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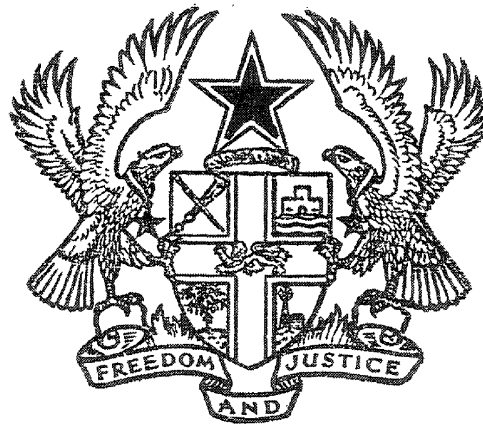
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FIRST SCHEDULE

CERTIFICATION TRADE MARKS

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TRANSITIONAL PROVISIONS



THE TWO HUNDRED AND SEVENTIETH

ACT

OF THE PARLIAMENT OF THE REPUBLIC
OF GHANA

ENTITLED

THE TRADE MARKS ACT, 1965

AN ACT to consolidate and amend the law relating to trade marks.

DATE OF ASSENT: *25th February, 1965*

BE IT ENACTED by the President and the National Assembly in this present Parliament assembled as follows:—

PART I—PROVISIONS RELATING TO REGISTRATION

The register
of trade
marks and
the
Registrar.

1. (1) There shall continue to be kept at the Registrar's office for the purpose of this Act a book called the register of trade marks, in which shall be entered all registered trade marks with the names, addresses and descriptions of their proprietors, notifications of assignments and transmissions, the names, addresses and descriptions of all registered users, disclaimers, conditions, limitations, and such other matters relating to registered trade marks as may be prescribed.

(2) The register shall continue to consist of two parts called respectively Part A and Part B.

(3) The register shall at all convenient times be open to the inspection of the public, subject to such regulations as may be made under section 65 of this Act.

(4) The register shall be kept under the control and management of the Registrar.

(5) The Registrar-General is the registrar of trade marks for the purposes of this Act, in this Act referred to as "the Registrar".

(6) The register may, in lieu of being kept in the form of a book, be kept in such other form of record as may from time to time be approved by the Minister.

(7) The register of trade marks existing immediately before the commencement of this Act shall form part of the register.

2. No person is entitled to institute any proceeding to prevent, or to recover damages for, the infringement of an unregistered trade mark, but nothing in this Act shall be deemed to affect rights of action against any person for passing off goods as the goods of another person or the remedies in respect thereof.

No action for infringement of unregistered trade mark.

3. A trade mark must be registered in respect of particular goods or classes of goods, and any question arising as to the class within which any goods fall shall be decided by the Registrar.

Registration to be in respect of particular goods.

4. (1) Subject to the provisions of this section, and to sections 7 and 8 of this Act, the registration (whether before or after the commencement of this Act) of a person in Part A of the register as proprietor of a trade mark (other than a certification trade mark) in respect of any goods shall, if valid, give or be deemed to have given to that person the exclusive right to the use of the trade mark in relation to those goods.

Right given by registration in Part A and infringement thereof.

(2) Without prejudice to the generality of subsection (1) of this section the right referred to in that subsection shall be deemed to be infringed by any person who, not being the proprietor of the trade mark or a registered user thereof using by way of the permitted use, uses a mark identical with it or so nearly resembling it as to be likely to deceive or cause confusion, in the course of trade, in relation to any goods in respect of which it is registered, and in such manner as to render the use of the mark likely to be taken either—

(a) as being used as a trade mark; or

(b) in a case in which the use is use upon the goods or in physical relation thereto or in an advertising circular or other advertisement issued to the public, as importing a reference to some person having the right either as proprietor or as registered user to use the trade mark or to goods with which such a person is connected in the course of trade.

(3) The right to the use of a trade mark given by virtue of this section by registration shall be subject to any conditions or limitations entered on the register, and shall not be deemed to be infringed by the use of any such mark as is referred to in subsection (2) of this section in any mode, in relation to goods to be sold or otherwise traded in in any place, in relation to goods to be exported to any market, or in any other circumstances, to which, having regard to any such limitations, the registration does not extend.

(4) The said right shall not be deemed to be infringed by the use of any such mark by any person—

(a) in relation to goods connected in the course of trade with the proprietor or a registered user of the trade mark if, as to those goods or a bulk of which they form part, the proprietor or the registered user conforming to the permitted use has applied the trade mark and has not subsequently removed or obliterated it, or has at any time expressly or impliedly consented to the use of the trade mark; or

(b) in relation to goods adapted to form part of, or to be accessory to, other goods in relation to which the trade mark has been used without infringement of the right given by registration or might for the time being be so used, if the use of the mark is reasonably necessary in order to indicate that the goods are so adapted and neither the purpose nor the effect of the use of the mark is to indicate otherwise than in accordance with the fact a connection in the course of trade between any person and the goods.

(5) The use of a registered trade mark, being one of two or more registered trade marks that are identical or nearly resemble each other, in exercise of the right to the use of that trade mark given by virtue of this section by registration shall not be deemed to be an infringement of the right so given to the use of any other of those trade marks.

Right given
by registra-
tion in Part
B and in-
fringement
thereof.

5. (1) Except as provided by subsection (2) of this section, the registration (whether before or after the commencement of this Act) of a person in Part B of the register as proprietor of a trade mark in respect of any goods shall, if valid, give or be deemed to have given to that person the like right in relation to those goods as if the registration had been in Part A of the register, and the provisions

of section 4 of this Act shall have effect in like manner in relation to a trade mark registered in Part B of the register as they have effect in relation to a trade mark registered in Part A of the register.

(2) In any action for infringement of the right to the use of a trade mark given under subsection (1) of this section by registration in Part B of the register, otherwise than by an act that is deemed to be an infringement by virtue of section 6 of this Act, no injunction or other relief shall be granted to the plaintiff if the defendant establishes to the satisfaction of the Court that the use of which the plaintiff complains is not likely to deceive or cause confusion or to be taken as indicating a connection in the course of trade between the goods and some person having the right either as proprietor or as registered user to use the trade mark.

6. (1) Where, by a contract in writing made with the proprietor or a registered user of a registered trade mark, a purchaser or owner of goods enters into an obligation to the effect that he will not do, in relation to the goods, an act to which this section applies, any person who, being the owner for the time being of the goods and having notice of the obligation, does that act, or authorises it to be done, in relation to the goods, in the course of trade or with a view to any dealing therewith in the course of trade, shall be deemed thereby to infringe the right to the use of the trade mark given by the registration thereof, unless that person became the owner of the goods by purchase for money or money's worth in good faith before receiving notice of the obligation or by virtue of a title derived through another who so became the owner thereof.

Infringe-
ment by
breach of
certain
restrictions.

(2) The acts to which this section applies are—

- (a) the application of the trade mark upon the goods after they have suffered alteration in any manner specified in the contract as respects their state or condition, get-up or packing;
- (b) in a case in which the trade mark is upon the goods, the alteration, part removal or part obliteration thereof;
- (c) in a case in which the trade mark is upon the goods, and there is also thereon other matter, being matter indicating a connection in the course of trade between the proprietor or registered user and the goods, the removal or obliteration, whether wholly or partly, of the trade mark unless that other matter is wholly removed or obliterated;
- (d) in a case in which the trade mark is upon the goods, the application of any other trade mark to the goods;
- (e) in a case in which the trade mark is upon the goods, the addition to the goods of any other matter in writing that is likely to injure the reputation of the trade mark.

(3) In this section references in relation to any goods to the proprietor, to a registered user, and to the registration, of a trade mark shall be construed, respectively, as references to the proprietor in whose name the trade mark is registered, to a registered user who is registered, and to the registration of the trade mark, in respect of those goods, and "upon" includes in relation to any goods a reference to physical relation thereto.

Saving for
vested rights.

7. Nothing in this Act shall entitle the proprietor or a registered user of a registered trade mark to interfere with or restrain the use by any person of a trade mark identical with or nearly resembling it in relation to goods in relation to which that person or a predecessor in title of his has continuously used that trade mark from a date anterior—

- (a) to the use of the first-mentioned trade mark in relation to those goods by the proprietor or a predecessor in title of his; or
- (b) to the registration of the first-mentioned trade mark in respect of those goods in the name of the proprietor or a predecessor in title of his;

whichever is the earlier, or to object (on such use being proved) to that person being put on the register for that identical or nearly resembling trade mark in respect of those goods under subsection (2) of section 12 of this Act.

Saving for
use of name,
address or
description
of goods.

8. No registration of a trade mark shall interfere with—

- (a) any *bona fide* use by a person of his own name or of the name of his place of business, or of the name, or of the name of the place of business, of any of his predecessors in business; or
- (b) the use by any person of any *bona fide* description of the character or quality of his goods, not being a description that would be likely to be taken as importing any such reference as is mentioned in paragraph (b) of subsection (2) of section 4, or in paragraph (b) of subsection (4) of section 36, of this Act.

Distinctive-
ness requi-
site for regis-
tration in
Part A.

9. (1) To be registrable in Part A of the register a trade mark (other than a certification trade mark) must contain or consist of at least one of the following essential particulars:

- (a) the name of a company, individual, or firm, represented in a special or particular manner;
- (b) the signature of the applicant for registration or some predecessor in his business;
- (c) an invented word or invented words;
- (d) a word or words having no direct reference to the character or quality of the goods, and not being according to its ordinary signification a geographical name or a surname;
- (e) any other distinctive mark;

but a name, signature, or word or words, other than such as fall within the descriptions in paragraphs (a), (b), (c) and (d) of this subsection, shall not be registrable under paragraph (e) except upon evidence of its distinctiveness.

(2) For the purposes of this section “distinctive” means adapted, in relation to the goods in respect of which a trade mark is registered or proposed to be registered, to distinguish goods with which the proprietor of the trade mark is or may be connected in the course of trade from goods in the case of which no such connection subsists, either generally or, where the trade mark is registered or proposed to be registered subject to limitations, in relation to use within the extent of the registration.

(3) In determining whether a trade mark is adapted to distinguish any goods as required by subsection (2) of this section the Court or the Registrar (as the case may be) may have regard to the extent to which—

- (a) the trade mark is inherently adapted so to distinguish the goods; and
- (b) by reason of the use of the trade mark or of any other circumstances, the trade mark is in fact adapted so to distinguish the goods.

10. (1) To be registrable in Part B of the register, a trade mark must be capable, in relation to the goods in respect of which it is registered or proposed to be registered, of distinguishing goods with which the proprietor of the trade mark is or may be connected in the course of trade from goods in the case of which no such connection subsists, either generally or, where the trade mark is registered or proposed to be registered subject to limitations, in relation to use within the extent of the registration.

Capability of distinguishing requisite for registration in Part B.

(2) In determining whether a trade mark is capable of distinguishing any goods as required by subsection (1) of this section, the Court or the Registrar (as the case may be) may have regard to the extent to which—

- (a) the trade mark is inherently capable of so distinguishing the goods; and
- (b) by reason of the use of the trade mark or of any other circumstances, the trade mark is in fact capable of so distinguishing the goods.

(3) A trade mark may be registered in Part B notwithstanding any registration in Part A in the name of the same proprietor of the same trade mark or any part or parts thereof.

Prohibition of registration of deceptive and certain other matter.

11. It shall not be lawful to register as a trade mark or part of a trade mark any matter the use of which would, by reason of its being likely to deceive or cause confusion or otherwise, be disentitled to protection in a court of law, or would be contrary to law or morality, or any scandalous design.

Prohibition of registration of identical and resembling trade marks.

12. (1) Subject to subsection (2) of this section, no trade mark shall be registered in respect of any goods or description of goods that is identical with a trade mark belonging to a different proprietor and already on the register in respect of the same goods or description of goods, or that so nearly resembles such a trade mark as to be likely to deceive or cause confusion.

(2) In case of honest concurrent use, or of other special circumstances which in the opinion of the Court or the Registrar make it proper so to do, the Court or the Registrar (as the case may be) may permit the registration of trade marks that are identical or nearly resemble each other in respect of the same goods or description of goods by more than one proprietor subject to such conditions and limitations, if any, as the Court or the Registrar (as the case may be) may think it right to impose.

(3) Where separate applications are made by different persons to be registered as proprietors respectively of trade marks that are identical or nearly resemble each other, in respect of the same goods or description of goods, the Registrar may refuse to register any of them until their rights have been determined by the Court, or have been settled by agreement in a manner approved by him or by the Court on an appeal, as the case may be.

Registration in Part A to be conclusive as to validity after seven years.

13. (1) In all legal proceedings relating to a trade mark registered in Part A of the register (including applications under section 32 of this Act) the original registration in Part A of the register of the trade mark shall, after the expiration of seven years from the date of that registration, be taken to be valid in all respects, unless—

- (a) that registration was obtained by fraud, or
- (b) the trade mark offends against section 11 of this Act.

(2) Nothing in subsection (1) of section 5 of this Act shall be construed as making applicable to a trade mark, as being a trade mark registered in Part B of the register, the provisions of subsection (1) of this section relating to a trade mark registered in Part A of the register.

14. If a trade mark—

- (a) contains any part not separately registered by the proprietor as a trade mark; or
- (b) contains matter common to the trade or otherwise of a non-distinctive character;

Registration subject to disclaimer.

the Court or the Registrar (as the case may be), in deciding whether the trade mark shall be entered or shall remain on the register, may require as a condition of its being on the register—

- (i) that the proprietor shall disclaim any right to the exclusive use of any part of the trade mark, or to the exclusive use of all or any portion of any such matter, to the exclusive use of which the Court or the Registrar (as the case may be) holds him not to be entitled; or

- (ii) that the proprietor shall make such other disclaimer as the Court or the Registrar (as the case may be) may consider necessary for the purpose of defining his rights under the registration:

Provided that no disclaimer on the register shall affect any rights of the proprietor of a trade mark except such as arise out of the registration of the trade mark in respect of which the disclaimer is made.

15. (1) Subject to the provisions of this section, the registration of a trade mark shall not be deemed to have become invalid by reason only of any use, after the date of the registration, of a word or words which the trade mark contains, or of which it consists, as the name or description of an article or substance.

Words used as name or description of an article or substance.

(2) If it is proved that there is a well-known and established use of the word or words as the name or description of the article or substance by a person or persons carrying on a trade therein, not being use in relation to goods connected in the course of trade with the proprietor or a registered user of the trade mark or (in the case of a certification trade mark) goods certified by the proprietor the provisions of subsection (3) of this section shall have effect.

(3) Where the facts mentioned in subsection (2) of this section are proved with respect to any word or words, then—

- (a) if the trade mark consists solely of that word or those words, the registration of the trade mark, so far as regards registration in respect of the article or substance in question or of any goods of the same description, shall be deemed for the purposes of section 32 of this Act to be an entry wrongly remaining on the register:
- (b) if the trade mark contains that word or those words and other matter, the Court or the Registrar (as the case may be), in deciding whether the trade mark shall remain on the register, so far as regards registration in respect of the article or substance in question and of any goods of the same description, may in case of a decision in favour of its remaining on the register require as a condition thereof that the proprietor shall disclaim any right to the exclusive use in relation to that article or substance and any goods of the same description of that word or those words, so, however, that no disclaimer on the register shall affect any rights of the proprietor of a trade mark except such as arise out of the registration of the trade mark in respect of which the disclaimer is made; and
- (c) for the purposes of any other legal proceedings relating to the trade mark—

- (i) if the trade mark consists solely of that word or those words, all rights of the proprietor, whether under the common law or by registration, to the exclusive use of the trade mark in relation to the article or substance in question or to any goods of the same description, or
- (ii) if the trade mark contains that word or those words and other matter, all such rights of the proprietor to the exclusive use of that word or those words in relation to the article or substance in question or to any goods of the same description,

shall be deemed to have ceased on the date at which the use mentioned in subsection (2) of this section first became well known and established.

(4) No word which is the commonly used and accepted name of any single chemical element or single chemical compound, as distinguished from a mixture, shall be registered as a trade mark in respect of a chemical substance or preparation, and any such registration in force at the commencement of this Act or thereafter shall, notwithstanding section 13 of this Act, be deemed for the purposes of section 32 of this Act to be an entry made in the register without sufficient cause, or an entry wrongly remaining on the register, as the circumstances may require.

(5) Subsection (4) of this section shall not have effect in relation to a word which is used to denote only a brand or make of the element or compound as made by the proprietor or a registered user of the trade mark, as distinguished from the element or compound as made by others and in association with a suitable name or description open to the public use.

16. (1) A trade mark may be limited in whole or in part to one or more specified colours, and in any such case the fact that it is so limited shall be taken into consideration by the Court or the Registrar (as the case may be) when deciding on the distinctive character of the trade mark.

Effect of limitation as to colour and of absence thereof.

(2) If and so far as a trade mark is registered without limitation of colour, it shall be deemed to be registered for all colours.

17. (1) Any person claiming to be the proprietor of a trade mark used or proposed to be used by him who is desirous of registering it must apply in writing to the Registrar in the prescribed manner for registration either in Part A or in Part B of the register.

Application for registration.

(2) Subject to this Act, the Registrar may refuse the application, or may accept it absolutely or subject to such amendments, modifications, conditions or limitations, if any, as he may think right.

(3) In the case of an application for registration of a trade mark (other than a certification trade mark) in Part A of the register, the Registrar may, if the applicant is willing, instead of refusing the application, treat it as an application for registration in Part B and deal with the application accordingly.

(4) In the case of a refusal or conditional acceptance, the Registrar shall, if required by the applicant within the prescribed time, state in writing the grounds of his decision and the materials used by him in arriving thereat.

(5) An applicant desiring to appeal under section 48 of this Act against a decision of the Registrar under this section must apply to the Registrar under subsection (4) of this section for the statement in writing therein referred to, and on the appeal the Court shall, if required, hear the applicant and the Registrar, and shall make an order determining whether, and subject to what amendments, modifications, conditions or limitations, if any, the application is to be accepted.

(6) Except by leave of the Court no appeal against a decision of the Registrar under this section shall be made save within a period of two months from the date of dispatch to the applicant of the statement in writing referred to in subsection (4) of this section or within such further period not exceeding three months as the Registrar may allow (upon request received before the expiration of the said period of two months).

(7) Appeals under section 48 of this Act against decisions of the Registrar under this section shall be heard on the materials stated under subsection (4) of this section by the Registrar, and no further grounds of objection to the acceptance of the application shall be allowed to be taken by the Registrar, other than those so stated by him, except by leave of the Court.

(8) The Registrar or the Court (as the case may be) may at any time, whether before or after acceptance, correct any error in or in connection with the application, or may permit the applicant to amend his application upon such terms as the Registrar or the Court (as the case may be) may think fit.

Opposi-
tion to
registration.

18. (1) When an application for registration of a trade mark has been accepted, whether absolutely or subject to conditions or limitations, the Registrar shall, as soon as may be after acceptance, cause the application as accepted to be advertised in the prescribed manner, and the advertisement shall set forth all conditions and limitations subject to which the application has been accepted :

Provided that the Registrar may cause an application to be advertised before acceptance in any case where it appears to him that it is expedient by reason of any exceptional circumstances so to do, and where an application has been so advertised the Registrar may, if he thinks fit, advertise it again when it has been accepted but shall not be bound so to do.

(2) Any person may, within the prescribed time from the date of the advertisement of an application, give notice to the Registrar of opposition to the registration.

(3) The notice shall be given in writing in the prescribed manner, and shall include a statement of the grounds of opposition.

(4) The Registrar shall send a copy of the notice to the applicant, and within the prescribed time after receipt thereof the applicant must send to the Registrar in the prescribed manner, a counter-statement of the grounds on which he relies for his application, and, if he does not do so, he shall be deemed to have abandoned his application.

(5) If the applicant sends a counter-statement under subsection (4) of this section, the Registrar shall furnish a copy thereof to the persons giving notice of opposition and shall, after hearing the parties, if so required, and considering the evidence, decide whether, and subject to what conditions or limitations, if any, registration is to be permitted and shall notify the applicant and the opponent accordingly.

(6) The applicant or the opponent may, within the prescribed time after the date of notification of the decision of the Registrar, apply to the Registrar for a written statement of the grounds of his decision.

(7) A person desiring to appeal under section 48 of this Act against a decision of the Registrar under this section must apply to the Registrar under subsection (6) of this section for the written statement therein referred to, and on the appeal the Court shall, if required, hear the parties and the Registrar and shall make an order determining whether, and subject to what conditions or limitations, if any, registration is to be permitted.

(8) Except by leave of the Court, no appeal against a decision of the Registrar under this section shall be made save within a period of two months from the date of dispatch to the applicant of the statement in writing referred to in subsection (6) of this section or within such further period not exceeding three months as the Registrar may allow (upon request received before the expiration of the said period of two months).

(9) On the hearing of an appeal under section 48 of this Act against a decision of the Registrar under this section any party may, either in the manner prescribed or by special leave of the Court, bring forward further material for the consideration of the Court.

(10) On an appeal under section 48 of this Act against a decision of the Registrar under this section no further grounds of objection to the registration of a trade mark shall be allowed to be taken by the opponent or the Registrar, other than those stated under subsection (3) of this section by the opponent, except by leave of the Court.

(11) Where any further grounds of objection are taken under subsection (10) the applicant is entitled to withdraw his application without payment of the costs of the opponent on giving notice as prescribed.

(12) On an appeal under section 48 of this Act against a decision of the Registrar under this section the Court may, after hearing the Registrar, permit the trade mark proposed to be registered to be modified in any manner not substantially affecting the identity thereof, but in any such case the trade mark as so modified shall be advertised in the prescribed manner before being registered.

(13) If a person giving notice of opposition or an applicant sending a counter-statement after receipt of a copy of such notice, or an appellant, neither resides nor carries on business in Ghana, the Court (in the case of an appeal) or the Registrar (in any other case) may require him to give security for costs of the proceedings and, in default of such security being duly given, may treat the opposition or application, or the appeal, as the case may be, as abandoned.

Registration. 19. (1) When an application for registration of a trade mark in Part A or in Part B of the register has been accepted, and either—

(a) the application has not been opposed and the time for notice of opposition has expired, or

(b) the application has been opposed and the opposition has been decided in favour of the applicant,

the Registrar shall, unless the application has been accepted in error, register the trade mark in Part A or Part B, as the case may be, and the trade mark, when registered, shall be registered as of the date of the application for registration, and that date shall be deemed for the purposes of this Act to be the date of registration.

(2) On the registration of a trade mark the Registrar shall issue to the applicant a certificate in the prescribed form of the registration thereof sealed with the official seal of the Registrar.

(3) Where registration of a trade mark is not completed within twelve months from the date of the application by reason of default on the part of the applicant, the Registrar may, after giving notice of the non-completion to the applicant in writing in the prescribed manner, treat the application as abandoned unless it is completed within the time specified in that behalf in the notice.

Duration and
renewal of
registration.

20. (1) The registration of a trade mark shall be for a period of seven years, but may be renewed from time to time in accordance with this section:

Provided that, in relation to a registration as of a date before the commencement of this Act, this subsection shall have effect with the substitution of a period of fourteen years for the said period of seven years.

(2) The Registrar shall, on application made by the registered proprietor of a trade mark in the prescribed manner and within the prescribed period, renew the registration of the trade mark for a period of fourteen years from the date of expiration of the original registration or of the last renewal of registration, as the case may be, which date is in this section called "the expiration of the last registration".

(3) At the prescribed time before the expiration of the last registration of a trade mark, the Registrar shall send notice in the prescribed manner to the registered proprietor of the date of expiration and the conditions as to payment of fees and otherwise upon which a renewal of registration may be obtained, and, if at the expiration of the time prescribed in that behalf those conditions have not been duly complied with, the Registrar may remove the trade mark from the register, subject to such conditions, if any, as to its restoration to the register as may be prescribed.

(4) Subject to subsection (5) of this section, where a trade mark has been removed from the register for non-payment of the fee for renewal, it shall, nevertheless, for the purpose of any application for the registration of a trade mark during one year next after the date of the removal, be deemed to be a trade mark that is already on the register.

(5) Subsection (4) of this section shall not apply where the Court or the Registrar (as the case may be) is satisfied either—

- (a) that there has been no *bona fide* trade use of the trade mark that has been removed during the two years immediately preceding its removal; or
- (b) that no deception or confusion would be likely to arise from the use of the trade mark that is the subject of the application for registration by reason of any previous use of the trade mark that has been removed.

21. (1) Where the proprietor of a trade mark claims to be entitled to the exclusive use of any part thereof separately, he may apply to register the whole and any such part as separate trade marks.

(2) Each such separate trade mark must satisfy all the conditions of an independent trade mark and shall, subject to subsection (3) of section 23 and subsection (2) of section 30 of this Act, have all the incidents of an independent trade mark.

Registration
of parts of
trade marks
and of trade
marks as a
series.

(3) Where a person claiming to be the proprietor of several trade marks, in respect of the same goods or description of goods, which, while resembling each other in the material particulars thereof, yet differ in respect of—

- (a) statements of the goods in relation to which they are respectively used or proposed to be used; or
- (b) statements of number, price, quality or names of places; or
- (c) other matter of a non-distinctive character which does not substantially affect the identity of the trade mark; or
- (d) colour ;

seeks to register those trade marks, they may be registered as a series in one registration.

Powers of
and restric-
tions on
assignment
and trans-
mission.

22. (1) Subject to this section, a registered trade mark shall be assignable and transmissible either in connection with the goodwill of a business or not.

(2) Subject to this section, a registered trade mark shall be assignable and transmissible in respect either of all the goods in respect of which it is registered, or of some (but not all) of those goods.

(3) Subsection (1) and (2) of this section shall have effect in the case of an unregistered trade mark used in relation to any goods as they have effect in the case of a registered trade mark registered in respect of any goods, if at the time of the assignment or transmission of the unregistered trade mark it is used in the same business as a registered trade mark, and if it is assigned or transmitted at the same time and to the same person as that registered trade mark and in respect of goods all of which are goods in relation to which the unregistered trade mark is used in that business and in respect of which that registered trade mark is assigned or transmitted.

(4) Notwithstanding anything in subsections (1), (2) and (3) of this section, a trade mark shall not be assignable or transmissible in a case in which as a result of an assignment or transmission there would in the circumstances subsist, whether under the common law or by registration, exclusive rights in more than one of the persons concerned to the use, in relation to the same goods or description of goods, of trade marks nearly resembling each other or of identical trade marks, if, having regard to the similarity of the goods and of the trade marks, the use of the trade marks in exercise of those rights would be likely to deceive or cause confusion.

(5) Where a trade mark is assigned or transmitted in such a case as is referred to in subsection (4) of this section, the assignment or transmission shall not be deemed to be invalid under that subsection if the exclusive rights subsisting as a result thereof in the persons concerned respectively are, having regard to limitations imposed thereon, such as not to be exercisable by two or more of those persons in relation to goods to be sold, or otherwise traded in, within Ghana (otherwise than for export therefrom) or in relation to goods to be exported to the same market outside Ghana.

(6) The proprietor of a registered trade mark who proposes to assign it in respect of any goods in respect of which it is registered may submit to the Registrar in the prescribed manner a statement of case setting out the circumstances, and the Registrar may issue to him a certificate stating whether, having regard to the similarity of the goods and of the trade marks referred to in the case, the proposed assignment of the first-mentioned trade mark would or would not be invalid under subsection (4) of this section, and a certificate so issued shall, unless it is shown that the certificate was obtained by fraud or misrepresentation, be conclusive as to the validity or invalidity under subsection (4) of this section of the assignment in so far as such validity or invalidity depends upon the facts set out in the case, but, as regards a certificate in favour of validity, only if application for the registration under section 25 of this Act of the title of the person becoming entitled is made within six months from the date on which the certificate is issued.

(7) Notwithstanding anything in subsections (1), (2) and (3) of this section, but subject to subsection (8) a trade mark shall not be assignable or transmissible in a case in which as a result of an assignment or transmission thereof there would in the circumstances subsist, whether under the common law or by registration, an exclusive right in one of the persons concerned to the use of the trade mark limited to use in relation to goods to be sold, or otherwise traded in, in a place or places in Ghana, and an exclusive right in another of those persons to the use of a trade mark nearly resembling the first-mentioned trade mark or of an identical trade mark in relation to the same goods or description of goods limited to use in relation to goods to be sold, or otherwise traded in, in another place or other places in Ghana;

(8) On application in the prescribed manner by the proprietor of a trade mark who proposes to assign it, or of a person who claims that a trade mark has been transmitted to him or to a predecessor in title of his in any such case as is referred to subsection (7), the Registrar, if he is satisfied that in all the circumstances the use of the trade mark in exercise of the said rights would not be contrary to the public interest, may approve the assignment or transmission, and an assignment or transmission so approved shall not be deemed to be, or to have been, invalid under subsection (7) or subsection (4) of this section, so, however, that in the case of a registered trade mark this subsection shall not have effect unless application for the registration under section 25 of this Act of the title of the person becoming entitled is made within six months from the date on which the approval is given or, in the case of a transmission, was made before that date.

(9) Where an assignment in respect of any goods of a trade mark that is at the time of the assignment used in a business in those goods is made otherwise than in connection with the goodwill of that business, the assignment shall not take effect until, in pursuance of an application made by the assignee in the prescribed manner to the Registrar within a period of six months from the date on which the assignment is made (or within such extended period, if any, as the Registrar may allow) a notice of the assignment is published in the *Gazette*.

Certain trade marks to be associated so as to be assignable as and transmissible as a whole only.

23. (1) Trade marks that are registered as, or that are deemed by virtue of this Act to be, associated trade marks shall be assignable and transmissible only as a whole and not separately, but they shall for all other purposes be deemed to have been registered as separate trade marks.

(2) Where a trade mark that is registered, or is the subject of an application for registration, in respect of any goods is identical with another trade mark that is registered, or is the subject of an application for registration, in the name of the same proprietor in respect of the same goods or description of goods, or so nearly resembles it as to be likely to deceive or cause confusion if used by a person other than the proprietor, the Registrar may at any time require that the trade marks shall be entered on the register as associated trade marks.

(3) Where a trade mark and any part or parts thereof are, by virtue of subsection (1) of section 21 of this Act, registered as separate trade marks in the name of the same proprietor, they shall be deemed to be, and shall be registered as, associated trade marks.

(4) All trade marks that are, by virtue of subsection (3) of section 21 of this Act, registered as a series in one registration shall be deemed to be, and shall be registered as, associated trade marks.

(5) On application made in the prescribed manner by the registered proprietor of two or more trade marks registered as associated trade marks, the Registrar may dissolve the association as respects any of them if he is satisfied that there would be no likelihood of deception or confusion being caused if that trade mark were used by another person in relation to any of the goods in respect of which it is registered, and may amend the register accordingly.

Power of registered proprietor to assign and give receipts.

24. Subject to this Act, the person for the time being entered in the register as proprietor of a trade mark shall, subject to any rights appearing from the register to be vested in any other person, have power to assign the trade mark, and to give effectual receipts for any consideration for an assignment thereof.

25. (1) Where a person becomes entitled by assignment or transmission to a registered trade mark, he must make application in the prescribed manner to the Registrar to register his title, and the Registrar shall, on receipt of the application and on proof of title to his satisfaction, register him as the proprietor of the trade mark in respect of the goods in respect of which the assignment or transmission has effect, and shall cause particulars of the assignment or transmission to be entered on the register.

Registration of assignments and transmissions.

(2) Except for the purposes of an appeal under section 48 of this Act against a decision of the Registrar under this section or of an application under section 32 of this Act, a document or instrument in respect of which no entry has been made in the register in accordance with subsection (1) of this section shall not be admissible in evidence in any court of law in proof of the title to a trade mark unless that court otherwise directs.

26. (1) Subject to section 27 of this Act, a registered trade mark may be taken off the register in respect of any of the goods in respect of which it is registered on application by any person aggrieved to the Court or, at the option of the applicant and subject to section 50 of this Act, to the Registrar, on the ground either—

Removal from the register and imposition of limitations on ground of non-use.

- (a) that the trade mark was registered without any *bona fide* intention on the part of the applicant for registration that it should be used in relation to those goods by him, and that there has in fact been no *bona fide* use of the trade mark in relation to those goods by any proprietor thereof for the time being up to the date one month before the date of the application; or
- (b) that up to the date one month before the date of the application a continuous period of five years or longer elapsed during which the trade mark was a registered trade mark and during which there was no *bona fide* use thereof in relation to those goods by any proprietor thereof for the time being.

(2) Except where the applicant has been permitted under subsection (2) of section 12 of this Act to register an identical or nearly resembling trade mark in respect of the goods in question or where the Court or the Registrar (as the case may be) is of opinion that he might properly be permitted so to register such a trade mark the Court or the Registrar (as the case may be) may refuse an application made under paragraph (a) or (b) of subsection (1) of this section in relation to any goods, if it is shown that there has been, before the relevant date or during the relevant period, as the case may be, *bona fide* use of the trade mark by any proprietor thereof for the time being in relation to goods of the same description, being goods in respect of which the trade mark is registered.

(3) Where in relation to any goods in respect of which a trade mark is registered—

(a) the matters referred to in paragraph (b) of subsection (1) of this section are shown so far as regards non-use of the trade mark in relation to goods to be sold, or otherwise traded in, in a particular place in Ghana (otherwise than for export from Ghana), or in relation to goods to be exported to a particular market outside Ghana; and

(b) a person has been permitted under subsection (2) of section 12 of this Act to register an identical or nearly resembling trade mark in respect of those goods under a registration extending to use in relation to goods to be sold, or otherwise traded in, in that place (otherwise than for export from Ghana), or in relation to goods to be exported to that market, or the Court or the Registrar is of opinion that he might properly be permitted so to register such a trade mark;

on application by that person to the Court, or, at the option of the applicant and subject to section 50 of this Act, to the Registrar, the Court or the Registrar (as the case may be) may impose on the registration of the first-mentioned trade mark such limitations as the Court or the Registrar (as the case may be) thinks proper for securing that that registration shall cease to extend to the last-mentioned use.

(4) An applicant shall not be entitled to rely for the purposes of paragraph (b) of subsection (1), or for the purposes of subsection (3) of this section on any non-use of a trade mark that is shown to have been due to special circumstances in the trade and not to any intention not to use or to abandon the trade mark in relation to the goods to which the application relates.

27. (1) Where a trade mark consisting of an invented word or invented words has become so well known as respects any goods in respect of which it is registered and in relation to which it has been used that the use thereof in relation to other goods would be likely to be taken as indicating a connection in the course of trade between those goods and a person entitled to use the trade mark in relation to the first-mentioned goods, then, notwithstanding that the proprietor registered in respect of the first-mentioned goods does not use or propose to use the trade mark in relation to those other goods and notwithstanding anything in section 26 of this Act, the trade mark may, on the application in the prescribed manner of the proprietor registered in respect of the first-mentioned goods,

be registered in his name in respect of those other goods as a defensive trade mark and, while so registered, shall not be liable to be taken off the register in respect of those goods under section 26 of this Act.

(2) The registered proprietor of a trade mark may apply for the registration thereof in respect of any goods as a defensive trade mark notwithstanding that it is already registered in his name in respect of those goods otherwise than as a defensive trade mark, or may apply for the registration thereof in respect of any goods otherwise than as a defensive trade mark notwithstanding that it is already registered in his name in respect of those goods as a defensive trade mark, in lieu in each case of the existing registration.

(3) A trade mark registered as a defensive trade mark and that trade mark as otherwise registered in the name of the same proprietor shall, notwithstanding that the respective registrations are in respect of different goods, be deemed to be, and shall be registered as, associated trade marks.

(4) On application by any person aggrieved to the Court or, at the option of the applicant and subject to section 50 of this Act, to the Registrar, the registration of a trade mark as a defensive trade mark may be cancelled on the ground that the requirements of subsection (1) of this section are no longer satisfied in respect of any goods in respect of which the trade mark is registered in the name of the same proprietor otherwise than as a defensive trade mark, or may be cancelled as respects any goods in respect of which it is registered as a defensive trade mark on the ground that there is no longer any likelihood that the use of the trade mark in relation to those goods would be taken as giving the indication mentioned in subsection (1) of this section.

(5) The Registrar may at any time cancel the registration as a defensive trade mark of a trade mark of which there is no longer any registration in the name of the same proprietor otherwise than as a defensive trade mark.

(6) Except as otherwise expressly provided in this section, this Act applies in respect of the registration of trade marks as defensive trade marks and of trade marks so registered as they apply in other cases.

28. (1) Subject to the provisions of this section, a person other than the proprietor of a trade mark may be registered as a registered user thereof in respect of all or any of the goods in respect of which it is registered (otherwise than as a defensive trade mark) and either with or without conditions or restrictions. Registered users.

(2) The use of a trade mark by a registered user thereof in relation to goods with which he is connected in the course of trade and in respect of which for the time being the trade mark remains registered and he is registered as a registered user, being use such as to comply with any conditions or restrictions to which his registration is subject, is in this Act referred to as the "permitted use" thereof.

(3) The permitted use of a trade mark shall be deemed to be use by the proprietor thereof, and shall be deemed not to be use by a person other than the proprietor for the purposes of section 26 of this Act and for any other purposes for which such use is material under this Act or at common law.

(4) Subject to any agreement subsisting between the parties, a registered user of a trade mark shall be entitled to call upon the proprietor thereof to take proceedings to prevent infringement thereof, and, if the proprietor refuses or neglects to do so within two months after being so called upon, the registered user may institute proceedings for infringement in his own name as if he were the proprietor, making the proprietor a defendant.

(5) A proprietor added as defendant under subsection (4) of this section, shall not be liable for any costs unless he enters an appearance and takes part in the proceedings.

(6) Where it is proposed that a person should be registered as a registered user of a trade mark, the proprietor and the proposed registered user must apply in writing to the Registrar in the prescribed manner and must furnish him with such documents, information or evidence as may be prescribed, or as may be required by the Registrar.

(7) When the requirements of subsection (6) of this section have been complied with, if the Registrar, after considering the information furnished to him under that subsection, is satisfied that in all the circumstances the use of the trade mark in relation to the proposed goods or any of them by the proposed registered user subject to any conditions or restrictions which the Registrar thinks proper would not be contrary to the public interest, the Registrar may register the proposed registered user as a registered user in respect of the goods as to which he is so satisfied subject to those conditions or restrictions.

(8) The Registrar shall refuse an application under subsection (6) of this section if it appears to him that the grant thereof would tend to facilitate trafficking in a trade mark.

(9) The Registrar shall, if so required by an applicant, take steps for securing that information given for the purposes of an application for registration under subsection (6) of this section (other than any matter entered in the register) is not disclosed to rivals in trade.

(10) Without prejudice to section 32 of this Act, the registration of a person as a registered user—

(a) may be varied by the Registrar as regards the goods in respect of which, or any conditions or restrictions subject to which, it has effect, on the application in writing in the prescribed manner of the registered proprietor of the trade mark to which the registration relates;

(b) may be cancelled by the Registrar on the application in writing in the prescribed manner of the registered proprietor or of the registered user or of any other registered user of the trade mark; or

(c) may be cancelled by the Registrar on the application in writing in the prescribed manner of any person on any of the following grounds, that is to say—

(i) that the registered user has used the trade mark otherwise than by way of the permitted use, or in such a way as to cause, or to be likely to cause, deception or confusion;

(ii) that the proprietor or the registered user misrepresented, or failed to disclose, some fact material to the application for the registration, or that the circumstances have materially changed since the date of the registration;

(iii) that the registration ought not to have been effected having regard to rights vested in the applicant by virtue of a contract in the performance of which he is interested.

(11) Provision shall be made by regulations for the notification of the registration of a person as a registered user to any other registered user of the trade mark, and for the notification of an application under subsection (10) of this section to the registered proprietor and each registered user (not being the applicant) of the trade mark, and for giving to the applicant on such an application, and to all persons to whom such an application is notified and who intervene in the proceedings in accordance with the regulations an opportunity of being heard.

(12) The Registrar may at any time cancel the registration of a person as a registered user of a trade mark in respect of any goods in respect of which the trade mark is no longer registered.

(13) Nothing in this section shall confer on a registered user of a trade mark any assignable or transmissible right to the use thereof.

(14) Any person who is registered under this Act as a registered user of a trade mark shall be deemed to have been so registered as of the date of the application for his registration as a registered user

Proposed
use of
trade mark
by corpora-
tion to be
constituted,
etc.

29. (1) No application for the registration of a trade mark in respect of any goods shall be refused, nor shall permission for such registration be withheld, on the ground only that it appears that the applicant does not use or propose to use the trade mark—

- (a) if the Court or the Registrar (as the case may be) is satisfied that a body corporate is about to be constituted, and that the applicant intends to assign the trade mark to the corporation with a view to the use thereof in relation to those goods by the corporation; or
- (b) if the application is accompanied by an application for the registration of a person as a registered user of the trade mark, and the Court or the Registrar (as the case may be) is satisfied that the proprietor intends it to be used by that person in relation to those goods and the Court or the Registrar (as the case may be) is also satisfied that that person will be registered as a registered user thereof immediately after the registration of the trade mark.

(2) Section 26 of this Act shall have effect, in relation to a trade mark registered under the power conferred by subsection (1) of this section as if for the reference, in paragraph (a) of subsection (1) of section 26 of this Act, to intention on the part of an applicant for registration that a trade mark should be used by him there were substituted a reference to intention on his part that it should be used by the corporation or registered user concerned.

(3) The Registrar or (in the case of an appeal) the Court may, as a condition of the exercise of the power conferred by subsection (1) of this section in favour of an applicant who relies on intention to assign to a corporation require him to give security for the costs of any proceedings before the Registrar or the Court (as the case may be), and in default of such security being duly given may treat the application as abandoned.

(4) Where a trade mark is registered in respect of any goods under the power conferred by subsection (1) of this section in the name of an applicant who relies on intention to assign to a corporation, then, unless within such period as may be prescribed, or within such further period not exceeding six months as the Registrar may on application being made to him in the prescribed manner allow, the corporation has been registered as the proprietor of the trade mark in respect of those goods, the registration shall cease to have effect in respect thereof at the expiration of that period, and the Registrar shall amend the register accordingly.

30. (1) Where under this Act use of a registered trade mark is required to be proved for any purpose, the Court or the Registrar (as the case may be) may accept use of an associated registered trade mark, or of the trade mark with additions or alterations not substantially affecting its identity, as an equivalent for the use required to be proved.

Use of one of associated or substantially identical trade marks equivalent to use of another.

(2) The use of the whole of a registered trade mark shall for the purposes of this Act be deemed to be also a use of any registered trade mark, being a part thereof, registered in the name of the same proprietor by virtue of subsection (1) of section 21 of this Act.

31. The application in Ghana of a trade mark to goods to be exported from Ghana, and any other act done in Ghana in relation to goods to be so exported which, if done in relation to goods to be sold or otherwise traded in within Ghana, would constitute use of a trade mark therein, shall be deemed to constitute use of the trade mark in relation to those goods for any purpose for which that use is material under this Act or at common law.

Use of trade mark for export trade.

32. (1) Any person aggrieved by the non-insertion in or omission from the register of any entry, or by any entry made in the register without sufficient cause, or by any entry wrongly remaining on the register, or by any error or defect in any entry in the register, may apply in the prescribed manner to the Court or, at the option of the applicant and subject to section 50 of this Act, to the Registrar, and the Court or the Registrar (as the case may be) may make such order for making, expunging or varying the entry as the Court or the Registrar (as the case may be) may think fit.

General power to rectify entries in register.

(2) The Court or the Registrar (as the case may be) may in any proceeding under this section decide any question that it may be necessary or expedient to decide in connection with the rectification of the register.

(3) In case of fraud in the registration, assignment or transmission of a registered trade mark, or in any other case in which he considers it to be necessary in the public interest, the Registrar may himself apply to the Court under this section.

(4) Any order of the Court rectifying the register shall direct that notice of the rectification shall be served in the prescribed manner on the Registrar, and the Registrar shall on receipt of the notice rectify the register accordingly.

(5) The power to rectify the register conferred by this section shall include power to remove a registration in Part A of the register to Part B.

Power to expunge or vary registration for breach of condition.

33. On application by any person aggrieved to the Court or, at the option of the applicant and subject to section 50 of this Act, to the Registrar or on application by the Registrar to the Court, the Court or the Registrar (as the case may be) may make such order as the Court or the Registrar (as the case may be) may think fit for expunging or varying the registration of a trade mark on the ground of any contravention of, or failure to observe, a condition entered on the register in relation thereto.

Correction
of register.

34. (1) The Registrar may, on request made in the prescribed manner by the registered proprietor—

- (a) correct any error in the name, address or description of the registered proprietor of a trade mark;
- (b) enter any change in the name, address or description of the person who is registered as proprietor of a trade mark;
- (c) cancel the entry of a trade mark on the register;
- (d) strike out any goods or classes of goods from those in respect of which a trade mark is registered; or
- (e) enter a disclaimer or memorandum relating to a trade mark which does not in any way extend the rights given by the existing registration of the trade mark.

(2) The Registrar may, on request made in the prescribed manner by a registered user of a trade mark, correct any error, or enter any change, in the name, address or description of the registered user.

(3) The Registrar may, of his own motion, after having given the prescribed notice, correct any error made by him in any entry on the register.

Alteration
of registered
trade mark.

35. (1) The registered proprietor of a trade mark may apply in the prescribed manner to the Registrar for leave to add to or alter the trade mark in any manner not substantially affecting the identity thereof, and the Registrar may refuse leave or may grant it on such terms and subject to such limitations as he may think fit.

(2) The Registrar may cause an application under this section to be advertised in the prescribed manner in any case where it appears to him that it is expedient so to do and, where he does so, if within the prescribed time from the date of the advertisement any person gives notice to the Registrar in the prescribed manner of opposition to the application, the Registrar shall, after hearing the parties if so required, decide the matter.

(3) Where leave is granted, the trade mark as altered shall be advertised in the prescribed manner, unless it has already been advertised, in the form to which it has been altered, in an advertisement under subsection (2) of this section.

36. (1) A mark adapted in relation to any goods to distinguish in the course of trade goods certified by any person in respect of origin, material, mode of manufacture, quality, accuracy or other characteristic, from goods not so certified shall be registrable as a certification trade mark in Part A of the register in respect of those goods in the name, as proprietor thereof, of that person:

Certification
trade marks.

Provided that a mark shall not be so registrable in the name of a person who carries on a trade in goods of the kind certified.

(2) In determining whether a mark is adapted to distinguish any goods as described in subsection (1) of this section the Court or the Registrar (as the case may be) may have regard to the extent to which—

- (a) the mark is inherently adapted so to distinguish in relation to the goods in question; and
- (b) by reason of the use of the mark or of any other circumstances, the mark is in fact adapted so to distinguish in relation to the goods in question.

(3) Subject to subsections (5) to (7) of this section, and of sections 7 and 8 of this Act, the registration of a person as proprietor of a certification trade mark in respect of any goods shall, if valid, give to that person the exclusive right to the use of the trade mark in relation to those goods.

(4) Without prejudice to the generality of subsection (3), the right referred to in that subsection shall be deemed to be infringed by any person who, not being the proprietor of the trade mark or a person authorised by him under the rules in that behalf using it in accordance therewith, uses a mark identical with it or so nearly resembling it as to be likely to deceive or cause confusion, in the course of trade, in relation to any goods in respect of which it is registered, and in such manner as to render the use of the mark likely to be taken either—

- (a) as being use as a trade mark; or
- (b) in a case in which the use is use upon the goods or in physical relation thereto or in an advertising circular or other advertisement issued to the public, as importing a reference to some person having the right either as proprietor or by his authorisation under the relevant rules to use the trade mark or to goods certified by the proprietor.

(5) The right to the use of a certification trade mark given by virtue of subsection (3) of this section by registration shall be subject to any conditions or limitations entered on the register, and shall not be deemed to be infringed by the use of any such mark as is referred to in subsection (4) of this section in any mode, in relation to goods to be sold or otherwise traded in in any place, in relation to goods to be exported to any market, or in any other circumstances, to which, having regard to any such limitations, the registration does not extend.

(6) The said right shall not be deemed to be infringed by the use of any such mark by any person—

- (a) in relation to goods certified by the proprietor of the trade mark if, as to those goods or a bulk of which they form part, the proprietor or another in accordance with his authorisation under the relevant rules has applied the trade mark and has not subsequently removed or obliterated it, or the proprietor has at any time expressly or impliedly consented to the use of the trade mark; or
- (b) in relation to goods adapted to form part of, or to be accessory to, other goods in relation to which the trade mark has been used without infringement of the right given by registration or might for the time being be so used, if the use of the mark is reasonably necessary in order to indicate that the goods are so adapted and neither the purpose nor the effect of the use of the mark is to indicate otherwise than in accordance with the fact that the goods are certified by the proprietor:

Provided that paragraph (a) of this subsection shall not have effect in the case of use consisting of the application of any such mark as is referred to in subsection (4) of this section to any goods, notwithstanding that they are such goods as are mentioned in that paragraph, if such application is contrary to the relevant rules.

(7) Where a certification trade mark is one of two or more registered trade marks that are identical or nearly resemble each other, the use of any of those trade marks in exercise of the right to the use of that trade mark given by registration shall not be deemed to be an infringement of the right so given to the use of any other of those trade marks.

(8) There shall be deposited at the office of the Registrar in respect of every trade mark registered under this section rules approved by the Minister for governing the use thereof, which shall include provisions as to the cases in which the proprietor is to certify goods and to authorise the use of the trade mark, and may contain any other provisions that the Minister may require or permit to be inserted therein (including provisions conferring a right of appeal to the Registrar against any refusal of the proprietor to certify goods or to authorise the use of the trade mark in accordance with the rules).

(9) Rules deposited under subsection (8) of this section shall be open to inspection in like manner as the register.

(10) A certification trade mark shall not be assignable or transmissible otherwise than with the consent of the Minister.

(11) The provisions of the First Schedule to this Act shall have effect with respect to the registration of a mark under this section and to marks so registered.

37. (1) A Minister may, subject to this Act, procure the registration of a trade mark or of a certification trade mark and a Minister by whom such registration is procured shall be, and shall be registered as, the proprietor thereof for all purposes under this Act.

Registration of marks by Ministers.

(2) A Minister may procure the registration in any register maintained in any place outside Ghana of a trade mark (whether registered or not registered under subsection (1) of this section) if and so far as and subject to such conditions as that registration is permitted by the law regulating that register and in any such case may procure himself to be entered in that register as the proprietor of the trade mark.

38. A Minister may take in any place outside Ghana such lawful steps, whether by way of action or prosecution at law or otherwise, as he may think proper to prevent, restrain, or to secure punishment for the registration, use, or application in relation to or in respect of goods not grown, produced, or manufactured in Ghana of any trade mark or other mark or description indicating or suggesting or likely to lead to the belief that the goods in respect of which or to which that trade mark, mark, or description is used or applied were grown, produced or manufactured in Ghana.

Misuse of trade marks indicative of Ghanaian origin.

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

Preliminary advice by Registrar as to distinctiveness.

39. (1) The power to give to a person who proposes to apply for the registration of a trade mark in Part A or Part B of the register advice as to whether the trade mark appears to the Registrar *prima facie* to be inherently adapted to distinguish, or capable of distinguishing, as the case may be, shall be a function of the Registrar under this Act.

(2) Any such person who is desirous of obtaining such advice must make application to the Registrar therefor in the prescribed manner.

(3) If on an application for the registration of a trade mark as to which the Registrar has given advice under this section in the affirmative, made within three months after the advice is given, the Registrar, after further investigation or consideration, gives notice to the applicant of objection on the ground that the trade mark is not adapted to distinguish, or capable of distinguishing, as the case may be, the applicant is entitled, on giving notice of withdrawal of the application within the prescribed period, to have repaid to him any fee paid on the filing of the application.

Registrar
may consult
Attorney-
General.

40. The Registrar may, in any case of doubt or difficulty in the administration of this Act, apply to the Attorney-General for directions in the matter.

Hearing
before
exercise of
Registrar's
discretion.

41. Where any discretionary or other power is given to the Registrar by this Act or by regulations made under section 65 of this Act he shall not exercise that power adversely to the applicant for registration or the registered proprietor of the trade mark in question without (if duly required so to do within the prescribed time) giving to the applicant or registered proprietor an opportunity of being heard.

Power of
Registrar to
award costs.

42. In all proceedings before the Registrar under this Act, the Registrar may award to any party such costs as he may consider reasonable, and to direct how and by what parties they are to be paid, and any such order may, by leave of the Court, be enforced in the same manner as a judgment or order of the Court to the same effect.

Registration
to be
prima facie
evidence of
validity.

43. In all legal proceedings relating to a registered trade mark (including applications under section 32 of this Act) the fact that a person is registered as proprietor of the trade mark shall be *prima*

facie evidence of the validity of the original registration of the trade mark and of all subsequent assignments and transmissions thereof.

44. In any legal proceedings in which the validity of the registration of a registered trade mark comes into question and is decided in favour of the proprietor of the trade mark, the Court may certify to that effect, and if it so certifies then in any subsequent legal proceedings in which the validity of the registration comes into question the proprietor of the trade mark on obtaining a final order or judgment in his favour shall have his full costs, charges and expenses as between solicitor and client, unless in the subsequent proceeding the Court certifies that he ought not to have them.

Certificate of
validity.

45. In any proceedings before the Court under this Act the Registrar shall be neither awarded costs nor ordered to pay the costs of any other party.

Costs of the
Registrar in
Court pro-
ceedings.

46. In any action or proceeding relating to a trade mark or trade name, the Court or the Registrar (as the case may be) shall admit evidence of the usages of the trade concerned and of any relevant trade mark or trade name or get-up legitimately used by other persons.

Trade usage
and other
matters to be
considered.

47. (1) The Registrar shall be given notice in writing (by the plaintiff, appellant or applicant, as the case may be) of any legal proceeding in which the relief sought would affect the register (including an appeal from any order or decision of the Registrar and an application under section 17 or 18 of this Act to extend the time for making an appeal against a decision of the Registrar under either of those sections) and of the decision of the Court respecting any such legal proceeding, and shall have the right to appear and be heard, and shall appear if so directed by the Court, in any such legal proceeding.

Registrar's
appearance
in
proceedings.

(2) Unless otherwise directed by the Court, the Registrar in lieu of appearing and being heard may submit to the Court a statement in writing signed by him, giving particulars of the proceedings before him in relation to the matter in issue or of the grounds of any decision given by him affecting it or of the practice of the office of the Registrar in like cases or of such other matters relevant to the issues, and within his knowledge as Registrar, as he thinks fit, and the statement shall be deemed to form part of the evidence in the proceeding.

48. (1) An appeal shall lie to the Court from any order or decision of the Registrar under any provision of this Act (not being a decision of the Registrar under section 3 of this Act) or from a correction of an error in the register by the Registrar under subsection (3) of section 34 of this Act, and the Court may make such order confirming, annulling or varying the order or decision or correction of the Registrar as it thinks fit.

Appeal to
the Court.

(2) In any appeal from a decision of the Registrar to the Court under this Act, the Court may exercise the same discretionary powers as under this Act are conferred upon the Registrar.

(3) Except by leave of the Court, no appeal (other than an appeal under section 17 or 18 of this Act) from an order or decision of the Registrar or from a correction of an error in the register by the Registrar under subsection (3) of section 34 of this Act shall be entertained of which notice to the Court is not given within one month from the date of the order, decision or correction appealed against or within such further period not exceeding three months as the Registrar may allow (upon request received before the expiration of the said period of one month).

(4) Subject to subsection (5) of this section, a decision of the Court under this section shall be final and not appealable.

(5) By leave of the Court, an appeal from a decision of the Court under this section shall lie to the Supreme Court on a specified question of law.

49. The Court, in dealing with any question of the rectification of the register (including all applications under section 32 of this Act), may review any decision of the Registrar relating to the entry in question or the correction sought to be made.

Court's
power to
review
Registrar's
decision.

Procedure in cases of option to apply to Court or Registrar.

50. Where under this Act an applicant has an option to make an application either to the Court or to the Registrar—

- (a) if an action concerning the trade mark in question is pending, the application must be made to the Court;
- (b) if in any other case the application is made to the Registrar he may, at any stage of the proceedings, refer the application to the Court, or he may, after hearing the parties, determine the question between them, subject to appeal to the Court.

Mode of taking evidence in proceedings before Registrar.

51. (1) In any proceeding under this Act before the Registrar, the evidence shall, subject to subsection (2) of this section, be given by statutory declaration.

(2) The Registrar may take evidence on oath in lieu of or in addition to a statutory declaration.

(3) Any statutory declaration taken under this section may, in the case of appeal, be used before the Court in lieu of evidence by affidavit, but if so used shall have all the incidents and consequences of evidence by affidavit.

(4) The Registrar shall have the same powers for requiring the attendance of witnesses and the production of documents and for taking evidence on oath as the Court.

(5) A witness before the Registrar is entitled to the same immunities and privileges and may, without prejudice to the general effect of the foregoing words of this subsection, be awarded by the Registrar and paid the same allowances in respect of his attendance as a witness, as if he were a witness before the Court.

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

(7) If any person—

- (a) on being duly summoned as a witness before the Registrar makes default in attending or
- (b) being in attendance as a witness refuses to take an oath legally required by the Registrar to be taken, or to produce any document in his power or control legally required by the Registrar to be produced by him, or to answer any question to which the Registrar may legally require an answer, or
- (c) does any other thing which would, if the Registrar were a court be contempt of court,

the Registrar may certify the offence of that person under his official seal to the Court and the Court may, after such inquiry as it thinks proper to make, punish or take steps for the punishment of that person in like manner as if he had been guilty of contempt of the Court.

52. (1) A copy of any entry in the register, purporting to be certified by, and sealed with the official seal of, the Registrar shall be admissible in evidence in any court of law, and in all proceedings, without further proof or production of the original. Evidence of entries in register.

(2) Any person requiring any such certified copy is entitled to obtain it on payment of the prescribed fee.

53. A certificate purporting to be under the official seal of the Registrar as to any entry, matter or thing that he is authorised by this Act or by regulations under section 65 of this Act to make or do shall be *prima facie* evidence of the entry having been made, and of the contents thereof, and of the matter or thing having been done or not done. Evidence of things done by Registrar.

PART III—GENERAL AND MISCELLANEOUS

54. A person who makes or causes to be made a false entry in the register, or a writing falsely purporting to be a copy of an entry in the register, or who produces or tenders or causes to be produced or tendered in evidence any such writing, knowing the entry or writing to be false, is guilty of an offence under this section and is liable on summary conviction thereof to a fine not exceeding one hundred pounds or to imprisonment for any term not exceeding three months or both. Falsification of entries in register.

Fine for falsely representing a trade mark as registered.

55. (1) Any person who makes a representation—

- (a) with respect to a mark not being a registered trade mark, to the effect that it is a registered trade mark; or
- (b) with respect to a part of a registered trade mark not being a part separately registered as a trade mark, to the effect that it is so registered; or
- (c) to the effect that a registered trade mark is registered in respect of any goods in respect of which it is not registered; or
- (d) to the effect that the registration of a trade mark gives an exclusive right to the use thereof in any circumstances in which, having regard to limitations entered on the register, the registration does not give that right;

is guilty of an offence under this section and is liable on summary conviction thereof to a fine not exceeding £G20 and, in the case of a continuing offence, a further fine not exceeding £G5 for every day on which the offence continues.

(2) For the purposes of this section, the use in Ghana in relation to a trade mark of the word “registered”, or of any other word or of a symbol referring whether expressly or impliedly to registration, shall be deemed to import a reference to registration in the register, except—

- (a) where that word or that symbol is used in physical association with words delineated in characters at least as large as those in which that word or that symbol is delineated and indicating that the reference is to registration as a trade mark under the law of a place outside Ghana, being a place under the law of which the registration referred to is in fact in force;
- (b) where that word (being a word other than the word "registered") or that symbol is of itself such as to indicate that the reference is to such registration as is described in paragraph (a) of this subsection; or
- (c) where that word or that symbol is used in relation to a mark registered as a trade mark under the law of a place outside Ghana and in relation to goods to be exported to that place.

56. (1) Without prejudice to the provisions of the Flags and Arms Protection Act, 1959 (No. 61), no person shall without lawful authority, use in connection with any business, trade, calling or profession any badge, seal, device, emblem or flag reserved by law for the use of the Republic, the President, a Minister, the Armed Forces, any Ministry or Department of State, any public officer or any member of the Armed Forces in such a manner as to lead to the belief that he is authorised to use that badge, seal, device, emblem or flag.

Penalty for unlawful user of official badges, etc.

(2) Subsection (1) applies also to the use of any badge, seal, device, emblem or flag so nearly resembling the badge, seal, device, emblem or flag referred to in that subsection, as to be likely to deceive.

(3) Any person who contravenes subsection (1) is guilty of an offence and is liable on summary conviction to a fine not exceeding £G20 and, in the case of a continuing offence, to a further fine not exceeding £G5 for every day on which the offence continues or to imprisonment not exceeding three months in lieu of a fine.

57. The use of a registered trade mark in relation to goods between which and the person using it any form of connection in the course of trade subsists shall not be deemed to be likely to cause deception or confusion on the ground only that the trade mark has been, or is, used in relation to goods between which and that person or a predecessor in title of his a different form of connection in the course of trade subsisted or subsists.

Change of form of trade connection not to be deemed to cause deception.

58. (1) Where the relations between two or more persons interested in a trade mark are such that no one of them is entitled as between himself and the other or others of them to use it except—

Jointly owned trade marks.

- (a) on behalf of both or all of them, or

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

those persons may be registered as joint proprietors of the trade mark, and this Act shall have effect in relation to any rights to the use of the trade mark vested in those persons as if those rights had been vested in a single person:

Provided that the rights of any person who is so registered shall be deemed to be infringed by any other of the said persons who uses the trade mark in physical or other relation to goods in respect of which the trade mark is registered under this section, but with which both or all of the said persons are not and have not been connected in the course of trade.

(2) Subject to subsection (1) of this section, nothing in this Act shall authorise the registration of two or more persons who use a trade mark independently, or propose so to use it, as joint proprietors thereof.

Trusts and equities.

59. (1) There shall not be entered in the register any notice of any trust express, implied or constructive, nor shall any such notice be receivable by the Registrar.

(2) Subject to this Act, equities in respect of a trade mark may be enforced in like manner as in respect of any other movable property.

Recognition of agents.

60. Where by this Act any act has to be done by or to any person in connection with a trade mark or proposed trade mark or any procedure relating thereto, the act may, subject to any regulations made under section 65 of this Act, or in particular cases by special leave of the Minister, be done by or to an agent of that person duly authorised in the prescribed manner.

International arrangements, etc.

61. (1) This section applies only to a country in relation to which an instrument under subsection (2) of this section applying this section thereto is for the time being in force.

(2) Where—

(a) Ghana is a party to an international arrangement with any other country for the mutual protection of trade marks, or

(b) the President is satisfied that the law of any country outside Ghana makes adequate provision for the protection of trade marks registered in Ghana,

the President may, by legislative instrument, apply this section to that country.

(3) Subject to the provisions of this section, where any person has applied in any country to which this section applies, for the protection of a trade mark of which he is the proprietor, that person or his legal representative or assignee is entitled to registration under this Act of that trade mark in priority to other applicants.

(4) Notwithstanding anything in this Act the registration of a trade mark under this Act by virtue of subsection (3) of this section, shall have the same date as the date of application in the country referred to in that subsection.

(5) Nothing in this section shall be deemed to entitle the proprietor of a trade mark to recover damages for any infringement occurring prior to the date which, but for subsection (4) of this section would have been the date of registration of that trade mark.

(6) The registration under this Act of a trade mark to which this section applies shall not be invalidated by reason only of the use of that trade mark in Ghana during the period prescribed by virtue of paragraph (b) of subsection (7) of this section as that within which the application for registration may be made.

(7) An application for registration under this Act of a trade mark to which this section applies must be made—

(a) in the manner specified in section 17 of this Act or, in the case of a certification trade mark, in the manner specified in the First Schedule to this Act; and

(b) within such period as may be prescribed.

(8) A person shall for the purpose of this section be deemed to have applied, in a country to which this section applies, for protection of a trade mark of which he is the proprietor if he has made an application which—

(a) in accordance with the law of that country is equivalent to an application duly made in that country, or

(b) in accordance with the terms of any international arrangement subsisting between that country and any other country to which this section applies is equivalent to an application duly made in the first-mentioned country.

62. Where an offence under section 54, 55 or 56, of this Act—

(a) is committed by a body corporate not being a partnership, or by a partnership or by a person purporting to act on behalf of the body corporate or the partnership, and

(b) is proved to have been so committed with the consent or approval of, or to have been facilitated by any default on the part of, any person being, in the case of the body corporate, a director thereof, or, in the case of the partnership, a partner thereof,

that person is also guilty of the offence.

Offences by
bodies of
persons.

63. All things required or authorised under this Act to be done by, to or before the Minister other than the making of regulations under section 65 of this Act, may be done by, to or before the Head of his Ministry or by some other public officer authorised in writing in that behalf by the Minister.

Exercise of
powers of
Minister.

64. If any person is, by reason of infancy, lunacy, or other ^{Infants, lunatics, etc.} inability, incapable of making any affidavit or doing anything required or permitted by this Act or by any regulations made under section 65 of this Act, then the guardian of that person, or if there be none, any person appointed by any Court possessing jurisdiction in respect of the property of incapable persons, upon the petition of any person on behalf of the person so incapable, or any other person interested in the making of that affidavit or doing that thing, may make that affidavit, or an affidavit as nearly corresponding thereto as circumstances may permit, and do that thing in the name and on behalf of the person so incapable, and all acts done by a person substituted under this section shall, for the purposes of this Act, be as effectual as if done by the person for whom he is substituted.

Regulations.

65. (1) The Minister may, and shall in a case where a duty is imposed by this Act in relation thereto, by legislative instrument, make regulations for carrying into effect the provisions of this Act.

(2) Without prejudice to subsection (1) of this section, an instrument may and shall, as the case may be, be made under that subsection—

- (a) for regulating the practice under this Act, including the service of documents;
- (b) for classifying goods for the purposes of registration of trade marks;
- (c) for making or requiring duplicates of trade marks and other documents;
- (d) for securing and regulating the publishing and selling or distributing, in such manner as the Minister thinks fit, of copies of trade marks and other documents;
- (e) for prescribing the fees to be paid in respect of applications and registrations and other matters under this Act and the mode of payment of those fees;
- (f) for prescribing such forms as may be necessary for any of the purposes of this Act;
- (g) generally, for regulating the business of the Registrar's office in relation to trade marks and all things placed by this Act under the direction or control of the Registrar; and
- (h) for providing for any matter which under this Act is required or authorised to be provided for by regulations or to be prescribed by regulations.

(3) Subject to subsections (4) and (5) of this section, regulations may be made under subsection (1) for empowering the Registrar to amend the register, whether by making or expunging or varying entries therein, so far as may be requisite for the purpose of adapting the designation therein of the goods or classes of goods in respect of which trade marks are registered to any amended or substituted classification that may be prescribed.

(4) The Registrar shall not in exercise of any power conferred on him by virtue of subsection (3) of this section, make any amendment of the register that would have the effect of adding any goods or classes of goods to those in respect of which a trade mark is registered (whether in one or more classes) immediately before the amendment is made, or of antedating the registration of a trade mark in respect of any goods:

Provided that this subsection shall not have effect in relation to goods as to which the Registrar is satisfied that compliance with this subsection in relation thereto would involve undue complexity and that the addition or antedating, as the case may be, would not affect any substantial quantity of goods and would not substantially prejudice the rights of any person.

(5) A proposal for the amendment of the register under any such power shall be notified to the registered proprietor of the trade mark affected, shall be advertised with any modifications, and may be opposed before the Registrar by any person aggrieved on the ground that the proposed amendment contravenes subsection (4) of this section.

(6) Every instrument made under subsection (1) of this section shall be subject to annulment by the National Assembly.

66. (1) In this Act, unless the context otherwise requires—

Interpre-
tation.

“assignment” means assignment by act of the parties concerned;

“Court” means the High Court;

“limitations” means any limitations of the exclusive right to the use of a trade mark given by the registration of a person as proprietor thereof, including limitations of that right as to mode of use, as to use in relation to goods to be sold (or otherwise traded in) in any place within Ghana or as to use in relation to goods to be exported to any market outside Ghana;

“mark” includes a device, brand, heading, label, ticket, name, signature, word, letter, numeral, or any combination thereof;

“the Minister” means the Minister to whom the functions of the Minister under this Act have for the time being been assigned by the President.

“permitted use” has the meaning assigned to it by subsection (2) of section 28 of this Act;

“prescribed” means, in relation to proceedings before the Court, prescribed by rules of court, and, in other cases, prescribed by this Act or by regulations made under section 65 of this Act;

“register” means the register of trade marks kept under this Act;

“registered trade mark” means a trade mark that is actually on the register;

“registered user” means a person who is for the time being registered as such under section 28 of this Act;

“Registrar” means the registrar of trade marks as defined in section 1 of this Act;

“trade mark” means, except in relation to a certification trade mark, a mark used or proposed to be used in relation to goods for the purpose of indicating, or so as to indicate, a connection in the course of trade between the goods and some person having the right either as proprietor or as registered user to use the mark, whether with or without any indication of the identity of that person, and means, in relation to a certification trade mark, a mark registered or deemed to have been registered under section 36 of this Act;

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

(2) In this Act references to the use of a mark shall be construed as references to the use of a printed or other visual representation of the mark, and references to the use of a mark in relation to goods shall be construed as references to the use thereof upon, or in physical or other relation to, goods.

(3) In any other enactment references to a trade mark shall be construed as references to a trade mark under this Act.

Transitional provisions.

67. The transitional provisions set out in the Second Schedule to this Act shall have effect with respect to the matters therein mentioned respectively.

Repeal and savings.

68. (1) The Trade Marks Ordinance (Cap. 180) and the Trade Marks (Amendment) Ordinance (Cap. 181) are hereby repealed.

(2) Without prejudice to the general effect of the Interpretation Act, 1960 (C.A. 4), with respect to repeals, nothing in this Act shall affect any requirement made, certificate issued, notice, decision, determination, direction or approval given, application made or thing done, under any enactment repealed by this section; and every such requirement, certificate, notice, decision, determination, direction, approval, application or thing shall, if in force immediately before the commencement of this Act, continue in force and shall, so far as it could have been made, issued, given or done under this Act, have effect as if made, issued, given or done under the corresponding provision of this Act.

(3) All statutory instruments made under section 60 of the Trade Marks Ordinance (Cap. 180) and also, the provisions contained in the Schedule to that Ordinance, so far as any such statutory instruments or provisions remain in force immediately before the commencement of this Act, shall continue in force as if they were regulations made under section 65 of this Act.

(4) Every Order made under section 68 of the Trade Marks Ordinance (Cap. 180) and in force immediately before the commencement of this Act shall continue in force as if it were a legislative instrument made under section 61 of this Act.

(5) Unless the President, by legislative instrument otherwise directs, section 61 of this Act shall apply to any country to which section 62 or 67 of the Trade Marks Ordinance (Cap. 180) or section 4 of the Trade Marks (Amendment) Ordinance (Cap. 181) applied immediately before the commencement of this Act.

(6) Any document referring to any enactment repealed by this section shall be construed as referring to the corresponding provision of this Act.

69. This Act shall come into force on such date as the President may by legislative instrument appoint. Commencement.

FIRST SCHEDULE

CERTIFICATION TRADE MARKS

1. (1) An application for the registration of a mark under section 36 of this Act must be made to the Registrar in writing in the prescribed manner by the person proposed to be registered as the proprietor thereof.

(2) The provisions of subsection (2) and of subsections (4) to (8) of section 17 of this Act shall have effect in relation to an application under the said section 36 as they have effect in relation to an application under subsection (1) of the said section 17, except that for references therein to acceptance of an application there shall be substituted references to authorisation to proceed with the application.

(3) In dealing under the said provisions with an application under the said section 36, the Court or the Registrar (as the case may be) shall have regard to the like considerations so far as relevant,

as if the application were an application under the said section 17 of this Act and to any other considerations (not being matters within the competence of the Minister under sub-paragraph (5) of this paragraph) relevant to applications under the said section 36, including the desirability of securing that a certification trade mark shall comprise some indication that it is such a trade mark.

(4) An applicant for the registration of a mark under the said section 36 must transmit to the Registrar draft rules for governing the use thereof at such time before the decision of the Registrar on the application as he may require in order to enable him to consider the draft, and the Registrar shall report thereon to the Minister.

(5) When authorisation to proceed with an application has been given, the Minister shall consider the application with regard to the following matters, that is to say:—

- (a) whether the applicant is competent to certify the goods in respect of which the mark is to be registered;
- (b) whether the draft rules are satisfactory; and
- (c) whether in all the circumstances the registration applied for would be to the public advantage;

and may either—

- (i) direct that the application shall not be accepted; or
- (ii) direct the Registrar to accept the application, and approve the rules, either without modification and unconditionally or subject to any conditions or limitations, or to any amendments or modifications of the application or of the rules, which he thinks requisite having regard to any of the said matters;

but, except in the case of a direction for acceptance and approval without modification and unconditionally, the Minister shall not decide the matter without giving to the applicant an opportunity of being heard:

Provided that the Minister may, at the request of the applicant made with the concurrence of the Registrar, consider the application with regard to any of the said matters before authorisation to proceed with the application has been given, so however that the Minister shall be at liberty to reconsider any matter on which he has given a decision under this proviso if any amendment or modification is thereafter made in the application or in the draft rules.

2. (1) When an application has been accepted, the Registrar shall, as soon as may be after the acceptance, cause the application as accepted to be advertised in the prescribed manner, and the provisions of subsections (2) to (13) of section 18 of this Act shall have effect in relation to the registration of the mark as if the application had been an application under section 17 of this Act:

Provided that, in deciding under the said provisions, the Court or the Registrar (as the case may be) shall have regard only to the considerations referred to in sub-paragraph (3) of paragraph 1 of this Schedule, and a decision under the said provisions in favour of the applicant shall be conditional on the determination in his favour by the Minister under sub-paragraph (2) of this paragraph of any opposition relating to any of the matters referred to in sub-paragraph (5) of the said paragraph 1.

(2) When notice of opposition is given relating to any of the matters referred to in sub-paragraph (5) of paragraph 1 of this Schedule, the Minister shall, after hearing the parties, if so required, and considering any evidence, decide whether, and subject to what conditions or limitations, or amendments or modifications of the application or of the rules, if any, registration is, having regard to those matters, to be permitted.

3. (1) The rules deposited in respect of a certification trade mark may, on the application of the registered proprietor, be altered by the Registrar with the consent of the Minister.

(2) The Minister may cause an application for his consent to be advertised in any case where it appears to him that it is expedient so to do, and, where the Minister causes an application to be advertised, if within the prescribed time from the date of the advertisement any person gives notice to him of opposition to the application, he shall not decide the matter without giving the parties an opportunity of being heard.

4. (1) The Minister may, on the application in the prescribed manner of any person aggrieved or on the application of the Registrar make such order as he thinks fit for expunging or varying any entry in the register relating to a certification trade mark, or for varying the deposited rules, on the ground—

(a) that the proprietor is no longer competent, in the case of any of the goods in respect of which the trade mark is registered, to certify those goods;

(b) that the proprietor has failed to observe a provision of the deposited rules to be observed on his part;

(c) that it is no longer to the public advantage that the trade mark should be registered; or

(d) that it is requisite for the public advantage that, if the trade mark remains registered, the rules should be varied;

and neither the Court nor the Registrar shall have any jurisdiction to make an order under section 32 of this Act on any of those grounds.

(2) The Registrar shall rectify the register and the deposited rules in such manner as may be requisite for giving effect to an order made under sub-paragraph (1) of this paragraph.

5. Notwithstanding anything in section 42 of this Act, the Registrar shall not have any jurisdiction to award costs to or against any party on an appeal to him against a refusal of the proprietor of a certification trade mark to certify goods or to authorise the use of the trade mark.

6. The following provisions of this Act shall not have effect in relation to a certification trade mark, that is to say, section 4, section 6, section 9, sections 17 and 18 (except as expressly applied by this Schedule), subsections (4) to (9) of section 22, sections 26 to 29, section 57, and any provisions the operation of which is limited by the terms thereof to registration in Part B of the register.

SECOND SCHEDULE

TRANSITIONAL PROVISIONS

Validity of registrations under previous Acts

1. (1) Subject to the provisions of this paragraph and section 13 of this Act, the validity of the original entry of a trade mark on the register of trade marks existing at the commencement of the Trade Marks Ordinance (Cap. 180) shall be determined in accordance with the Ordinance in force at the date of that entry, and any such trade mark shall retain its original date, but for all other purposes it shall be deemed to have been registered under the said Trade Marks Ordinance.

(2) No trade mark which was on the register at the commencement of the Trade Marks Ordinance (Cap. 180), and which under that Ordinance was then a registrable trade mark, shall be removed from the register on the ground that it was not registrable under the Ordinance in force on the date of its registration.

(3) No trade mark which was on the register at the commencement of this Act, and which, having regard to any amendment by this Act of the law relating to registration of trade marks, whether as respects limitations that may be imposed on registration or as respects any other matter, is a registrable trade mark under this Act, shall be removed from the register on the ground that it was not registrable under the Ordinance in force at the date of its registration.

(4) Nothing in this Act shall be taken to invalidate the original registration of a trade mark that immediately before the commencement of this Act was validly on the register.

(5) Nothing in this Act shall subject any person to any liability in respect of any act or thing done before the commencement of this Act to which he would not have been subject under the Ordinance then in force.

Association of trade marks assignable or transmissible as a whole

2. Where immediately before the commencement of this Act a trade mark was registered in Part B of the register subject to a condition rendering it assignable or transmissible only as a whole with another trade mark registered in the name of the same proprietor or with two or more other trade marks so registered, and not separately, the trade marks shall be deemed to be associated trade marks, and the entries in the register relating thereto may be amended accordingly.

*Trade marks registered under section 61 of the Trade Marks Ordinance
(Cap. 180) to be deemed to have been registered under
section 36 of this Act*

3. Section 36 of this Act shall have effect, in relation to a trade mark that immediately before the commencement of this Act was on the register by virtue of section 61 of the Trade Marks Ordinance (Cap. 180) as if the said section 36 had been in force at the date of the registration of the trade mark and it had been registered under that section, subject however to the following modifications, that is to say:—

- (a) the proviso to subsection (1) of the said section 36 shall not apply;
 - (b) in a case in which rules for governing the use of the trade mark are deposited at the office of the Registrar at the commencement of this Act, those rules shall be deemed to have been deposited under the said section 36;
 - (c) in a case in which no such rules are deposited at the commencement of this Act, the proprietor shall be at liberty, or may be required by the Minister as a condition of the continuance of the registration, to deposit at any time thereafter such rules as the Minister may permit or require; and
 - (d) in a case in which no such rules are for the time being deposited, the said section 36 shall have effect as if references therein, and in the First Schedule to this Act, to the rules had been omitted.
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