

TRADE MARKS ACT, 2004 (ACT 664)

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REPUBLIC OF GHANA

**THE SIX HUNDRED AND SIXTY-FOURTH
ACT
OF THE PARLIAMENT OF THE REPUBLIC OF GHANA
ENTITLED
TRADE MARKS ACT, 2004**

AN ACT to provide for the protection of trade marks and for related matters.

DATE OF ASSENT: 29th January, 2004.

BE IT ENACTED by Parliament as follows

PART I—REGISTRATION OF TRADE MARKS

Section 1—Meaning of Trade Mark.

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

Section 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 other enterprises.

Section 3—Registration of Trade Mark.

Registration of a trade mark by any person confers an exclusive right to the use of the trade mark on the person.

Section 4—Application for Registration.

(1) An application for the registration of a trade mark 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 trade mark and a list of the goods or services for which the registration of the trade mark 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 provide for in article 4 of the Paris Convention set out in Schedule 1

(a) in or for any state party to the Convention; or

(b) in or for any 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.

Section 5—Grounds for Refusal of Registration.

No trade mark shall be registered if,

(a) it is a trade name;

(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, 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 trade mark or trade name which is well known in the country for identical or similar goods or services of another enterprise, or the trade mark 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 trade mark will indicate a connection between those goods or services and the owner of the well known trade mark and the interests of the owner of the well known trade mark are likely to be damaged by the use of the trade mark;

(g) the trade mark is identical to a trade mark of another owner already on the register or identical to a trade mark 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 trade mark so closely that it is likely to deceive or cause confusion.

Section 6—Examination and Opposition to Registration of Trade Mark.

- (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 any 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 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 trade mark 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 trade mark as the applicant would have if the trade mark had been registered, it shall however be a valid defence to an action in respect of an act done after the application was published, if the alleged infringer establishes that the trade mark could not validly have been registered at the time the act was done.

Section 7—Registration Certificate

The Registrar shall register the trade mark, 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.

Section 8—Application for Registration of Collective Mark.

- (1) An application for registration of a collective mark shall designate the trade mark as a collective mark and 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 any changes made in the regulations.

Section 9—Rights Conferred by Registration.

- (1) A person other than a registered owner of a trade mark shall not use the mark in relation to any goods or services for which the trade mark was registered without the agreement of the owner.
- (2) The registered owner may institute court action against any person who infringes a registered trade mark by
 - (a) using a registered mark without permission; or
 - (b) performing acts which make it likely that infringement may occur.
- (3) No person shall knowingly infringe the rights of the owner of a registered trade mark by using a trade mark in relation to goods or services for which the trade mark 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 trade mark 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 such modification as may be required in any action instituted by the owner of a well-known trade mark against any person in respect of the unlawful use of the well-known trade mark.
- (8) A person who infringes the right of a registered owner of a trade mark by knowingly using a trade mark 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 250 penalty units or a term of imprisonment not exceeding one year or to both.

Section 10—Term of Protection of Trade Mark.

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

Section 11—Renewal of Trade Mark.

- (1) The registration of a trade mark may be renewed for consecutive periods of ten years upon payment of the fee prescribed for renewal.
- (2) A grace period of six months is allowed for the late payment of the renewal fee upon payment of the prescribed surcharge.

Section 12—Invalidation of Mark.

- (1) The High Court shall invalidate the registration of a trade mark if the person requesting the invalidation proves that section 1 or any requirement of section 4 has not been complied with.
- (2) The court may invalidate the registration of a trade mark if because of any act or inactivity of the owner, it has become the common name in the trade for goods or services for which it is registred.
- (3) The invalidation of the trade mark is effective from the date of registration.
- (4) The Registrar shall record the invalidation and publish the invalidation as soon as possible.

Section 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 trade mark to the exclusion of other enterprises;
- (b) the registered owner permits the use of the trade mark in contravention of the regulations of the collective mark; or
- (c) the registered owner uses or permits the use of the trade mark 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.

Section 14—Removal of Trade Mark from Register for Non-use.

- (1) A person interested in a trade mark may request the Registrar to remove a trade mark from the register because up to one month prior to filing for removal, the trade mark 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 trade mark shall not be removed from the register if it is shown that special circumstances prevented the use of the trade mark and that there was no intention to abandon the trade mark in respect of those goods or services.

Section 15—Change in Ownership.

- (1) (a) A change in the ownership of a trade mark or of an application for registration of a trade mark shall be in writing and shall be filed with the Registrar;
- (b) 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.
- (2) The change shall be recorded and published by the Registrar.
- (3) A third party shall not be affected by a change of ownership of a trade mark or collective mark until the change of ownership has been filed with the Registrar.
- (4) A change in the ownership of the registration of a trade mark 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 trade mark or collective mark is applied.

(5) 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.

Section 16—Licence Contract.

(1) A licence contract concerning the registration of a trade mark 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 shall not be valid against third parties until it has been filed with the Registrar.

Section 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.

PART II—TRADE MARK REGISTRY

Section 18—Trade Mark Registry.

(1) There shall be a Trade Mark Registry which shall be located at the Registrar-General's Department.

(2) The Registry shall be responsible for the registration of trade marks and for the administration of registered marks.

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

(4) The Registrar may delegate any functions of the office of the Registrar to an Assistant Registrar.

Section 19—Register of Marks.

(1) There shall be a register of trade marks.

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

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

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

Section 20—Rectification or Correction of Register.

(1) A person aggrieved by the non-insertion, omission, an error or 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 any matter that affects the validity of the registration of the trade mark.

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

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

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

(5) A rectification order from the 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 trade mark in the register;

(b) to cancel the entry of a trade mark in the register;

(c) to strike out any 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 trade mark which does not extend the rights given by the existing registration of the mark.

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

Section 21—Publication.

The Registrar shall cause to be published in the Gazette, or in an official Bulletin, and any print media any publication required under this Act.

Section 22—Corrections of Errors and Extension of Time.

(1) The Registrar may correct any error or 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 any act or taking any proceeding under this Act upon notice to the parties concerned and on such terms as the Registrar may direct.

PART III—TRADE DESCRIPTION AND FRAUDULENT MARKS

Section 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 any goods; or

(b) as to the standard of quality of any 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 any goods; or

(d) as to the place or country in which any goods were made or produced; or

(e) as to the mode of manufacturing or producing any goods; or

(f) as to the material of which any goods are composed; or

(g) as to any 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 trade mark or part of a trade mark 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 shall extend to the application to goods of any figures, words, or marks, or arrangement or a combination of any of them, whether including a trade mark 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, shall extend to the application to goods of any false name or 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) any name which is or initials which are not a trade mark 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) any name which is or initials which are either those of a fictitious person or of a person not in good faith carrying on business in connection with those goods.

Section 24—Application of Mark and Descriptions.

(1) A person applies a trade mark, mark or trade description to goods who

(a) applies the trade mark, mark or trade description to goods directly or causes the trade mark, mark or trade description to be applied to goods;

(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 any 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 trade mark or trade description has been applied;

(d) uses a trade mark or mark 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 trade mark or mark or trade description.

(2) A trade mark 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 trade mark or trade description appearing in an advertisement, invoice, 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 trade mark or trade description is used.

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

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

Section 25—Forging Trade Mark

(1) A person forges a trade mark who

(a) Without the consent of the owner of the trade mark makes that trade mark or mark so nearly resembling that trade mark as to be likely to deceive; or

(b) falsifies a genuine trade mark, whether by alteration, addition, effacement, or otherwise; and a trade mark or mark so made or falsified is in this Act referred to as a "forged trade mark".

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

Section 26—Offences Relating to Trade Marks and Trade Descriptions.

(1) No person shall

(a) apply a false trade description to goods; or

(b) falsely apply to goods a trade mark or mark so nearly resembling a trade mark as to be likely to deceive; or

(c) forge a trade mark; or

(d) use an article or instrument to forge a trade mark; or

(e) possess an article to forge a trade mark; or

(f) cause the infringement of a mark under this subsection.

(2) No person shall sell or expose for or possess for sale or for any purpose of trade or manufacture any goods or things

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

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

(3) Any person who contravenes subsection (1) and (2) commits an offence and is liable on summary conviction to a fine not exceeding 500 penalty units or to a term of imprisonment not exceeding two years or to both.

(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.

Section 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 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 trade marks, the 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;

(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 trade mark, mark, or trade description; and

(d) that the police officer was given the relevant information with respect to the persons on whose behalf the trade mark, 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 trade mark, 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.

Section 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 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.
 - (b) deposit with the Commissioner such sum of money as the Commissioner may require to cover expenses which may be incurred in the examination of goods under this Part.
- (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) Failure to provide the security permits the Commissioner to 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 Schedule 2.
- (6) An informant is a person other than a customs officer who has information about an offence committed under this Part.

Section 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 shall be prima facie evidence of the place of origin of the goods.

Section 30—Limitation of Prosecutions.

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

Section 31—Implied Warranty on Sale or Marked Goods.

On the sale or in the contract for the sale of any goods to which a trade mark or mark or trade description has been applied, the seller warrants that the mark is a genuine trade mark 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 some 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.

Section 32—Forfeiture of Unclaimed Goods and Powers of Commissioner.

The Customs, Excise and Preventive Service (Management) Law, 1993 (P.N.D.C.L. 330) applies to this Part with respect to the procedure for processing of unclaimed goods and the power of the Commissioner in relation to imported goods not properly marked.

Section 33—Definition.

In this Part unless the context otherwise requires,

"Commissioner" means Commissioner of the Customs, Excise and Preventive Service.

PART IV—PROVISIONS RELATING TO POWERS AND DUTIES OF REGISTRAR AND TO LEGAL PROCEEDINGS

Section 34—Power of Registrar to Award Costs.

- (1) The Registrar may award costs and direct how and by which 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.

Section 35—Registration to be prima facie Evidence of Validity.

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

Section 36—Certificate of Validity.

- (1) Where there is an issue about the validity of the registration of a registered trade mark in legal proceedings, the court may certify validity in favour of the owner.
- (2) In subsequent legal proceedings where validity is an issue, the owner of the trade mark is entitled to costs, charges and expenses between legal practitioner and client on obtaining a final order or judgment unless the court certifies otherwise.

Section 37—Costs of the Registrar in Court Proceedings.

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

Section 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 court may direct the Registrar to appear in any legal proceedings before the court.
- (3) The Registrar instead of appearing in court may submit a signed statement giving particulars of the proceedings in relation to the matter in issue and any decision given affecting the matter and the statement shall form part of the evidence in the proceeding.

Section 39—Appeal to the Court.

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

Section 40—Procedure in Cases of Option to Apply to Court or Registrar.

Where an applicant has an option to make an application either to the court or to the Registrar

- (a) the application shall be made to the court if an action concerning the trade mark in question is before the Court; or

(b) Where the application is made to the Registrar, the Registrar may refer the application to the court at any stage of the proceedings or may determine the question.

Section 41—Mode of Taking Evidence in Proceedings before Registrar.

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

(2) Notwithstanding 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 a court.

(4) A witness before the Registrar is entitled to the same immunities and privileges as if appearing as a witness before the 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 any 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 any 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 court and the court may take such measure as may be necessary as if the person is in contempt of court.

Section 42—Evidence of Entries in Register.

(1) a copy of any entry in the register, purporting to be certified and sealed with the official seal of the Registrar shall be admissible in evidence in a court 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.

Section 43—Evidence of Things Done by Registrar.

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

PART V—MISCELLANEOUS PROVISIONS

Section 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 500 penalty units or to imprisonment for a term not exceeding one year or to both.

Section 45—Offence of Falsely Representing a Trade Mark as Registered.

(1) Any person who makes a false representation

- (a) that a trade mark is a registered trade mark; or
- (b) that a part of a registered trade mark is separately registered as a trade mark; or
- (c) that a registered trade mark is registered in respect of specific goods; or
- (d) that the registration of a trade mark 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 250 penalty units or to a term of imprisonment not exceeding six months or to both and, in the case of a continuing offence, a further fine not exceeding 25 penalty units for each day on which the offence continues.

(2) For the purposes of this section, the use in the country in relation to a trade mark of the word "registered", or of any other word or of a symbol referring whether expressly or impliedly to registration, shall be deemed to import 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;

(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 trade mark registered as a trade mark under the law of a place outside the country and in relation to goods to be exported to that place.

Section 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 any badge, seal, device, emblem or flag reserved by law for the use of the Republic, the President, a Minister of State, the Armed Forces, any Ministry, Department or Agency, any public officer or any member of the Armed Forces in such a manner as to lead to the belief that the person is authorised to use that badge, seal, device, emblem or flag.

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

(3) Any person who contravenes subsection (1) commits an offence and is liable on summary conviction to a fine not exceeding 250 penalty units or to a term of imprisonment not exceeding six months or to both and, in the case of a continuing offence, to a further fine not exceeding 25 penalty units for each day on which the offence continues or to imprisonment not exceeding three months instead of a fine.

Section 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 trade mark in respect of the goods, the trade mark shall not be deemed to be likely to cause deception or confusion.

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

Section 48—Jointly Owned Trade Marks.

(1) Where the relations between two or more persons jointly interested in a trade mark do not permit the use of the trade mark 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 trade mark and this Act shall apply as if those rights had been vested in a single person but the rights of any person registered as a joint owner shall be deemed to be infringed by any of the other owners who uses the trade mark in physical or other relation to goods in respect of which the trade mark 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 trade mark independently or propose to use it independently to be registered as joint owners.

Section 49—Trusts and Equities.

(1) No notice shall be entered in the register of any trust express, implied or constructive and the Registrar shall not receive notice of a trust.

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

Section 50—Offences by Bodies of Persons.

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

(a) and the body of persons is a body corporate other than a partnership, every director, manager, secretary or an officer of similar status of that body corporate shall also be deemed to be guilty of that offence, and

(b) in the case of a partnership, every partner or officer of similar status shall be deemed to be guilty of that offence.

Section 51—Regulations.

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 trade marks;

(b) for making or requiring duplicates of trade marks and other documents;

- (c) to secure and regulate the publication of trade marks and other documents;
 - (d) to prescribe the fees to be paid for applications and registration and other matters and the mode of payment of those fees;
 - (e) to prescribe periods for doing specific things under the Act;
 - (f) to prescribe such forms as may be necessary for any of the purposes of this Act;
 - (g) to regulate the business of the Registrar's office in relation to trade marks and any other things placed under the direction or control of the Registrar; and
 - (h) to provide for any matter required or authorised to be prescribed by regulations.
- (2) The Minister responsible for trade may make regulations on the importation of goods with fraudulent marks.

Section 52—Interpretation.

In this Act unless the context otherwise requires

"court" means the High Court;

"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 any body of persons corporate or unincorporated;

"mark" means a trade mark;

"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 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;

"trade name" means a name or designation which identifies and distinguishes an enterprise.

Section 53—Repeal and Savings.

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

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

(3) Notwithstanding 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 upon renewal shall be reclassified in accordance with the International Classification.

(5) Notwithstanding 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 32 1936 (Regulations No.33 of 1936) are hereby revoked.

SCHEDULE 1

Article 4

Paris Convention (1967)

(Section 4(3))

[A to I. Patents, Utility Models, Industrial Designs, Marks, Investors' Certificates: Right of Priority.—G. Patents: Division of the Application]

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 recognised 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.

(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 inventor's 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.

SCHEDULE 2

Section 28

FORM OF NOTICE

Notice of fraudulent mark under Part III

I

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of.....

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....

hereby request that the goods specified and about to be imported into the country be detained by the Commissioner of the Customs, Excise and Preventive Service.

Particulars

1. Number of packages.....

2. Description of goods.....

3. Name of ship and date of arrival.....

4. If importation not by ship any other manner of importation.....

5. Full particulars of the reasons for which detention is asked.....

Signed.....

Witness to Signature.....

Date.....

Date of Gazette Notification: 6th February, 2004.