
THE TRADE MARKS ACT, 2023

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SCHEDULE

GOVERNMENT OF ZAMBIA

ACT

No. 11 of 2023

Date of Assent: 22nd December, 2023

An Act to provide for the registration and protection of trade marks and geographical indications; provide for the rights conferred by the registration of trade marks and geographical indications; provide for the effects of registration of trade marks and geographical indications; provide for civil and criminal enforcement for infringement of registered trade marks and geographical indications; domesticate the Madrid Protocol relating to the International Registration of Marks, the Paris Convention for the Protection of Industrial Property and the World Trade Organisation Agreement on Trade-Related Aspects of Intellectual Property Rights, and any other relevant international treaty or convention to which the Republic is a State Party; repeal and replace the Trade Marks Act, 1958; and provide for matters connected with, or incidental to, the foregoing.

[26th December, 2023

ENACTED by the Parliament of Zambia.

Enactment

PART I

PRELIMINARY PROVISIONS

1. This Act may be cited as the Trade Marks Act, 2023, and shall come into operation on the date appointed by the Minister by statutory instrument.

Short title and commencement

2. In this Act, unless the context otherwise requires—

Interpretation

“Agency” means the Patents and Companies Registration Agency continued under the Patents and Companies Registration Agency Act, 2020;

Act No.4 of 2020

“applicant” means a person who makes an application under this Act;

Cap. 322

“assignee” means a person who derives title to a registered trade mark or geographical indication from a proprietor;

“assignment” means a transfer of rights and liabilities of a party in a registered trade mark or geographical indication made in accordance with this Act;

“associated trade mark” means a trade mark that is required to be registered as an associated trade mark in accordance with this Act;

“authorised officer” means an officer authorised by the Commissioner-General in accordance with the Customs and Excise Act;

“authorised user” means a person authorised to use a certification mark;

“certification mark” means a trade mark on a good or a service that indicates that, the use of that good or service is certified by a proprietor in respect of origin, material, mode of manufacture of a good or the performance of a service, quality, accuracy or other characteristics;

“collective association” means a body of persons, whether incorporated or not, that has, or is able to have, members and is established for the joint benefit of the members who can be ascertained;

“collective mark” means a trade mark used, or intended to be used, in relation to a good or service provided, in the course of trade, by members of a collective association to distinguish the good or service from a good or service provided by persons who are not members of the collective association;

“Commissioner-General” means the person appointed as Commissioner-General in accordance with the Zambia Revenue Authority Act;

Cap. 321

“competent authority” means a local authority, an agency, a department, ministry or person that has authority to perform a designated function;

“Convention country” means a country that is a State Party to the Paris Convention;

“counterfeit trade mark good” means a good which bears, without authorisation, a trade mark that is

identical or similar to the trade mark that is registered under this Act;

“Court” means the High Court established under the Constitution;

Cap. 1

“geographical indication” means—

- (a) the name of, or a reference to, a geographical area that indicates the specific geographical origin of a good where the quality, reputation or other characteristic of that good is essentially attributable to a geographical area where that good is produced, processed or prepared for sale; or
- (b) a word, phrase or symbol that has become essentially attributable to a geographical area where the good is produced, processed or prepared for sale as a result of long term and consistent use of that word, phrase or symbol;

“good in transit” means a good imported, whether or not landed or transhipped within the Republic, and intended to be carried to another country either by the same or another conveyance;

“infringing article” in relation to a registered trade mark means an article that—

- (a) is specifically designed or adapted for making a copy of a mark identical with or similar to a registered trade mark; or
- (b) a person has in that person’s possession, custody or control, knowing or having reason to believe that the article has been or is intended to be used to produce an infringing good or material;

“infringing good” in relation to a registered trade mark means a good, or the packaging of a good, which bears a mark that is identical with, or similar to, a registered trade mark and the—

- (a) application of the mark to a good or its packaging is an infringement of the registered trade mark; or

- (b) mark has been used in relation to a good, or its packaging, in a way that infringes a registered trade mark;

“infringing material” in relation to a registered trade mark means a material which bears a mark identical with, or similar to, a registered trade mark and the material is—

- (a) used for labelling or packaging a good, as a business paper, or for advertising a good or service, in a manner that infringes the registered trade mark; or
- (b) intended to be used in a manner that would infringe the registered trade mark;

“Intellectual Property Journal” means a journal published by the Agency periodically for purposes of advertising intellectual property applications and other matters required to be published for the purposes of this Act;

“International Bureau” means the International Bureau of the World Intellectual Property Organisation;

“International Non-Proprietary Name” means a name used and recommended by the World Health Organisation to identify a pharmaceutical substance of an active pharmaceutical ingredient;

“international registration” means the registration of a mark effected under the Madrid Protocol;

“legal practitioner” has the meaning assigned to the word “practitioner” in the Legal Practitioners Act;

“legal representative” means a—

- (a) liquidator of a company appointed in accordance with the Corporate Insolvency Act, 2017;
- (b) receiver for a company or other person appointed in accordance with the Corporate Insolvency Act, 2017;
- (c) person appointed under a power of attorney;

Cap. 30

Act No. 9 of
2017

Act No. 9 of
2017

(d) person recognised by law, representing a deceased or bankrupt person; or

(e) person recognised by law, representing a child or a legally disqualified person;

“legally disqualified” means the absence of legal capacity as provided under section 4 of the Mental Health Act, 2019;

Act No.6 of
2019

“licence agreement” means an agreement entered into between a proprietor and a person with permitted use of a registered trade mark which contains—

(a) particulars of the extent of control by the proprietor over the permitted use of the trade mark;

(b) details as to whether the licence shall be exclusive or non exclusive;

(c) proposed conditions or restrictions with respect to the characteristic of the good or service, the mode or place of permitted use or other matter; and

(d) the duration of the permitted use of the registered trade mark;

“licensee” means a person who is registered as a licensee in accordance with section 60;

“limitation” means a restriction to the exclusive right to use a registered trade mark or geographical indication, including a limitation of a right to the mode of use, use of a good to be sold or otherwise traded in, a service to be performed within the Republic or a good to be exported to any market outside the Republic;

“Madrid Protocol” means the Protocol relating to the Madrid Agreement concerning the international Registration of Marks adopted at Madrid on 27th June, 1989, and acceded to by Zambia on 15th August, 2001;

“mark” includes a device, brand, heading, label, ticket, name, signature, smell, sound, word, letter, numeral, shape of a good, packaging or combination of colours or any combination thereof;

- Cap.1 “national symbol” means a national symbol specified in the Constitution;
- “Paris Convention” means the Convention for the Protection of Industrial Property adopted in Paris on 20th March, 1883, and acceded to by Zambia on 14th February, 1977;
- “permitted use” means the use of a registered trade mark with the consent of a proprietor as specified under section 59;
- Cap.1 “person” has the meaning assigned to the word in the Constitution;
- “producer” means a person who—
- (a) produces an agricultural product;
 - (b) exploits a natural product; or
 - (c) manufactures a product of handicraft or industry;
- “proprietor” means, in relation to a—
- (a) registered trade mark, the person whose name appears in the Register as proprietor;
 - (b) registered collective mark, the collective association whose name appears in the Register as proprietor;
 - (c) registered certification mark, the person whose name appears in the Register as being responsible for certifying a good or service to which the certification mark relates;
 - (d) well known mark, a person entitled to protection under Article 6bis of the Paris Convention or Article 16 of the TRIPS Agreement; or
 - (e) registered geographical indication, a producer who is in an area where a certificate of registration has been issued for that geographical indication;
- “Register” means the Register of trade marks and geographical indication established and maintained in accordance with section 133;

“register of trade mark agents” means a register established and maintained under section 119;

“registered”, in relation to a trade mark or geographical indication, means registered under this Act;

“registered trade mark” means a trade mark that—

- (a) has been entered in the Register;
- (b) has a certificate of registration issued; and
- (c) is valid;

“Registrar” means the person appointed as Registrar under the Patents and Companies Registration Agency Act, 2020;

Act No.4 of
2020

“repealed Act” means the Trade Marks Act, 1958;

Cap.401

“respondent” means a person against whom infringement proceedings have been commenced under this Act;

“series of trade marks” means trade marks that resemble each other and differ on matters of non-distinctive character which do not substantially affect the identity of the trade marks;

“successor in title” means a person who derives title to a registered trade mark or geographical indication from a proprietor;

“trade mark” means a mark—

- (a) capable of being represented in the register in a manner that determines the clear and precise subject matter of protection; and
- (b) that distinguishes a good or service—
 - (i) of one person from an identical or similar good or service of another person; or
 - (ii) certified by a proprietor from an identical or similar good or service that has not been certified by that proprietor;

“trade mark agent” means a person registered as a trade mark agent under section 116;

“trade name” means a name or designation identifying and distinguishing an enterprise;

“transmission” means a transfer by operation of the law, devolution on the personal representative of a deceased person, or any other mode not being an assignment;

“TRIPS Agreement” means the Agreement on Trade Related Aspects of Intellectual Property Rights set out in annex 1C of the Marrakesh Agreement establishing the World Trade Organisation that entered into force on 1st January, 1995, and was acceded to by Zambia on 10th August, 2009; and

“well-known trade mark” means a trade mark that is well known in the Republic as being the trade mark of a person who is a national of a Convention country or domiciled in, or has a real and effective industrial or commercial establishment in the Convention country, whether or not the person carries on business in the Republic.

Application
and
administration
of Act

3. (1) This Act applies to a registered trade mark, geographical indication and a well-known trade mark.

(2) This Act shall be administered by the Agency.

PART II

APPLICATION FOR REGISTRATION OF TRADE MARKS

Application
for
registration
of trade mark

4. (1) Subject to subsection (2), a person who intends to register a trade mark in respect of a good or service shall apply to the Registrar in the prescribed manner and form on payment of the prescribed fee.

(2) A person is eligible to make an application under subsection (1), if that person—

(a) claims to be the owner of the trade mark; or

(b) is using or intends to use a trade mark in relation to the good or service referred to in subsection (1).

(3) A person may make a single application under subsection (1), for the registration of a trade mark for different classes of a good or service and the prescribed fee shall be payable in respect of each class of a good or service.

(4) Where an application for registration of a trade mark under subsection (1) is to be made by a person not resident in the Republic, that person shall appoint a trade mark agent domiciled in the Republic to apply for the registration of a trade mark.

(5) Despite subsection (1), a person resident in the Republic may appoint a trade mark agent domiciled in the Republic to apply for the registration of a trade mark.

(6) A trade mark agent appointed under subsection (4) or (5) shall file with the Registrar, an authorisation of agent in a prescribed manner and form on payment of a prescribed fee.

5. (1) Two or more persons may make a joint application for registration of a trade mark where—

(a) any of the persons is entitled to the use of the trade mark; or

(b) in relation to a good or service, those persons are connected in the course of trade.

(2) Subject to this Act, two or more applicants may be registered as joint proprietors.

(3) Joint proprietors of a trade mark have the right to use the trade mark as if the right is vested in one person.

6. (1) A person may apply to the Registrar for the registration of a series of trade marks in a prescribed manner and form on payment of a prescribed fee.

(2) The Registrar shall, for purposes of registration of a trade mark, consider a series application as a single application.

7. (1) An applicant shall complete the application for registration of a trade mark within twelve months from the date of filing the application with the Registrar.

(2) The Registrar may, three months before the expiry of the period under subsection (1), notify the applicant to complete the application for registration in the prescribed manner and form.

(3) The Registrar shall, where an applicant fails to comply with a notice under subsection (2), treat the application as abandoned.

(4) Despite subsection (3), the Registrar shall not treat an application for registration of a trade mark as abandoned, if that application—

Joint application

Series application

Period for completion of application for registration

- (a) has been opposed and is pending determination by the Registrar or the Court; or
- (b) is pending cancellation or other proceedings under this Act.

(5) The Registrar shall, where the Registrar or Court determines the matter under subsection (4) in favour of an applicant, notify the applicant in accordance with subsection (2).

Commencement of applicant's right

8. An applicant's right in relation to an application for registration of a trade mark shall commence from the date of filing of the application for registration of a trade mark with the Registrar.

Classification of good or service

9. The Registrar shall, for purposes of registration of a trade mark, determine the classification of a good or service, in accordance with international best practice.

Single application for multiple classes

10. The Registrar shall, where an application for the registration of a trade mark contains several classes of goods or services, treat that application as a single application for registration of the goods or services specified under that application.

Division of application

11. (1) An applicant may, before a trade mark is registered, apply to the Registrar for the division of an application for the registration of a trade mark in a prescribed manner and form on payment of a prescribed fee, where that application consists of—

- (a) a series of applications for the registration of a trade mark;
- (b) multiple classes within an application for the registration of a trade mark; or
- (c) specific goods or services within an application for the registration of a trade mark.

(2) The Registrar may grant or reject an application under subsection (1).

(3) The Registrar shall, where the Registrar rejects an application under subsection (2), inform the applicant, and give reasons for the rejection.

(4) The Registrar shall, where the Registrar grants an application under subsection (2), treat the part that is divided as—

- (a) independent of the original application for registration of a trade mark; and
- (b) having retained the filing date of the original application for registration of a trade mark.

12. The date of filing of an application for registration of a trade mark shall be the date on which the applicant complies with the requirements specified in section 4.

Filing date of application

13. Where two or more applications for registration of an identical or similar trade mark relating to an identical or similar good or service are filed with the Registrar by different applicants, the Registrar shall give priority to the application filed first.

Priority of application for registration of identical or similar trade mark

14. (1) A person who has duly filed an application for registration of a trade mark in a Convention country and has filed an application for registration of the same trade mark in the Republic may claim a right of priority within a period of six months from the date of filing of the application for registration of the trade mark in the Convention country.

Priority claim

(2) The Registrar shall, where an application for registration of a trade mark is made in the Republic under subsection (1), enter in the Register the date on which the application was filed in a Convention country as the date on which the application was filed.

(3) An applicant shall not claim a priority right on the basis of an application that was withdrawn, abandoned or rejected by a relevant authority in a Convention country.

(4) An applicant who intends to claim a right of priority shall make a declaration of priority, in a prescribed manner.

(5) The particulars of the declaration of priority under subsection (4) shall be published in the Intellectual Property Journal.

(6) A right of priority arising out of an application filed in a Convention country shall be submitted with an application filed in the Republic.

(7) A person who does not claim the right of priority within the period of six months referred to in subsection (1) shall lose that right of priority.

15. (1) The Registrar shall, on receipt of an application for registration of a trade mark, conduct a formality examination to determine whether the application for registration of a trade mark meets the requirements specified in section 4.

Formality examination of application

(2) The Registrar shall, where the Registrar conducts the formality examination under subsection (1), and is of the opinion that an application does not meet the requirements specified in section 4, request the applicant, in writing, to make the necessary amendments to the application.

(3) The amendment under subsection (2) shall be in the prescribed manner and form on payment of a prescribed fee.

(4) The Registrar shall, where an applicant does not make the necessary amendments after the request under subsection (2), treat the application as abandoned.

Substantive
examination
of
application

16. (1) The Registrar shall, where the Registrar is satisfied after a formality examination under section 15 that an application for registration of a trade mark meets the requirements specified in this Act, conduct a substantive examination to determine whether a mark is capable of being registered as a trade mark under this Act.

(2) The Registrar shall, on completion of the substantive examination under subsection (1), produce a report.

(3) The Registrar shall accept or reject the application for registration of a trade mark taking into consideration the report under subsection (2).

(4) Where the Registrar intends to reject the application for registration of a trade mark, the Registrar shall notify the applicant of the intention to reject the registration and require the applicant, within sixty days of the notification to—

(a) take remedial measures; or

(b) show cause why the application should not be rejected.

(5) The Registrar shall, where the Registrar rejects an application for registration of a trade mark under subsection (3), notify the applicant, in writing, of the Registrar's decision and give reasons for the rejection.

(6) The Registrar shall not reject an application for registration of a trade mark under this section where an applicant takes remedial measures to the satisfaction of the Registrar within the period specified in subsection (4).

(7) The Registrar shall, in making a final determination on an application for registration of a trade mark, consider the submissions made by an applicant under subsection (4).

(8) A person who is dissatisfied with the decision of the Registrar under this section may, within three months of receipt of the decision of the Registrar, appeal to the Court.

(9) The Registrar shall, where a notice of appeal is not filed in accordance with subsection (8), treat the application for registration of a trade mark as abandoned.

17. (1) An applicant shall, where the Registrar accepts an application for registration of a trade mark under this Act, publish the acceptance of the application in the Intellectual Property Journal within ninety days of receipt of the acceptance of the application, on payment of a prescribed fee.

Publication
of
acceptance
of
application

(2) The Registrar shall, where an applicant fails to publish the acceptance of an application for registration of a trade mark in accordance with subsection (1), treat the application for registration of a trade mark as abandoned.

(3) Despite subsection (2), an applicant may apply for the restoration of an application for the registration of a trade mark in a prescribed manner and form on payment of a prescribed fee.

(4) Where the Registrar restores an application for registration of a trade mark under subsection (3), that application shall retain the original date of filing.

(5) Despite subsection (3), the Registrar shall not accept an application for restoration of an application for registration of a trade mark where the—

- (a) period of twelve months specified in section 7 (1) has elapsed; or
- (b) application for restoration is made after nine months from the date of filing of the application.

18. (1) An applicant may, before the Registrar registers a trade mark, withdraw an application for registration of a trade mark or restrict a good or service covered by an application for registration of a trade mark in a prescribed manner and form on payment of a prescribed fee.

Withdrawal
of
application,
or restriction
of goods
or services
covered by
application
for
registration
of trade
mark

(2) The Registrar shall, where an applicant withdraws or restricts a good or service covered in the application for registration of a trade mark after the acceptance of the application for registration of a trade mark is published in accordance with section 17, publish the withdrawal or restriction in the Intellectual Property Journal.

19. (1) A person may, within sixty days of the date of publication of the acceptance of the application for registration of a trade mark in the Intellectual Property Journal under section 17, file with the Registrar a notice of opposition to the registration of a trade mark in a prescribed manner and form on payment of a prescribed fee.

Opposition
to
registration
of trade
mark

(2) The notice filed under subsection (1) shall be accompanied by evidence in support of the opposition to the registration of a trade mark in the prescribed manner.

(3) A person shall not file an opposition under subsection (1), unless that person has an interest or right in the trade mark which would be prejudiced if the trade mark is registered.

Grounds of
opposition

20. A person may oppose an application for registration of a trade mark on—

- (a) the grounds set out in sections 41 and 42; or
- (b) the ground that the application for registration of the trade mark was made in bad faith.

Counter
statement to
notice of
opposition

21. (1) An applicant who intends to respond to a notice of opposition to the application for registration of a trade mark under section 19 shall, within sixty days of receipt of the notice of opposition, file with the Registrar a counter statement in a prescribed manner and form on payment of a prescribed fee.

(2) The counter statement filed under subsection (1) shall be accompanied by evidence in support of the application in a prescribed manner.

(3) The Registrar shall, where an applicant fails to file a counter statement in accordance with subsection (1), treat the application for registration of a trade mark as abandoned.

Evidence in
reply of
application
for
registration
of trade
mark

22. A person who files a notice of opposition to an application for registration of a trademark under section 19 may, within thirty days of receipt of the counter statement, file with the Registrar evidence in reply.

Hearing

23. (1) The Registrar shall hear an application to oppose the registration of a trade mark filed under section 19 in a prescribed manner.

- (2) The Registrar may at the conclusion of the hearing—
- (a) refuse to register the trade mark; or
 - (b) register the trade mark with, or without, conditions in respect of a good or service specified in the application.

Dismissal of
notice
of
opposition

24. (1) The Registrar may dismiss an opposition to the application for registration of a trade mark without hearing an applicant where the Registrar considers that the opposition is frivolous, vexatious or lacks merit.

(2) The Registrar shall, where an opposition to an application for registration of a trade mark is dismissed under subsection (1), notify the applicant, in writing.

PART III

REGISTRATION OF TRADE MARKS

25. (1) The Registrar shall register a trade mark and issue a certificate of registration to an applicant where the Registrar is satisfied that—

Registration of trade mark

- (a) the application for registration of a trade mark meets the requirements under this Act;
- (b) the application for registration of a trade mark is not opposed; and
- (c) where an application for registration has been opposed, the opposition has been dismissed.

(2) Despite subsection (1), the Registrar shall not register and issue a certificate of registration unless the applicant has made a request for registration of a trademark in a prescribed manner and form on payment of a prescribed fee.

(3) The Registrar shall, when registering a trade mark—

- (a) enter in the Register the date of registration of the trademark in accordance with section 26; and
- (b) publish in the Intellectual Property Journal a reference to the registration.

(4) A certificate of registration issued under subsection (1) shall be *prima facie* evidence of any matter in respect of the registration of the trade mark.

26. The date of filing of an application for registration of a trade mark shall be considered as the date of registration of the trade mark.

Date of registration

27. (1) The Registrar may, where a trade mark contains a mark that is not separately registered by a proprietor as a trade mark, or a matter that is not common to a trade or business, or that mark is not distinctive in deciding whether a trade mark can be entered in the Register—

Disclaimer of part of trade mark

- (a) disclaim an exclusive right to the use of all or any portion of the matters that a proprietor is not entitled to; or
- (b) make any other disclaimer or statement that the Registrar considers necessary for the purpose of defining the proprietor's rights in relation to the registration.

(2) A disclaimer or statement made by the Registrar under subsection (1) shall be entered in the Register and shall restrict the rights of a proprietor.

Disclaimer on grounds of public interest

28. The Registrar may, in determining whether a trade mark can be registered, or remain on the Register, consider public interest as a condition of the trade mark being, or remaining, on the Register.

Registration of separate trade marks

29. (1) A person who claims to be entitled to the exclusive right to the use of a part of a trade mark may apply to the Registrar to register the whole, or part, of that trade mark, as a separate trade mark.

(2) Subject to subsection (1), each separate trade mark shall satisfy the requirements for registration of a trade mark under this Act.

Registration of series of trade marks

30. The Registrar may register a trade mark as a series in one registration where a person who seeks to register a trade mark claims to be the proprietor of several trade marks in respect of the same, or similar good or service, or description of a good or service, that resemble each other in a material particular, but differ in respect of—

- (a) statement of the good or service in relation to which the good or service is respectively used or proposed to be used;
- (b) statement of number, price, quality or name of place;
- (c) other matter of a non distinctive character that does not substantially affect the identity of the trade mark; or
- (d) colour.

Registration of trade mark as associated trade mark

31. (1) The Registrar may enter a trade mark in the Register as an associated trade mark with an earlier registered trade mark or application for registration of a trade mark where the trade mark is—

- (a) in the name of the same proprietor;
- (b) in respect of the same or similar good or service or description of a good or service; and
- (c) identical with, or similar to, another trade mark that is registered or is the subject of an application for registration of a trade mark and is likely to deceive or cause confusion when used by a person other than the proprietor.

(2) A trade mark shall, where the trade mark is registered as a separate trade mark in the name of the same proprietor in accordance with section 29, be registered as an associated trade mark.

(3) A trade mark that is registered as, or that is considered to be, an associated trade mark is assignable or transmissible collectively and not separately.

(4) The Registrar may, on an application made by a proprietor, and where the Registrar is satisfied that there is no likelihood of deception or confusion being caused if a trade mark is used by another person in relation to a good or service in respect of which that trade mark is registered, dissolve the association of trade marks and amend the Register accordingly.

(5) An application under subsection (4) shall be made in a prescribed manner and form on payment of a prescribed fee.

32. The Registrar shall not accept an application for registration of a trade mark that contains—

Non-
registrable
words

- (a) a word that suggests that the word is protected by another intellectual property right or a word in a language, or an abbreviation of that word to the like effect; or
- (b) the word “President”, “Republic”, “Zambia”, or a letter, device or representation of the image of the President that is likely to lead a person to believe that the applicant either has, or has had, the patronage or authorisation of the President, or patronage or authorisation from the Government, whether or not that may be the case.

33. The Registrar shall not register a trade mark that contains the name, or representation of the image, of a known person, whether living or dead, as part of the trade mark, unless the applicant has obtained the written consent of the—

Trade mark
containing
name of
known
person

- (a) person whose name, or representation of whose image, is contained in the trade mark; or
- (b) legal representative of the person whose name, or representation of whose image, is contained in the trade mark.

34. (1) The Registrar may accept an application for the registration of a trade mark that is identical or similar to an earlier application or registration of a trade mark where the applicant shows to the satisfaction of the Registrar that—

Honest
concurrent
use

- (a) there has been an honest concurrent use in the course of trade of the trade mark for which registration is sought in the Republic; and
- (b) due to special circumstances, it is proper for the trade mark to be registered.

(2) The proprietor of an earlier application or registration of a trade mark may oppose the Registrar's acceptance of an application made under subsection (1).

(3) The Registrar may impose limitations and conditions to the registration of a trade mark under subsection (1) that the Registrar may consider necessary.

Registration of trade mark containing representation of national symbol

35. (1) The Registrar shall not register a mark as a trade mark if the mark contains a—

- (a) national symbol of the Republic;
- (b) representation or design, in whole or part, of a national symbol of the Republic; or
- (c) device resembling a national symbol of the Republic which is likely to be mistaken for a national symbol of the Republic.

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(2) Despite subsection (1), an applicant who intends to register a trade mark that contains a mark referred to in subsection (1) shall obtain the written consent of the Minister responsible for national symbols in accordance with the National Flag and Armorial Ensigns Act.

(3) The Registrar may, where an applicant has obtained written consent from the Minister under subsection (2), register a trademark that contains a mark referred to in subsection (1).

(4) This section applies to any other emblem of the Republic.

Registration of trade mark containing flag, armorial bearings or official signs of Convention country

36. (1) The Registrar shall not, except with the prior written approval of a competent authority of a Convention country, register a mark as a trade mark if that mark contains—

- (a) the flag of a Convention country, unless the use of the flag in the manner proposed is permitted without authorisation;
- (b) an armorial bearing or other state emblem of a Convention country protected under the Paris Convention or TRIPS Agreement; or
- (c) an official sign or hallmark—

- (i) adopted by a Convention country;
- (ii) that indicates control and warranty adopted by a Convention country in relation to a good or service of the same or similar kind as that good or service in respect of which the trade mark is to be registered; and
- (iii) that is protected under the Paris Convention or TRIPS Agreement.

(2) This section applies to a mark that imitates or contains a representation of a flag, armorial bearing, state emblem, official sign or hallmark of a Convention country.

(3) Despite subsections (1) and (2), the Registrar shall register a mark as a trade mark, including a trade mark similar to that of a Convention country if—

- (a) an applicant is a national of that Convention country; and
- (b) the competent authority of that Convention country has authorised the applicant to make use of the flag, armorial bearing, state emblem, official sign or trade mark of the Convention country.

37. (1) Subject to subsection (2), the Registrar shall not, without the authorisation of an international organisation to which one or more Convention countries are members, register a trade mark that contains an armorial bearing, flag, emblem, abbreviation or a name of an international organisation where that armorial bearing, flag, emblem, abbreviation or name of the international organisation is protected under the Paris Convention or TRIPS Agreement.

Registration of trade mark containing armorial bearings, flag, or other symbol of international organisation

(2) Despite subsection (1), the Registrar may register a trade mark if the Registrar considers that the use of an armorial bearing, flag, emblem, abbreviation or a name of an international organisation specified in subsection (1), in the manner applied for, is not likely to—

- (a) suggest to the public that a connection exists between the international organisation and the trade mark; or
- (b) mislead the public as to the existence of a connection between the user and the international organisation.

(3) This section applies to a mark which imitates an armorial bearing, a flag, emblem, abbreviation or a name of an international organisation referred to in subsection (1).

Emblems,
official
signs or
hallmarks
protected
under the
Paris
Convention
or TRIPS
Agreement

38. (1) For purposes of sections 36 and 37, an armorial bearing, flag, state emblem, emblem, official sign, hallmark, abbreviation or name of a Convention country or international organisation protected under the Paris Convention shall be protected under this Act to the extent that—

- (a) the Convention country or the international organisation concerned has notified the Republic in accordance with paragraph (3) of Article 6^{ter} of the Paris Convention, or under that Article as applied by the TRIPS Agreement, that the Convention country or international organisation desires to protect the armorial bearing, flag, state emblem, emblem, official sign, hallmark, abbreviation or name;
- (b) the notification remains in force; and
- (c) the Republic has not objected, or has withdrawn its objection, to the notification in accordance with paragraph (4) of Article 6^{ter} of the Paris Convention or under that Article as applied by the TRIPS Agreement.

(2) A communication under subsection (1) shall have effect in relation to an application for registration of a trade mark that is made after two months from the date of receipt of the communication.

(3) The Registrar shall keep and make available for public inspection, during normal working hours, a list of an armorial bearing, flags, other emblems, state emblems, official signs, hallmarks, abbreviations and names of Convention countries and international organisations protected under the Paris Convention in accordance with notifications specified in subsection (2).

Limitation
of trade
mark to
particular
colours

39. (1) A trade mark may be limited, wholly or in part, to a particular colour or combination of colours.

(2) The Registrar shall, before registering a trade mark, consider whether the trade mark is limited wholly or in part, to a particular colour or combination of colours.

(3) Where a trade mark is registered without limitation to a particular colour or combination of colours, the trade mark shall be considered to be registered for all colours.

(4) A trade mark considered to be registered for all colours does not enjoy exclusive rights to any registered colour.

40. The Registrar shall not register a mark as a trade mark if the mark includes a word that is—

- (a) commonly used and is an accepted name of a single chemical element or compound in respect of a chemical substance or preparation;
- (b) declared by the World Health Organisation, and notified to the public by the Registrar, in the prescribed manner, as an International Non-Proprietary Name; or
- (c) deceptively similar to a name referred to in paragraph (b).

Prohibition of registration of names of chemical elements or International Non-Proprietary Names

41. (1) Subject to subsection (2), the Registrar shall not register a mark as a trade mark where that mark—

- (a) does not satisfy the definition of a trade mark under section 2;
- (b) consists exclusively of a mark or indication that may serve, in the course of trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, time of production of a good or rendering of services, or other characteristics of a good or service;
- (c) according to its ordinary signification, is a surname;
- (d) consists exclusively of a mark or indication that has become customary in a specific language or in the bona fide and established practice of a trade;
- (e) is contrary to law, public policy or accepted principles of morality;
- (f) comprises or contains a scandalous or obscene matter;
- (g) is of a nature intended to deceive, or cause confusion on the part of the public as to the nature, quality or geographical origin of a good or service;
- (h) consists exclusively of a shape that—
 - (i) results from the nature of that good;
 - (ii) is necessary to obtain a technical result; or
 - (iii) gives substantial value to the good; or
- (i) is a letter, numeral or a number, or a combination of letters, numerals or numbers, that is not defined in a manner intended to give the mark a distinctive character.

Absolute grounds for refusal to register mark as trade mark

(2) The Registrar shall not refuse to register a mark as a trade mark under subsection (1) where the mark has acquired a distinctive character as a result of the mark's use before the date of application for registration of a trade mark.

Relative
grounds for
refusal of
registration

42. (1) The Registrar shall not register a mark as a trade mark, where the mark—

- (a) is identical with, or similar to, an earlier application or registration of a trade mark and—
 - (i) relates to a good or service identical with or similar to a good or service that was the subject of an earlier application or registration of a trade mark; and
 - (ii) there exists a likelihood of deception or confusion, on the part of the public, which includes the likelihood of association with an earlier application or registration of a trade mark;
- (b) constitutes, or the essential part of the mark constitutes, a reproduction, imitation or translation of a well-known trade mark and the use of the mark is—
 - (i) in respect of a good or service identical with or similar to a good or service for which the trade mark is well-known; and
 - (ii) likely to deceive or cause confusion; or
- (c) constitutes, or the essential part of the mark constitutes, a reproduction, imitation or translation of a well known trade mark registered in the Republic for a good or service that is neither identical nor similar to the good or service in respect of which the well-known trade mark is registered and the use of the trade mark in relation to that good or service would—
 - (i) indicate a connection between that good or service and the proprietor of the registered trade mark;
 - (ii) likely damage the interest of the proprietor of the registered trade mark; and
 - (iii) likely cause confusion with the name of a company or business registered in the Republic.

(2) Despite subsection (1), the Registrar may register a trade mark if a proprietor or a person with an interest in an earlier right consents to the registration.

43. Subject to this Act, a registered trade mark shall be valid for a period of ten years from the date of filing the application for registration of that trade mark.

Validity of registration of trade mark

44. (1) A proprietor or licensee may apply to the Registrar for renewal of the registration of a trade mark within six months before the date of expiry of the registration of a trade mark in a prescribed manner and form on payment of a prescribed fee.

Renewal of registration of trade mark and notice of expiry

(2) The Registrar may, before the expiry of the registration of a trade mark, send a notice to a proprietor or a licensee of the date of expiration of a trade mark, in a prescribed manner and form.

(3) Despite subsection (2), the registration of a trade mark shall expire on the date of expiry of the registration.

(4) The Registrar shall, on receipt of an application made under subsection (1), renew the registration of a trade mark and issue a certificate of renewal in a prescribed form.

(5) The certificate of renewal issued under subsection (4), shall be valid for a period of ten years from the date of expiry of the registration of a trade mark or the last date of renewal of a registration.

(6) A proprietor or licensee may, within six months after the expiration of the last registration or renewal of a trade mark, apply for late renewal of registration of a trade mark.

(7) A surcharge shall be imposed on an application made under subsection (6) as prescribed.

(8) The Registrar shall, where a proprietor or licensee does not make an application in accordance with subsections (1) or (6), remove a trade mark from the Register six months after the expiry of registration of a trade mark.

(9) A proprietor or licensee may, where a trade mark has been removed from the Register under subsection (8), apply to the Registrar, within six months of the removal of a trade mark from the Register, for the restoration of a trade mark in a prescribed manner and form on payment of a prescribed fee.

(10) The Registrar shall, within thirty days of receipt of an application under subsection (9), publish an application for restoration of a trade mark in the Intellectual Property Journal.

(11) The Registrar may restore a trade mark to the Register for a period of ten years from the date of expiry of the last registration on terms and conditions that the Registrar may determine.

(12) The Registrar shall not accept an application for the registration of an identical or similar trade mark relating to a similar good or service where a trade mark has been removed from the Register, within a period of one year of the date of removal of a trade mark from the Register.

(13) Subsection (12) does not apply where the Registrar is satisfied that—

- (a) there has been no *bona fide* use, by a proprietor or licensee, of a trade mark that has been removed from the Register within two years immediately preceding the trade mark's removal from the Register; or
- (b) deception or confusion is not likely to arise from the use of a trade mark that is the subject of an application for registration by reason of previous use of the trade mark that has been removed from the Register.

Variation of
registration

45. (1) A proprietor may apply to the Registrar for variation of registration of a trade mark in a prescribed manner and form on payment of a prescribed fee.

(2) An application made under subsection (1) shall relate to some or all of the goods or services for which the trade mark is registered.

Alteration
of
registered
trade mark

46. (1) The Registrar may, on application by a proprietor in a prescribed manner and form and on payment of a prescribed fee, alter a registered trade mark if the alteration does not substantially affect the identity of a trade mark.

(2) The Registrar shall, within ninety days of receipt of an application under subsection (2), publish the application for alteration of a registered trade mark in the Intellectual Property Journal.

(3) Sections 19, 20, 21, 22 and 23 apply, with necessary modifications, on the publication of the application for alteration of a registered trade mark under this section.

Cancellation
of
registered
trade
mark

47. (1) A proprietor or a person with an interest in a trade mark may apply to the Registrar for cancellation of a registration of a trade mark in a prescribed manner and form on payment of a prescribed fee.

(2) Where the application under subsection (1) is made by a proprietor, the Registrar shall, on receipt of that application, cancel the registration of a trade mark.

(3) The Registrar may, on the Registrar's own motion or on application by a person with an interest in a trade mark under subsection (1), cancel the registration of a trade mark—

- (a) on the ground that a proprietor has contravened or failed to observe a condition relating to the trade mark as entered in the Register;
- (b) on the death of a proprietor who is a natural person and has no successor or legal representative appointed;
- (c) in the case of a legal entity, on the dissolution of that legal entity;
- (d) where the trade mark has become a generic term that designates a good for which the trade mark is registered; or
- (e) where the use of the trade mark by the proprietor or licensee has caused the public to be misled as to the kind, quality, quantity, or geographical origin of the goods in respect of which the trade mark was registered.

(4) The Registrar shall, before cancelling the registration of a trade mark under subsection (3), publish in the Intellectual Property Journal the intention to cancel the registration of the trade mark and shall—

- (a) give reasons for the intended cancellation; and
- (b) require a proprietor to show cause, within a period of sixty days, why the trade mark should not be cancelled.

(5) The Registrar shall not cancel a trade mark under this section if a proprietor takes remedial measures, to the satisfaction of the Registrar, within the period specified under subsection (4).

(6) The Registrar shall, in making a final determination on the cancellation of registration of a trade mark, consider the submissions made by a proprietor under subsection (4).

(7) A proprietor shall, where a trade mark registration is cancelled in accordance with this section, surrender the certificate of registration to the Registrar.

(8) The Registrar shall publish the cancellation of registration of a trade mark in the Intellectual Property Journal.

(9) The cancellation of the registration of a trade mark shall be effective when the cancellation is entered in the Register and published in accordance with subsection (8).

Removal of
trade mark
from
Register

48 . (1) A person affected by a registered trade mark may apply to the Registrar, in a prescribed manner and form on payment of a prescribed fee, for the removal of that trade mark from the Register in respect of any of the good or service for which that trademark is registered on the ground that—

- (a) the trade mark has not been used by a proprietor or licensee for a continuous period of five years or more;
- (b) an entry has wrongly remained on the Register;
- (c) there is an error or defect in an entry in the Register; or
- (d) the trade mark was fraudulently entered in the Register.

(2) Despite subsection (1) (a), the Registrar shall not remove a trade mark from the Register if it is proved that special circumstances exist that have prevented a proprietor or licensee from using the trade mark.

(3) The Registrar shall not remove a trade mark from the Register without providing a proprietor or a licensee an opportunity to be heard and section 21 applies with necessary modifications.

(4) The Registrar shall, after hearing the parties, remove the trade mark from the Register or dismiss an application made under subsection (1).

(5) The Registrar shall, where the Registrar decides to remove the trade mark from the Register, publish the removal of the trade mark from the Register in the Intellectual Property Journal.

(6) A removal of a trade mark from the Register shall be effective after the date of the removal is entered in the Register and published in the Intellectual Property Journal in accordance with subsection (5).

Acquiescence
in use of
trade mark

49. Where a proprietor of an earlier registered trade mark or user of a well known trade mark has acquiesced to the use of a trade mark by a person in the Republic for a continuous period of five years, that proprietor of the earlier registered trade mark or user of a well known trade mark is not entitled to—

- (a) apply for revocation of the registration of a trade mark under this Act; or
- (b) oppose the registration and use of the trade mark in relation to a good or service in respect of which the trade mark has been used.

PART IV

RIGHTS OF PROPRIETOR

50. (1) Subject to this Act, the registration of a trade mark confers on a proprietor the exclusive right—

Rights conferred by registration of trade mark

- (a) to use the registered trade mark in relation to a good or service in respect of which the trade mark is registered; and
- (b) to obtain relief in respect of infringement of the registered trade mark in accordance with this Act.

(2) Subject to subsections (1) and (3), the exclusive right to the use of a registered trade mark is subject to the limitations and conditions that the Registrar may impose on registration of the trade mark.

(3) Joint proprietors have exclusive rights to the use of a registered trade mark as if the trade mark was registered by a single proprietor, subject to the terms and conditions entered in the Register, or an agreement made by the joint proprietors.

(4) Despite subsection (3), each of the joint proprietors—

- (a) is entitled to the use of the registered trade mark without the consent of the other proprietor; and
- (b) is not entitled, without the consent of the other proprietor to—
 - (i) grant a licence to the use of the registered trade mark; or
 - (ii) transfer or offer the registered trade mark as security.

(5) For purposes of this section, a member of a collective association who owns a collective mark that is registered in respect of a class of goods or services—

- (a) has the right to the use of the collective mark in respect of a good produced or service provided by the member; and
- (b) does not have the right to exclude another member from using the trade mark in respect of a good produced or a service provided by any other member.

- Protection of well-known trade mark
- 51.** (1) A proprietor of a well known trade mark is entitled to—
- (a) oppose an application for the registration of a trade mark;
 - (b) apply to the Registrar to cancel the registration of a trade mark; or
 - (c) obtain an injunction to restrain the use of a trade mark in the Republic, which is identical with, or similar to, the well-known trade mark in relation to the identical or similar good or service where the use of that trade mark is likely to cause deception or confusion on the part of the public.
- (2) This section does not affect the validity of a registered trademark or the continued *bona fide* use of a trade mark which existed before the commencement of this Act.
- (3) A trade mark shall be considered to be a well-known trade mark if that trade mark is well-known in the Republic as being the trade mark of a person who is a citizen of a Convention country or domiciled, or has a real and effective industrial or commercial establishment, in a Convention country, whether or not the person carries on business in the Republic.
- (4) The Minister may, in addition to the consideration under subsection (2), by statutory instrument, prescribe factors to be taken into account in determining whether a trade mark is a well-known trade mark in the Republic in accordance with subsection (3).
- Rights of proprietor in infringement proceedings
- 52.** Subject to any restriction on the commencement of proceedings for infringement of a right of a proprietor under this Act, the right that accrues to a proprietor is—
- (a) subject to a limitation or condition that is entered in the Register in respect of a registered trade mark;
 - (b) from the date of application for registration of a trade mark; and
 - (c) conferred in respect of each component that is registered as a separate trade mark.
- Protection of vested rights
- 53.** A proprietor is not, under this Act, entitled to interfere with, or restrain, the use by a person of a trade mark, which is identical with, or similar to, the registered trade mark of the proprietor if the trade mark relates to a good or service that the person or person's predecessor in title has continuously used from a date prior to the—

- (a) use of the registered trade mark by the proprietor or proprietor's predecessor in title; or
- (b) date of registration of the registered trade mark in the name of the proprietor or proprietor's predecessor in title.

54. (1) The use of a trade mark or part of a trade mark, by a proprietor or any other person, as a name or description of an article, substance or service after the date of registration of a trade mark does not affect the validity of the registered trade mark.

Use of trade mark as description of article, substance or service

(2) Despite subsection (1), a proprietor does not have an exclusive right to the use of a trade mark in relation to an article, substance, good or service of the same description, where a registered trade mark or part of the trade mark has become generally accepted within the relevant trade as a mark that—

- (a) describes or is the name of an article, substance or service; or
- (b) is the commonly known way to describe or identify an article formerly exploited under a patent, or a service formerly provided as a patented process, and at least two years has lapsed since the patent expired.

(3) A proprietor may, where a trade mark has acquired common usage in the circumstances referred to in subsection (2), apply to the Registrar for the amendment of the registration of a registered trade mark in the prescribed manner and form on payment of a prescribed fee.

(4) Despite subsection (1), a person who is affected by the circumstances set out in subsection (2), may apply to the Registrar for the cancellation of a registered trade mark in accordance with section 47 of this Act.

55. (1) A registered trade mark is personal property capable of being—

Registered trade mark as property

- (a) transferred by any means by which personal property may be lawfully transferred including—
 - (i) assignment;
 - (ii) pledge;
 - (iii) testamentary disposition; or
 - (iv) operation of law; or
- (b) licensed.

(2) A registered trade mark may be a subject of a charge or security in the same manner as other personal property.

Act No.3 of
2016

(3) Where a trade mark is subject to a charge or security, the proprietor shall register the particulars of the charge or security in the Registry established under the Movable Property (Security Interest) Act, 2016.

(4) Where a charge or security on a trade mark has been registered under subsection (3), the Registrar shall record in respect of that trade mark an endorsement on the Register as prescribed.

Transfer of
trade mark

56. (1) A transfer of a trade mark may be partial and shall apply to—

- (a) some of the goods or services for which a trade mark is registered; or
- (b) the use of a trade mark in a particular manner or locality.

(2) A transfer of a trade mark under subsection (1) shall be valid where the transfer is—

- (a) in writing;
- (b) signed by, or on behalf of, a proprietor or the proprietor's assignee; and
- (c) registered with the Agency in accordance with this Act.

(3) A proprietor who intends to transfer a registered trade mark shall apply to the Registrar for the registration of a transfer of the trade mark in a prescribed manner and form on payment of a prescribed fee.

(4) The Registrar shall, on receipt of an application under subsection (3)—

- (a) in the case of an application for registration of an assignment with goodwill, record the assignment in the Register and issue a certificate of assignment; or
- (b) in the case of an application for registration of an assignment without goodwill, cause the proprietor to publish a notice of the assignment in the Intellectual Property Journal within six months of the date of assignment or within a period that the Registrar may determine.

(5) A person who intends to oppose the registration of an assignment without goodwill shall, within sixty days of the date of assignment under subsection 4 (b), file a notice of opposition with the Registrar in a prescribed manner and form on payment of a prescribed fee.

(6) Sections 21 and 22 apply with the necessary modifications, to an opposition filed under subsection (5).

(7) The Registrar shall, in the case of an application for registration of an assignment without goodwill, record the assignment in the Register and issue a certificate of assignment in the prescribed form where the—

- (a) period for filing a notice of opposition has expired; or
- (b) determination of an opposition is in favour of the applicant.

57. Despite section 56, a trade mark is not transferable where the transfer would result in exclusive rights to the use of the trade mark subsisting in more than one person in relation to—

Restriction
on transfer
of trade
mark

- (a) an identical good or service;
- (b) an identical description of a good or service;
- (c) a good or service or description of good or service which is associated with each other; or
- (d) a similar or identical trade mark, where having regard to the similarity of a good or service and a trade mark, the use of that trade mark, in exercise of such rights is likely to cause confusion on the part of the public.

58. Subject to this Act, an associated trade mark is transferable or transmissible as a whole and not separately.

Transfer or
transmission
of
associated
trade marks

PART V

PERMITTED USE AND LICENSEE

59. (1) A person who uses a registered trade mark with the consent of a proprietor is considered to have permitted use of that registered trade mark under this Act.

Permitted
use

(2) Despite subsection (1), a person shall only be considered to have permitted use if that person is registered as a licensee under this Act.

(3) A permitted use of a registered trade mark may be general or limited.

(4) A limited permitted use of a registered trade mark may be in respect of—

- (a) all or any of the goods or services for which the trade mark is registered; or
- (b) the use of the trade mark in a particular manner or locality.

Registration
of licensee

60. (1) A person with permitted use of a registered trade mark may be registered as a licensee.

(2) A proprietor may apply to the Registrar for registration of a person with permitted use of a registered trade mark as a licensee in a prescribed manner and form on payment of a prescribed fee.

(3) An application under subsection (2) shall be accompanied by a licence agreement or a duly authenticated copy of that agreement.

(4) The Registrar shall, where an application under subsection (2) meets the requirements of this Act, register a person with permitted use as a licensee in respect of a registered trade mark and—

- (a) enter the particulars of the registration of a licensee in the Register; and
- (b) issue a certificate of registration as licensee in a prescribed manner.

(5) The Registrar shall, within thirty days of the date of registration of a licensee under subsection (4), publish a notice of registration as licensee in the Intellectual Property Journal.

Variation of
registration
of
licensee

61. (1) A proprietor or licensee may apply to the Registrar for the variation of the registration of a licensee in a prescribed manner and form on payment of a prescribed fee.

(2) An application under subsection (1) shall be accompanied by an amended licence agreement or a duly authenticated copy of that agreement.

Cancellation
of
registration
of
licensee

62. (1) The Registrar may, on the Registrar's own motion, in the prescribed manner and form, cancel the registration of a licensee, where—

- (a) a trade mark is no longer registered under this Act;
- (b) the Registrar is satisfied that a proprietor or licensee misrepresented, or failed to disclose some material fact in an application for registration; or
- (c) the Registrar is satisfied that the registration of a licensee should not have been effected having regard to the rights vested in the applicant.
- (2) The Registrar may, on an application made by a proprietor or a licensee, in a prescribed manner and form on payment of a prescribed fee, cancel the registration of a licensee, where—
- (a) a proprietor or licensee applies for cancellation in accordance with the licence agreement;
- (b) the court has made an order for cancellation; or
- (c) there is mutual consent by the proprietor and licensee for cancellation.
- (3) The Registrar shall, within thirty days of the date of cancellation of a registration of a licensee, publish a notice of the cancellation in the Intellectual Property Journal.

63. (1) A licensee shall not transfer or transmit the right to the use of the registered trade mark.

Prohibition of transfer or transmission of trade mark

(2) Where a licensee is a partner in a partnership, the right of that licensee, shall not be considered to have been granted to the partnership.

PART VI

INFRINGEMENT OF REGISTERED TRADE MARK

64. (1) For purposes of this Act, a reference to an infringement of a registered trade mark shall be construed as a reference to an infringement of any rights of a proprietor.

Infringement of registered trade mark

(2) A person is not entitled to institute infringement proceedings to prevent an infringement or to recover damages in respect of the infringement of an unregistered trade mark.

(3) Despite subsection (2), nothing in this Act affects the right of action of a proprietor against a person for passing off a good or service as the good or service provided by another person and the remedies available under that right.

65. (1) Subject to section 66, a person infringes a registered trade mark if that person, not being a proprietor or licensee uses in the course of trade—

Infringing acts

-
- (a) a mark that is identical with a registered trade mark in relation to a good or service identical with, or similar to, a good or service for which the trade mark is registered;
 - (b) a mark that is similar to a registered trade mark in relation to a good or service identical with, or similar to, a good or service for which the trade mark is registered, and there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the registered trade mark; or
 - (c) in relation to a good or service, a mark that is identical with, or similar to, a registered trade mark where the trade mark has a reputation in the Republic and the use of the mark, takes unfair advantage of, or is detrimental to, the distinctive character or repute of the registered trade mark.
- (2) A person infringes a registered trade mark if the person knowingly, or having reason to believe that the trade mark is not authorised by the proprietor or licensee, uses an infringing material.
- (3) Despite subsection (1), a person shall not be prevented from using a registered trade mark for purposes of identifying a good or service as a good or service of a proprietor or licensee of a trade mark.
- (4) For purposes of this section, a person uses a registered trade mark if that person—
- (a) applies a registered trade mark to a good or service, or packaging of a good;
 - (b) offers, supplies or exposes a good or service, for sale, under a registered trade mark;
 - (c) puts a good or service on the market under a registered trade mark;
 - (d) stocks a good under a registered trade mark for purposes of offering or exposing the good for sale or putting that good on the market;
 - (e) imports or exports a good or service under a registered trade mark;
 - (f) uses the registered trade mark on a paper used during the course of business or for advertising; or
 - (g) manufactures or distributes a good under the registered trade mark.

66. (1) Despite section 65, a person does not infringe a registered trade mark if that person uses in relation to a trade mark—

Exemptions
to
infringement

- (a) a registered trade mark with the consent of a proprietor or licensee;
- (b) that person's own name or predecessor in title's name or address;
- (c) that person's pseudonym or the predecessor in title's pseudonym;
- (d) a mark which serves to designate the kind, quality, quantity, intended purpose, value, geographical origin, time of production of a good, rendering of service, or other characteristics of a good or service; or
- (e) a mark that is necessary to indicate the intended purpose of a good or service.

(2) The use of a registered trade mark that is identical with, or similar to, another registered trade mark is not an infringement if a trade mark is used in relation to a good or service for which a trade mark is registered.

(3) A person who has vested rights in an unregistered trade mark under section 53 is not considered to have infringed a registered trade mark through the use of the unregistered trade mark in the course of a trade or business.

67. A person who advertises a good or service as a good or service of a proprietor or licensee in accordance with honest and industrial practices shall not be considered to have infringed a registered trade mark.

Exceptions
in relation to
advertising

68. (1) Despite section 65, a registered trade mark is not infringed by the use of the trade mark for a good which has been placed on the market anywhere in the world by the proprietor or with the proprietor's consent.

Exhaustion
of rights

(2) Subsection (1) does not apply where the condition of a good has been changed or impaired after that good has been placed on the market and the use of a registered trade mark in relation to that good is detrimental to the distinctive character or repute of the registered trade mark.

69. (1) Subject to this Act, a proprietor may commence an action in the Court for infringement of a registered trade mark, if the infringement occurs on or after the date on which a certificate of registration of a trade mark is issued and sealed by the Registrar in accordance with this Act.

Commencement
of
infringement
proceedings

(2) Infringement proceedings under subsection (1), may be brought by a person who is a joint proprietor, except that a joint proprietor may not, without leave of the Court, proceed with the action unless each of the proprietors is joined to the proceedings.

Request by licensee for commencement of infringement proceedings

70. (1) A licensee may, unless a licence agreement provides otherwise, request a proprietor to commence infringement proceedings in respect of a matter which affects that licensee's interests.

(2) Where a proprietor refuses or fails to commence infringement proceedings within two months after a licensee's request under subsection (1), a licensee may commence infringement proceedings, in the licensee's name, as if the licensee is the proprietor, and the proprietor shall be joined as a party to the proceedings.

Groundless threats of infringement proceedings

71. (1) Subject to subsection (5), a person may apply to the Court for relief where that person has been threatened by another person with infringement proceedings in relation to an act that does not constitute an infringement act under section 65.

(2) A person may apply to the Court under subsection (1) for the following reliefs:

- (a) a declaration that the threat is unjustifiable;
- (b) an injunction against the continuation of the threat;
- (c) damages in respect of any loss sustained as a result of the threat; or
- (d) any other relief that the Court may consider appropriate.

(3) A person who is threatened in accordance with subsection (1) is entitled to a relief claimed under subsection (2) unless a proprietor or licensee proves to the Court that the act in respect of which infringement proceedings are threatened constitute, or if done would constitute, an infringement of a registered trade mark.

(4) Despite subsection (3), where a proprietor or licensee proves to the Court that the act in respect of which infringement proceedings were threatened constitute, or if done would constitute, an infringement of a registered trade mark, a person threatened under subsection (1), is entitled to the relief claimed under subsection (2) if that person proves to the Court that the registration of the trade mark is no longer valid.

(5) An application under subsection (1) shall not be commenced, or if commenced may not proceed, if a proprietor or licensee commences infringement proceedings of a trade mark, within thirty days of a threat being made against a person threatened.

72. (1) A proprietor or licensee has, in infringement proceedings, the right to any relief available for an infringement of a personal property right. Remedies for infringement

(2) Despite subsection (1), a proprietor or a licensee who commences infringement proceedings may apply to the Court for any of the following reliefs:

- (a) an injunction;
- (b) damages or an account of profits;
- (c) an order for delivery up in accordance with section 73;
- (d) in lieu of damages, at the option of a proprietor, a royalty which would have been payable by a licensee for the permitted use of a registered trade mark; or
- (e) any other remedy that the Court may consider appropriate.

73. (1) The Court may, on an application made by a proprietor or licensee for an order for delivery up, order a person in possession, custody or control of an infringing good, material or article to surrender that good, material or article to the proprietor or any other person the Court considers appropriate. Order for delivery up

(2) An application for an order for delivery up under subsection (1) shall be made where—

- (a) the Court grants an order in accordance with section 74; or
- (b) there are grounds for the Court to grant an order in accordance with section 74.

(3) The application under subsection (2) shall be made within six years from the date on which, in the case of an—

- (a) infringing good, a trade mark was applied to that good or the packaging;
- (b) infringing material, a trade mark was applied to that material; or
- (c) infringing article, that article was made.

(4) Despite subsection (3), a proprietor may apply for delivery up after the expiry of six years where that proprietor is prevented from discovering the infringing good, material or article, due to fraud or concealment.

(5) An application under subsection (4), shall be made within six months from the date of discovering the infringing good, material or article.

(6) Nothing in this section shall affect the power that the Court may exercise under this Act, or the court's original jurisdiction.

Order for disposal

74. (1) A proprietor may apply to the Court, where an infringing good, material or article has been surrendered under section 73 (1), for an order that the—

- (a) infringing good, material or article be destroyed or forfeited to a proprietor or another person that the Court considers appropriate;
- (b) person found to have infringed the registered trade mark cause the offending mark to be erased, removed or obliterated from the infringing good, material or article in that person's possession, custody or control;
- (c) infringing good, material or article be disposed of outside the channels of commerce in a manner that the Court considers appropriate; or
- (d) infringing good, material or article be dealt with as the Court considers appropriate.

(2) Despite subsection (1) (b), the Court may, in exceptional circumstances, allow the release of goods into the channels of commerce.

(3) The Court shall, in granting an order under subsection (1), consider the following:

- (a) that the disposal is in a manner that minimises the risks of further infringements, and detriment to the rights of the proprietor;
- (b) the proprietor's proposed manner of destruction or disposal including the effect on the environment of the manner of destruction; and
- (c) the possibility, in the case of counterfeit trade mark goods, of re exportation of the goods in an unaltered state.

(4) The Court may, where there is more than one person with an interest in an infringing good, material or article—

- (a) direct that the infringing good, material or article be sold or otherwise dealt with, and the proceeds divided among the interested persons; or
- (b) make any other order that the Court considers appropriate.

(5) The Court shall, in deciding the order to grant under this section, consider—

- (a) whether the remedies specified under section 72 would be adequate to compensate a proprietor or a licensee and protect the interest of that proprietor or licensee;
- (b) the need for proportionality between the gravity of the infringement of a registered trade mark and the remedy sought; or
- (c) the interests of third parties.

(6) An order made under subsection (1), shall take effect—

- (a) at the expiry of the period within which a notice of an appeal may be filed;
- (b) on the final determination of an appeal; or
- (c) on abandonment of the proceedings.

(7) Where a Court does not make an order under subsection (1), the person, in whose possession an infringing good, material or article was before that good, material or article was surrendered under section 73 (1), is entitled to the return of that good, material or article.

75. (1) Where a proprietor has commenced infringement proceedings under section 69, that proprietor may apply to the Court for an order for a provisional measure. Provisional measures

(2) The Court may grant an order for a provisional measure to—

- (a) prevent an infringing good from entering into the channels of commerce; and
- (b) preserve relevant evidence relating to an alleged infringement.

(3) The Court may, before making an order under subsection (2)—

- (a) require an applicant to provide evidence to the satisfaction of the Court that—
 - (i) the applicant is a proprietor whose right is being infringed; or
 - (ii) an infringement of a proprietor's right is imminent;

- (b) order an applicant to provide security that is sufficient to protect the respondent; and
 - (c) require an applicant to provide other information necessary for the identification of a good, material or article.
- (4) A Court may make an order for a provisional measure without giving the respondent an opportunity to be heard where—
- (a) a delay in determining the infringement proceedings is likely to cause an irreparable harm to a proprietor; or
 - (b) there is a demonstrable risk of evidence being destroyed.
- (5) The respondent may, where the Court makes an order under subsection (4), apply to the Court to be heard within fourteen days of the date of an order for a provisional measure.
- (6) The Court may, after hearing the respondent under subsection (5), confirm, modify or revoke an order for a provisional measure.
- (7) The Court may, where a provisional measure is revoked under subsection (6), on the request of the respondent, order a proprietor to compensate that respondent for injury or loss caused by an order for a provisional measure.

PART VII

COLLECTIVE MARKS

Application
of Act to
collective
marks

76. (1) Subject to this Part, the provisions relating to a trade mark under this Act apply to a collective mark, with the necessary modifications.

(2) For the purposes of this Act, the use of a collective mark by a member of a collective association shall be considered to be a use of the collective mark by the collective association.

Application
for
registration
of collective
mark

77. (1) A collective association shall apply to the Registrar for the registration of a collective mark in a prescribed manner and form on payment of a prescribed fee.

(2) An application made under subsection (1) shall be accompanied by the rules governing the use of a collective mark.

(3) The rules referred to in subsection (2) shall specify—

- (a) the conditions and requirements governing the use of the collective mark; and
- (b) any other matters as may be prescribed.

(4) The Registrar shall, where the rules governing the use of the collective mark do not comply with the requirements in subsection (3), inform the applicant and give that applicant an opportunity to comply with the conditions and requirements within a period that the Registrar may determine.

(5) The Registrar shall, where an applicant fails to comply with subsections (3) and (4), reject an application for registration of a collective mark.

(6) The Registrar may determine that any other application for registration of a trade mark that has been made under this Act be registered as a collective mark as prescribed.

78. The rules governing the use of a registered collective mark referred to in section 77 shall be open for inspection by members of the public at the Agency during normal working hours on payment of a prescribed fee.

Inspection
of rules for
collective
mark

79. (1) Subject to this Act, a proprietor may apply to the Registrar to amend the rules governing the use of a collective mark, in a prescribed manner and form on payment of a prescribed fee.

Amendment
of rules for
collective
mark

(2) The Registrar may, before accepting an amendment to the rules under subsection (1), publish the proposed amendments to the rules in the Intellectual Property Journal.

(3) The Registrar shall reject an application under subsection (1) if the amendments do not comply with the requirements under section 77.

(4) The amended rules shall take effect on the date the Registrar accepts the amendments and enters the amendments in the Register.

80. A collective mark shall not be transferred or transmitted.

Non-transfer
or
transmission
of collective
mark

81. The Registrar may, in addition to the grounds for removal of a trade mark from the Register under section 48, revoke the registration of a collective mark on the ground that—

Grounds for
revocation of
registration
of collective
mark

- (a) the manner in which a collective mark is being used by a proprietor is likely to mislead the public;
- (b) a proprietor has failed to observe, or to secure the observance of the rules governing the use of a collective mark;

- (c) a proprietor ceases to exist as an association; or
- (d) it is not in the public interest for the collective mark to be registered.

Infringement proceedings

82. (1) Subject to any agreement to the contrary between a member of a collective association and the proprietor, that member of the collective association may, with the consent of the proprietor, bring proceedings for infringement of a registered collective mark.

(2) Where infringement proceedings are commenced by the proprietor of a collective mark, the Court may, in determining the matter—

- (a) take into account any loss suffered or likely to be suffered by an authorised user; and
- (b) grant any other order the Court considers appropriate to safeguard the interest of an authorised user.

PART VIII

CERTIFICATION MARKS

Application of Act to certification marks

83. (1) Subject to this Part, the provisions relating to a trade mark under this Act, apply to a certification mark, with the necessary modifications.

(2) Despite subsection (1), sections 4 (2) (b) and 48 (1) (a) do not apply to this Part.

Application for registration of certification mark

84. (1) A person responsible for the certification of a good or service shall apply to the Registrar for the registration of a certification mark in a prescribed manner and form on payment of a prescribed fee.

(2) An application made under subsection (1) shall be accompanied by rules governing the use of the certification mark which shall specify—

- (a) the conditions and requirements governing the use of the certification mark;
- (b) the procedure for certification of a good or service by a proprietor; and
- (c) any other matter as may be prescribed.

(3) The Registrar shall only register a certification mark where the—

- (a) rules governing the use of the certification mark comply with subsection (2) and are not contrary to public policy or to acceptable principles of morality; and

(b) applicant is competent to certify the good or service for which the mark is to be registered.

(4) The Registrar shall, where an applicant fails to comply with subsection (3), reject an application for registration of a certification mark.

(5) The Registrar may determine that any other application for registration of a trade mark that has been made under this Act be registered as a certification mark as prescribed.

85. The rules governing the use of a registered certification mark under section 84 shall be open for inspection by members of the public at the Agency during normal working hours on payment of the prescribed fee.

Inspection
of rules for
certification
mark

86. (1) Subject to this Act, a proprietor may apply to the Registrar to amend the rules governing the use of a registered certification mark in a prescribed manner and form on payment of a prescribed fee.

Amendment
of rules for
certification
mark

(2) The Registrar may, before accepting an amendment to the rules under subsection (1), publish the proposed amendments to the rules in the Intellectual Property Journal.

(3) The Registrar shall reject an application under subsection (1) if the amendments do not comply with the requirements under section 84.

87. The Registrar shall not register a certification mark if—

Restriction
on
application
for
certification

(a) an applicant carries on a business involving the supply of a good or service which the applicant is required to certify; or

(b) the mark is likely to mislead the public on the character or significance of that mark.

88. (1) Despite section 56, a proprietor who intends to transfer a registered certification mark shall apply to the Registrar for consent to transfer a certification mark.

Registrar's
consent to
transfer
certification
mark

(2) An application under subsection (1) shall be made in a prescribed manner and form on payment of a prescribed fee.

89. (1) A proprietor may authorise a person to use a registered certification mark to a good or service certified by the proprietor.

Authorised
use of
certification
mark

(2) An authorised user has the right to use the certification mark in accordance with the rules governing the use of the certification mark under section 84.

Rights of authorised user in relation to infringement of certification mark

90. An authorised user does not have the same rights as a licensee under this Act in relation to an infringement of a certification mark.

Acts not constituting infringement of certification mark

91. (1) The following do not constitute an infringement of a certification mark:

- (a) the use of a certification mark in relation to a good or service to which the registration of a certification mark does not apply, subject to conditions or limitations entered on the register;
- (b) the use of a certification mark in relation to a good or service certified by a proprietor if the proprietor, or authorised user, has applied the certification mark and has not subsequently removed or obliterated it, or the proprietor has expressly or impliedly consented to the use of the certification mark, except that this paragraph does not apply if the application of a certification mark is contrary to the rules governing the use of the certification mark; and
- (c) the use of a certification mark for a good or service adapted to form part of, or to be an accessory to, another good for which the certification mark is used without infringement, if the use of that certification mark is reasonably necessary in order to indicate that the good or service is so adapted and the purpose or effect of the use of the certification mark indicates that the good or service is certified by a proprietor.

(2) Where a certification mark is one of two or more trade marks registered under this Act that are identical or similar, the use of any of those trade marks, shall not be considered to be an infringement of the other trade marks.

Cancellation of registration of certification mark

92. (1) The Registrar may, on the Registrar's own motion or on an application made by a person with an interest in a certification mark, cancel a certification mark on the ground that—

- (a) a proprietor is no longer competent to certify a good or service in respect of which a certification mark is registered;
- (b) the manner in which a certification mark has been used by a proprietor is likely to mislead the public;
- (c) a proprietor has failed to observe or to secure the observance of the rules governing the use of a certification mark;
- (d) it is no longer for the benefit of the public that the certification mark remains registered; or
- (e) a proprietor has amended the rules in a manner that the rules—
 - (i) no longer comply with any of the conditions or limitations imposed at the time of registration of the certification mark; or
 - (ii) are contrary to public policy or to accepted principles of morality.

(2) An application under subsection (1) shall be made in the prescribed manner and form on payment of the prescribed fee.

(3) The Registrar shall, where the Registrar cancels a certification mark under subsection (1), notify the proprietor and the person with interest in the certification mark who applied for the cancellation of a certification mark in writing, of the decision stating the reason for the decision.

93. (1) The Registrar may, on the Registrar's own motion or on an application made by a person with an interest in a certification mark, vary the rules relating to a certification mark where it is in the best interest of the public that the rules be varied if a certification mark is to remain registered.

Variation of rules governing certification mark

(2) An application under subsection (1) shall be made in a prescribed manner and form on payment of a prescribed fee.

(3) The Registrar shall, where the Registrar varies the rules under subsection (1), notify, the proprietor of the certification mark and the person with an interest in the certification mark who applied for the variation of rules, in writing, of the decision stating the reason for the decision.

94. (1) Subject to an agreement between the authorised user and the proprietor, the authorised user may, with the consent of the proprietor, bring proceedings for infringement of a registered certification mark.

Infringement proceedings of certification mark

(2) Where infringement proceedings are commenced by the proprietor of a certification mark, the Court may, in determining the matter—

- (a) take into account loss suffered or likely to be suffered by an authorised user; and
- (b) grant any other order the Court considers appropriate to safeguard the interest of an authorised user.

PART IX

GEOGRAPHICAL INDICATIONS

Protection of registered geographical indication **95.** A geographical indication shall only be protected if that geographical indication is registered under this Act.

Geographical indication excluded from protection **96.** A geographical indication shall not be protected under this Act if that geographical indication—

- (a) designates a good where the given quality, reputation or other characteristic of that good is not essentially attributable to the geographical origin of the good;
- (b) is a generic name or a name that is generally used in the trading of that good;
- (c) is contrary to public policy or accepted principles of morality;
- (d) is not protected or has ceased to be protected in the country of origin;
- (e) has become a common name of a good and is being used to designate the the kind, quality, variety or other property or characteristic of that good; or
- (f) although true as to the geographical origin of the good, may falsely represent to the public that the good originates in another geographical area.

Application for registration of geographical indication **97.** (1) A producer carrying on an activity in a specified geographical area, or competent authority responsible for a geographical indication, may apply to the Registrar for the registration of a geographical indication in a prescribed manner and form on payment of a prescribed fee.

(2) Where an applicant is not ordinarily resident in the Republic or the principal place of business is outside the Republic, an application for the registration of a geographical indication shall be made by a trade mark agent.

98. (1) Subject to section 96 (f), a homonymous geographical indication that relates to a wine shall be accorded protection independently.

Homonymous
geographical
indication
for wines

(2) The Minister may, by statutory instrument, make Regulations for the criteria of differentiating homonymous geographical indications to which subsection (1) applies.

(3) The Regulations made under subsection (2) shall provide for—

- (a) an equitable treatment of a producer in a geographical area; and
- (b) mechanisms to ensure that a consumer is not misled as to the geographical indication.

(4) For the purposes of this section, “homonymous geographical indications” means identical or misleading similar words that are used for identifying different wines with—

- (a) the same pronunciation and spelling;
- (b) the same pronunciation but different spelling; or
- (c) different pronunciation but same spelling.

99. (1) The Registrar shall examine an application for a geographical indication filed under section 97 to determine whether or not that application complies with the requirements of this Act.

Examination
of application
and
publication of
acceptance of
geographical
indication

(2) The Registrar shall, where the Registrar determines that an application does not comply with the requirements of this Act, notify an applicant, in writing, to make the relevant amendment to an application within the period specified in the notice.

(3) An amendment referred to in subsection (2) shall be made in a prescribed manner and form on payment of a prescribed fee.

(4) The Registrar shall, where an applicant fails to make the relevant amendment within the specified period under subsection (2), reject an application and notify the applicant, in writing, of the decision.

(5) The Registrar shall, where the Registrar is satisfied that an application under subsection (1) complies with the requirements of this Act, accept the application filed under section 97.

(6) An applicant shall publish the acceptance of an application for a geographical indication under this section in the Intellectual Property Journal on payment of a prescribed fee.

Opposition
to
registration

100. (1) A person may, within a prescribed period and manner, file with the Registrar a notice of opposition to the registration of a geographical indication on the ground that it does not comply with the requirements of this Act.

(2) Sections 19, 20, 21, 22 and 23 apply, with the necessary modifications, to an opposition filed under this section.

Registration
of
geographical
indication

101. (1) The Registrar shall register a geographical indication and issue a certificate of registration to the applicant in a prescribed manner and form on payment of a prescribed fee, where the Registrar is satisfied that the applicant has complied with the requirements of this Act and that there is—

(a) no opposition to the registration of a geographical indication within the prescribed period; or

(b) an opposition to the registration of a geographical indication and the opposition has been—

(i) decided in favour of the person who has applied for the registration of geographical indication; or

(ii) withdrawn by the person who filed a notice of opposition.

(2) The Registrar shall publish a notice of the registration of a geographical indication in the Intellectual Property Journal.

(3) The Registrar may reject an application for the registration of a geographical indication if the application does not comply with the requirements of this Act.

(4) The Registrar shall, where the Registrar rejects an application for the registration of a geographical indication under subsection (3), notify the applicant, in writing, of the decision and the reasons for the rejection.

Right to use

102. A producer carrying on an activity in a geographical area where a certificate of registration has been issued for that geographical indication has the right, in the course of trade, to use a registered geographical indication in relation to a good specified if that good possesses the quality, reputation or other characteristic specified in the Register.

103. Subject to this Act, a registered geographical indication shall be valid for a period of ten years from the date of filing of an application for registration of a geographical indication and may be renewed, in a prescribed manner and form on payment of a prescribed fee, for each subsequent period of ten years from the date of expiry.

Validity and renewal of registered geographical indication

104. (1) A person shall not use a geographical indication that is identical with, or similar to, a registered geographical indication for designating—

Unlawful use of geographical indication

- (a) a good where that person is not the producer of that good specified in the Register;
- (b) a good that lacks the quality, reputation or any other characteristic specified in the Register;
- (c) a good that is not specified in the Register but that is of the same kind as a specified good; or
- (d) another good where the use of the geographical indication constitutes the use of the reputation of a registered geographical indication in bad faith.

(2) A person shall not use misleading information, in advertising materials or relevant documents relating to a good, about the origin, nature or basic characteristic of a good on the inner or outer packaging of a good.

(3) The prohibitions under subsections (1) and (2) do not extend to the use, in the course of trade, of a person's trade name, except where the trade name is used in a manner that misleads the public.

(4) A person who contravenes subsections (1) and (2) commits an offence and is liable, on conviction, to a fine not exceeding one million penalty units.

(5) Despite subsection (4), a user of a registered geographical indication or a competent authority may commence civil proceedings to restrain a person from unlawfully using a registered geographical indication.

105. (1) An authorised officer may seize a good that is in the process of being imported or exported if that good unlawfully bears a registered geographical indication.

Seizure in case of unlawful marking with geographical indication

(2) A seizure under subsection (1) shall be undertaken in accordance with the Customs and Excise Act.

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Transfer of
registered
geographical
indication

106. (1) A proprietor who intends to transfer a registered geographical indication to another person may apply to the Registrar for the transfer of that registered geographical indication in the prescribed manner and form on payment of a prescribed fee.

(2) The Registrar shall, within a prescribed period, reject or approve an application under subsection (1), and notify the applicant of the decision.

(3) The Registrar shall reject an application under subsection (1) if the person to whom a registered geographical indication is to be transferred—

- (a) is not entitled to file an application for registration of a geographical indication under section 97; or
- (b) does not consent to the transfer.

(4) A decision to reject an application under subsection (3) shall be in writing and shall state the reasons for the rejection.

(5) The Registrar shall, where the Registrar approves an application under subsection (2), issue a certificate of registration in a prescribed form to the transferee.

Exemptions
regarding
prior and
other users

107. (1) Nothing in this Act prevents the continued and similar use in the Republic of a particular geographical indication of another country identifying a wine or spirit, or in connection with a good or service by a person in the Republic who has used that geographical indication in a continuous manner with regard to the same or related good or service in the Republic either—

- (a) for a period of at least ten years immediately preceding the date on which the TRIPS Agreement was signed; or
- (b) in good faith at any time preceding the date on which the TRIPS Agreement was signed.

(2) This Act does not prejudice the registrability, or validity, of the registration of a trade mark, or the right to use a trade mark, on the basis that the trade mark is identical with or similar to a geographical indication, in the case of a person who applied for the registration of a trade mark or who registered a trade mark in good faith or who acquired rights through use in good faith—

- (a) before the date of entry into force or commencement of this Act; or
- (b) before the geographical indication is protected in the geographical indication's country of origin.

(3) A request for relief made in accordance with this Act relating to the use or registration of a trade mark shall be commenced within five years after the adverse use of the protected geographical indication has become generally known in the Republic, or after the date of registration of a trade mark in the Republic.

(4) Subsection (3) does not apply where—

- (a) a trade mark has been published on the date of registration of the trade mark in the Republic where that date is earlier than the date on which the adverse use became generally known in the Republic; and
- (b) a geographical indication is not used or registered in bad faith.

(5) This Act does not affect or prejudice the right of a person to use, in the course of trade, that person's name or the name of that person's successor in title in business, except where that name is used in a manner that is likely to mislead the public.

108. (1) The Registrar may, on the Registrar's own motion, cancel a geographical indication from the Register, where a proprietor fails to comply with conditions and limitations attached to the geographical indication's registration or renewal.

Cancellation of
registration of
geographical
indication

(2) The Registrar may, on an application by a person with an interest in a geographical indication made in a prescribed manner and form on payment of a prescribed fee, cancel the registration of a geographical indication on the ground that the—

- (a) area specified in the registration does not correspond to a geographical indication;
- (b) indication in respect of which a good is intended to apply or the indication of the quality, reputation or other characteristic of a good is missing, or unsatisfactory; or
- (c) indication does not comply with this Act.

(3) The Registrar shall, where the Registrar cancels a registration of a geographical indication under subsection (2), notify the proprietor of a geographical indication and the person with an interest in the geographical indication who applied for cancellation of a geographical indication, in writing, of the decision stating the reasons for the decision.

PART X

BORDER MEASURES

Notice for
border
measures

109. (1) Where a proprietor or licensee has valid grounds for suspecting that the importation or exportation of counterfeit trade mark goods may take place, that proprietor or licensee may apply, by notice, for border measures to the Commissioner-General in a prescribed manner and form .

(2) A notice under subsection (1) does not apply to goods in transit.

(3) The Commissioner-General shall, on receipt of the notice made under subsection (1), in writing, request the Registrar to verify whether—

(a) the person submitting the notice is the registered proprietor or licensee of the trade mark in respect of the counterfeit good; and

(b) the trade mark is valid.

(4) The Registrar shall, on receipt of the notice under subsection (3), conduct a search of the Register and submit a report to the Commissioner-General within the prescribed period.

(5) The Commissioner-General shall, on the Registrar's written verification of the information under subsection (3)—

(a) inform the applicant in writing within the prescribed period—

(i) that the application for border measures has been approved; and

(ii) the period for which the commissioner-General shall enforce the notice;

(b) direct an authorised officer to seize and detain the goods specified in the notice in a secure place if the proprietor or licensee deposits with the Commissioner-General security as the Commissioner-General may determine to—

(i) reimburse the Government for liability or expenses the Government is likely to incur as a result of the seizure of those goods;

(ii) prevent abuse and protect the importer or exporter; or

(iii) pay compensation that may be ordered by the Court under this Part; or

(c) take appropriate action to prevent a person from importing or exporting goods identified in the notice.

(6) The Commissioner-General shall, within seven days from the date of the seizure and detention of the infringing goods under subsection (5), issue to the applicant and the importer or exporter, a notice of suspension of the release of the goods in a prescribed manner and form.

(7) A proprietor or licensee may, for purposes of this section, commence infringement proceedings under section 69 within ten days of receipt of the notice issued under subsection (6).

110. An authorised officer who seizes and detains goods under section 109 shall, within seven days of the seizure and detention of the goods, give a notice of the seizure in a prescribed manner and form to the Registrar, a proprietor, licensee and importer or exporter.

Notice of seizure

111. (1) The Commissioner-General may, on an application by a proprietor, licensee, importer or exporter, made in a prescribed manner and form, authorise the inspection by the proprietor, licensee, importer or exporter of seized and detained goods.

Inspection and release of seized goods

(2) The Commissioner-General may permit a proprietor, licensee, importer or exporter to remove a sample of seized and detained goods.

(3) Where the Commissioner-General permits the inspection or removal of a sample of seized and detained goods under this section, the Commissioner-General shall not be liable to the importer or exporter for any loss or damage suffered by the importer or exporter arising out of—

- (a) damage to seized and detained goods incurred during the inspection; or
- (b) anything done to the sample of seized and detained goods removed from the custody of the Commissioner-General.

112. (1) An importer or exporter may, where infringement proceedings have not commenced, in accordance with section 109 (7) and before the expiry of ninety days, admit to the infringement of a trade mark, and consent to the forfeiture of seized goods in a prescribed manner and form.

Forfeiture of seized goods by consent

(2) Where an importer or exporter has made an admission and given consent under subsection (1), the Commissioner-General shall order the destruction or disposal of seized goods outside the channels of commerce.

(3) Where seized goods are destroyed or disposed of under subsection (2), compensation is not payable to the importer or exporter for any loss relating to the destruction or disposal of those goods.

Release of
seized goods
and
compensation
to importer

113. An importer or exporter of seized and detained goods may apply to the Court for the release of the seized and detained goods and compensation for the loss or damage relating to the seizure and detention of the goods, where the proprietor or registered licensee—

- (a) does not commence proceedings for infringement within the period specified in section 109 (7); and
- (b) had no reasonable grounds for submitting a notice under section 109 (1).

PART XI

TRADE MARK AGENTS

Holding out
as trade mark
agent

114. (1) A person shall not practice as a trade mark agent, impersonate or use the title of a trade mark agent unless that person is registered as a trade mark agent under this Act.

(2) A person who contravenes subsection (1) commits an offence and is liable, on conviction, to a fine not exceeding seven hundred thousand penalty units or to imprisonment for a term not exceeding seven years, or to both.

Prohibition
of
establishment
of business
without
registration

115. (1) A person shall not set up a business as trade mark agent unless that person is registered under this Act.

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

Registration
as trade
mark agent

116. (1) A person who intends to be registered as a trade mark agent may apply to the Registrar in a prescribed manner and form on payment of a prescribed fee.

(2) A person is eligible to be registered as a trade mark agent if that person has been practising as a legal practitioner for a period of at least five years.

(3) Despite subsection (2), a person who has passed a qualifying examination approved by the Registrar as prescribed, is eligible to be registered as a trade mark agent.

(4) A person is not eligible to be registered as a trade mark agent if that person is—

- (a) not a citizen or holder of a residence permit;
- (b) legally disqualified;
- (c) less than twenty one years of age;

- (d) an undischarged bankrupt;
- (e) a body corporate; or
- (f) not domiciled in the Republic.

(5) The Registrar shall register a person who qualifies to be registered as a trade mark agent and issue that person with a trade mark agent's notification, as prescribed.

(6) The registration of a trade mark agent under subsection (5) shall be valid for a period of one year from the date of registration and shall be subject to renewal.

(7) For purposes of subsection (4)—

“citizen” has the meaning assigned to the word in the Constitution; and

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“residence permit” has the meaning assigned to the words in the Immigration and Deportation Act, 2010.

Act No.18
of 2010

117. A trade mark agent may apply to the Registrar for renewal of a trade mark agent's certificate in a prescribed manner and form on payment of a prescribed fee.

Renewal of
trade mark
agent's
certificate

118. (1) Subject to this Act, a trade mark agent may—

Functions
of trade
mark agent

- (a) act as an agent on behalf of an applicant in connection with an application for registration of a trade mark under this Act; or
- (b) act as an agent on behalf of a proprietor or licensee in connection with any matter or proceedings before the Registrar.

119. The Registrar shall maintain a register of trade mark agents which shall contain particulars of trade mark agents, as prescribed.

Register of
trade mark
agents

120. (1) The Registrar shall cancel a trade mark agent's certificate if the trade mark agent—

Cancellation
of trade
mark
agent's
certificate

- (a) does not comply with the terms and conditions under which the certificate was issued;
- (b) becomes legally disqualified;
- (c) becomes bankrupt;
- (d) obtained the certificate through fraud, misrepresentation or concealment of a material fact;

- (e) in case of a legal practitioner, is no longer entitled to practice as a legal practitioner;
- (f) is convicted of fraud, forgery or uttering a forged document; or
- (g) commits an offence under this Act.

(2) Despite subsection (1), a trade mark agent may apply to the Registrar for the cancellation of the trade mark agent's certificate in a prescribed manner and form on payment of a prescribed fee.

Restoration
of trade
mark agent's
certificate

121. A trade mark agent may apply to the Registrar, in a prescribed manner and form on payment of a prescribed fee, for restoration of a trade mark agent's certificate cancelled under section 120.

PART XII

OFFENCES

Counterfeiting
trade mark

122. (1) A person commits an offence if that person knowingly—

- (a) has in possession or control in the course of trade a counterfeit trade mark good;
- (b) manufactures, produces or makes in the course of trade a counterfeit trade mark good;
- (c) sells, hires out, barters, or offers or exposes for sale, hiring out, or donates a counterfeit trade mark good;
- (d) exposes or exhibits for the purposes of trade a counterfeit trade mark good;
- (e) distributes a counterfeit trade mark good for the purposes of trade;
- (f) imports into or exports from the Republic a counterfeit trade mark good; or
- (g) disposes of a counterfeit trade mark good in any manner in the course of trade.

(2) A person convicted of an offence under subsection (1) is liable to a fine not exceeding five hundred thousand penalty units or to imprisonment for a term not exceeding five years, or to both.

(3) A body corporate that contravenes subsection (1) is liable to a fine not exceeding three million penalty units.

123. (1) A person commits an offence if that person with intent to benefit that person or another, or cause loss to a proprietor or licensee, and without the consent of the proprietor or licensee—

Falsely applying a registered trade mark to good or service

- (a) applies to a good or packaging of a good a mark identical to, or likely to be mistaken for, a registered trade mark; or
- (b) applies a mark identical to, or likely to be mistaken for, a registered trade mark to material intended to be used—
 - (i) for labelling or packaging a good;
 - (ii) as a business paper in relation to a good; or
 - (iii) for advertising a good.

(2) A person convicted of an offence under subsection (1) is liable to a fine not exceeding three hundred thousand penalty units or to a term of imprisonment not exceeding three years, or to both.

(3) A body corporate that contravenes subsection (1) is liable to a fine not exceeding three million penalty units.

124. (1) A person commits an offence if that person knowingly—

Making or possessing of infringing article

- (a) makes an infringing article; or
- (b) has in that person's possession, custody or control an infringing article.

(2) A person convicted of an offence under subsection (1) is liable to a fine not exceeding three hundred thousand penalty units or imprisonment for a term not exceeding three years, or to both.

(3) A body corporate that contravenes subsection (1) is liable to a fine not exceeding three million penalty units.

125. (1) A person commits an offence if that person sells or offers for sale, imports, or has in that person's possession, for the purpose of trade or manufacture, a good to which a registered trade mark is falsely applied.

Importing or selling goods with falsely applied trade mark

(2) It shall be a defence for an offence under this section if a person proves that the person had—

- (a) taken all reasonable precautions against committing an offence under this section;
- (b) at the time of the commission of an alleged offence, no reason to suspect that a registered trade mark was falsely applied to a good; or
- (c) acted innocently.

(3) A person convicted of an offence under subsection (1) is liable to a fine not exceeding five hundred thousand penalty units or imprisonment for a term of not exceeding five years, or to both.

(4) A body corporate that contravenes subsection (1) is liable to a fine not exceeding three million penalty units.

Unauthorised
reproduction
of registered
trade mark

126. (1) A person shall not without the consent of the proprietor—

- (a) make a reproduction, replica or representation of a registered trade mark; or
- (b) import a reproduction, replica or representation of a registered trade mark.

(2) A person convicted of an offence under subsection (1) is liable to a fine not exceeding three hundred thousand penalty units or to imprisonment for a term not exceeding three years, or to both.

(3) A body corporate that contravenes subsection (1) is liable to a fine not exceeding three million penalty units.

Falsification
of entries in
Register

127. (1) A person commits an offence if that person makes or causes to be made a false entry in the Register or register of trade mark agents, or a document purporting to be a copy of an entry in the Register or register of trade mark agents, or produces, tenders or causes to be produced or tendered in evidence a document, knowing the entry or document to be false.

(2) A person convicted of an offence under subsection (1) is liable to a fine not exceeding two hundred thousand penalty units or to imprisonment for a term not exceeding two years, or to both.

Altering of
documents

128. A person who alters or defaces a document issued by the Registrar commits an offence and is liable, on conviction, to a fine not exceeding three hundred thousand penalty units or to imprisonment for a term not exceeding three years, or to both.

Deceiving
Registrar or
officer with
false
statement

129. (1) A person commits an offence if that person, for the purpose of deceiving the Registrar or an officer of the Agency in the execution of this Act, makes or submits a false statement or representation whether orally or in writing, knowing that statement or representation to be false.

(2) A person commits an offence if that person makes a statement or representation whether orally or in writing, for the purpose of procuring or influencing the doing or omission of anything in relation to this Act, and who on becoming aware that such statement or representation was false, fails to inform the Registrar of the falsity.

(3) A person convicted of an offence under subsection (1) or (2) is liable to a fine not exceeding two hundred thousand penalty units or to imprisonment for a term not exceeding two years, or to both.

130. (1) A person commits an offence if that person—

- (a) places on a document, as a description of that person's office or business, the words "trade marks office", or words of similar nature whether alone or together with other words;
- (b) impersonates or falsely purports to be an employee or agent of the Agency; or
- (c) uses a word or acts in a manner, that would reasonably lead a person to believe that, that person's office is officially connected with the Agency.

False
representation
about
Agency

(2) A person convicted of an offence under subsection (1) is liable to a fine not exceeding two hundred thousand penalty units or to imprisonment for a term not exceeding two years, or to both.

131. A person commits an offence if that person—

- (a) provides false information in an application for a registration made in accordance with this Act;
- (b) after having been sworn, wilfully gives false evidence before the Registrar knowing the evidence to be false; or
- (c) aids, abets, counsels or procures the commission of an offence or is in any way directly or indirectly a party to the commission of an offence under this Act.

General
offences

(2) A person convicted of an offence under subsection (1) is liable to a fine not exceeding three hundred thousand penalty units or to imprisonment for a term not exceeding three years, or to both.

132. (1) An authorised officer may arrest, without a warrant, a person who—

- (a) sells or offers for sale a good or service to which a registered trade mark is falsely applied;
- (b) has, or is reasonably suspected of having, in that person's possession, for the purpose of trade or manufacture, a good to which a registered trade mark is falsely applied; or
- (c) deals in a counterfeit trade mark good in a manner prohibited under section 122 (1).

Arrests and
inspections

(2) An authorised officer who makes an arrest under subsection (1) shall, without undue delay, have the person arrested brought to a police station.

(3) An authorised officer may, with a warrant, at any reasonable time—

(a) enter and search any premises or private dwelling where that authorised officer has reasonable cause for suspecting that there is a—

(i) good that is the subject of an offence under this Part;

(ii) material or article that is being, or has been, used in the commission of an offence under this Part; or

(iii) document that evidences that an offence has been committed under this Part; and

(b) seize and detain a good, material, article or document found at the premises or private dwelling connected with the commission of an offence under this Part.

(4) An authorised officer who seizes and detains a good, material, article or document under subsection (3) shall, within sixty days of the seizure and detention, commence or cause to be commenced criminal proceedings against the person alleged to have committed an offence under this Part.

(5) An authorised officer shall return a seized and detained good, material, article or document to the person in whose possession that good, material, article or document was at the time of seizure and detention if criminal proceedings are not commenced within the period specified in subsection (4).

(6) Where it is not reasonably practicable to return a seized and detained good, material, article or document, the seized and detained good, material, article or document shall be dealt with in accordance with any written law relating to the detention and disposal of seized and detained property.

PART XIII
GENERAL PROVISIONS

133. (1) The Agency shall keep and maintain a Register of trade marks and geographical indications in which the Registrar shall enter the following information:

Register of trade marks and geographical indications

- (a) particulars of a registered trade mark and geographical indication, including conditions and limitation imposed at the time of registration of the trade mark and geographical indication;
- (b) particulars of any transaction required to be registered under this Act; or
- (c) any other matter relating to a trade mark or geographical indication as the Minister may prescribe.

(2) The Register under subsection (1) shall be maintained in electronic and non-electronic form.

(3) Subject to this Act, the Register shall be kept in the custody of the Registrar at the offices of the Agency and shall be open for inspection to the public during normal office hours, on payment of a prescribed fee.

134. (1) A certificate purporting to be signed by the Registrar and certifying that an entry, which the Registrar is authorised in accordance with this Act to make, has, or has not, been made or that any other thing which the Registrar is authorised to do, has, or has not, been done, shall be *prima facie* evidence of the matter so certified.

Evidence of certain entries and documents

(2) A copy of an entry or a document or an extract from the Register or register of trade mark agents certified by the Registrar shall be admitted in evidence without further proof and without production of the original.

(3) The Registrar may, on an application by a person, issue to that person a certified extract from, or a copy of, an entry in the Register or register of trade mark agents on payment of a prescribed fee.

135. (1) The Registrar may, on an application by a proprietor in the prescribed manner and form, on payment of a prescribed fee, rectify the Register by—

Rectification of Register

- (a) correcting an error in the name, address or description of a proprietor;

- (b) entering a change in the name, address or description of a proprietor;
- (c) striking out a good from those in respect of which a trade mark is registered; or
- (d) entering a disclaimer or statement relating to a registered trade mark.

(2) Despite subsection (1), the Registrar may, on the Registrar's own motion rectify an error or omission without an application under subsection (1), and shall give notice to a proprietor affected by the rectification.

(3) The Registrar shall not effect a rectification in respect of a matter that affects the validity of a registration of a trade mark.

Amendment
of Register
for
adaptation
of
classification

136. (1) The Registrar may, on application by a proprietor in the prescribed manner and form on payment of a prescribed fee, amend the Register by adapting the designation of a good or service in respect of which a trade mark is registered to conform to a change that has occurred in the classification of a good or service.

(2) The Registrar may, where there is a change in the classification of a good or service, request a proprietor to file an application for an amendment within a specified period.

(3) The Registrar may cancel or refuse to renew a registration of a trade mark where a proprietor fails to comply with the request by the Registrar under subsection (2).

Intellectual
Property
Journal

137. The Registrar shall, at intervals as prescribed, publish in the Intellectual Property Journal particulars required to be published under this Act and other information relating to a trade mark and geographical indication that the Registrar considers appropriate.

Correction
of error in
document

138. (1) The Registrar may authorise the correction of a clerical error in a document filed with the Agency on request by an applicant in the prescribed manner and form on payment of the prescribed fee.

(2) The Registrar shall, where an error in a document filed with the Agency is identified by the Registrar, notify an applicant, in writing, to correct the clerical error in a prescribed manner and form on payment of a prescribed fee.

Service of
documents
by Registrar

139. (1) Despite any other written law, the Registrar shall serve a document under this Act, in the case of—

- (a) a company, by delivery of the document to—

- (i) the registered office of the company; or
- (ii) an agent of the company; or
- (b) an individual, by personally serving the individual or agent of that individual.
- (2) Where service in the manner specified under subsection (1) is not practicable or expedient, a document may be served by—
- (a) registered mail or electronic mail; or
- (b) publication in a daily newspaper of general circulation in the Republic.
- (3) Where a document is sent by electronic means, service is considered to be effected when the complete data message enters an information system designated or used for that purpose in accordance with the Electronic Communications and Transactions Act, 2021.
- 140.** (1) An application, notice or document required to be filed with, or served on, the Registrar shall be filed or served in accordance with this Act.
- (2) Where a document is filed or served by electronic means, the document is considered to be filed or served when the complete data message enters an information system designated or used for that purpose in accordance with the Electronic Communications and Transactions Act, 2021.
- 141.** (1) The Registrar may, on an application made by a person who intends to register a trade mark, give advice or issue a report as to whether the trade mark may be registered under this Act in the prescribed manner and on payment of a prescribed fee.
- (2) The Registrar's advice given under subsection (1) shall not be binding on the Registrar as to the registrability of a trade mark.
- 142.** Subject to this Act, the Registrar shall, on a request by a person in the prescribed manner and form, on payment of a prescribed fee, furnish copies of a document that is open to public inspection and required to be maintained in accordance with this Act.
- 143.** (1) The Registrar may, in any proceedings under this Act—
- (a) summon a witness;
- (b) receive written or oral evidence, on oath or affirmation;
- (c) require the production of a document, good, material or article for inspection;

Act No. 4
of 2021Filing and
service of
documents
on RegistrarAct No. 4
of 2021Preliminary
advice and
searchRequest for
informationPowers of
Registrar in
proceedings

- (d) provide for the manner of inspection of a document, good, material or article;
- (e) hear the matter in issue and rely on the evidence of any expert that the Registrar considers necessary to consult;
- (f) allow a witness to be cross examined on oral evidence or evidence adduced in an affidavit or solemn declaration;
- (g) in the case of a party to the proceedings who is resident outside the Republic, order that party to give security for costs of the proceedings within a period that the Registrar may direct;
- (h) award, to a party, costs as the Registrar may consider reasonable and direct how the costs are to be paid, and the costs awarded shall be taxed by the Court and the payment of the costs may be enforced in the same manner as if the costs were awarded by the Court; or
- (i) exercise any other power as the Registrar considers appropriate for the performance of the Registrar's functions under this Act.

(2) The Registrar may make an order as the Registrar considers appropriate regarding any matter under subsection (1).

Registrar not bound by rules of evidence

144. The Registrar is not bound by the rules of evidence in any proceedings under this Act.

Power of Registrar to determine time and place of sitting

145. The Registrar may determine the time and place at which proceedings shall take place.

Extension of time

146. The Registrar may, on an application by a person in a prescribed manner and form on payment of a prescribed fee, extend the prescribed time for performing an act that is required under this Act.

Appeal against decision of Registrar

147. (1) A person that is dissatisfied with the decision of the Registrar made under this Act may appeal to the Court within ninety days of the person's receipt of the decision.

(2) The Registrar shall, where an appeal has been lodged in accordance with subsection (1), submit to the Court a record of the proceedings or any other relevant documents in relation to the appeal.

- 148.** The Registrar shall, where the Registrar is required, as provided in this Act, to do any act or thing and no time or period is provided within which the act or thing is to be done, be required to do the act or thing as soon as is practicable. Registrar to act as soon as practicable
- 149.** (1) A proprietor shall, where a certificate issued in accordance with this Act is lost or destroyed, apply to the Registrar for a duplicate certificate of registration, in a prescribed manner and form on payment of the prescribed fee. Duplicate certificate
- (2) The Registrar may, on receipt of an application under subsection (1), issue a replacement certificate in a prescribed form.
- 150.** The forfeiture and confiscation orders provisions in the Forfeiture of Proceeds of Crime Act, 2010, apply to the prosecution of offences under this Act. Forfeiture and confiscation orders Act No. 19 of 2010
- 151.** (1) The Registrar may impose an administrative penalty on a person for failure to comply with a provision that is not an offence under this Act. Administrative penalty
- (2) An administrative penalty under subsection (1) shall be as prescribed.
- (3) An administrative penalty imposed in accordance with subsection (1) shall be paid to the Agency in a prescribed manner and form.
- (4) The Registrar may, where a person fails to pay an administrative penalty, within a prescribed period, by way of civil action in a competent court, recover the amount of the administrative penalty from that person as an amount due and owing to the Agency.
- 152.** A person who contravenes any provision of this Act where no specific penalty has been provided is liable, on conviction, to a fine not exceeding two hundred thousand penalty units or to imprisonment for a term not exceeding two years, or to both. General penalty
- 153.** Where an offence under this Act is committed by a body corporate or unincorporate body, with the knowledge, consent or connivance of the director, manager, shareholder or partner, that director, manager, shareholder or partner of the body corporate or unincorporate body commits an offence and is liable, on conviction, to the penalty specified for that offence. Offence by principal officer, shareholder or partner or body corporate or unincorporate body
- 154.** (1) The Minister may, by statutory instrument, make Regulations to give effect to the provisions of the Madrid Protocol in the Republic. Regulations to give effect to Madrid Protocol

(2) Despite subsection (1), Regulations made under this section may provide for—

- (a) the procedure for making an application for international registration of a mark where the Agency is the office of origin;
- (b) the procedure to be followed where the basic application or registration fails or ceases to be in force;
- (c) the procedure to be followed where the Agency receives from the International Bureau a request for extension of protection to the Republic;
- (d) the effect of a successful request for extension of protection to the Republic;
- (e) the transformation of an application for an international registration, or an international registration, into a national application for registration;
- (f) the communication of information to the International Bureau;
- (g) the fee for an application for international registration, extension of protection and renewal of an international registration; and
- (h) any other matter necessary to give effect to the provisions of the Madrid Protocol.

Regulations

155. (1) The Minister may, by statutory instrument, make Regulations for the better carrying out of the provisions of this Act.

(2) Despite the generality of subsection (1), Regulations made by the Minister may make provision for—

- (a) administrative requirements or any necessary details for the implementation of this Act and any relevant international treaty or convention to which the Republic is a State Party;
- (b) procedures and conditions for applications for a trade mark and geographical indication in accordance with this Act;
- (c) forms to be used for purposes of this Act;
- (d) fees to be charged for purposes of this Act;
- (e) registration of trade mark agents;
- (f) classifying a good or service for the purposes of registration of trade marks;
- (g) procedures, requirements, and other matters, in respect of a registration, renewal, alteration or cancellation, of trade marks under this Act.

Repeal of
Cap. 401
and savings
and
transitional
provisions

156. (1) The Trade Marks Act, 1958, is repealed.

(2) Despite subsection (1), the Schedule applies to the savings and transitional provisions for purposes of this Act.

SCHEDULE
(Section 156 (2))

SAVINGS AND TRANSITIONAL PROVISIONS

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| <p>1. Any act done or executed in accordance with the repealed Act and in force and operative at the commencement of this Act has effect as if done or executed in accordance with this Act.</p> | <p>Acts done under repealed Act to remain valid</p> |
| <p>2. An application for the registration of a trade mark made under the repealed Act prior to the commencement of this Act shall be processed in accordance with this Act.</p> | <p>Previous application</p> |
| <p>3. (1) The enactment of this Act does not affect any investigations or legal proceedings instituted under the repealed Act, which were pending before the Registrar or in court, immediately before the date of commencement of this Act, and such investigations or proceedings shall be disposed of as if this Act had not been passed.</p> | <p>Pending proceedings</p> |
| <p>(2) An appeal which, immediately before the commencement of this Act, was pending shall proceed as if this Act had not been passed.</p> | |
| <p>4. (1) A trade mark registered in accordance with the repealed Act shall remain valid until the expiry of the registration and the renewal of that trade mark shall be made in accordance with this Act.</p> | <p>Existing registered trade mark</p> |
| <p>(2) A reference in this Act, express or implied, to the date of registration of a trade mark under subparagraph (1) shall be construed as a reference to the date on which the trade mark was registered in accordance with the repealed Act.</p> | <p>CAp. 401</p> |
| <p>5. A trade mark agent registered under the repealed Act shall apply for registration as a trade mark agent within six months of the commencement of this Act.</p> | <p>Trade mark agents</p> |
| <p>6. A Register or any other register kept in accordance with the repealed Act, shall be considered to be part of the Register kept in accordance with this Act.</p> | <p>Register under repealed Act Cap.401</p> |
| <p>7. Infringement proceedings of a registered trade mark under the repealed Act shall be disposed of in accordance with the repealed Act.</p> | <p>Infringements under repealed Act Cap.401</p> |
| <p>8. A fee paid or unpaid before the commencement of this Act shall be considered to be a fee paid or unpaid, in accordance with this Act.</p> | <p>Fee, charge or sum paid or unpaid in accordance with repealed Act</p> |

Approvals
and
authorisations
Cap.401

Cap.401

9. An approval given or authorisation granted before the commencement of this Act or any act or thing done in accordance with the repealed Act, shall be considered to have been given or authorised under this Act, and any approval or authorisation shall remain valid for the period specified under the repealed Act.
