed.

(4) Where the Registrar finds that the requirements under subsection (3) have not been met, the declaration shall cease to have effect.

(5) The applicant may withdraw the application.

**5. Grounds for refusal of registration**

A trademark shall not be registered if,

(a) it is a trade name;

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1. The Act was assented to on 29th January, 2004 and notified in the *Gazette* on 6th February, 2004.

- (b) it is incapable of distinguishing the goods or services of one enterprise from the goods or services of another enterprise;
- (c) it is contrary to public order or morality;
- (d) it is likely to mislead the public or trade circles with particular reference to the geographical origin of the goods or services, their nature or characteristics;
- (e) it is identical to or is an imitation of or contains as an element, an armorial bearing, flag, emblem, name, abbreviation or initials of the name, official sign or hallmark adopted by a State, an intergovernmental organisation or organisation created by an international convention unless authorised by the competent authority of that State or organisation;
- (f) it is identical to or confusingly similar to or constitutes a translation of a trademark or trade name which is well known in the country for identical or similar goods or services of another enterprise, or the trademark is well known and registered in the country for goods or services which are not identical or similar to those under application but the use of the trademark will indicate a connection between those goods or services and the owner of the well known trademark and the interests of the owner of the well known trademark are likely to be damaged by the use of the trademark;
- (g) the trademark is identical to a trademark of another owner already on the register or identical to a trademark the subject of an application with an earlier filing or priority date for the same goods or services or closely related goods or services or if it resembles that trademark so closely that it is likely to deceive or cause confusion.

## **6. Examination and opposition to registration of trademark**

(1) The Registrar shall examine whether the application complies with the requirements of

- (a) section 1,
- (b) section 3,
- (c) subsection (1) and (2) of section 4, and
- (d) section 5.

(2) If the Registrar finds that the conditions in subsection (1) have been complied with, the Registrar shall accept the application to be published so that an interested person may file a notice of opposition to the registration within the prescribed period and in the prescribed manner.

(3) An interested party may give notice of opposition to the Registrar on the grounds that section 1 or one or more of the requirements of section 4 has or have not been complied with.

(4) The Registrar shall send the notice of opposition to the applicant and the applicant shall send the Registrar in the prescribed manner within the prescribed period a counter-statement of the grounds on which the applicant relies.

(5) If the applicant fails to respond to the notice of opposition the applicant shall be deemed to have abandoned the application.

(6) The Registrar shall send a copy of the counter-statement to the person who filed the notice of opposition and shall decide whether the trademark should be registered after hearing the parties.

(7) The applicant has the same privileges and rights when an application is published and until the registration of the trademark, as the applicant would have if the trademark had been registered

(8) It is a valid defence to an action in respect of an act done after the application was published, if the alleged infringer establishes that the trademark could not validly have been registered at the time the act was done.

## **7. Registration certificate**

The Registrar shall register the trademark, publish a reference to the registration and issue the applicant with a certificate of registration if

- (a) the registration has not been opposed within the prescribed time limit, or
- (b) the registration has been opposed but the opposition was decided in favour of the applicant.

## **8. Application for registration of collective mark**

(1) An application for registration of a collective mark shall designate the trademark as a collective mark and shall be accompanied with a copy of the regulations governing the use of the collective mark.

(2) Sections 4, 5, 6, 7, 9, 10, 11 and 14 shall apply to collective marks.

(3) The registered owner of a collective mark shall notify the Registrar of the changes made in the regulations.

## **9. Rights conferred by registration**

(1) A person other than a registered owner of a trademark shall not use the mark in relation to goods or services for which the trademark was registered without the agreement of the owner.

(2) The registered owner may institute court action against a person who infringes a registered trademark by

- (a) using a registered mark without permission, or
- (b) performing acts which make it likely that infringement may occur.

(3) A person shall not knowingly infringe the rights of the owner of a registered trademark by using a trademark in relation to goods or services for which the trademark was registered without the consent of the owner.

(4) The right of the registered owner under this section shall, in addition to any other remedies, extend to the use of a sign similar to the registered trademark and use in relation to goods or services similar to those for which the mark has been registered where confusion may arise in the public.

(5) Where there is use of an identical sign for identical goods or services, a likelihood of confusion shall be presumed.

(6) The rights conferred by registration of a mark shall not extend to acts in respect of articles which have been put on the market in any country by the registered owner or with the consent of the owner.

(7) Section 5 (f) shall apply with the modifications that are required in an action instituted by the owner of a well-known trademark against a person in respect of the unlawful use of the well-known trademark.

(8) A person who infringes the right of a registered owner of a trademark by knowingly using a trademark for goods or services without the consent of the registered owner commits an offence and is liable on summary conviction to a fine not exceeding two hundred and fifty penalty units or to a term of imprisonment not exceeding one year or to both the fine and the imprisonment.

#### **10. Term of protection of trademark**

The registration of a trademark is for a period of ten years from the filing date of the application for registration.

#### **11. Renewal of trademark**

(1) The registration of a trademark may be renewed for consecutive periods of ten years on payment of the fee prescribed for renewal.

(2) A grace period of six months is allowed for the late payment of the renewal fee on payment of the prescribed surcharge.

#### **12. Invalidation of mark**

(1) The High Court shall invalidate the registration of a trademark if the person requesting the invalidation proves that section 1 or a requirement of section 4 has not been complied with.

(2) The Court may invalidate the registration of a trademark if because of an act or inactivity of the owner, it has become the common name in the trade for goods or services for which it is registered.

(3) The invalidation of the trademark is effective from the date of registration.

(4) The Registrar shall record the invalidation and publish the invalidation as soon as possible.

#### **13. Invalidation of collective mark**

The High Court shall invalidate the registration of a collective mark if the person requesting the invalidation proves that

- (a) only the registered owner uses the trademark to the exclusion of any other enterprises,
- (b) the registered owner permits the use of the trademark in contravention of the regulations of the collective mark, or

- (c) the registered owner uses or permits the use of the trademark in a manner likely to deceive trade circles or the public as to the origin or any other common characteristics of the goods or services concerned.

#### **14. Removal of trademark from register for non-use**

(1) A person interested in a trademark may request the Registrar to remove a trademark from the register because up to one month prior to filing for removal, the trademark had not been used by the registered owner or a licensee for any of the goods or services in respect of which it was registered for a continuous period of five years or longer.

(2) The trademark shall not be removed from the register if it is shown that special circumstances prevented the use of the trademark and that there was no intention to abandon the trademark in respect of those goods or services.

#### **15. Change in ownership**

(1) A change in the ownership of a trademark or of an application for registration of a trademark shall be in writing and shall be filed with the Registrar.

(2) A change in the ownership of a collective mark or of an application for the registration of a collective mark shall be in writing and shall be filed with the Registrar.

(3) The change shall be recorded and published by the Registrar.

(4) A third party shall not be affected by a change of ownership of a trademark or collective mark until the change of ownership has been filed with the Registrar.

(5) A change in the ownership of the registration of a trademark or a collective mark shall not be valid if it is likely to deceive or cause confusion with regard to the nature, origin, manufacturing process, characteristics or suitability for the purpose of the goods or services to which the trademark or collective mark is applied.

(6) A change in the ownership of a trade name shall be in writing addressed to the Registrar when an enterprise is being transferred or when part of the enterprise identified by that name is being transferred.

#### **16. Licence contract**

(1) A licence contract concerning the registration of a trademark or an application for registration shall be submitted to the Registrar who shall keep its contents confidential but shall record it and publish a reference to it.

(2) A licence contract is not valid against third parties until it has been filed with the Registrar.

#### **17. Agency**

If the ordinary residence or principal place of business of an applicant under this Act is outside the country, the applicant shall be represented by a legal practitioner resident and practising in the country.

*Trademark Registry***18. Trademark registry**

(1) There shall be a trademark registry which shall be located at the Registrar-General's Department.

(2) The registry is responsible for the registration of trademarks and for the administration of registered marks.

(3) The registry shall be headed by the Registrar-General who shall be assisted by the Assistant Registrars appointed in accordance with article 195 of the Constitution.

(4) The Registrar may delegate a function of the office of the Registrar to an Assistant Registrar.

**19. Register of marks**

(1) There shall be a register of trademarks.

(2) Collective marks shall be registered in a special section of the register of trademarks.

(3) There shall be recorded in the register entries required under this Act.

(4) The register of trademarks shall be open to the public and a person may obtain an extract from the register in accordance with this Act.

**20. Rectification or correction of register**

(1) A person aggrieved by the non-insertion, omission, error or a defect in an entry in the register or by an entry that wrongly remains on the register may apply to the Registrar to make, expunge or vary the entry, but an application for rectification may not be made for a matter that affects the validity of the registration of the trademark.

(2) Where court proceedings have commenced concerning the trademark, the application for rectification of the register shall be made to the High Court.

(3) Where an application for rectification is made to the Registrar, the Registrar may refer the application to the High Court at any stage during the proceedings before the Registrar.

(4) Where there is fraud in the registration, assignment or transmission of a registered trademark, the Registrar may apply to the High Court for rectification.

(5) A rectification order from the High Court shall direct that notice of the rectification be served in the prescribed manner on the Registrar who shall comply with the notice.

(6) A registered owner or a person authorised by the owner may apply to the Registrar

- (a) to correct an error or enter a change in the name, address or description of the registered owner of a trademark in the register;
- (b) to cancel the entry of a trademark in the register;



- (c) to strike out goods or classes of goods from those in respect of which a mark is registered; or
- (d) to enter a disclaimer or memorandum relating to a trademark which does not extend the rights given by the existing registration of the mark.

(7) A licensee of a trademark may correct an error or enter a change in the name, address or description of the registered owner with the consent of the owner.

## 21. Publication

The Registrar shall publish in the *Gazette*, or in an official Bulletin, and any print media a publication required under this Act.

## 22. Corrections of errors and extension of time

- (1) The Registrar may correct an error or a mistake in
  - (a) an application or document filed with the Registry, and
  - (b) an entry made under this Act.

(2) The Registrar may extend the time for doing an act or taking a proceeding under this Act on notice to the parties concerned and on the terms directed by the Registrar.

### *Trade Description and Fraudulent Marks*

## 23. Trade description and fraudulent marks

(1) A trade description is a description, statement or any other indication direct or indirect,

- (a) as to the number, quantity, measure, gauge, or weight of goods; or
- (b) as to the standard of quality of goods, according to a classification commonly used or recognised in the trade; or
- (c) as to the fitness for purposes, strength, performance or behaviour of goods; or
- (d) as to the place or country in which goods were made or produced; or
- (e) as to the mode of manufacturing or producing goods; or
- (f) as to the material of which goods are composed; or
- (g) as to goods the subject of an existing patent, privilege, or copyright;

and the use of a figure, word, or mark which, according to the custom of the trade, is commonly taken to be an indication of any of the matters referred to in paragraphs (a) to (g) shall be deemed to be a trade description within the meaning of this Act.

(2) A description is false if

- (a) it is likely to be misunderstood as, or mistaken for, an indication as to the same or some other matter which would be false or misleading in a material respect with respect to the goods to which the description is applied; and

- (b) anything likely to be misunderstood as, or mistaken for, an indication of any of those matters is for those purposes a trade description and includes an alteration of a trade description whether by addition, effacement or otherwise where that alteration makes the description false or misleading in a material respect; and
- (c) the fact that a trade description is a trademark or part of a trademark shall not prevent the trade description from being a false trade description.

(3) The provisions of this Act with respect to the application of a false trade description to goods extend to the application to goods of figures, words, or marks, or arrangement or a combination of any of them, whether including a trademark or not, as are reasonably likely to lead persons to believe that the goods are the manufacture or merchandise of a person other than the person whose manufacture or merchandise they really are.

(4) The provisions of this Act with respect to the application of a false trade description to goods, or with respect to goods to which a false trade description is applied, extend to the application to goods of a false name or the initials of a person, and to goods with the false name or initials of a person applied, in the same way as if the name or initials were a trade description.

(5) In subsection (4), the expression “**false name or initials**” means, as applied to goods,

- (a) a name which is or the initials which are not a trademark or part mark but is or are identical with or a colourable imitation of the name or initials of a person carrying on business in connection with goods of the same description, and not having authorised the use of the name or initials, and
- (b) a name which is or the initials which are those of a fictitious person or of a person not in good faith carrying on business in connection with those goods.

#### **24. Application of mark and descriptions**

(1) A person applies a trademark, mark or trade description to goods if that person,

- (a) applies the trademark, mark or trade description to goods directly or causes the trademark, mark or trade description to be applied to goods; or
- (b) applies it to a covering label, reel, or any other thing in which the goods are sold or exposed or had in possession for the purpose of sale, trade, or manufacture; or
- (c) places, encloses, or annexes goods which are sold or exposed or had in possession for the purpose of sale, trade, or manufacture, in, with, or to a covering, label, reel, or any other thing to which a trademark or trade description has been applied; or
- (d) uses a trademark or trade description in a manner likely to lead to the belief that the goods in connection with which it is used are designed or described by that trademark or mark or trade description.

(2) A trademark or mark or trade description is applied whether it is woven, impressed or otherwise worked into, or annexed or affixed to the goods or to a covering, label, reel or any other thing.

(3) Goods delivered in pursuance of a request made by reference to a trademark or trade description appearing in an advertisement, invoice, a sign, list, business letter, business paper or any other commercial communication, are, for the purposes of paragraph (d) of subsection (1), goods in connection with which the trademark or trade description is used.

(4) The particulars on the customs entry relating to imported goods are, for the purposes of this Act, a trade description applying to the goods.

(5) A person falsely applies a trademark or mark to goods if without the consent of the owner of a trademark the trademark or mark applied resembles the original as to be likely to deceive; but in a prosecution for falsely applying a trademark or mark to goods the burden of proving the assent of the owner is on the defendant.

(6) In this section,

“**covering**” includes a stopper, cork, bottle, vessel, box, cover, capsule, case, frame or wrapper;

“**label**” includes a band or ticket.

## **25. Forging a trademark**

(1) A person forges a trademark if that person

- (a) without the consent of the owner of the trademark makes that trademark or a mark so nearly resembling that trademark as to be likely to deceive, or
- (b) falsifies a genuine trademark, whether by alteration, addition, effacement, or otherwise,

and a trademark or mark so made or falsified is in this Act referred to as a “forged trademark”.

(2) In a prosecution for forging a trademark, the burden of proving the consent of the owner lies on the defendant.

## **26. Offences relating to trademarks and trade descriptions**

(1) A person shall not

- (a) apply a false trade description to goods; or
- (b) falsely apply to goods a trademark or mark so nearly resembling a trademark as to be likely to deceive; or
- (c) forge a trademark; or
- (d) use an article or instrument to forge a trademark; or
- (e) possess an article to forge a trademark; or
- (f) cause the infringement of a mark under this subsection.

(2) A person shall not sell or expose or possess for sale or for any purpose of trade or manufacture goods or things

- (a) to which a forged trademark or false trade description is applied, or

- (b) to which a trademark or a mark so nearly resembling a trademark as to be likely to deceive is applied.

(3) A person who contravenes subsection (1) and (2) commits an offence and is liable on summary conviction to a fine not exceeding five hundred penalty units or to a term of imprisonment not exceeding two years or to both the fine and the imprisonment.

(4) Where a person is convicted of an offence under this section the goods and things of any kind by means of or in relation to which the offence is committed are liable, at the discretion of the Court, to be forfeited to the Republic.

## 27. Defences

(1) Where a person is charged with an offence under subsection (1) of section 26, it is a good defence if that person proves that the act was done without the intent to defraud.

(2) Where a person is charged with an offence under paragraph (a), (b) or (d) of subsection (1) of section 26, or under paragraph (f) of that subsection, it is a good defence if that person proves

- (a) that being in the business of making articles or other instruments to make trademarks, that person applied marks or descriptions to goods and was not interested in the goods for profit or commission dependent on the sale of the goods; and
- (b) that reasonable precautions were taken against committing the offence charged; and
- (c) that at the time of the commission of the alleged offence, there was no reason, as an employee, to doubt the genuineness of the trademark, mark, or trade description; and
- (d) that the police officer was given the relevant information with respect to the persons on whose behalf the trademark, mark, or description was applied.

(3) Where a person is charged with an offence under subsection (2) of section 26, it is good defence for that person to prove

- (a) that having taken reasonable precautions against committing an offence against this Act, that person, did not at the time of the commission of the alleged offence have a reason to doubt the genuineness of the trademark, mark or trade description and that on demand made by or on behalf of the police officer, gave the information that was required with respect to the persons from whom the goods or things were obtained, or
- (b) that otherwise that person had acted innocently.

## 28. Informant to give notice to Commissioner

(1) An informant shall

- (a) give the Commissioner notice in writing which shall stipulate
  - (i) the number of packages expected,
  - (ii) a description of the goods by marks or any other particulars sufficient for identification,

- (iii) details of the means of conveyance and expected date of arrival of the goods in the country,
  - (iv) the reasons for which the detention is requested, and
  - (v) any other information the Commissioner may require; and
- (b) deposit with the Commissioner the sum of money that the Commissioner may require to cover expenses which may be incurred in the examination of goods.
- (2) The Commissioner may require security from the informant to recover expenses, charges, costs and damages incurred in respect of the detention and subsequent proceedings.
- (3) On failure to provide the security permits, the Commissioner may refuse to detain the goods.
- (4) This section applies to transhipped goods and goods in transit.
- (5) The notice shall be in the form set out in the Second Schedule.
- (6) An informant is a person other than a customs officer who has information about an offence committed under this Act.

### **29. Proof of place of origin**

In a prosecution for an offence under this Act where goods are imported, evidence of the port of shipment is prima facie evidence of the place of origin of the goods.

### **30. Limitation of prosecutions**

A prosecution for an offence against this Act shall not be commenced after the expiration of three years from the commission of the offence, or one year after the first discovery of the commission, by the prosecutor, whichever occurs first.

### **31. Implied warranty on sale or marked goods**

On the sale or in the contract for the sale of goods to which a trademark or mark or trade description has been applied, the seller warrants that the mark is a genuine trademark and not forged or falsely applied and that the trade description is not a false trade description within the meaning of this Act, unless the contrary is expressed in a writing signed by or on behalf of the seller and delivered at the time of the sale or contract to and accepted by the purchaser.

### **32. Forfeiture of unclaimed goods and powers of Commissioner**

The Customs, Excise and Preventive Service (Management) Act, 1993<sup>2</sup> applies to this with respect to the procedure for processing unclaimed goods and the power of the Commissioner in relation to imported goods not properly marked.

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2. P.N.D.C.L 330.

**33. Definition**

For the purposes of sections 28, and 32,

“**Commissioner**” means Commissioner of the Customs, Excise and Preventive Service.

*Functions of Registrar and Legal Proceedings***34. Power of Registrar to award costs**

(1) The Registrar may award costs and direct how and by which of the parties they are to be paid in proceedings under this Act.

(2) The order for costs may, by leave of the Court, be enforced in the same manner as a judgment or order of the Court.

**35. Registration to be prima facie evidence of validity**

In legal proceedings relating to a registered trademark including applications under section 20, the fact that a person is registered as owner of the trademark is prima facie evidence of the validity of the original registration of the trademark and of subsequent assignments and transmission of the trademark.

**36. Certificate of validity**

(1) Where there is an issue about the validity of the registration of a registered trademark in legal proceedings, the High Court may certify validity in favour of the owner.

(2) In subsequent legal proceedings where validity is an issue, the owner of the trademark is entitled to costs, charges and expenses between legal practitioner and client on obtaining a final order or judgment unless the High Court certifies otherwise.

**37. Costs of the Registrar in court proceedings**

In proceedings before the High Court under this Act, the Registrar shall not be awarded costs or ordered to pay the costs of any other party.

**38. Registrar’s appearance in proceedings**

(1) The Registrar shall be a party to proceedings by the plaintiff, appellant or applicant in which the relief sought would affect the register and the Registrar shall appear and be heard.

(2) The High Court may direct the Registrar to appear in legal proceedings before the Court.

(3) The Registrar instead of appearing in the Court may submit a signed statement giving particulars of the proceedings in relation to the matter in issue and a decision given affecting the matter and the statement shall form part of the evidence in the proceeding.

**39. Appeal to the High Court**

An order or decision of the Registrar is subject to appeal.

**40. Procedure in cases of option to apply to court or Registrar**

Where an applicant has an option to make an application to the High Court or to the Registrar,

- (a) the application shall be made to the High Court if an action concerning the trademark in question is before the Court, or
- (b) *where the application is made to the Registrar, the Registrar may refer the application to the High Court at any stage of the proceedings or may determine the question.*

**41. Evidence in proceedings before Registrar**

(1) Evidence shall be given by statutory declaration in proceedings before the Registrar.

(2) Despite subsection (1) the Registrar may take evidence on oath instead of or in addition to a statutory declaration.

(3) The Registrar shall have the same powers to require the attendance of a witness, the production of a document and the taking of evidence on oath as the High Court.

(4) A witness before the Registrar is entitled to the same immunities and privileges as if appearing as a witness before the High Court and may be awarded the same allowances as a witness.

(5) A summons under this section for the attendance of a witness to give evidence or for the production of a document shall be signed by the Registrar.

(6) If a person

- (a) defaults to attend as a witness when summoned by the Registrar, or
- (b) refuses to take an oath, fails to produce a document or to answer a question required by the Registrar, or
- (c) does any other thing which would amount to contempt of court,

the Registrar may certify the offence of that person under official seal to the High Court and the Court may take the measures that are necessary as if that person is in contempt of Court.

**42. Evidence of entries in register**

(1) A copy of an entry in the register, purporting to be certified and sealed with the official seal of the Registrar is admissible in evidence in a court of competent jurisdiction without further proof or production of the original.

(2) A person may obtain a certified copy of an entry in the register from the Registrar on payment of the prescribed fee.

**43. Evidence of things done by Registrar**

A certificate purporting to be under the official seal of the Registrar is evidence of the action taken by the Registrar.

*Miscellaneous Provisions***44. Falsification of entries in register**

A person who knowingly makes or causes a false entry to be made in the register commits an offence and is liable on summary conviction to a fine not exceeding five hundred penalty units or to a term of imprisonment not exceeding one year or to both the fine and the imprisonment.

**45. Offence of falsely representing a trademark as registered**

(1) A person who makes a false representation

- (a) that a trademark is a registered trademark, or
- (b) that a part of a registered trademark is separately registered as a trademark, or
- (c) that a registered trademark is registered in respect of specific goods, or
- (d) that the registration of a trademark gives an exclusive right to its use taking into account the limitations entered on the register,

commits an offence and is liable on summary conviction to a fine not exceeding two hundred and fifty penalty units or to a term of imprisonment not exceeding six months or to both the fine and the imprisonment and, in the case of a continuing offence, a further fine not exceeding twenty five penalty units for each day during which the offence continues.

(2) For the purposes of this section, the use in the country in relation to a trademark of the word “**registered**”, or of any other word or of a symbol referring whether expressly or impliedly to registration, imports a reference to registration in the register, except

- (a) where that word or that symbol is used in physical association with words delineated in characters at least as large as those in which that word or that symbol is delineated and indicating that the reference is to registration as a mark under the law of a place outside the country, where the registration referred to is in force, or
- (b) where that word is a word other than the word “registered” or that symbol itself indicates that the reference is to the registration as described in paragraph (a), or
- (c) where that word or that symbol is used in relation to a trademark registered as a trademark under the law of a place outside the country and in relation to goods to be exported to that place.

**46. Penalty for unlawful user of official badges**

(1) Without limiting the provisions of the Flags and Arms Protection Act, 1959 (No. 61), a person shall not without lawful authority use a badge, seal, device, an emblem or a flag reserved by law for the use of the Republic, the President, a Minister of State, the Armed Forces, a Ministry, Department or Agency, a public officer or a member of the Armed Forces in a manner that leads or is likely to lead to the belief that that person is authorised to use that badge, seal, device, emblem or flag.



(2) Subsection (1) applies to the use of a badge, seal, device, an emblem or a flag closely resembling the badge, seal, device, emblem or flag referred to in that subsection which is likely to deceive.

(3) A person who contravenes subsection (1) commits an offence and is liable on summary conviction to a fine not exceeding two hundred and fifty penalty units or to a term of imprisonment not exceeding six months or to both the fine and the imprisonment, and, in the case of a continuing offence, to a further fine not exceeding twenty-five penalty units for each day during which the offence continues or to a term of imprisonment not exceeding three months instead of the fine.

#### **47. Possible cause of deception**

(1) Where in the course of trade a form of connection subsists between goods and the person who has registered a trademark in respect of the goods, the trademark shall not be deemed to be likely to cause deception or confusion.

(2) Subsection (1) operates on the ground that the trademark has been or is used between the goods and the person using the trademark or a predecessor of that person whether or not a different form of connection in the course of trade subsisted or subsists.

#### **48. Jointly owned trademarks**

(1) Where the relations between two or more persons jointly interested in a trademark do not permit the use of the trademark by one of them except

- (a) on behalf of both or all of them, or
- (b) in relation to an article with which both or all of them are connected in the course of trade,

those persons may be registered as joint owners of the trademark and this Act shall apply as if those rights had been vested in a single person but the rights of a person registered as a joint owner is infringed by any of the other owners who uses the trademark in physical or any other relation to goods in respect of which the trademark is registered under this section where both or all of the joint owners are not and have not been connected in the course of trade.

(2) Subject to subsection (1), this Act does not authorise the registration of two or more persons who use a trademark independently or propose to use it independently to be registered as joint owners.

#### **49. Trusts and equities**

(1) A notice shall not be entered in the register of a trust express, implied or constructive and the Registrar shall not receive notice of a trust.

(2) Equities in respect of a trademark may be enforced in the same manner as any other movable property.

**50. Offences by bodies of persons**

Where an offence under sections 9, 45, 46 or 47 is committed by a body of persons

- (a) in the case of a body corporate other than a partnership, every director, manager, secretary or an officer of similar status of that body corporate shall be deemed to have committed that offence; and
- (b) in the case of a partnership, every partner or officer of similar status shall be deemed to have committed that offence.

**51. Regulations**

(1) The Minister may, by legislative instrument, make Regulations for carrying into effect the provisions of this Act and in particular

- (a) for the classification of goods and services for the purposes of registration of trademarks;
- (b) for making or requiring duplicates of trademarks and any other documents;
- (c) to secure and regulate the publication of trademarks and any other documents;
- (d) to prescribe the fees to be paid for applications and registrations and other matters and the mode of payment of those fees;
- (e) to prescribe period for doing specific things under the Act;
- (f) to prescribe the forms that are necessary for any of the purposes of this Act;
- (g) to regulate the business of the Registrar's office in relation to trademarks and any other things placed under the direction or control of the Registrar; and
- (h) to provide for a matter required or authorised to be prescribed the by Regulations.

(2) The Minister responsible for trade may make Regulations on the importation of goods with fraudulent marks.

**52. Interpretation**

In this Act, unless the context otherwise requires,

“**functions**” includes powers and duties;

“**goods**” means anything which is the subject of trade, manufacture or merchandise;

“**International Classification**” means the classification according to the Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of June 15th, 1957 as last revised;

“**manufacturer**”, “**dealer**”, “**trader**” and “**owner**” includes a body of persons corporate or unincorporated;

“**mark**” means a trademark;

“**Minister**” means the Minister responsible for Justice;

“**name**” includes abbreviation of a name;

“**Paris Convention**” means the Paris Convention for the Protection of Industrial Property of March 20th, 1883 as last revised;

“**prescribed**” means prescribed in or by the Regulations made under this Act;

“**priority date**” means the date of the earlier application that serves as the basis for the right of priority provided for in the Paris Convention;

“**Registrar**” means Registrar-General;

“**Regulations**” means Regulations made under this Act;

“**trade name**” means a name or designation which identifies and distinguishes an enterprise.

### 53. Repeal and savings

(1) The Trademarks Act, 1965 (Act 270) is hereby repealed.

(2) The Merchandise Marks Act, 1964 (Act 253) is hereby repealed.

(3) Despite the repeal of Act 270, a mark registered under Part A and B of the register under that Act shall remain in force subject to section 3 and shall be deemed to have been registered under this Act.

(4) Marks registered under Act 270 shall be due for renewal for a period of fourteen years from the date of expiration of the original registration or of the last renewal of registration and on renewal shall be reclassified in accordance with the International Classification.

(5) Despite the repeal under subsection (1) any Regulations made under Act 270 and in force immediately before the coming into force of this Act shall continue in force as if made under the corresponding provisions of this Act until revoked.

(6) The Merchandise Marks (Prohibited Goods) Regulations, 1936 (Regulations No. 33 of 1936) are hereby revoked.

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## SCHEDULES

### FIRST SCHEDULE

[Section 4 (3)]

#### *Article 4*

*Paris Convention (1967)*

[A to F and H: (Patents, Utility Models, Industrial Designs, Marks, Investors' Certificates:  
Right of Priority)

G: Patents, Division of the Application]

*Article 4—continued*

**A.—**(1) Any person who has duly filed an application for a patent, or for the registration of a utility model, or of an industrial design, or of a trademark, in one of the countries of the Union, or his successor in title, shall enjoy, for the purpose of filing in the other countries, a right of priority during the periods hereinafter fixed.

(2) Any filing that is equivalent to a regular national filing under the domestic legislation of any country of the Union or under bilateral or multilateral treaties concluded between countries of the Union shall be recognized as giving rise to the right of priority.

(3) By a regular national filing is meant any filing that is adequate to establish the date on which the application was filed in the country concerned, whatever may be subsequent fate of the application.

**B.—**Consequently, any subsequent filing in any of the other countries of the Union before the expiration of the periods referred to above shall not be invalidated by reason of any acts accomplished in the interval, in particular, another filing, the publication or exploitation of the invention, the putting on sale of copies of the design, or the use of the mark, and such acts cannot give rise to any third-party right or any right of personal possession. Rights acquired by third parties before the date of the first application that serves as the basis of the right of priority are reserved in accordance with the domestic legislation of each country of the Union.

**C.—**(1) The periods of priority referred to above shall be twelve months for patents and utility models, and six months for industrial designs and trademarks.

(2) These periods shall start from the date of filing of the first application; the day of filing shall not be included in the period.

(3) If the last day of the period is an official holiday, or a day when the office is not open for the filing of applications in the country where protection is claimed, the period shall be extended until the first following working day.

(4) A subsequent application concerning the same object as a previous first application within the meaning of paragraph (2), above, filed in the same country of the Union, shall be considered as the first application, of which the filing date shall be the starting point of the period of priority, if, at the time of filing the subsequent application, the said previous application has been withdrawn, abandoned, or refused, without having been laid open to public inspection and without leaving any rights outstanding, and if it has not yet served as a basis for claiming a right of priority. The previous application may not thereafter serve as a basis for claiming a right of priority.

**D.—**(1) Any person desiring to take advantage of the priority of a previous filing shall be required to make a declaration indicating the date of such filing and the country in which it was made. Each country shall determine the latest date on which such declaration must be made.

(2) These particulars shall be mentioned in the publications issued by the competent authority, and in particular in the patents and the specifications relating thereto.

(3) The countries of the Union may require any person making a declaration of priority to produce a copy of the application (description, drawings, etc.) previously filed. The copy, certified as correct by the authority which received such application, shall not require any authentication, and may in any case be filed, without fee, at any time within three months of the filing of the subsequent application. They may require it to be accompanied by a certificate from the same authority showing the date of filing, and by a translation.

*Article 4—continued*

(4) No other formalities may be required for the declaration of priority at the time of filing the application. Each country of the Union shall determine the consequences of failure to comply with the formalities prescribed by this Article, but such consequences shall in no case go beyond the loss of the right of priority.

(5) Subsequently, further proof may be required.

Any person who avails himself of the priority of a previous application shall be required to specify the number of that application; this number shall be published as provided for by paragraph (2), above.

**E.—**(1) Where an industrial design is filed in a country by virtue of a right of priority based on the filing of a utility model, the period of priority shall be the same as that fixed for industrial designs.

(2) Furthermore, it is permissible to file a utility model in a country by virtue of a right of priority based on the filing of a patent application, and vice versa.

**F.—**No country of the Union may refuse a priority or a patent application on the ground that the applicant claims multiple priorities, even if they originate in different countries, or on the ground that an application claiming one or more priorities contains one or more elements that were not included in the application or applications whose priority is claimed, provided that, in both cases, there is unity of invention within the meaning of the law of the country.

With respect to the elements not included in the application or applications whose priority is claimed, the filing of the subsequent application shall give rise to a right of priority under ordinary conditions.

**G.—**Priority may not be refused on the ground that certain elements of the invention for which priority is claimed do not appear among the claims formulated in the application in the country of origin, provided that the application documents as a whole specifically disclose such elements.

**H.—**(1) Applications for inventors' certificates filed in a country in which applicants have the right to apply at their own option either for a patent or for an inventor's certificate shall give rise to the right of priority provided for by this Article, under the same conditions and with the same effects as applications for patents.

(2) In a country in which applicants have the right to apply at their own option either for a patent or for an inventor's certificate, an applicant for an inventor's certificate shall, in accordance with the provisions of this Article relating to patent applicants, enjoy a right of priority based on an application for a patent, a utility model, or an inventor's certificate.

