

# Trademarks Act 2019

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# Trademarks Act 2019

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## TABLE OF AMENDMENTS

The Trademarks Act 2019 No 19 was certified and commenced on 12 July 2019 (GN No 493 of 2019; Gaz 109 of 2019).

<b>Amending Legislation</b>	<b>Certified</b>	<b>Date of Commencement</b>
Revised Written Laws Act 2021 No 7	1 June 2021	1 June 2021

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An Act to establish the legal framework for the registration and protection of trademarks and for related purposes.

Enacted by the Parliament of Nauru as follows:

## PART 1 — PRELIMINARY

### 1 Short title

This Act may be cited as the *Trademarks Act 2019*.

### 2 Commencement

This Act commences on certification by the Speaker and came into effect on 12 July 2019.

### 3 Act binds the Republic

This Act binds the Republic.

### 4 Interpretation

In this Act:

**‘applicant’** means a person who seeks an application for the registration of a mark or sign as a trademark;

**‘assignment’** includes transfer or transmission of a trademark;

**‘authorised user’** includes assignee;

**‘condition’** includes a limitation of the exclusive right to use a trademark given by the registration of the trademark including a limitation of that right as to:

- (a) mode of use;
- (b) use in relation to goods to be sold or otherwise traded in the Republic;
- (c) use in relation to services provided within the Republic; or
- (d) use in relation to goods to be exported to any market outside the Republic;

**‘deceptively similar’** means a trademark is taken to be deceptively similar to another trademark that is likely to deceive or cause confusion;

**‘limitation’** means any limitation of the exclusive right to the use of a trademark given by a person at the time of registration as owner of it, including limitations of that right as to mode of use and use in relation to goods to be sold or services to be performed;

**‘mark’** includes a sign, slogan, device, brand, heading, label, ticket name, word, letter, numeral, aspect of packaging, shape, colour, sound, scent, hologram, motions, textures or any combinations thereof;

**‘owner’** means:

- (a) in relation to a trademark, the person in whose name the trademark is registered; or
- (b) in relation to an unregistered trademark that is a well known trademark, the person to whom the unregistered mark belongs;

**‘Register’** means the Register of Trademarks established under Section 7;

**‘Secretary’** means the Secretary for Justice;

**‘sign’** includes any letter, word, name, signature, numeral, device, brand, heading, label, ticket, shape, colour, aspect of packaging or any combination thereof;

**‘similar goods’** means goods are similar to other goods if they are the same as the other goods or if they are of the same description as that of the other goods;

**‘similar services’** means services are similar to other services if they are similar as other services or if they are of the same description as that of the other services;

**‘trade’** includes business or profession; and

**‘trademark’** means any mark which is registered under this Act and is capable of distinguishing goods or services dealt with or provided in the course of trade by a person from goods or services so dealt with or provided by any other person and includes the reference to the words ‘trade’ and ‘mark’.

[Clarification on the spelling of ‘trademark’ as used in the World Intellectual Property Organisation (WIPO) and ‘trade mark’ as used in the United Kingdom pursuant to Section 9 of the Law Revision and Consolidation Act 2019.]

## 5 Objectives

The objectives of this Act are to:

- (a) provide a framework for the registration of trademarks;
- (b) provide protection for registered trademarks;
- (c) provide for the scope of rights protected by registered trademarks;
- (d) provide for the management, ownership and use of trademarks;
- (e) protect the consumers from being deceived by counterfeit goods and services marked with trademarks of the quality and origin of goods and services; and
- (f) provide for the remedies, offences and penalties for breach of trademarks.

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## PART 2 — REGISTRAR OF TRADEMARKS

### 6 Registrar of Trademarks

- (1) There shall be a Registrar of Trademarks.
- (2) The Secretary shall be the Registrar of Trademarks.
- (3) The Registrar shall:
  - (a) be responsible for the registration of trademarks;
  - (b) keep and maintain the Register of Trademarks;
  - (c) perform the functions and duties conferred on him or her under this Act;
  - (d) do all things as are necessary to be done in the proper administration of this Act; and
  - (e) keep and maintain the records of documents lodged by persons for the purposes of this Act.
- (4) The Registrar has the powers expressly conferred on him or her by this Act or any other written law to be able to perform his or her functions.
- (5) The Minister may, on the recommendation of the Registrar, appoint a Deputy Registrar.
- (6) The Deputy Registrar may perform such functions and exercise such powers of the Registrar under this Act, as the Registrar may in writing from time to time direct or authorise him or her to perform or exercise.

### 7 Register of Trademarks

- (1) There shall be a Register of Trademarks.
- (2) The Registrar shall in relation to a trademark enter in the Register:
  - (a) the date of application, publication and registration;
  - (b) the name, description and address of the owner;
  - (c) the original representation, drawing or design of the trademark;
  - (d) the particular goods or services to which the trademark relate to;
  - (e) renewal, rectification, amendment or cancellation;
  - (f) any conditions or limitations with which the registration was made;
  - (g) notification of authorisation, assignment or transmission; and
  - (h) such other particulars required under this Act and as may be prescribed.
- (3) Upon the payment of prescribed fees:
  - (a) the Register shall be made available for search and inspection by a person during business hours; and
  - (b) certified copies of the entries in the Register shall be provided.
- (4) The particulars registered in the Register and the records kept and maintained by the Registrar under this Section shall be of the record of the trademarks kept and maintained by the Registrar.
- (5) A copy or extract of any document contained in the Register certified to be a true copy or extract under the hand and seal of the Registrar is admissible as of the record of the trademark kept and maintained by the Registrar.
- (6) In any legal proceedings, a certificate under the hand and seal of the Registrar is *prima facie* evidence of the fact that a requirement of this Act specified in the certificate:

- 
- (a) had or had not been complied with at a date or within a period specified in the certificate; or
  - (b) had been complied with, but at a date later than that specified in the certificate.
- (7) The Registrar may refuse to accept any document lodged or request that the document be amended and re-lodged or a new document be lodged, if he or she is of the opinion that the document:
- (a) contains matters contrary to law;
  - (b) by reasons of any omission or misdescription has not been duly completed;
  - (c) does not comply with the requirements of this Act; or
  - (d) contains any error, alteration or erasure.

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## PART 3 — REGISTRATION OF TRADEMARKS

### 8 Who may apply to register trademark

A trademark may be registered by:

- (a) the owner of the mark;
- (b) a person authorised by the owner of the mark; or
- (c) an assignee of the trademark under Part 8.

### 9 Application for registration

- (1) An application for the registration of a trademark shall:
  - (a) be in the prescribed form;
  - (b) include the name, description and address of the applicant;
  - (c) include a clear representation, drawing or design of the mark;
  - (d) state the goods or services for which the trademark is associated with;
  - (e) include a declaration for use or intention to use the trademark;
  - (f) include such other information as may be prescribed;
  - (g) be declared and signed by the applicant; and
  - (h) provide evidence of payment of the prescribed fee.
- (2) Where 2 or more persons have a common interest in the registration of a mark as a trademark, the application shall be made jointly by such persons.
- (3) A trademark applied for and registered under subsection (2) may only be used by such persons where it is used:
  - (a) on behalf of all of them; and
  - (b) for goods or services with which all of them are connected to.

### 10 Notification of an application in the Gazette

- (1) The Registrar shall publish the details of an application in the Gazette in the prescribed form.
- (2) The publication under subsection (1) shall specify all such conditions or limitations that the Registrar deems necessary for the purposes of the registration.

### 11 Opposition to application

- (1) A person may give a notice of opposition to the Registrar within 21 days of the gazettal of the application.
- (2) The notice of opposition shall be made in the prescribed form and shall include a precise statement or reason for opposition.
- (3) The Registrar shall provide a copy of the notice of opposition to the applicant and require a response within 21 days from the date the notice of opposition is provided to the applicant.
- (4) Where the applicant fails to provide a response under subsection (3), the Registrar may deem the application as abandoned and decline to register the mark.
- (5) Where the applicant responds to the notice under subsection (3), the Registrar shall provide a copy of the response to the person opposing the registration.

- (6) The Registrar shall require all parties to provide such other information he or she deems necessary before making a decision on the application.

## **12 Registrar may refuse to register a trademark**

The Registrar may decline an application to register a mark as a trademark on the grounds contained in Part 6.

## **13 Rejection of application**

The Registrar shall reject an application for the registration of a mark as a trademark:

- (a) which does not comply with Part 5;
- (b) where the applicant fails to complete the registration process of the mark within 3 months of the date of lodging the application with the Registrar; or
- (c) for any other reason he or she deems fit.

## **14 Acceptance for registration**

- (1) The Registrar shall register a mark that has been accepted for registration where:
  - (a) there has been no opposition to the registration of the trademark; or
  - (b) there has been opposition, the Registrar's decision is that the trademark is to be registered.
- (2) The Registrar shall assign a prescribed code for the identification of every trademark, he or she registers.
- (3) The registration shall be deemed to have come into effect from the date of the filing of the application for registration.

## **15 Applicant to be notified for non-complying application**

Where the Registrar considers that an application does not comply with the requirements of this Act, he or she shall:

- (a) inform the applicant; and
- (b) give the applicant an opportunity to respond or amend the application by correcting only those matters set out by the Registrar within the time specified.

## **16 Amendment of pending application for registration**

- (1) The applicant may apply in the prescribed form to the Registrar requesting an amendment to a pending application for the registration of a mark.
- (2) The Registrar may on his or her own initiative amend the application for registration, where he or she deems necessary.
- (3) Where an application has not been published in the Gazette and a request for an amendment is made in order to correct a clerical error or an obvious mistake, the Registrar shall amend the application for the registration of a mark as a trademark.
- (4) Where an application has been published in the Gazette, the application may only be amended where the amendment does not substantially affect the identity of the trademark as at the time when the particulars of the application were published.

**17 Notice of decision**

The Registrar shall within 90 days of the lodgement of the application:

- (a) notify the applicant in writing of his or her decision; and
- (b) publish his or her decision in the Gazette.

**18 Certificate of registration**

The Registrar shall on the registration of a trademark:

- (a) issue to the applicant a certificate of registration in the prescribed form; and
- (b) publish in the Gazette the trademark with or without any conditions or limitations.

[The next page is 601,201]

## PART 4 — EFFECT OF REGISTRATION

### **19 Effect of registration**

A trademark is a property right obtained by the registration of the trademark under this Act.

### **20 Rights attached to a trademark**

- (1) The owner of a trademark has the exclusive right to:
  - (a) use the trademark;
  - (b) authorise or assign to other persons the right to use the trademark; or
  - (c) obtain a remedy or relief under this Act for any infringement of the trademark.
- (2) For the purposes of subsection (1)(a), where more than one person owns a trademark, he or she:
  - (a) along with the other owners, have the exclusive right to the use of trademark in respect of those goods or services; and
  - (b) does not have the right to exclude any other owners from using the trademark in respect of goods or services provided by the other owners.

### **21 Conditions and limitations of registration**

Where the trademark is registered subject to any conditions or limitations, the rights of the owner are restricted by such conditions or limitations.

### **22 Rights and obligations of authorised user of trademark**

- (1) Subject to any agreement with the registered owner, the authorised user of a trademark may:
  - (a) use the trademark for the goods or services for which the trademark is registered;
  - (b) use the trademark with conditions or limitations of registration; or
  - (c) bring an action for infringement of the trademark by any other person where the registered owner refuses or neglects to do so within 6 months of such infringement.
- (2) Where the authorised user brings an action under subsection (1)(c) for infringement of the trademark, the authorised user shall join the registered owner of the trademark as a party to the action.

[The next page is 601,401]



## PART 5 — TRADEMARKS THAT ARE NOT REGISTRABLE

### 23 Non distinctive trademark not registrable

- (1) The Registrar shall not register a:
  - (a) mark that is not capable of being registered as a trademark;
  - (b) mark that has no distinctive character;
  - (c) mark that consists only of signs or indications that may serve in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, time of production of goods or rendering of services or other characteristics of goods or services; or
  - (d) mark that consists only of signs or indications that have become customary in the current language or in the *bona fide* and established practices of trade.
- (2) The Registrar shall not refuse to register a mark under subsection 1(b), (c) or (d) where before the date of application for registration as a result of either the use made of it or any other circumstances, the mark had acquired a distinctive character.

### 24 Limitation as to colour

- (1) A trademark may be registered limited in whole or in part to one or more specified colours.
- (2) Where a trademark is registered without limitation of colour, it shall be deemed to be registered for all colours.

### 25 Trademark that contains protected geographical indication

The Registrar shall not register a mark that:

- (a) contains a protected geographical indication in respect of specified goods;  
or
- (b) relates to specified goods that do not originate from the place indicated in the protected geographical indication.

### 26 Mark that contains commonly used chemical names

- (1) The Registrar shall not register in respect of a chemical substance or preparation a mark that contains the commonly used and accepted name of any single chemical element or single chemical compound.
- (2) Subsection (1) does not apply to a word that is used to denote only a brand or make of the element or compound made by the owner or an authorised user of the trademark together with a suitable name or description open for public use.

### 27 Mark that contains certain words

The Registrar may not register a mark that contains the words or any abbreviations to those words or any similar words:

- (a) ‘*copyright*’;
- (b) ‘*layout*’;
- (c) ‘*patent*’;

- (d) *'patented'*;
- (e) *'plant variety right'*;
- (f) *'registered'*;
- (g) *'registered design'*; or
- (h) *'trademark'*.

## **28 Mark that contains person's name**

Where a person applies for the registration of a sign as a trademark and the sign contains the name or representation of a person, the Registrar may require the written consent of:

- (a) that person unless the person died 10 years or more before the making of the application; or
- (b) the person's legal representative where:
  - (i) the person died within 10 years before the making of the application; or
  - (ii) the Registrar believes on reasonable grounds that the person's consent cannot for any other reason be obtained.

## **29 Mark that contains representations of the President and Cabinet**

The Registrar shall not register a mark that contains a representation of the President or any member of the Cabinet or an imitation of any such representation.

## **30 Identical or similar mark**

The Registrar shall not register a mark in respect of any goods or services where:

- (a) it is identical to a trademark that belongs to a different owner and that is registered or has priority under Section 34 in respect of the same goods or services;
- (b) it is similar to a trademark that belongs to a different owner and that is registered or has priority under Section 34 in respect of the same goods or services that are similar to those goods or services and its use is likely to deceive; or
- (c) it is for an essential element of it is identical or similar to or a translation of a trademark that is well known in the Republic whether through advertising or otherwise, in respect of those goods or services or similar goods or services or any other goods or services if the use of the trademark would be taken to indicate a connection in the course of trade between those other goods or services and the owner of the trademark and would be likely to prejudice the interests of the owner.

## **31 Mark that contains representation of flag**

Where a person applies for the registration of a mark which includes a representation of a flag, armorial bearing, insignia or decorations of any entity, the Registrar may require that the applicant obtains written consent as

prescribed under the *Naoero National Anthem Emblem and Flag Protection Act 2018* and under any written law or require the applicant to apply to such person who has authority to give such consent.

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## PART 6 — REFUSAL TO REGISTER A TRADEMARK

### 32 Trademark not distinguishing applicant's goods or services

- (1) An application for the registration of a mark shall be rejected where the mark is not capable of distinguishing the applicant's goods or services from the goods or services of other persons.
- (2) The Registrar in considering an application under subsection (1), shall take into account the extent to which the mark is adapted to distinguish the applicant's goods or services from the goods or services of other persons.
- (3) For the purposes of this Section, the use of the trademark by the applicant's predecessor in title is taken to be a use of the trademark by the applicant.

### 33 Trademark scandalous or its use is contrary to law

An application for the registration of a mark shall be rejected where:

- (a) the mark contains or consists of scandalous matter;
- (b) it is obscene, immoral or contrary to public order; or
- (c) its use would be contrary to law.

### 34 Identical trademarks

- (1) An application for the registration of a mark for goods or services shall be rejected where:
  - (a) the applicant's mark is substantially identical with or deceptively similar to;
    - (i) a trademark registered by another person for similar goods or services; or
    - (ii) a trademark, whose registration for similar goods or services is being sought by another person; and
  - (b) the priority date for the registration of the applicant's trademark for the applicant's goods or services is the same as or after the priority date for the registration of the other trademark for the similar goods or services.
- (2) The Registrar may allow the registration of a trademark subject to any conditions or limitations where he or she is satisfied that there has been an honest concurrent use of the 2 trademarks and it is reasonable to do so.
- (3) Where the Registrar is satisfied that the applicant or the applicant's predecessor in title has continuously used the applicant's trademark for a period:
  - (a) beginning before the priority date for the registration of the other trademark; and
  - (b) ending on the priority date for the registration of the applicant's trademark,the Registrar shall not reject the application on the basis of the existence of the other trademark.

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**PART 7 — DURATION, RENEWAL, SURRENDER, REMOVAL OF  
TRADEMARK**

**35 Duration of trademark**

- (1) Subject to subsection (2), a trademark shall be registered for a period of 10 years.
- (2) The owner of a registered trademark shall pay the prescribed annual fee for maintaining the trademark.

**36 Application for renewal**

- (1) A registered owner of a trademark may apply to the Registrar to renew the registration before or after the expiration of a registered trademark.
- (2) The application shall be in the prescribed form and accompanied by evidence of payment of the prescribed fee.
- (3) The Registrar may renew the registration for a period of 10 years from the date of the expiry of the trademark.

**37 Correction of Register**

The Registrar may on an application of the owner of a trademark:

- (a) correct an error or omission in the name, address or description of the owner of the trademark;
- (b) enter any change in the name, address or description of the owner of the trademark; or
- (c) cancel any entry of the trademark.

**38 Surrender of trademark**

- (1) An owner of a trademark may surrender the registration of the trademark in respect of some or all of the goods or services for which it is registered.
- (2) Where an application is made to surrender the trademark, the Registrar shall:
  - (a) record the surrender; and
  - (b) publish such surrender in the Gazette.

**39 Alteration of a trademark**

- (1) The owner of a trademark may apply to the Registrar to alter the trademark in any manner not substantially affecting the identity of the trademark or the goods or services for which it was registered.
- (2) An application under subsection (1) shall be:
  - (a) made in the prescribed form; and
  - (b) accompanied by proof of payment of the prescribed fee.
- (3) The Registrar shall publish the application for alteration of the trademark in the Gazette.
- (4) The Registrar may alter the registration:
  - (a) where no opposition is received within 14 days of the publication under subsection (3);

(b) in case of an objection, after considering the merits of the objection.

#### 40 Addition of goods or services

- (1) The owner of the trademark may apply to add goods or services with respect to which the trademark is registered in the prescribed form and accompanied by evidence of payment of the prescribed fee.
- (2) The Registrar shall publish the application for addition of goods or services to which the trademark is registered in the Gazette.
- (3) The Registrar may alter the registration:
  - (a) where no opposition to addition of goods or services is received within 14 days of the publication under subsection (2); or
  - (b) where an objection is made, after considering the merits of the objection.

#### 41 Removal for non-use of trademark

- (1) A person may make an application in the prescribed form and accompanied by evidence of payment of the prescribed fee to the Registrar for removal of trademark for non-use for any or all of the goods or services for which the trademark is registered.
- (2) An application for removal of the registration of a trademark from the Register may be made where:
  - (a) the owner of the trademark at the time of the registration had no *bona fide* intention to:
    - (i) use the trademark in the Republic; or
    - (ii) authorise, assign or transmit the use of the trademark in the Republic;
  - (b) the owner of the trademark at the time of the registration had no intention to use or had not used the trademark for the specified goods or services for which registration relates; or
  - (c) the owner of the trademark had not used the trademark for a continuous period of 3 years in relation to the goods or services for which the registration relates.
- (3) The Registrar shall:
  - (a) give notice of the application for removal to the registered owner of the trademark; and
  - (b) publish a notice of the application in the Gazette.
- (4) The Registrar shall consider the application and notify the applicant and the owner of the trademark of his or her decision.

#### 42 Rectification of Register

The Registrar shall have the power to rectify any entry in the Register at his or her discretion or on an application by a person, where there is:

- (a) omission of an entry;
- (b) entry made without any sufficient cause;
- (c) an error or defect in the entry; or
- (d) an entry wrongly remaining in the Register.

[The next page is 602,001]



## PART 8 — ASSIGNMENT OF TRADEMARK

### 43 Assignment of trademark

- (1) A registered trademark may be assigned in accordance with this Section.
- (2) The assignment may be partial, applicable to only some of the goods or services:
  - (a) for which registration is sought; or
  - (b) for which the trademark is registered.

### 44 Application to register assignment of trademark

- (1) A person who seeks to register an assignment of a trademark shall apply in the prescribed form to the Registrar for the assignment to be registered.
- (2) Where the application complies with this Act, the Registrar shall:
  - (a) within 7 days of receiving the application, record the application for registration and particulars of the assignment in the Register; and
  - (b) publish the particulars of the assignment in the Gazette.

### 45 Recording assignment of trademark in Register

- (1) Where a trademark is assigned:
  - (a) the person registered as the owner of the trademark; or
  - (b) the person to whom the trademark has been assigned,shall apply in the prescribed form and provide evidence of payment of the prescribed fee to the Registrar for a record of the assignment to be entered in the Register.
- (2) Where the application complies with this Act, the Registrar shall within 7 days:
  - (a) enter the particulars of the assignment in the Register; and
  - (b) register the assignee of the relevant trademark.
- (3) The registration of the assignee shall take effect from the day the application was filed.
- (4) The Registrar shall publish in the Gazette:
  - (a) the recording of the assignment; and
  - (b) the registration of the person to whom the trademark is assigned.

### 46 Notice of application to be given to person recorded claiming interest in trademark

Where an application for the assignment of a trademark complies with this Act, the Registrar shall notify in writing any person recorded as claiming an interest or a right in respect of the trademark.

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## PART 9 — COLLECTIVE TRADEMARKS

### **47 Collective Trademarks**

A collective trademark is a sign used or intended to be used for goods or services dealt with or provided in the course of trade by members of an association, to distinguish those goods or services from goods or services so dealt with or provided by any person who is not a member of the association.

### **48 Limitation on rights given by registered Collective Trademark**

- (1) A member of an association in whose name a collective trademark is registered does not have the right to prevent another member of the association from using the collective trademark in accordance with the rules established by the association.
- (2) A collective trademark may not be assigned.

### **49 Infringement of Collective Trademark**

In any suit or action filed in court by an association in whose name a collective trademark is registered seeking relief of infringement of the collective trademark, the association may take into account in claiming damages, any damage or loss of profits sustained or incurred by the members of the association as a result of the infringement.

[The next page is 602,401]

## PART 10 — INFRINGEMENT OF TRADEMARKS

### 50 Infringement of trademarks

- (1) A person infringes a trademark where, without the consent of the owner, he or she uses in the course of trade, a sign:
  - (a) that is identical with the trademark and is used in relation to goods or services identical to those for which the trademark is registered; or
  - (b) that is similar to the trademark and is used in relation to goods or services similar to those for which the trademark is registered, which may or may not mislead the public.
- (2) A person infringes a trademark which is well known, where the person uses a sign that is substantially identical with or deceptively similar to the trademark for:
  - (a) goods or services of the same description as that of the goods or services for which the trademark is registered; or
  - (b) goods or services that are closely related to the registered goods or services.
- (3) Subsection (1) applies only if the sign is used in such a manner as to render the use of the sign as likely to be taken as being used as a trademark.
- (4) A person infringes a registered trademark where:
  - (a) he or she uses the mark without the consent of the owner in the course of trade which is identical or similar to the trademark in relation to goods or services which are not similar to those for which the trademark is registered;
  - (b) the trademark is well known in the Republic;
  - (c) the person uses a mark that is substantially identical or deceptively similar to the trademark for:
    - (i) unrelated goods that are not of the same description as that of the goods for which the trademark is registered or are not closely related to services for which the trademark is registered; or
    - (ii) unrelated services that are not the same description as that of the registered services or not closely related to registered goods;
  - (d) the trademark is well known that it is likely to be taken as showing a connection between the unrelated goods or services and the registered owner of the trademark; and
  - (e) the interest of the registered owner is likely to be adversely affected.
- (5) In deciding whether a trademark is well known in the Republic, the court shall take into account the extent to which the trademark is known within the relevant sector of the public, whether as a result of the promotion of the trademark or for any other reasons.

### 51 Infringement of contractual requirements

- (1) A trademark is infringed where:
  - (a) a purchaser or owner of the goods or services and the owner or assignee of the trademark have entered into a written contract that prohibits the purchaser or owner of the goods or services from doing any of the acts listed in subsection (2); and

- (b) the owner for the time being of the goods or services:
  - (i) has brought to the notice of the purchaser such contractual requirement;
  - (ii) authorises in the course of trade of the goods or services, any of those listed acts;
  - (iii) did not purchase the goods for value and in good faith before receiving notice of the contractual requirement; and
  - (iv) is not a successor in title to an owner to whom subparagraph (iii) applies.
- (2) The acts referred to under subsection (1) are:
  - (a) the application of the trademark on the goods after their condition, get-up or packaging has been altered in any manner specified in the contract;
  - (b) if the trademark is on the goods:
    - (i) the alteration, part removal or part obliteration of the trademark;
    - (ii) the application of any other trademark to the goods; or
    - (iii) the addition to the goods of any written material that is likely to damage the reputation of the trademark; or
  - (c) if the trademark is on the goods and there is something else on the goods that indicates a connection in the course of trade between the owner or assignee and the goods, the removal or obliteration whether wholly or partly of the trademark.

## **52 Infringement of trademark by breach of restrictions**

- (1) This Section applies to a trademark where the registered owner, assignee or an authorised user of the trademark having power to do so has caused a notice prohibiting any act, in relation to the goods for which the trademark is registered, to be displayed:
  - (a) on the registered goods; or
  - (b) on their package or the container in which they were offered to the public.
- (2) The following acts are prohibited:
  - (a) applying the trademark to registered goods or using the trademark in physical relation to them after the state, condition, get up or packaging in which they were originally offered to the public has been altered;
  - (b) altering or partially removing or obliterating any representation of the trademark applied to registered goods or used in physical relation to them;
  - (c) if the trademark has been applied to registered goods or used in physical relation to them together with other matter indicating the registered owner or authorised user has dealt with the goods removing or obliterating totally or in part any representation of the trademark without totally removing or obliterating the other matter;
  - (d) applying another trademark to registered goods or using another trademark in physical relation to them; or
  - (e) if the trademark has been applied to registered goods or used in physical relation to them, using on goods, packaging or container of the goods, any matter that is likely to injure the reputation of the trademark.

- (3) Subject to subsection (4), a person infringes a trademark to which this Section applies if the person:
  - (a) is the owner of registered goods; or
  - (b) in the course of trade or with a view to dealing with the goods in the course of trade:
    - (i) does an act that is prohibited under the notice of prohibition; or
    - (ii) authorises that act to be done.
- (4) The trademark is not infringed if the owner of the goods:
  - (a) acquired them in good faith and without being aware of the notice of prohibition; or
  - (b) became the owner of the goods through a title derived from a person who had so acquired them.

### **53 Trademark not infringed when used in good faith**

A person does not infringe a trademark when:

- (a) the person uses in good faith:
  - (i) the person's name or the name of the person's place of business; or
  - (ii) the name of a predecessor in business of the person or the name of the predecessor's place of business;
- (b) the person uses a sign in good faith to show:
  - (i) the kind, quality, quantity, intended purpose, value, geographical origin or some other characteristics of the goods or services; or
  - (ii) the time of production of goods or provision of services;
- (c) the person uses the trademark in good faith to show the intended purpose of the goods or services;
- (d) the person uses the trademark for the purposes of comparative advertising; or
- (e) the person exercises a right to use a trademark given to the person under this Act.

### **54 Goods or services to which the registered trademark has been applied by or with consent of registered owner**

A person who uses a registered trademark for goods or services that are similar to goods or services for which the trademark is registered does not infringe the trademark where the trademark has been applied to or in relation to the goods or services by or with the consent of the registered owner of the trademark.

### **55 Action for infringement**

- (1) An owner of a trademark may commence proceedings for any infringement of his or her trademark in the Supreme Court.
- (2) The relief that the Court may grant in an action for an infringement of a trademark includes:
  - (a) an injunction which may be granted subject to any condition that the Court deems fit;
  - (b) an order for removal of the infringing mark from all material and, where the infringing mark is inseparable or incapable of being removed from the material, an order that all such material be delivered up to the owner;
  - (c) damages, including those arising from acts performed after publication

- of the acceptance of an application for registration which, if performed after registration, would amount to infringement of the rights acquired by registration; or
- (d) in lieu of damages, a reasonable royalty which would have been payable by an assignee or authorised person for the use of the trademark concerned, including any use which took place after publication of the acceptance of an application for registration and which, if taking place after registration, would amount to infringement of the rights acquired by registration.
- (3) For the purposes of determining the amount of damages or reasonable royalty to be awarded under this Section, the Supreme Court may direct an enquiry to be held and may prescribe such procedures for conducting such enquiry as it may deem fit.
- (4) Prior to instituting proceedings under this Section, the owner of a trademark shall give notice in writing of his or her intention to do so to every assignee or authorised person in the Register, who shall be entitled to intervene in such proceedings and to recover any damages that he or she may have suffered as a result of the infringement.

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## PART 11 — OFFENCES

### **56 Falsifying trademark**

- (1) A person shall not knowingly falsify or remove a trademark, that has been applied to or in relation to any goods or services, that are being or are to be dealt with or provided in the course of trade.
- (2) A person who contravenes subsection (1) commits an offence and upon conviction is liable to a fine not exceeding \$20,000 or a term of imprisonment not exceeding 5 years or to both.

### **57 False representation of trademark**

- (1) A person shall not make a representation that a trademark is a registered trademark unless the person knows or has reasonable grounds to believe that the trademark is registered in the Republic.
- (2) A person who contravenes subsection (1) commits an offence and upon conviction is liable to a fine not exceeding \$20,000 or a term of imprisonment not exceeding 5 years or to both.

### **58 False entries in Register**

- (1) A person shall not:
  - (a) make a false entry in the Register;
  - (b) cause a false entry to be made in the Register; or
  - (c) tender a document that falsely purports to be a copy of or an extract from an entry in the Register or a document in the Registrar's office.
- (2) A person who contravenes subsection (1) commits an offence and upon conviction is liable to a fine not exceeding \$20,000 or a term of imprisonment not exceeding 5 years or to both.

### **59 Deceiving or influencing the Registrar**

- (1) A person shall not make or submit a false statement or representation whether orally or in writing to the Registrar in order to deceive or to procure or influence the doing or omission of anything in relation to this Act.
- (2) A person who contravenes subsection (1) commits an offence and upon conviction is liable to a fine not exceeding \$20,000 or a term of imprisonment not exceeding 5 years or to both.

### **60 Forgery of trademark**

- (1) A person shall not forge a trademark or falsely apply to goods or in relation to services, any trademark or any mark so nearly resembling a trademark.
- (2) A person who contravenes subsection (1) commits an offence and upon conviction is liable to a fine not exceeding \$20,000 or a term of imprisonment not exceeding 5 years or to both.

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## PART 12 — MISCELLANEOUS

### **61 Minister may authorise officers**

The Minister may, by notice in the Gazette, authorise an officer of the Department of Justice or a police officer to be an authorised officer for the purposes of this Act.

### **62 Liability of Registrar or authorised officers**

The Registrar or an authorised officer shall not be liable in any civil or criminal proceedings for anything done in the exercise of a power under this Act if the act or omission was done in good faith or on reasonable grounds.

### **63 Jurisdiction of District Court**

The District Court shall have jurisdiction to hear and determine all criminal offences under this Act and, shall have powers to impose the penalty or punishment in respect of the offences under this Act.

### **64 Legal practitioners may assist**

A legal practitioner with more than 5 years' experience may assist an owner, person authorised by the owner or an assignee of a trademark to:

- (a) register a trademark; and
- (b) carry out such other requirements under this Act.

### **65 Passing-off actions**

- (1) Except as provided in subsection (2), this Act does not affect the law relating to passing-off.
- (2) In an action for passing-off arising out of the use by a person of a registered trademark:
  - (a) of which he or she is the registered owner or an authorised user; and
  - (b) that is substantially identical with or deceptively similar to the trademark of the owner,damages may not be awarded against the person if the person satisfies the court.
- (3) It is a defence to a claim under subsection (2):
  - (a) that at the time when the person began to use the trademark he or she was unaware and had no reasonable means of finding out that the trademark of the owner was in use; and
  - (b) that when the person became aware of the existence and nature of the trademark of the owner, he or she immediately ceased to use the trademark in relation to the goods or services to which it was used by the owner.

### **66 Regulations**

The Cabinet may make regulations prescribing all matters necessary or convenient to be prescribed to give effect to this Act.

**67 Repeal**

[s 67 repealed by the Law Revision Commission under powers authorised by Act 10 of 2019]

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