

THE INDUSTRIAL DESIGNS ACT, 2016

ARRANGEMENT OF SECTIONS

PART I

PRELIMINARY PROVISIONS

Section

1. Short title and commencement
2. Interpretation
3. Act to bind Republic

PART II

ADMINISTRATION

4. Administration of Act
5. Seal of Agency
6. Registrar
7. Functions of Agency
8. Appointment of other staff
9. Non warranty and non-liability
10. Register of Designs
11. Rectification of Register
12. Inspection of register and evidentiary proof
13. Regulations on registration processes and procedures
14. Intellectual Property Journal

PART III

SCOPE AND REQUIREMENTS FOR PROTECTION OF DESIGN

15. Protection of designs
16. Designs excluded from protection
17. Novelty
18. Individual character
19. Proprietorship of designs
20. Subsisting of copyright in artistic work

PART IV

APPLICATION FOR REGISTRATION OF A DESIGN

21. Persons entitled to apply for registration of design
22. Application by joint creators
23. Filing of registration for design application
24. Disclosure of design before filing date
25. Contents of application
26. Filing date
27. First to file rule

28. Right of priority
29. Right of priority by exhibition of design
30. Application based on design of another person
31. Refusal of application in certain cases
32. Amendment of application for registration of design
33. Postdating of application
34. Correction of errors in documents
35. Withdrawal of application
36. Revocation of acceptance
37. Lapse of application
38. Filing of application by non resident

PART V

EXAMINATION, PUBLICATION AND OPPOSITION

39. Examination for compliance with requirements
40. Acceptance of application
41. Publication of acceptance
42. Inspection of application
43. Opposition to registration of design
44. Opposition procedure for registration

PART VI

DESIGNS BY EMPLOYEE

45. Design created by employee
46. Design created by Government employee
47. Disputes over design by employee

PART VII

INTERNATIONAL APPLICATIONS FOR REGISTRATION OF DESIGN

48. Role of Agency regarding international applications
49. Procedure relating to international application
50. ARIPO registration of design

PART VIII

REGISTRATION, TERM AND RENEWAL OF DESIGN

51. Registration of design
52. Date and term of registration of design
53. Publication of registration
54. Restoration of design on Register
55. Rights of proprietor of restored registration of design

PART IX

PROPRIETOR'S RIGHTS AND LIMITATIONS

56. Exclusive rights of proprietor
57. Nature of registered design right
58. Joint ownership of registered design
59. Limitations of registered design rights

PART X

INFRINGEMENT

60. Infringement
61. Non-infringement acts
62. Right to commence proceedings for Infringement
63. Remedies for infringement
64. Order for delivery up
65. Order for forfeiture, destruction and disposal
66. Restrictions on recovery of damages for innocent infringement
67. Declaration of non-infringement
68. Infringement proceedings where concurrent rights exist
69. Affidavit evidence
70. Groundless threat of infringement proceedings

PART XI

CANCELLATION OF REGISTRATION OF REGISTERED DESIGN

71. Application to cancel registration of registered design
72. Cancellation of registration by order of Court
73. Cancellation of registration of registered design in public interest
74. Effect of cancellation of registration

PART XII

PUBLICATION OR COMMUNICATION OF DESIGN RELATED TO DEFENCE
AND SECURITY

75. Prohibiting publication or communication of information prejudicial to defence
76. Effects of directions on application
77. Penalty

PART XIII

CONTRACTUAL AND COMPULSORY LICENCES

78. Licence contract
79. Refusal by Registrar to register licence contract
80. Exclusive licence

81. Compulsory licence
82. Compulsory license granted under regulation
83. Revocation of compulsory license
84. Registration of compulsory licence

PART XIV

EXPLOITATION OF REGISTERED DESIGNS BY GOVERNMENT

85. Use of registered design by Government
86. Notification of proprietor by Government
87. Extent, duration and limitation of use of registered design
88. Compensation of proprietor for use of registered design

PART XV

OFFENCES

89. Manufacture and possession of die for use in commission of offence
90. Holding out as patent agent
91. Offences by body corporate or unincorporated body
92. General offences
93. General penalty

PART XVI

GENERAL PROVISIONS

94. Exercise of discretionary power
95. Registrar may sit with assessors in determining a matter
96. Evidence of certain entries and documents
97. Requests for information
98. Extension of time
99. Registrar to act as soon as practicable
100. Registrar to act in accordance with court
101. Authorisation to publish advertisement of notice
102. Replacement of certificate
103. Lodging and authentication of documents
104. Expenses relating to administration
105. Administrative penalties
106. Prescribed fee
107. Waiver of payment of prescribed fee
108. Regulations
109. Repeal
110. Transitional provisions

SCHEDULE

GOVERNMENT OF ZAMBIA

ACT

No. 22 of 2016

Date of Assent: 6th June, 2016

An Act to encourage the creation of designs and development of creative industries through enhanced protection and utilisation of designs; to provide for the registration and protection of designs; to provide for the rights of proprietors of registered designs: to provide for the restriction, publication and communication of registered designs; to provide for contractual and compulsory licences; to provide for the use and acquisition of registered designs by the Government; to give effect to the Paris Convention for the Protection of Industrial Property 1883, the Harare Protocol on Patents and Industrial Designs adopted on December 10, 1982, the World Trade Organisation Agreement on Trade Related Aspects of Intellectual Property Rights 1994 and any other relevant international treaty or Convention to which Zambia is a State Party; to repeal and replace the Registered Designs Act, 1958; and to provide for matters connected with, or incidental to, the foregoing.

[7th June, 2016

ENACTED by the Parliament of Zambia.

Enactment

PART I

PRELIMINARY PROVISIONS

1. This Act may be cited as the Industrial Designs Act, 2016, and shall come into operation on such date as the Minister may appoint by statutory instrument.

Short title
and
commencement

- Interpretation
2. In this Act, unless the context otherwise requires—
- “Agency” means the Patents and Companies Registration Agency established under the Patent and Companies Registration Act, 2010;
- “applicant” means a person who applies for registration of a design and includes a person making any other formal application in accordance with this Act;
- “ARIPO” means the African Regional Intellectual Property Organisation established by an agreement adopted at Lusaka on 9 December, 1976;
- “article” includes any substance, material, equipment, machinery or apparatus whether affixed to land or not;
- “artistic work” means work of any of the following descriptions:
- (a) paintings, sculptures, drawings, engravings and photographs irrespective of artistic quality;
 - (b) works of architecture, being either buildings or models for buildings; or
 - (c) works of artistic craftsmanship not falling within paragraph (a) or (b);
- “assessor” means a person who is an expert in Intellectual Property or any relevant field appointed by the Registrar;
- “assignee” means a person who derives title to a design from a proprietor;
- “authorised person” includes a contractor, subcontractor, firm or corporation who is authorised, in writing, to undertake an activity for noncommercial purposes for or on behalf of the Government;
- “Board” means the Board of the Agency constituted in accordance with the Patents and Companies Registration Agency Act, 2010;
- “child” has the meaning assigned to it in the Constitution;
- “compulsory licence” means a licence granted by the Minister, in accordance with, and for the purposes stated in, section *eighty-one*;
- “convention application” means an application for the registration of a design from a convention country;
- “convention country” means a country or an inter-governmental body which is party to the Paris Convention;
- “corresponding design” in relation to an artistic work means a design which, when applied to an article, results in a reproduction of that work;

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- “court” in relation to any matter means the High Court;
- “creator” means a person who actually creates the design and includes a person who made arrangements for the creation of a computer aided design, but does not include a person to whom a design has been communicated, from within or outside Zambia;
- “date of lodging” means the date on which a document is lodged or deemed by virtue of any provision in this Act to have been lodged;
- “design” means an industrial design taking the form of features of shape, configuration, pattern, ornament or composition of lines or colours applied to any article, whether in two dimensional or in three dimensional or in both forms, by any industrial process or means, which in the finished article appeal to, and are judged solely by the eye, and are not related to functionality; but does not include any mode or principle of construction or anything which is in substance a mere mechanical device;
- “designated office” means the national designs office designated by an applicant for a conventional registration of a design;
- “elected office” means the national designs office elected by an applicant for the registration of a conventional application;
- “exclusive licence” means a licence, in writing, signed by or on behalf of a proprietor, authorising the licensee, to the exclusion of all other persons, including the person granting the licence, to exercise a right that would otherwise be exercisable exclusively by the proprietor, and “exclusive licensee”, “exclusive assignee” and “exclusive assignment” shall be construed accordingly, with the necessary modifications;
- “filing date” means the date of receipt of an application which complies with the requirements of this Act;
- “Harare Protocol” means the Protocol for the Protection of Patents, Utility Models and Industrial Designs administered by ARIPO;
- “legal representative” means a—
- (a) liquidator or receiver of a company;
 - (b) person appointed under a power of attorney;
 - (c) person recognised by law, representing a person

who has died, become bankrupt or assigned their estate; or

- (d) person recognised by law, representing a child, a person of unsound mind or a person with a legal disability;

“licensee” means a person who has been permitted by a proprietor of a design to exploit the protected design in accordance with the terms and conditions specified in a licence contract;

“novelty” means the newness of a design in terms of features or appearance;

“officer” means an employee of the Agency;

“Paris Convention” means the Convention for the Protection of Industrial Property signed at Paris on March 20, 1883;

“practitioner” has the same meaning assigned to it by the Legal Practitioners Act;

“product” means any industrial or handicraft item other than a computer program and includes packaging, getup, graphic symbols, typographic typefaces and parts intended to be assembled into a complex product;

“proprietor” means a legal owner of a design which was not exploited anywhere else in the world before it was exploited in Zambia or in a conventional country and includes the creator of the design;

“Register” means the Register of Designs established and maintained in accordance with section ten;

“Registrar” means the person appointed as Registrar in accordance with the Patents and Companies Registration Agency Act, 2010;

“repealed Act” means the Registered Designs Act, 1958;

“release date” means the date on which the design was first made available to the public in Zambia or elsewhere with the consent of the proprietor or any predecessor in title; and

“WIPO” means the World Intellectual Property Organisation established on July 14, 1967.

PART II

ADMINISTRATION

- 4.** This Act shall be administered by the Agency. Administration of Act
- 5.** The seal of the Agency kept in terms of the Patents and Companies Registration Agency Act, 2010, shall be used for the purposes of this Act and the impression made for such purposes shall be judicially noticed. Seal of Agency
- 6.** (1) The Registrar appointed in accordance with the Patents and Companies Registration Agency Act, 2010 shall, in addition to the Registrar's other functions and powers specified in that Act and any other law, exercise the powers and perform the functions conferred on the Registrar in accordance with this Act. Registrar
- (2) The Board may delegate the functions and powers of the Agency, specified in this Act, to the Registrar when the Board considers it necessary for the better implementation of this Act.
- 7.** The functions of the Agency are to— Functions of Agency
- (a) receive and process applications for the registration of designs made by a person referred to in section *twenty-one*;
- (b) act as a designated or an elected industrial designs office for international applications;
- (c) act as an elected office for purposes of an international preliminary examination; and
- (d) perform any other functions as are necessary or incidental to the carrying out of its functions under this Act.
- 8.** The Board shall appoint assistant registrars, such number of examiners and other officers as may be necessary for carrying out the provisions of this Act and who shall, subject to the control of the Registrar, have all the powers conferred by this Act on the Registrar. Appointment of other staff
- 9.** An examination, investigation or any act undertaken, in accordance with this Act, shall not warrant the validity of such examination, investigation or act and no liability shall be incurred by the Registrar, examiner or any other officer by reason of, or in connection with, any examination, investigation, act or other consequent proceeding. Non-warranty and non-liability
- 10.** (1) The Agency shall establish and maintain a Register of designs in which shall be entered— Register of designs

- (a) particulars of designs;
- (b) licences, assignments or transmissions of designs;
- (c) notices of matters which are required, in accordance with this Act to be entered in the Register; and
- (d) such other matters affecting the validity or ownership of a design, as may be prescribed.

(2) The Register may be established in nonelectronic or electronic form or partly in electronic form.

(3) Where the Register is kept wholly or partly in electronic form, reference in this Act to—

- (a) an entry in the Register shall include reference to a record of particulars kept in electronic form;
- (b) particulars being entered in the Register shall include references to the keeping of records in electronic form; and
- (c) the rectification of the Register shall include references to the rectification of the record of particulars kept in electronic form.

Rectification of Register

11. The Registrar shall, where a design has been registered in accordance with section *fifty-one* and entered into the Registrar as provided in section ten, rectify the Register, if the court so orders, at the instance of the Registrar or a proprietor.

Inspection of register and evidentiary proof

12. (1) Subject to this Act, the Register shall, on payment of the prescribed fee, be open for inspection by the public during prescribed hours.

(2) The Register shall be *prima facie* evidence of any matters required or authorised, by or in accordance with this Act, to be entered in the Register.

(3) A copy of any entry in the Register or an extract from the Register, certified by the Registrar, shall be admitted in evidence without further proof and without production of the original copy.

Regulations on registration processes and procedures

13. (1) The Minister may, by statutory instrument, make regulations for, or with respect to, any matter under this Part that is to be prescribed or necessary for carrying out or giving effect to the registration processes and procedures.

(2) Without limiting the generality of subsection (1), regulations made, in accordance with that subsection, may be made on the following matters:

- (a) the format of applications for the registration of a design;
- (b) the payment of fees in respect of any matter or anything done or provided for under this Part;
- (c) the procedure to be followed in connection with any application or request to the Registrar or any proceeding before the Registrar;
- (d) the provision of copies of any documents registered in the Register and the certification of such copies;
- (e) the making of searches to the Register, including the times when, and the manner in which, the searches may be made;
- (f) the service of notices and other documents with respect to the Register; or
- (g) any matter required to be provided for in relation to the Register.

14. (1) The Registrar shall arrange for the periodic publication of an Intellectual Property Journal on registered designs in accordance with this Act and any matter which the Registrar may consider desirable relating to such matters.

Intellectual
Property
Journal

(2) The Registrar may sell copies of the Intellectual Property Journal at such price and in such manner as the Board may approve.

PART III

SCOPE AND REQUIREMENTS FOR PROTECTION OF DESIGN

15. A design shall be eligible for protection, by registration in accordance with this Part, if the design is new and has individual character as provided in accordance with this Act.

Protection of
designs

16. Despite section *fifteen*, the following designs shall not be registered and shall be excluded from being protected:

Designs
excluded
from
protection

- (a) designs which are contrary to written laws or well established natural laws;
- (b) designs which contravene or are inconsistent with public order, public morality, principles of humanity and environmental conservation; and

(c) designs which comprise a flag, emblem, armorial bearings, abbreviation, decoration, coat of arms or other official sign and hallmark of Zambia or any other convention country or intergovernmental organisation of which one or more convention countries are State parties, used without consent.

Novelty

17. (1) A design shall be considered new if no design, whose features differ only in immaterial details, has been made available to the public within Zambia or elsewhere before the release date.

(2) A design shall be considered to be available to the public before the release date if it has been published, exhibited, or used in trade or otherwise disclosed before the release date.

Individual character

18. A design shall be considered to have individual character if the overall impression it produces on an informed user differs from the overall impression produced on such a user by any earlier design, which has been made available to the public before the release date of such a design.

Proprietorship of designs

19. Subject to the other provisions of this Act or a written agreement, the creator of a design shall be considered as the original proprietor of a design, except where—

(a) a design is created in pursuance of a commission for money or money's worth, the person commissioning the design shall be treated as the original proprietor of the design;

(b) a design is created by an employee in the course of employee's employment, the employer shall be considered as the original proprietor of the design;

(c) a design becomes vested in a person other than the original proprietor, either alone or jointly with the original proprietor, such person, alone or jointly with the original proprietor, as the case may be, shall be considered as the proprietor or joint proprietors; or

(d) a design is generated by computer in a manner which does not involve a human creator, the person who arranges the computer program for the creation of such design, shall be considered as the original proprietor.

20. Where copyright subsists in an artistic work and an application for the registration of a corresponding design is made by or with the consent of the owner of the copyright, the design shall, for the purpose of this Act, be treated as new despite the artistic work being previously made use of, unless the previous use—

Subsisting of copyright in artistic work

- (a) of the artistic work consisted of or included selling, hiring, or offering to sale or hire articles to which the design is different only in immaterial details; or
- (b) was done by the owner of the artistic work or with the owner's consent.

PART IV

APPLICATION FOR REGISTRATION OF DESIGN

21. An application for registration of a design, may be filed with the Agency, in a prescribed form and manner by any of the following:

Persons entitled to apply for registration of design

- (a) a person claiming to be a creator of the design;
- (b) an assignee of the person claiming to be a creator;
- (c) a legal representative of a creator of a design or assignee;
- (d) two or more persons who claim to be the creators of the design, as specified in section *twenty-two*; or
- (e) a successor in title to a creator of a design or assignee.

22. (1) An application for the registration of a design may be filed by two or more creators who have jointly created a design.

Application by joint creators

(2) An application, referred to in subsection (1), shall be made notwithstanding that —

- (a) the creators of the design did not physically work together when coming up with the design; or
- (b) the creators of the design did not make equal contribution to the creation of the design.

23. (1) An application for the registration of a design shall be filed in accordance with section *twenty-one*, accompanied by a prescribed fee.

Filing of registration for design application

(2) Where one or more of the creators who jointly created a design, as provided in section *twenty-two*, cannot be found or reached for purposes of filing, the Registrar may, on being satisfied, allow an application to be made with the inclusion of the name or names of the missing creator or creators.

(3) The Registrar may, where a design is created jointly by two or more creators as specified in section *twenty-two*, but one or more of the persons refuse to be included on the application for the registration of a design, on being satisfied of the proof of such refusal, allow the application to be filed without the name or names, as the case may be, of the creator or creators who have refused to be included.

Disclosure of
design before
filing date

24. An application for the registration of a design, consisting of a design which has been disclosed before the filing date, shall not be refused registration by the Registrar or invalidated if the disclosure—

- (a) occurred within six months preceding the date of filing of the application for registration;
- (b) was due to the design having been obtained unlawfully or in breach of confidence by any person—
 - (i) from the creator of the design or any other person to whom the matter was made available in confidence or who obtained the design from the creator because the creator believed that the person was entitled to obtain it;
 - (ii) from any other person to whom the matter was made available in confidence by any person mentioned in subparagraph (i) or in this subparagraph or who obtained it from any person so mentioned because that person or the person from whom that person obtained the design believed that such person was entitled to obtain it;
- (c) in the case of textile, was as a result of a confidential order for products bearing the design, made before the registration of a design and such disclosure was made without the consent of the creator of the design;
- (d) was made by way of the creator communicating the design to a Government department, agency or an authorised person, to consider the merits of the design;
- (e) was made due to, or in consequence of, the creator of a design displaying the design at an exhibition, recognised by the Agency, and the applicant states, on filing the application, that the creator has notified the Registrar, in the prescribe manner, that the design has been so displayed and files written evidence in support of such notification, within the prescribed period; or

(f) was made to the public for the purpose of providing the result of a research undertaken by a higher education institution, research institution or development institution, within six months preceding the date of lodging an application for the registration of the design.

25. An application for the registration of a design shall contain—

Contents of application

- (a) the name and residence of the creator of a design;
- (b) the name and residence of the applicant;
- (c) where the applicant has a representative, the name and address of the representative;
- (d) where the applicant is a legal entity, the name and nature of the entity;
- (e) a detailed description of a design; and
- (f) any other requirements as may be prescribed.

26. (1) An application for the registration of a design shall be assigned a filing date by the Registrar.

Filing date

(2) The Registrar shall assign, as the filing date of an application, the date on which the applicant has satisfied the requirements of this Act.

(3) Where the Registrar finds that, on the face of it, the application for the registration of a design does not fully comply with the requirements of this Act, at the time of filing, the Registrar shall request the applicant to file the necessary correction, within a prescribed period, before the application is assigned a filing date.

(4) Where the applicant complies with the request referred to in subsection (3), the Registrar shall assign, as the filing date for the registration of a design, the date on which the correction is lodged.

(5) Where the applicant fails to comply with the request referred to in subsections (3), within the prescribed period, the Registrar shall consider the application for the registration of a design not to have been filed and the design shall form part of the prior art.

27. Where two or more persons, separately and independently, create the same design and each of them separately files an application for the registration of a design, the right to register such a design shall belong to the person whose application has the earliest filing date, or if priority is claimed, the earliest priority date.

First to file rule

Right of
priority

28. (1) Subject to this Act, a person who has filed an application for the registration of a design in a convention country shall, in relation to the registration of the same design in Zambia, have a right of priority for a period not exceeding six months from the date of filing the conventional application.

(2) A right of priority referred to in subsection (1), shall be capable of being assigned or transmitted with the application or independent of the application.

(3) An assignment or transmission or a right of priority referred to in subsection (1), shall be in writing and if not so done shall have no legal effect.

(4) Where a subsequent application for the registration of a design is filed in a convention country, following an earlier application, in respect of the same design, such subsequent application shall be considered to be the first application in that country in respect of that design if, at the time of filing the application—

(a) the previous application had been withdrawn, abandoned or refused without having been opened to public inspection;

(b) no priority rights have been claimed on the basis of the first application; and

(c) no rights are outstanding in that convention country in connection with an earlier application.

(5) An application which has been withdrawn, abandoned or refused shall not, after the filing of a subsequent application relating to the same subject matter, be capable of supporting a claim for priority under this section, unless a right of priority is outstanding in Zambia or in any convention country in connection with the first application.

(6) Where a person makes an application for the registration of a design and the application is—

(a) in accordance with the terms of a treaty subsisting between any two or more convention countries, equivalent to an application duly made in any one of those convention countries; or

(b) in accordance with the law of any convention country, equivalent to an application made in that convention country: the person shall, for the purposes of this section, be considered to have applied in a convention country.

(7) Where priority is not claimed within the period specified in subsection (1), the right of priority shall lapse.

- 29.** A design which has been displayed or used by the creator or with the creator's consent, at an exhibition recognised by the Agency, before it is registered, shall have the right of priority for a period not exceeded six months from the date of such exhibition. Right of priority by exhibition of design
- 30.** (1) Where a person claims that the design, disclosed in the application for the registration of a design, is derived from a design for which the rights to such design belong to the person making the claim, the court may, on the application of such person, make an order, to the Registrar, to replace the name of the applicant with that of the person making such claim. Application based on design of another person
- (2) An action referred to in subsection (1), shall be brought not later than three years from the time the person claiming to have the right to the design becomes aware of the filing of the application or the registration of the design.
- 31.** (1) The Registrar may refuse, in a prescribed manner, an application for the registration of a design, where the Registrar considers the— Refusal of application in certain cases
- (a) application to be frivolous, in that it claims, as a design, something contrary to well established natural laws; or
- (b) use of the design would encourage offensive, immoral or anti-social behaviour:
- (2) Despite subsection (1), the Registrar may, where the Registrar considers that the ground for refusal of an application under this section can be addressed by amendment, request the applicant to amend the application accordingly.
- (3) A person aggrieved by the decision of the Registrar, under subsection (1) may, within three months of receiving the decision, appeal to the court.
- 32.** (1) An applicant for the registration of a design may amend the application, in the prescribed manner, on the applicant's own volition, except that, the amendment shall not go beyond the disclosure in the initial application. Amendment of application for registration of design
- (2) Where an applicant for the registration of a design makes an amendment as provided in subsection (1), but goes beyond the earlier disclosure, the Registrar may request the applicant to exclude, within a prescribed period, certain additional matter before the Registrar considers the application.

(3) Where an applicant fails to comply with the notification as provided in subsection (2), the Registrar shall, in examining the amended application, ignore the additional matter and notify the applicant accordingly.

(4) Where an applicant for the registration of a design makes a request to amend the application for the registration of a design, as provided in subsection (1), after the Registrar has accepted the application, the Registrar shall notify the applicant making the request, to advertise the request in the Industrial Property Journal, within a prescribed period.

(5) Where the request, referred to in subsection (4), has been advertised by the applicant for the registration of a design, an interested person may oppose the request within the prescribed period and manner.

(6) Where opposition is made as provided in subsection (5), the Registrar shall decide the matter.

(7) A person aggrieved by the decision of the Registrar under subsection (6) may, within three months of receiving the decision, appeal to the court.

Post-dating of application

33. (1) At any time, after an application for the registration of a design has been filed and before it is published, the Registrar may, at the request of the applicant, made in the prescribed manner, direct that the application be postdated.

(2) The Registrar shall not direct the postdating of an application for the registration of a design, referred to in subsection (1), to a period exceeding six months from the date on which the application was filed.

(3) The Registrar shall not postdate an application for the registration of a design where priority has been claimed by an applicant, in Zambia or elsewhere, or the applicant's successor or predecessor in title, in a subsequent application which leaves any rights outstanding.

Correction of errors in documents

34. (1) The Registrar may, on the request made by an applicant for the registration of a design, authorise the correction of a clerical error in a document filed with the Agency, on payment of a prescribed fee.

(2) Where a request for the correction of an error referred to in subsection (1), concerns drawings or illustrations of the design, the correction must be obvious and immediately evident that nothing else would be intended than what is offered as a correction.

(3) Where a correction of a clerical error is proposed to be made by the Registrar, other than upon a request referred to in subsection (1), the Registrar shall inform the applicant, in the prescribed manner, of the correction proposed to be made.

35. A person making an application for the registration of a design may, at any time before registration, notification of rejection or refusal to register, withdraw the application, in a prescribed manner and upon payment of the prescribed fee.

Withdrawal of application

36. The Registrar may, at any time before an application for the registration of a design is withdrawn, or the registration of a design is granted, revoke the acceptance of the application, in the prescribed manner, where the Registrar is satisfied that the application contains a material misrepresentation or a false statement which the applicant knew of at the time when the declaration was made.

Revocation of acceptance

37. Subject to this Act, an application for the registration of a design shall lapse where an applicant fails to amend the application to the satisfaction of the Registrar, within the prescribe period, as provided in subsection (2) of section *thirty-nine*, unless—

Lapse of application

(a) an appeal has been lodged in respect of the application; or

(b) the period within which such appeal may be lodged has not expired.

38. An applicant for the registration of a design or any other application referred to in this Act, who is not resident in Zambia, shall, for matters connected with or incidental to the filing and processing of an application by the Registrar, operate through a patent agent appointed in accordance with the Patents Act, 2016

Filing of application by non-resident

PART V

EXAMINATION, PUBLICATION AND OPPOSITION

39. (1) Where a person making an application for the registration of a design has paid the prescribed fee and the application has not lapsed, refused, withdrawn or treated as withdrawn by the Registrar, the Registrar shall conduct a formalities examination to ascertain compliance of the application with this Act and its regulations.

Examination for compliance with requirements

(2) Where the Registrar is of the opinion, after conducting an examination, referred to in subsection (1), that an application is not compliant with the requirements of this Act, the Registrar shall notify the applicant, in writing, to make relevant amendments to the application, within a prescribed period.

(3) Where the applicant fails, after the notification referred to in subsection (2), to make the relevant amendments to the application, the Registrar shall consider the application to have lapsed, as provided in section *thirty-seven*.

(4) Where an application is found to be compliant with the requirements of this Act, after the examination referred to in subsection (1), the Registrar shall cause to be conducted a novelty search to ascertain the design's individual character.

Acceptance
of
application

40. Subject to section *thirty-seven*, where the Registrar is of the opinion that the application, and the design to which it relates, meets the requirements of this Act, the Registrar shall issue or cause to be issued an acceptance of the application for the registration of a design, in a prescribed manner.

Publication
of
acceptance

41. Subject to the other provisions of this Act, the Registrar shall publish the acceptance of an application for the registration of a design in the Industrial Property Journal, as soon as practicable, upon payment of a prescribed fee.

Inspection of
application

42. Subject to section *seventy-five*, an application for the registration of a design and all accompanying documents shall, on payment of the prescribed fee, be open for inspection by the public during prescribed hours, after the Registrar has accepted and published the application in accordance with section *forty*.

Opposition
to
registration
of design

43. A person, including the State, may oppose the registration of a design at any time, within a period of two months from the date an application is published, or within such further period as the Registrar may allow, by filing a written notice of opposition to the Registrar, stating any of the following grounds:

(a) that the applicant is not entitled in accordance with section *twenty-one*, to make an application for the registration of a design;

(b) that the person making the application or the person through whom the applicant claims the design wrongfully obtained the design from a person opposing the grant;

- (c) that the design claimed in an application for registration is not new as it was publicly known or publicly used in Zambia or elsewhere before the priority date of that claim;
- (d) that, in the case of a convention application, the application was not made within six months from the date of the first application for protection of a design made in a convention country by the applicant or a person from whom the applicant derives title;
- (e) that the use of the design would be contrary to law or morality;
- (f) that the application contains a material misrepresentation or a false statement which the applicant knew of at the time when the declaration was made;
- (g) that the application for registration of a design is in contravention of the rights of the person giving such notice or of any persons under or through whom the person claims; or
- (h) that an application does not satisfy the requirements of this Act.

44. (1) A person shall file, with the Registrar, a notice opposing the registration of a design which shall be accompanied by a statement of the particulars of the facts alleged in support of any of the stated grounds opposing the grant.

Opposition
procedure
for
registration

(2) Where an applicant for the registration of a design wishes to contest a notice opposing the registration of a design, as specified in subsection (1), the applicant shall, within the prescribed period or any such further period as the Registrar may allow, file, with the Registrar, a counterstatement, setting out particulars of the grounds on which the notice is contested.

(3) Any particulars referred to in subsection (2), may be amended with the express permission of the Registrar.

(4) Evidence shall not be admitted to prove that a ground on which any particular, referred to in subsection (2), has not been filed, except with the express permission of the Registrar.

(5) Any person aggrieved by the decision of the Registrar may, within three months of receiving the decision, appeal to the court.

PART VI

DESIGNS BY EMPLOYEES

Design
created by
employee

45. (1) Subject to the other provisions this Act or a contract of employment or service, the right to a design created by an employee, in the performance of such employee's contract, shall belong to the employer or the person who commissioned the work, as the case may be, except that, where the design acquires an economic value much greater than the parties could reasonably have foreseen at the time of concluding the contract, the employee shall be entitled to an equitable remuneration to be agreed upon by the parties or in default, to be determined by the court.

(2) Where an employee, whose employment or service contract does not require the employee to engage in any creative activity, creates a design using resources or means placed at the employee's disposal by the employer, the right to the register such design shall belong to the employer, subject to any provision to the contrary in the contract.

(3) A design, created by an employee without any relation to an employment or service contract, and without the use of the employer's resources, shall belong to the employee.

(4) In determining equitable remuneration, as referred to in subsection (1), the court shall, among other things, take into account the following:

- (a) the nature of the employee's duties, the employee's remuneration and any other rights conferred on the employee by contract or this Act;
- (b) the effort and skill which the employee devoted to creating the design;
- (c) the effort and skill which any other person contributed to the creating of the design; and
- (d) any contribution made by the employer in creating the design.

(5) The rights conferred on an employee, in accordance with this Part, shall not be restricted by contract.

Design
created by
Government
employee

46. (1) The provisions of section *forty-five* shall, with the necessary modifications and subject to other laws, apply to a Government employee.

(2) In this section, "Government employee" includes a person employed in a Government ministry, department or unit and a statutory body or any other Government agency.

47. A dispute arising between an employer and an employee, in respect of a design created by an employee during the subsistence of a contract of employment or service, shall be determined by the court.

Disputes over design by employee

PART VII

INTERNATIONAL APPLICATIONS FOR REGISTRATION OF DESIGN

48. The Agency shall, in respect of an international application for registration of a design, act as a receiving, designated or elected office.

Role of Agency regarding international applications

49. (1) An international application for the registration of a design shall be considered to be an application filed with the Registrar and shall be processed in accordance with this Act and regulations made in accordance with the Act.

Procedure relating to international application

(2) An application for the registration of a design shall not be treated as an international application by the Agency by reason only of the application containing an indication that the applicant wishes to obtain an ARIPO registration of a design, unless the application separately designates Zambia for the national registration of a design.

50. (1) A design registered by ARIPO, in accordance with the Harare Protocol, shall have effect in Zambia in a like manner as a design registered in accordance with this Act, except where the Registrar communicates to ARIPO a decision, in accordance with the Harare Protocol, that such a registration shall not have legal effect in Zambia.

ARIPO registration of design

(2) Where a design is registered by ARIPO but the registration is made without the communication required to be made by ARIPO to Zambia in accordance with the Harare Protocol, or where the registration precedes the communication by ARIPO, such registration shall not have legal effect in Zambia.

PART VIII

REGISTRATION, TERM AND RENEWAL OF DESIGN

51. (1) Subject to this Act, the Registrar shall register a design, pursuant to an application for the registration of a design, made in accordance with this Act, on payment of a prescribed fee.

Registration of design

(2) Despite subsection (1), where —

(a) an applicant, named in a joint application dies, the Registrar may, with the written consent of the deceased applicant's legal representative, register the design and grant the certificate in the name or names of the surviving applicant or applicants named in the joint application; and

(b) an applicant or joint applicants have agreed, in writing, to assign the design or a share in the design, the Registrar shall not, without proof of an executed instrument, register the design and grant the certificate in the name of the assignee or their assignees.

(3) Subject to any proceedings in accordance with this Act, the effective date of a registered design shall be the filing date of the application for the registration of a design.

Date and
term of
registration

52. (1) Subject to this Act, a registered design certificate shall be dated as of the date on which the application was filed with the Registrar.

(2) The date, referred to in subsection (1), shall be entered in the Register of designs, in the prescribed manner.

(3) Subject to this Act, a registered design shall be valid for a period of five years from the filing date of the application for the registration of a design and may be renewed for a further period of five years, subject to the advertisement of the application in a prescribed manner and payment of a prescribed renewal fee.

(4) The Registrar shall publish, in the Intellectual Property Journal, a design that has ceased to be protected by registration, as soon as is practicable.

(5) A design in respect of which protection by registration has ceased, shall be removed from the Register.

Publication
of
registration

53. The Registrar shall, as soon as practicable, publish, in a prescribed manner, a notice of the registration of a design or the renewal of the registration of a design, in the Industrial Property Journal.

Restoration
of design on
Register

54. (1) Where a design has been removed from the Register under section *fifty-two*, a proprietor may, within six months of the removal, apply to the Registrar for the restoration of a design on the Register, in a prescribed manner.

(2) Where the Registrar is satisfied that the omission to pay the maintenance fee was unintentional and that no undue delay has occurred in the making of the application referred to in subsection (1), the Registrar shall publish the application in the prescribed manner.

(3) A person wishing to object to an application for the restoration of a design under this section shall do so within a prescribed period and manner upon payment of a prescribed fee.

(4) The Registrar shall, where there is no objection to the restoration of the registration of a design, subject to the payment of such fees and any administrative penalty due, restore the registration of a design in the Register and issue a certificate of payment of maintenance fee to the proprietor.

(5) The Registrar shall, where there is an objection to the restoration of the registration of a design, after investigating the matter and hearing the applicant and the objector—

- (a) restore the registration, subject to the payment of such fees and any administrative penalty due, and issue a certificate of payment of maintenance fee to the proprietor; or
- (b) dismiss the application for restoration of the registration of a design.

55. Where the registration is restored as provided in section *fifty-four*, the rights of the proprietor shall be subject to such conditions as may be imposed, by the Registrar, for the protection or compensation of persons who may have begun to avail themselves of the design or have taken steps by contract or otherwise to avail themselves of the design between the date when the design ceased to be protected and the date of the publication of the application for the restoration of the registration of a design, made in accordance with section *fifty-one*.

Rights of proprietor of restored design rights

PART IX

PROPRIETOR'S RIGHTS AND LIMITATIONS

56. (1) Subject to this Act, a registered design gives the proprietor the following exclusive rights, during the term of the registered design:

Exclusive rights of proprietor

- (a) to reproduce and to authorise others to reproduce all or part of the registered design or a product which embodies the design;
- (b) to exploit and to authorise any other person to exploit the registered design; and
- (c) to prevent any person, without the proprietor's consent, from making, using, offering for sale, selling or importing a product which embodies the design; and
- (d) to assign, transmit or licence the registered design.

(2) A person shall not do any of the acts referred to in subsection (1), without the written consent of the proprietor.

Nature of registered design right

57. (1) The registered design rights, referred to in section *twenty-two*, shall be personal property, capable of being transferred by any means by which such property may be lawfully transferred, including assignment, mortgage, pledge, testamentary instrument or operation of law.

(2) A transfer of a right, referred to in subsection (1), shall not be effective unless it is in writing, signed by or on behalf of the proprietor and registered with the Agency, in accordance with this Act.

(3) A transfer of a right, as provided in subsection (1), binds each successor in title to the proprietor, except a purchaser in good faith for value without actual or constructive notice of the transfer and a person who derives title from such purchaser.

(4) The Registrar shall record or cause to be recorded, in the Register, all transfers of rights or interests undertaken in accordance with this Act.

Joint owner of registered design

58. Where a design is registered to two or more proprietors, the proprietors shall, subject to any agreement in force, be considered as joint owners.

Limitations of registered design rights

59. (1) Despite any other provision of this Act, rights under a registered design shall be limited to industrial or commercial activities and shall not extend to the following:

- (a) acts done by any person for scientific research;
- (b) acts related to experimental use of the registered design;
- (c) using of the design for teaching purposes;
- (d) acts which include testing, making or selling of a registered design, for purposes reasonably related to the development and submission of information required under any written law in Zambia or in a convention country;
- (e) the exploitation of the registered design beyond the duration of the term of registration, as provided in this Act; and
- (f) compulsory licences as provided in this Act; and
- (g) the prohibition of the use of the registered design by the Government or persons authorised by the Government, as provided in this Act.

PART X
INFRINGEMENT

60. Subject to the other provisions of this Act, it is an infringement of a proprietor's right in a registered design for a person to do any of the acts referred to in section *fifty-six*, without the written consent of the proprietor or a successor in title.

Infringement

61. It is not an infringement of a proprietor's right in a registered design if—

Non-infringement acts

- (a) the reproduction of a registered design is done by a person for private and not commercial exploitation purposes;
- (b) the reproduction of a registered design is done by a person for the sole purpose of evaluation, analysis, research or teaching and the proprietor of the design is acknowledged;
- (c) a person uses the results of an evaluation, analysis or research, which involves a registered design, to create a different design that complies with the requirements of section *fifteen*.
- (d) it is used on a ship, aircraft, vehicle or any vessel which is registered in another country but is temporarily in Zambia; or
- (e) it is used in the repair and restoration of a complex product or article.

62. (1) A proprietor or exclusive licensee shall have the right to commence court proceedings against a person, who is alleged to have infringed or is performing an act likely to cause an infringement of a proprietor's right in a registered design.

Right to commence proceedings for infringement

(2) A person alleged to have infringed the proprietor's right may, in proceedings for infringement, counterclaim for the revocation of the registration of a design, relaying on any ground on which registration of a design may be revoked in accordance with this Act.

(3) A proprietor or licensee shall, before commencing court proceedings referred to in subsection (1), give notice to any other holder of a licence under such a registered design, whose name appears in the Register.

(4) A person notified in accordance with subsection (3), may join as a co-plaintiff to the court proceedings referred to in subsection (1).

(5) Despite subsection (1), court proceedings shall not be commenced in respect of an infringement committed before the date of registration of a design by the Registrar.

Remedies for infringement

63. On an application for infringement, by a proprietor an exclusive licensee, the court may grant any of the following reliefs:

(a) an injunction to prevent an infringement of the proprietor's or exclusive licensee's right, where infringement is imminent, or to prohibit the continuation of an infringement;

(b) an order that the infringing product or article embodying a registered design be delivered up;

(c) damages;

(d) account of profits;

(e) royalty;

(f) destruction or disposal of infringing products or articles embodying a registered design, as the court considers appropriate, in accordance with laws relating to public health and the environment; or

(g) any other remedy the court may consider appropriate.

Order for delivery up

64. (1) Where a person has in the person's possession, custody or control, for commercial exploitation, a product or article embodying a registered design, a creator or licensee may apply to court for an order, referred to in paragraph (b) of section *sixty-three*, that the alleged infringing product or article be delivered to the proprietor or licensee or to another person that the court specifies.

(2) A proprietor shall, by post or otherwise, notify an assignee or exclusive licensee who has a concurrent right of action in respect of an infringement of a registered design, before applying for an order for delivery up in accordance with subsection (1).

(3) The court may, on the application of an assignee or exclusive licensee, make an order for delivery up which the court considers just, having regard to the terms of the assignment or licence.

(4) The court shall not make an order for delivery up unless it also makes, or it appears to the court that there are grounds for making, an order as provided in section *sixty-five*.

(5) A person to whom an alleged infringing product or article embodying a registered design is delivered up shall retain the product or article pending the making of an order, or a decision not to make an order, in accordance with section *sixty-five*.

65. (1) An application may be made by a proprietor or a licensee to the court for—

Order for
forfeiture,
destruction
and disposal

(a) an order that a product or article embodying a registered design be delivered up in accordance with section *sixty-four*, be forfeited to the proprietor or exclusive licensee, destroyed or disposed of as the court considers appropriate, in accordance with laws relating to public health and the environment; or

(b) a decision that no order be made under paragraph (a).

(2) In deciding what order or decision to make under subsection (1), the court shall have regard to whether other remedies available would be adequate to compensate the proprietor or licensee and protect the interests of the creator or licensee.

(3) The court shall issue directions as to the service of notice on persons having an interest in a product or article, embodying a registered design, which has been delivered up.

(4) A person having an interest in a product or article which embodies a registered design, which has been delivered up shall be entitled to—

(a) appear in proceedings for an order under this section, whether or not the person is served with notice; and

(b) appeal against any order made, whether or not that person appears in the proceedings.

(5) An order made in accordance with this section shall not take effect until the end of the period within which notice of an appeal may be given or, if before the end of that period notice of appeal is duly given, until the final determination or abandonment of the proceedings on the appeal.

(6) Where there is more than one person interested in the product or article, embodying a registered design, delivered up, the court may direct that the product or article be sold, or otherwise dealt with, and the proceeds divided, subject to any agreement, and shall make any other order as it considers appropriate.

(7) If the court decides that no order should be made in accordance with this section, the person in whose possession, custody or control the product or article, embodying a registered design, was before being delivered up is entitled to its return.

Restrictions
on recovery
of damages
for innocent
infringement

66. (1) In proceedings for infringement of a registered design, damages shall not be awarded, and an order shall not be made for an account of profits, against a defendant who satisfies the court that at the time of the infringement, the defendant was not aware, and had no reasonable grounds for supposing that the registered design existed.

(2) A person shall not be taken to be aware, or to have reasonable grounds for supposing that a design is registered by reason only of the application to a product of the word “Registered”, or any word or words expressing or implying that a design has been registered, unless the registration number of a design accompanied the word or words in question.

Declaration
of non-
infringement

67. (1) A person interested in a registered design may apply to court for a declaration, by the court, of the performance of a specific act, by the applicant, as not constituting an infringement of the proprietor’s right in the registered design.

(2) A proprietor, an assignee or licensee shall have the right to be joined as defendants in the proceedings referred to in subsection (1).

(3) The court shall not make the declaration, referred to in subsection (1), if—

(a) the act to which the application relates is already a subject of infringement proceedings; or

(b) the person making the application fails to satisfy the court that the person had previously written to the proprietor or a successor in title, requesting for a written acknowledgment of whether such act is infringing or noninfringing, and the creator or successor in title has failed or neglected to respond to such request within a reasonable period.

(4) The court shall award costs for the proceedings, referred to in subsection (1), in a manner the court considers appropriate in the circumstances.

Infringement
proceedings
where
concurrent
rights exist

68. (1) Where a proprietor, an assignee or licensee brings proceedings for any infringement of a registered design in respect of which a proprietor, assignee or licensee has concurrent rights of action, a proprietor, assignee or exclusive licensee need not—

(a) join the other as a plaintiff; or

(b) add the other as a defendant;

unless the court otherwise orders.

(2) A person who is added as a defendant, in accordance with subsection (1), shall not be liable for costs in the proceedings unless such person takes part in the proceedings.

(3) An exclusive licensee may, if the proprietor refuses or fails to commence court proceedings within three months after giving notice to the creator to commence court proceedings, commence such proceedings in the licensee's own name, and the proprietor may join in the proceedings at any time after commencement.

69. (1) In proceedings to enforce a proprietor's or successor in title's right in accordance with this Part, evidence may be submitted by affidavit asserting relevant facts showing that—

Affidavit
evidence

(a) a proprietor or successor in title is the owner of a registered design; and

(b) the design is a registered design.

(2) Where the court considers, on the application of a party, that the deponent to an affidavit should be available to be cross-examined with respect to matters asserted in the affidavit, the court shall order that such a deponent appear to be cross-examined.

(3) If a deponent does not appear to be cross-examined in court as required in subsection (2), the court shall exclude the admission of the affidavit.

70. (1) Where a person, by means of circulars, advertisements or otherwise, threatens another person with proceedings in respect of an infringement as specified in this Part, whether or not the person making the threat is a proprietor, the court may, on the application of the aggrieved person, do any of the following:

Groundless
threat of
infringement
proceedings

(a) declare that the threat is unjustified;

(b) grant an injunction against the continuance of the threat;
or

(c) award compensation for any damage sustained.

(2) The court shall not make any order, as specified in subsection (1), if the defendant satisfies the court that the acts in respect of which the proceeding was threatened constituted, or would constitute, an infringement of a proprietor's right as specified in this Part.

(3) The mere notification of the existence of a right, as specified in this Part, shall not constitute a threat of a proceeding for the purposes of subsection (1).

(4) An application may not be brought under this section where the threat is to bring a proceeding for an infringement that is alleged to consist of making or importing anything.

(5) Nothing in this section shall render a practitioner liable to an action in respect of an act done by the practitioner in a professional capacity on behalf of a client.

PART XI

CANCELLATION OF REGISTRATION OF REGISTERED DESIGN

Application
to cancel
registration
of registered
design

71. (1) A proprietor may, at any time before the expiry of the term of the registration of a registered design, apply to the Registrar, in the prescribed manner and on payment of the prescribed fee, requesting the Registrar to cancel the registration of a registered design.

(2) Where an application is made in accordance with subsection (1), the Registrar shall publish the application, in the prescribed manner, and shall notify, in a prescribed manner, every person, other than the proprietor, whose names appear in the Register as having an interest in the registered design.

(3) A person who is notified in accordance subsection (2) may, within the prescribed period after the publication of the application referred to in subsection (1), give written notice to the Registrar objecting to the application.

(4) Where a person gives notice, as specified in subsection (3), the Registrar shall notify the proprietor, in the prescribed manner and within a prescribed period, of the objection.

(5) Where there is no objection to an application to cancel the registration of a registered design, the Registrar shall make an order cancelling the registration.

(6) The Registrar shall, where there is an objection to an application to cancel the registration of a registered design, give an opportunity to the person applying for a cancellation of the registration of a registered design and the objector to be heard, after which the Registrar shall make an order to cancel the registration or dismiss the application to cancel the registration.

72. The Registrar shall, on the application of an interested person or the Government, where a design has been registered in accordance with section *fifty-one* and entered into the Register as provided in section ten, cancel the registration of a registered design, if the court so orders.

Cancellation of registration by order of Court

73. (1) The Registrar may, in consultation with the Minister, if the Registrar is of the opinion that a registered design or the mode in which the design is being exploited is prejudicial to the environment, public safety or public health, cancel the registration of a design.

Cancellation of registration of registered design in public interest

(2) Where the registration of a registered design is cancelled, in accordance with this Part, the Registrar shall publish or cause to be published the cancellation in the Industrial Property Journal within a prescribed period from the date of cancellation.

74. Where the registration of a registered design is cancelled in accordance with this Part, the design shall cease to be protected from the date of cancellation.

Effect of cancellation of registration

PART XII

PUBLICATION OR COMMUNICATION OF DESIGN RELATED TO DEFENCE AND SECURITY

75. (1) The Minister responsible for defence or the Minister responsible for internal security, as the case may be, may issue a notice, in a prescribed manner, to the Registrar, directing the Registrar to prohibit the publication or communication, to an unauthorised person, of an application for the registration of a design and information contained therein, which, in the opinion of the Minister may, if published or communicated, be prejudicial to the defence of the country or the safety of the public.

Prohibition publication or communication of information prejudicial to defence

(2) Where an application for the registration of a design is filed with the Registrar, in accordance with this Act, and it appears to the Registrar that the application contains information, referred to in subsection (1), the Registrar may give directions prohibiting the publication or communication of such information to an unauthorised person for a period not exceeding three months from the date on which such application was to be published in accordance with section fifty.

76. (1) The directions issued by the Registrar, in section *seventy-five*, shall have the following effects on an application for the registration of a design:

Effects of directions an application

(a) where the application is made or considered to have been made in accordance with this Act, it may be processed but—

(i) the application shall not be published;

(ii) any information relating to the application shall not be communicated to any unauthorised person; and

(iii) a design shall not be registered as applied for;

(b) where it is an application for an ARIPO registration of a design, the application shall not be sent to the ARIPO office; and

(2) Where the Registrar issues directions against an application for the registration of a design, as specified in section *seventy-five*, the Registrar shall give notice, within a prescribed period, to the Minister responsible for defence or the Minister responsible for internal security, as the case may be, of such directions and the reasons for the directions and the Minister shall, on receipt of the notice, consider whether the publication or communication of such an application and the information contained in the application would be prejudicial to the defence of the country or the safety of the public.

(3) Where the Minister responsible for defence, after considering the notice, referred to in subsection (2), determines that the publication or communication of the application or the registration of a design and the information contained therein, shall be prejudicial to the defence of the country or the safety of the public, the Minister shall notify the Registrar to maintain the directions in force until notification to revoke them is given by the Minister.

(4) Where the directions referred to in section *seventy-five*, are not issued or revoked soon after notification, the Minister responsible for defence shall review the directions, within a period of nine months from the date of filing of the application for the registration of a design or once in every subsequent period of twelve months.

(5) The Minister responsible for defence may, where it appears that the publication or communication of an application for the registration of a design and the information contained therein, is no longer prejudicial to the defence of the country or the safety of the public, give notice to the Registrar to revoke the directions and, subject to any conditions imposed by the Minister, extend the time for doing anything required to be done, in accordance with this Act, in respect of the application, whether that time had previously expired or not.

(6) Where it appear to the Minister responsible for defence or the Registrar, that the person making an application for the registration of a design has suffered hardship by reason of the continuation in force of the directions issued in accordance with in section *seventy-five*, the Minister may, in consultation with the Minister responsible for finance, make such payment, by way of compensation, to the applicant, as the Minister may consider reasonable.

(7) A person aggrieved by the amount of compensation paid in accordance with subsection (6) may, within three months of being paid the compensation, appeal to the court.

77. A person who contravenes any provision of section *seventy-five*, commits an offence and is liable, upon conviction, to a fine not exceeding two hundred thousand penalty units or to imprisonment for a term not exceeding two years, or to both.

Penalty

PART XIII

CONTRACTUAL AND COMPULSARY LICENCE

78. (1) Subject to the other provisions of this Act, a proprietor or a successor in title may grant a licence, in respect of a registered design, to another person by way of a licence contract.

Licence
contract

(2) A licence contract shall be in writing, signed by both parties and lodged with the Registrar, by either party, in a prescribed manner.

(3) The Registrar shall, on payment of the prescribed fee, enter or cause to be entered a licence contract in the Register.

(4) Subject to the other provisions of this Act, the Registrar shall issue or cause to be issued a certificate of registration of a licence contract in a prescribed form to a licensee, where the requirements of this Part are satisfied.

(5) A certificate of registration shall be prima facie evidence of any matter in respect of the registration of the licence contract.

(6) A licence contract shall not have effect against third parties until it is registered and a certificate of registration is issued in respect thereof.

Refusal by Registrar to register licenced contract

79. (1) The Registrar may refuse to register a licence contract which imposes unjustified restrictions on the licensee, or is prejudicial to the economic interest of the country.

(2) The Registrar shall, before refusing to register a licence contract as provided in subsection (1), notify the parties within ninety days of receiving the contract and shall give the parties an opportunity to be heard.

(3) Where the Registrar refuses to register a licence contract but does not notify the parties to the contract or give them an opportunity to be heard, within ninety days as provided in subsection (2), the licence contract shall be deemed to have been registered at the expiry of ninety days.

(5) A licence contract lodged with the Registrar shall be open to the public for inspection.

(6) A person aggrieved by the decision of the Registrar made in accordance with this section may, within three months of receiving the decision, appeal to the court.

Exclusive licence

80. (1) Where a licence contract has been granted, by a proprietor, to a licensee as an exclusive licence, the creator shall not grant any other licence, in respect of the same registered design, to a third person, and shall not do anything consistent with the ownership of the registered design.

(2) An exclusive licensee enjoys the rights of a proprietor or a successor in title referred to in section *fifty-six*.

Compulsory licence

81. (1) A person may, after three years from the date of the registration of a design, apply to the Registrar for the grant of a compulsory licence on any of the following grounds:

- (a) that without reasonable cause, the proprietor or a successor in title of a registered design has not meet the demand for the design on the domestic market in Zambia;
- (b) that the refusal by the creator or a successor in title to grant a contract licence, on reasonable terms, is prejudicial to the country's establishment and development of industries or commercial activities;
- (c) that the applicant for a contract licence has failed to obtain the creator's consent for the use of a registered design, under reasonable terms and conditions;

- (d) that the interest of public health or safety demands the commercial working of registered design in Zambia;
- (e) that there is a need to remedy the abuse of intellectual property rights or anti-competitive practices; or
- (f) that there is a national emergency which requires the use of a registered design.

(2) The Registrar shall, within three months of receiving an application for a compulsory licence, give notice to the proprietor or a successor in title of the application, and give the proprietor or a successor in title an opportunity to be heard.

(3) Where the Registrar, in consultation with the Minister, is satisfied with the submissions made by the creator, disputing any ground referred to in subsection (1), the Registrar shall reject an application made by an interested person for the grant of a compulsory licence in respect of a registered design.

(4) Where the Registrar, in consultation with the Minister, is satisfied that any of the grounds, referred to in subsection (1), is established, the Registrar shall issue a compulsory licence to the applicant on such terms and conditions as the Registrar considers appropriate in the circumstances.

(5) A compulsory licence, granted by the Registrar in accordance with subsection (4), shall not be an exclusive licence and shall not entitle the licensee to grant further licences to third parties, without the written consent of the proprietor.

(6) A person who is granted a compulsory licence, in accordance with subsection (4), shall be required to pay the proprietor such remuneration as is considered equitable, with regard to all the circumstances, including the economic value of the licence.

(7) The Registrar may, on the request of a proprietor or licensee, or on the order of the court, vary the terms and conditions of a compulsory licence.

(8) Subsection (3) does not apply where a compulsory licence is granted as a result of a national emergency.

82. The Minister may, by statutory instrument, direct the Registrar to grant compulsory licences with respect to a product embodying a registered design, declared by the Government, to be of vital importance to the defence, public health, the environment or the economy of the country.

Compulsory
licence
granted
under
regulation

- Revocation of compulsory licence
- 83.** The Registrar may on the application of an interested person, or on the Registrar's own motion, revoke a compulsory licence on any of the following grounds:
- (a) that the licensee has failed to comply with the terms of the licence;
 - (b) that the conditions which justified the grant of the licence have ceased to exist and are unlikely to recur,
 - (c) that the interests of the licensee have been adequately protected;
 - (d) that the licensee has failed, within twentyfour months from the grant of the licence, to take the necessary steps to work the design to satisfy the reason for the grant of a compulsory licence; or
 - (e) that the proprietor has granted the licensee a licence contract on more favourable terms.
- Registration of compulsory licence
- 84.** The Registrar shall enter in the Register, a grant of a compulsory licence, the terms and conditions of the licence, variation of the terms and conditions of the licence, and revocation of the licence.

PART XIV

EXPLOITATION OF REGISTERED DESIGN BY GOVERNMENT

- Use of registered design by Government
- 85.** Where the Government requires, for purposes of public health, the environment or national emergency, that a registered design be exploited, for non-commercial purposes, by the Government or an authorised person, the Minister may, with or without the consent of the proprietor, authorise in a prescribed manner, the exploitation of the registered design.
- Notification of proprietor by Government
- 86.** (1) Where the Government or an authorised person knows, without conducting a search that it is using or will be using a registered design for purposes, referred to in section *eighty-five* the Minister shall, as soon as it is practicable, notify the proprietor of the use or the intended use of the registered design.
- (2) A proprietor who is aggrieved by the decision of the Minister in accordance with this section may, within three months of the decision, appeal to the court.
- Extent, duration and limitation of use of registered design
- 87.** (1) The extent and duration of the use of a registered design, by the Government or an authorised person, shall be limited to the purposes referred to in section *eighty-five*.

(2) The use of the registered design, in accordance with in section *eighty-five*, shall not be assignable or exclusive.

88. (1) Where a registered design is used by the Government or an authorised person, the proprietor shall be paid, within a prescribed period, by the Government or the authorised person, such remuneration as may be considered equitable compensation, with regard to all the circumstances, including the economic value of the registered design.

Compensation of proprietor for use of registered design

(2) A proprietor aggrieved with the amount of compensation, paid in accordance with subsection (1), may, within three months of being paid the compensation, appeal to the court.

PART XV

OFFENCES

89. (1) A person commits an offence if the person makes a die, block, machine or instrument

Manufacture and possession of die for use in commission of offence

(a) knowing that it is likely to be used for, or in the course of committing an offence against a design; or

(b) whether or not it is likely to be used for, or in the course of, committing an offence against design.

(2) A person commits an offence if the person possesses or disposes of—

(a) a die, block, machine or instrument; or

(b) a representation of a registered design knowing that, or reckless of whether or not, the die, block, machine, instrument, computer, device or representation is likely to be used for, or in the course of, committing an offence.

(3) For the purposes of subsection (1), strict liability shall apply to the physical element of the offence.

90. A person who describes or holds out, or permits another to describe or hold out as a patent agent when not duly registered, in accordance with the Patents Act, 2016, commits an offence and is liable, upon conviction, to a fine not exceeding two hundred thousand penalty units or to imprisonment for a term not exceeding two years or to both.

Holding out as patent agent

91. Where an offence in accordance with this Act is committed by a body corporate or unincorporated body, every director or manager of the body corporate or unincorporated body shall be liable, on conviction, as if the director or manager had personally committed the offence, unless the director or manager proves to

Offences by body corporate or unincorporated body

the satisfaction of the court that the act constituting the offence was done without the knowledge, consent or connivance of the director or manager or that the director or manager took reasonable steps to prevent the commission of the offence.

General
offence

92. A person who—

- (a) provides false information in an application for the registration of a design;
- (b) makes or causes to be made a false entry in the Register, or any document purporting it to be a copy of an entry in the Register or produces or tenders or causes to be produced or tendered in evidence any such document, knowing the entry or document to be false;
- (c) alters or defaces or partly removes, erases or obliterates any document issued by the Registrar;
- (d) makes or submits a false statement or representation, whether orally or in writing, to the Registrar or Agency knowing the same to be false;
- (e) knowingly uses, in any way, words, whether orally or in writing, or acts in a manner which lead other persons to believe that the person is an employee or agent of the Agency;
- (f) having innocently made a false statement or representation, whether orally or in writing, for the purpose of procuring or influencing the doing or omission of anything in relation to this Act and who on becoming aware that such statement or representation was false, fails to advise the Registrar of such falsity;
- (g) after having been sworn, willfully gives false evidence before the Registrar knowing such evidence to be false or not knowing or believing it to be true;
- (h) aids, abets, counsels or procures the commission of an offence or is in any way directly or indirectly a party to the commission of an offence; or
- (i) otherwise breaches any other provision of this Act;

commits an offence and is liable, upon conviction, to a fine not exceeding five hundred thousand penalty units or to imprisonment for a term not exceeding five years, or to both.

General
penalty

93. A person who contravenes any provision of this Act, where no specific penalty has been provided is liable, upon conviction, to a fine not exceeding four hundred thousand penalty units or to imprisonment for a term not exceeding four years, or to both.

PART XVI
GENERAL PROVISIONS

- 94.** Subject to the other provisions this Act, where any discretionary or other power is given to the Registrar, the Registrar shall not exercise that power adversely or arbitrarily and a person challenging a decision of the Registrar shall have the right to apply to the court. Exercise of discretionary power
- 95.** (1) The Registrar may sit with such number number of assessors, in all proceedings brought before the Registrar. Registrar may sit with assessors in determining a matter
- (2) The Registrar may appoint the assessors, referred to in subsection (1), as and when required and such assessors shall be remunerated by the Agency as the Minister may, in consultation with the Minister responsible for finance, prescribe.
- 96.** (1) A certificate purporting to be signed by the Registrar and certifying that an entry, which the Registrar is authorised in accordance with this Act to make, has or has not been made or that any other thing which the Registrar is so authorised to do, has or has not been done, shall be prima facie evidence of the matters so certified. Evidence of certain entries and documents
- (2) A copy of any entry in the Register or any other register maintained in accordance with this Act or any document or an extract from the Register or any such register or document certified by the Registrar shall be admitted in evidence without further proof and without production of the original.
- 97.** Subject to this Act, the Registrar shall, on the request of a person and on payment of the prescribed fee, furnish copies of a document which is open to public inspection and which is lodged in the Register or any other register, which is maintained in accordance with this Act, or furnishes a certificate in respect of the document. Requests for information
- 98.** If, due to circumstances beyond the control of a person, an act is required by this Act to be done within a prescribed time is not or cannot be done within that time, the Registrar may, on application by the person, extend the time for doing the act. Extension of time
- 99.** Where the Registrar is required in this Act to do any act or thing and no time or period is provided within which the act or thing is to be done, the Registrar is to do the act or thing as soon as practicable. Registrar to act as soon as practicable
- 100.** (1) Where an aggrieved person appeals to the court, the Registrar shall act in accordance with the decision of the court, subject to any further appeal. Registrar to act in accordance with court

(2) Unless otherwise directed by the court, the Registrar may submit to the court a statement, in writing, signed by the Registrar, giving particulars of the proceedings that were before the Registrar in relation to the matter in issue, the practice of the Agency in similar cases and such other matters within the particular knowledge of the Registrar and the statement shall form part of the evidence in the proceedings before the court.

Authorisation to publish advertisement of notice

101. (1) An advertisement or notice specified in this Act, other than a notice issued by the Minister, shall not be published unless it is in the prescribed form and the Registrar has approved the contents of the advertisement or notice.

(2) An advertisement or notice that is published in contravention of subsection (1) shall have no legal effect for purposes of this Act.

Replacement of certificate

102. Where a certificate, issued under the hand of the Registrar, in accordance with this Act, is lost or destroyed, the Registrar may, upon being satisfied, issue and seal a replacement certificate, on payment of a prescribed fee.

Lodging and authentication of documents

103. (1) Any application, notice or document authorised or required, in accordance with this Act, to be lodged, made or given at the Agency, may be lodged, made or given to the Registrar or to any other officer and may be delivered by hand, sent by registered post or electronically.

(2) An authentication shall not be required in respect of any document lodged in with the Agency.

Expenses relating to administration

104. Monies necessary for the administration and implementation of this Act, shall be paid out of fees charged in respect of services rendered and monies accrued to the Agency and monies appropriated by Parliament.

Administrative penalties

105. (1) The Registrar may impose an administrative penalty on a person for a failure to comply with this Act where the Registrar is expressly authorised to impose an administrative penalty.

(2) An administrative penalty, referred to in subsection (1), shall not exceed the amount prescribed by the Minister for each day during which such failure continues.

(3) An administrative penalty, imposed in accordance with subsection (1), shall be paid to the Agency within the period specified by the Registrar.

(4) If a person fails to pay an administrative penalty, within the period specified in subsection (2), the Registrar may, by way of civil action in a competent court, recover the amount of the administrative penalty from such person as an amount due and owing to the Agency.

106. (1) Subject to this Act, where—

Prescribed fee

(a) a prescribe fee is payable in respect of the performance of any act by the Registrar or any other authorised person, the act shall not be performed until the fee is paid in full; or

(b) a prescribed fee is payable in respect of the filing of a document, the document shall be considered not to have been filed until the fee is paid in full.

(2) Prescribed fees shall be paid to the Agency in such manner as the Agency may determine.

107. Despite section *one hundred and six*, the Registrar may, in whole or in part, waive the payment of a prescribed fee, in accordance with prescribed circumstances.

Waiver of payment of prescribed fee

108. (1) The Minister may, by statutory instrument, make regulations prescribing anything which is required to be prescribed and generally for the better carrying out of, or giving effect to, the purposes of this Act.

Regulations

(2) Without derogating from the generality of subsection (1), regulations made by the Minister may provide for—

(a) administrative requirements or any necessary details for the implementation of this Act and any relevant international treaty or convention to which Zambia is a State Party;

(b) procedures for applications for the registration of a design in accordance with this Act;

(c) forms to be used for purposes of this Act;

(d) fees to be charged for purposes of this Act; and

(e) preventive mechanisms aimed at protecting registered designs.

109. The Registered Designs Act, 1958, is repealed.

Repeal

110. The transitional provisions set out in the Schedule apply for purposes of this Act.

Transitional provisions

SCHEDULE

(Section one hundred and ten)

TRANSITIONAL PROVISIONS

1. An application for the registration of a design made prior to the commencement of this Act shall be processed as if this Act had not been passed, but the registration shall be made in accordance with this Act.

2. Any registration of a design, licence or contract made prior to the commencement of this Act shall, subject to equitable treatment of the rights and interests acquired by third parties, be continued in accordance with this Act and shall, within six months of the commencement of this Act, comply with this Act.

3. (1) The enactment of this Act shall not affect any proceedings instituted in terms of the repealed Act, which were pending in court, immediately before the date of commencement of this Act, and such proceedings shall be disposed off in court as if this Act had not been passed.

(2) Criminal proceedings instituted as specified in subsection (1), shall be regarded as having been pending if the person concerned had pleaded to the charge in question.

(3) An administrative investigation instituted in accordance with the repealed Act, which was pending, shall be disposed off as if this Act had not been passed.

(4) Disciplinary proceedings which, immediately before the commencement of this Act, were underway or pending shall be concluded as if this Act had not been passed.

(5) Appeal processes which, immediately before the commencement of this Act, were underway or pending shall proceed as if this Act had not been passed.
