

Intellectual Property Law Developments in Zimbabwe

Trade Mark Amendments including ARIPO – A Shared Tribunal

Two “new” Laws

The Intellectual Property Tribunal Act, 2001 (Chapter 26:08) and the Trade Marks Amendment Act, 2001 (“the 2001 Act”) were brought into operation by statutory instruments on 10 September 2010. This follows a period of nine years when that legislation remained on the back-burner.

The 2001 Act updates the Trade Marks Act Chapter 26:04 dated 1974 and last amended in 1994. It is particularly important to international trade mark owners and practitioners because it addresses the issue of African Regional Intellectual Property Organization (“ARIPO”) trade mark registrations (“ATMRs”) and their effects under Zimbabwe national law and practice.

Trade Mark Law Reform

ARIPO/Banjul Background – The Common Law Issue – Interim Measures

ARIPO was founded in 1976 to facilitate centralised filing of patent and design applications and the harmonisation of intellectual property (“IP”) legislation. The Banjul Protocol concerning trade marks came into effect in 1997, Zimbabwe being a founding member. The other Banjul members are Botswana, Lesotho, Liberia, Malawi, Namibia, Tanzania and Uganda.

Zimbabwe, among other subscribers, is usually regarded as a common-law country, where it is generally held that “an international agreement can only become part of the domestic law of a subscribing country, when it has expressly been enacted into that national law by an Act of Parliament”. There was no such reference to ARIPO in Zimbabwe national laws at the date of accession, so it appeared unlikely that an ATMR designating that territory could be recognised or enforced under the Trade Marks Act as it then stood.

Possibly encouraged by ARIPO’s presence in Harare and resulting dialogues between officials, the Zimbabwe IP Office (“ZIPO”) gave a measure of de facto recognition to ATMRs. On notification by ARIPO to ZIPO, they have been recorded, examined and accepted or refused. On the other hand, local compliance with ARIPO procedures has not been exact; ATMRs were not advertised or cited against national trade mark applications.

Legitimation of ARIPO/Banjul and ATMRs

Section 97A of the Trade Marks Act, introduced by the 2001 Act, is designed to confirm and ratify the effect of ATMRs in Zimbabwe, stating that:

- The [Banjul] Protocol shall have the force of law within Zimbabwe.
- Any trade mark which has been registered by the ARIPO office in accordance with the Protocol and in respect of which Zimbabwe has been designated:
 1. shall have the same effect, mutatis mutandis, as a trade mark registered under the Trade Marks Act; and
 2. shall be accorded the same protection, mutatis mutandis, as a trade mark registered and enjoying Paris convention priority.
- The above provisions apply to trade marks registered by the ARIPO office before the 2001 Act came into effect - provided that the proprietor shall not be entitled to damages or any other remedy for infringement of [copyright in (sic)] the mark which took place before that date.

Although the basic meaning of section 97A is clear, several details need to be clarified as to the processing, recognition and enforcement of ATMRs on Zimbabwe territory. Under the Trade Marks Act as now amended:

- A statutory instrument is to be published setting out the provisions of the Protocol and regulations made under the Protocol; and
- Regulations subsidiary to the Trade Marks Act may provide inter alia for giving effect to international arrangements relating to trade marks, to which Zimbabwe is a party.

It is likely that specific matters omitted from the 2001 Act will be covered in that statutory instrument and/or new Regulations under the Trade Marks Act.

Other Trade Mark Innovations

In addition to the ARIPO-related changes set out above, further amendments introduced by the 2001 Act include:

- Conforming to current practice, the basic definition of a “Mark” is now “any sign which can be represented graphically and is capable of distinguishing the goods or services of one undertaking from those of other undertakings”.
- Despite the above, the existing, separate standards of distinctiveness are retained, for Parts A and B of the Register as inherited from the UK law of 1938.
- Collective marks are now provided for, in addition to certification, defensive and series marks already recognised.
- There is clarification of what may constitute infringement, and remedies are more closely specified including “additional” (exemplary or punitive) damages and

- Anton Piller orders as well as border measures to deter import or export of infringing items.
- Special protection is afforded for Familiar Foreign Marks - known in Zimbabwe even if the owner has no business or goodwill there.

The Intellectual Property Tribunal (IPT)

Formerly the Patents Tribunal established under the Patents Act [Chapter 26:03] performed several functions under that legislation and other intellectual property laws.

Now the Intellectual Property Tribunal Act, 2001 (Chapter 26:08), has created the IPT and has vested in it, and updated, the powers formerly exercised by the Patents Tribunal.

The IPT has jurisdiction to hear appeals from the Registrars and other contentious matters under the several intellectual property laws, namely the Industrial Designs Act [Chapter 26:02], the Patents Act, the Trade Marks Act [Chapter 26:04], the Copyright and Neighbouring Rights Act [Chapter 26:05], the Geographical Indications Act [Chapter 26:06] and the Integrated Circuit Layout-Designs Act [Chapter 26:07].

The IPT does not have jurisdiction to try any criminal case and such matters remain in the hands of the High Court and Magistrates' Courts. Appeals from the IPT lie directly to the Supreme Court.

For further information, please speak to your usual contact person. Alternatively, please write to us at zimbabwe@spoor.co.uk.