

LAWS OF MALAWI

**TRADE MARKS
CHAPTER 49:01**

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14 of 1957(F)

37 of 1960(F)
2 of 1962(F)
G.N.. 5/1964(M)
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TRADE MARKS CHAPTER 49:01

PRELIMINARY

An Act to make provision relating to the registration of Trade Marks for other purposes incidental thereto

(1ST APRIL 1958)

Short title

1. This Act may be cited as the Trade Marks Act.

Interpretation

2. (2) In this Act, unless inconsistent with the context –

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

“Convention” means the Union Convention of Paris, dated the 20th March 1883, for the Protection of Industrial Property, revised at Brussels on the 14th December, 1900, at Washington on the 2nd June 1911, at The Hague on the 6th November 1925, and at London on the 2nd June 1934, and any revision thereof to which Malawi may accede in terms of section 7 of the Patents Act;

“assignee” means-;

“Convention country”, in relation to any provision of this Act, means a country (including any colony, protectorate or territory subject to the authority or under the suzerainty of that country, or any territory over which a mandate or trusteeship is exercised) which has been declared to be a convention country in terms of section 7 of the Patents Act;

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“examiner” means an examiner appointed under section 5;

“former trade marks legislation” means this Act as in force from time to time prior to the 1st January 1964;

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

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

“patent agent” means a person who is registered as such under section 68(1) of the Patents Act and is by virtue of that Act entitled to practise as a patent agent;

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“**permitted use**” has the meaning assigned to it by section 33(1);

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

“**register of trade marks agents**” means the register of trade mark agents kept under section 83(1);

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

“**registered user**” means a person who is for the time being registered as such under section 33;

“**Registrar**” means the Registrar of Trade Marks appointed under section 5;

“**regulations**” means regulations made under section 81;

“**trade mark**” means, except in relation to a certification trade mark, a mark used or proposed to be used in relation to goods for the purpose of indicating, or so as to indicate, a connection in the course of trade between the goods and some person having the right either as proprietor or as registered user to use the mark, whether with or without any indication of the identity of that person, and means, in relation to a certification trade mark, a mark registered or deemed to have been registered under section 42;

“**trade mark agent**” means a person who is:-

- (a) registered as a trade mark agent in terms of section 83(2); or
- (b) a legal practitioner or patent agent entitled to practise as a trade mark agent in terms of section 85;

“**Trade Marks Office**” means the Trade Marks Office established under section 3;

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

“**Tribunal**” means the Patents Tribunal established under the Patents Act;

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

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PART I ADMINISTRATION

- 3.** There shall be established under the direction of the Minister an office to be called the Trade Marks Office. **Establishment of Trade Marks Office.**
- 4.** The seal of the Patent Office kept in terms of the Patents Act shall also be the seal of the Trade Marks Office, and impressions thereof made for the purposes of this Act shall be judicially noticed. **Cap. 49:02**
- 5.** There shall be appointed:- **Appointment of officers.**
- (a) a Registrar of Trade Marks who shall exercise the powers and perform the duties assigned to the Registrar by this Act and shall be responsible for its administration;
 - (b) one or more Deputy Registrars of Trade Marks who shall, subject to the control of the Registrar, have all the powers conferred by this Act upon the Registrar;
 - (c) such examiners and other officers as the Minister may consider necessary for carrying out the Act.
- 6.** (1) There shall be kept at the Trade Marks Office for the purposes of this Act the record called the register of trade marks wherein shall be entered all registered trade marks with the names, addresses and descriptions of their proprietors, notifications of assignments and transmissions, the names, addresses and descriptions of all registered users, disclaimers, conditions, limitations and such other matters relating to registered trade marks as may be prescribed. **Register of trade marks.**
- (2) The register shall be divided into four parts which shall be known as Part A, Part B, Part C and Part D respectively.
 - (3) Any trade mark which was registered under the former trade marks legislation shall continue in force in Malawi for the remainder of the unexpired portion of the period for which it was of force and effect when registered under the said legislation.
 - (4) Subject to this Act, the register of trade marks shall, at all convenient times, be open to inspection by the public, and certified copies, sealed with the seal of the Patent Office, of any entry in the register shall be given to any person requiring them on payment of the prescribed fee.
 - (5) No notice of any trust, wither expressed, implied or constructive, shall be entered in the register, and the Registrar shall not be affected by any such notice

PART II
EFFECT OF REGISTRATION AND THE ACTION FOR INFRINGEMENT

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| 7. | <p>No person shall be entitled to institute any proceedings to prevent or to recover damages for the infringement of an unregistered trade mark, but nothing in this Act shall be deemed to affect rights of action against any person for passing off goods as the goods of another person or the remedies in respect thereof.</p> | <p>No action for infringement of unregistered trade mark.</p> |
| 8. | <p>A trade mark must be registered un respect of particular goods or classes of goods, and any question arising as to the class within which any goods fall shall be determined by the Registrar whose decision shall be final.</p> | <p>Registration to be in respect of particular goods.</p> |
| 9. | <p>(1) Subject to this section and sections 12 and 13, the registration of a person in Part A of the register as proprietor of a trade mark in respect of any goods shall, if valid, give or be deemed to have given to that person the exclusive right to the use of the trade mark in relation to those goods and, without prejudice to the generality of the foregoing words, that right shall be deemed to be infringed by any person who, not being the proprietor of the trade mark or a registered user thereof using by way of the permitted use, uses a mark identical with it or so nearly resembling it as to be likely to deceive or cause confusion in the course of trade in relation to any goods in respect of which it is registered and in such manner as to render the use of the mark likely to be taken either:-</p> <div style="margin-left: 40px;"> <p>(a) as being used as a trade mark; or</p> <p>(b) in a case in which the use is use upon the goods or in physical relation thereto or in an advertising circular or other advertisement issued to the public, as referring:-;</p> <div style="margin-left: 40px;"> <p>(i) to some person having the right either as proprietor or as registered user to use the trade mark; or</p> <p>(ii) to goods with which such a person as aforesaid is connected in the course of trade.</p> </div> </div> <p>(2) The right to the use of a trade mark given by registration as aforesaid shall be subject to any conditions or limitations entered on the register and shall not be deemed to be infringed by the use of any such mark as aforesaid in any mode in relation to goods to be sold or otherwise traded in in any place, in relation to goods to be exported to any market or in. any other circumstances to which, having regard to any such limitations, the registration does not extend.</p> <p>(3) The right to the use of a trade mark given by registration as aforesaid shall not be deemed to be infringed by the use of any such mark as aforesaid by any person:-</p> | <p>Right given by registration in Part A and infringement thereof.</p> |

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- (a) In relation to goods connected in the course of trade with the proprietor or a registered user of the trade mark if, as to those goods or a bulk of which they form a part, the proprietor or the registered user conforming to the permitted use has applied the trade mark and has not subsequently removed or obliterated it or has at any time expressly or impliedly consented to the use of the trade mark; or
 - (b) In relation to goods adapted to form part of, or to be accessory to, other goods in relation to which the trade mark has been used without infringement of the right given as aforesaid or might for the time being be so used, if the use of the mark is reasonably necessary in order to indicate that the goods are so adapted and neither the purpose nor the effect of the use of the mark is to indicate otherwise than in accordance with the fact a connection in the course of trade between any person and the goods.
- (4) The use of a registered trade mark, being one of two or more registered trade marks that are identical or nearly resemble each other, in exercise of the right to the use of that trade mark given by registration as aforesaid shall not be deemed to be an infringement of the right so given to the use of any other of those trade marks.

10. (1) Except as provided by subsection (2), the registration of a person in Part B of the register as proprietor of a trade mark in respect of any goods shall, if valid, give or be deemed to have given to that person the like right in relation to those goods as if the registration had been in Part A of the register, and section 9 shall have effect in like manner in relation to a trade mark registered in Part B of the register as they have effect in relation to a trade mark registered in Part A of the register.

**Right given by
registration in Part
B and
infringement
thereof.**

- (2) In any action for infringement of the right to the use of a trade mark given by registration as aforesaid in Part B of the register, otherwise than by an act that is deemed to be an infringement by virtue of section 11 no injunction or other relief shall be granted to the plaintiff if the defendant establishes to the satisfaction of the High Court that the use of which the plaintiff complains is not likely to deceive or cause confusion or to be taken as indicating a connection in the course of trade between the goods and some person having the right either as proprietor or as registered user to use the trade mark.

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- 11.** (1) Where, by a contract in writing made with the proprietor or a registered user of a registered trade mark, a purchaser or owner of goods enters into an obligation to the effect that he will not do, in relation to the goods, an act to which this section applies, any person who, being the owner for the time being of the goods and having notice of the obligation, does that act or authorizes it to be done, in relation to the goods, in the course of trade shall be deemed thereby to infringe the right to the use of the trade mark given by the registration thereof, unless that person become the owner of the goods by purchase for money or money's worth in good faith before receiving notice of the obligation or by virtue of a title derived through another who so became the owner thereof.
- Infringement by breach of certain restrictions.**
- (2) The acts to which this section applies are:-
- (a) The application of the trade mark upon the goods after they have suffered alteration in any manner specified in the contract as respects their state or condition, get-up or packing;
 - (b) In a case in which the trade mark is upon the goods, the alteration, part removal or part obliteration thereof;
 - (c) In a case in which the trade mark is upon the goods and there is also thereon other matter, being matter indicating a connection in the course of trade between the proprietor or registered user and the goods, the removal or obliteration, whether wholly or partly, of the trade mark unless that other matter is wholly removed or obliterated;
 - (d) In a case in which the trade mark is upon the goods, the application of any other trade mark to the goods;
 - (e) In a case in which the trade mark is upon the goods, the addition to the goods of any other matter in writing that is likely to injure the reputation of the trade mark.
- (3) In this section, references, in relation to any goods, to the proprietor, to a registered user and to the registration of a trade mark shall be construed, respectively, as references to the proprietor in whose name the trade mark is registered, to a registered user is registered and to the registration of the trade mark, in respect of those goods, and the expression "upon" includes, in relation to any goods, a reference to physical relation thereto.
- 12.** Nothing in this act shall entitle the proprietor or a registered user of a registered trade mark to interfere with or restrain the use by any person of a trade mark identical with or nearly resembling it, in relation to goods, in relation to which that person or a predecessor in title of his has continuously used that trade mark from a date anterior:-
- Saving for vested rights.**

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

Whichever is the earlier, or to object (On such use being proved) to that person being put on the register for that identical or nearly resembling trade mark in respect of those goods under section 17(2).

13. No registration of a trade mark shall interfere with:-

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

- (a) Any *bona fide* use by a person of his own name or of the name of his place business, or of the name or of the name of the place of business of any of his predecessor in business; or
- (b) The use by any person of any bona fide description of the character or quality of his goods, not being a description that would be likely to be taken as importing any such reference as is mentioned in section 9(1)(b) or in section 42(3)(b).

PART III REGISTRABILITY AND VALIDITY OF REGISTRATION

14. (1) In order for a trade mark (other than a certification trade mark) to be registrable in Part A of the register, it must contain or consist of at least one of the following essential particular:-

Distinctiveness requisite for registration in Part A.

- (a) the name of a company, individual or firm, represented in a special or particular manner;
- (b) the signature of the applicant for registration or some predecessor in his business;
- (c) an invented word or invented words;
- (d) a word or words having no direct reference to the character or quality of the goods and not being, according to its ordinary signification, a geographical name or a surname;
- (e) any other distinctive mark, but a name, signature or word or words, other than such as fall within the descriptions in the foregoing paragraphs (a), (b), (c) and (d), shall not be registrable under this paragraph except upon evidence of its distinctiveness.

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- (2) For the purposes of this section, “**distinctive**” means adapted, in relation to the goods in respect of which a trade mark is registered or proposed to be registered, to distinguish goods with which the proprietor of the trade mark is or may be connected in the course of trade from goods in the case of which no such connection subsists, either generally or, where subject of mark is registered or proposed to be registered subject to limitations, in relation to use within the extent of the registration.
- (3) The Registrar, or the Tribunal in the event of an appeal from a decision of the Registrar, in determining whether a trade mark is adapted to distinguish as aforesaid may have regard to the extent to which:-
 - (a) The trade mark is inherently adapted to distinguish as aforesaid; and
 - (b) By reason of the use of the trade mark or of any other circumstances the trade mark is, in fact adapted to distinguish as aforesaid.
 - (c) An appeal shall lie from any decision of the Registrar under this section.

15.

- (1) In order for a trade mark to be registrable in Part B of the register, it must be capable, in relation to the goods in respect of which it is registered or proposed to be registered, of distinguishing goods with which the proprietor of the trade mark is or may be connected in the course of trade from goods in the case of which no such connection subsists, either generally or, where the trade mark is registered or proposed to be registered subject to limitations, in relation to use within the extent of the registration.
- (2) In determining whether a trade mark is capable of distinguishing as aforesaid, the Registrar, or the Tribunal in the event of an appeal from a decision of the Registrar, may have regard to the extent to which:-
 - (a) The trade mark is inherently capable of distinguishing as aforesaid; and
 - (b) By reason of the use of the trade mark or of any other circumstances the trade mark is, in fact, capable of distinguishing as aforesaid.
- (3) A trade mark may be registered in Part B notwithstanding any registration in Part A in the name of the same proprietor of the same trade mark or any part or parts thereof.
- (4) An appeal shall lie from any decision of the Registrar under this section.

Capability of distinguishing requisite for registration in Part B.

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- 16.** It shall not be lawful to register as a trade mark or part of a trade mark any matter the use of which would, by reason of its being likely to deceive or cause confusion or otherwise, be disentitled to protection in a court of justice or would be contrary to law or morality, or any scandalous design. **Prohibition of registration of deceptive matter.**
- 17.** (1) Subject to subsection (2), no trade mark shall be registered in respect of any goods or description of goods that is identical with a trade mark belonging to a different proprietor and already on the register in respect of the same goods or description of goods or that so nearly resembles such a trade mark as to be likely to deceive or cause confusion. **Prohibition of registration of identical and resembling trade marks.**
- (2) In the case of honest current use or other special circumstances which, in the opinion of the Registrar, or the Tribunal in the event of an appeal from a decision of the Registrar, make it proper so to do, the Registrar or the Tribunal, as the case may be, may permit the registration of trade marks that the identical or nearly resemble each other in respect of the same goods or description of goods more than one proprietor subject to such conditions and limitations, if any, as the Registrar or the Tribunal may think it right to impose.
- (3) Where separate applications are made by different persons to be registered as proprietors respectively of trade marks that are identical or nearly resemble each other in respect of the same goods or description of goods, the Registrar may refuse to register any of them until their rights have been determined by the Tribunal or have been settled by agreement in a manner approved by him or on an appeal by the Tribunal.
- 18.** (1) In all legal proceedings relating to a trade mark registered in Part A of the register (including applications under section 37) the original registration in Part A of the register of the trade mark shall, after the expiration of seven years from the date of that registration, be taken to be valid in all respects, unless:- **Registration in Part A to be conclusive as to validity after seven years.**
- (a) that registration was obtained by fraud; or
- (b) the trade mark offends against section 16.
- (2) Nothing in section 10(1) shall be construed as making applicable to a trade mark, as being a trade mark registered in Part B of the register, the foregoing provisions of this section relating to a trade mark registered in Part A of the register.
- 19.** If a trade mark:- **Registration subject to disclaimer.**

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

The Registrar, or the Tribunal in the event of an appeal from a decision of the Registrar, in deciding whether the trade mark shall be entered or shall remain on the register, may require as a condition of its being on the register:-

- (i) That the proprietor shall disclaim any right to the exclusive use of any part of the trade mark or to the exclusive use of all or any portion of such trade mark as aforesaid, to the exclusive use of which the Registrar or the Tribunal holds him not to be entitled; or
- (ii) That the proprietor shall make such other disclaimer as the Registrar or the Tribunal may consider necessary for the purposes of defining his rights under the registrations:

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

- 20.** (1) The registration of a trade mark shall not be deemed to have become invalid by reason only of any use, after the date of the registration, of a word or words which the trade mark contains, or of which it consists, as the name or description of an article or substance:

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

Provided that, if it is proved either:-

- (a) that there is a well-known and established use of the word or words as the name or description of the article or substance by a person or persons carrying on a trade therein, not being use in relation to goods connected in the course of trade with the proprietor or a registered user of the trade mark on (in the case of a certification trade mark) goods certified by the proprietor; or
- (b) that the article or substance was formerly manufactured under a patent, that a period of two years or more after the cesser of the patent has elapsed, and that the word or words is or are the only practicable name or description of the article or substance,

subsection (2) shall have effect.

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- (2) Where the facts mentioned in proviso (a) or (b) to subsection (1) are proved with respect to any word or words, then:-
- (a) If the trade mark consists solely of that word or those words, the registration of the trade mark, so far as regards registration in respect of the article or substance in question or of any goods of the same description, shall be deemed, for the purposes of section 37, to be an entry wrongly remaining on the register.
 - (b) If the trade mark contains that word or those words and other matter, the Registrar, or the Tribunal in the event of an appeal from a decision of the Registrar, in deciding whether the trade mark shall remain on the register, so far as regards registration in respect of the article or substance in question and of any goods of the same description, may in case of a decision in favour of its remaining on the register require as a condition thereof that the proprietor shall disclaim any right to the exclusive use in relation to that article or substance and any goods of the same description of that word or those words, so, however, that no disclaimer on the register shall affect any rights of the proprietor of a trade mark except such as arise out of the registration of the trade mark in respect of which the disclaimer is made; and
 - (c) For the purposes of any other legal proceedings relating to the trade mark:
 - (i) If the trade mark consists solely of that word or those words, all rights of the proprietor, whether under the common law or by registration, to the exclusive use of the trade mark in relation to the article or substance in question or to any goods of the same description; or
 - (ii) If the trade mark contains that word or those words and other matter, all such rights of the proprietor to the exclusive use of that word or those words in such relation as aforesaid.

Shall be deemed to have ceased on the date at which the use mentioned in proviso (a) to subsection (1) first became well known and established or at the expiration of the period of two years mentioned in proviso (b).

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- (3) No word which is the commonly used and accepted name of any single chemical element or single chemical compound, as distinguished from a mixture, shall be registered as a trade mark in respect of a chemical substance or preparation, and any such registration in force at the commencement of this Act or thereafter shall, notwithstanding anything in section 18, be deemed, for the purposes of section 37, to be an entry made in the register without sufficient cause, or an entry wrongly remaining on the register, as the circumstances may require:

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

- 21.** A trade mark may be limited in whole or in part to one or more specified colours, and in any such case the fact that it is limited shall be taken into consideration by the Registrar, or by the Tribunal in the event of an appeal from a decision of the Registrar, in deciding on the distinctive character of the trade mark.

Effect of limitation as to colour and of absence thereof.

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

PART IV PROCEDURE FOR, AND DURATION OF, REGISTRATION

- 22.** (1) Any person claiming to be the proprietor of a trade mark used or proposed to be used by him who is desirous of registering it must apply in writing to the Registrar in the prescribed manner for registration either in Part A or in Part B of the register.
- (2) Subject to this Act, the Registrar may refuse the application or may accept it absolutely or subject to such amendments, modifications, conditions or limitations, if any, as he may think right.
- (3) In the case of an application for registration of a trade mark (other than a certification trade mark) in Part A of the register, the Registrar may, if the applicant is willing, instead of refusing the application, treat it as an application for registration in Part B and deal with the application accordingly.
- (4) In the case of a refusal or conditional acceptance, the Registrar shall, if required by the applicant, state in writing the grounds of his decision and the materials used by him in arriving thereat, and the decision of the Registrar shall be subject to appeal.

Application for registration.

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- (5) An appeal under this section shall be made in the prescribed manner, and on the appeal the Tribunal shall, if required, hear the applicant and the Registrar, and shall otherwise deal with such appeal in accordance with Part X.
- (6) Appeals under this section shall be heard on the materials stated as aforesaid by the Registrar, and no further grounds of objection to the acceptance of the application shall be allowed to be taken by the Registrar, other than those so stated as aforesaid by him, except by leave of the Tribunal. Where any further grounds of objection are taken, the applicant shall be entitled to withdraw his application without payment of costs on giving notice as prescribed.
- (7) The Registrar, or the Tribunal in the event of an appeal from a decision of the Registrar, may at any time, whether before or after acceptance, correct any error in or in connection with the application or may permit the applicant to amend his application upon such terms as the Registrar or the Tribunal may think right.

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

**Opposition to
registration
and
appeals.**

Provided that the Registrar may direct that an application shall be advertised before acceptance if it is made under section 14(1)(e), or in any other case where it appears to him that it is expedient by reason of any exceptional circumstances so to do, and where an application has been so advertised, the Registrar may, if he thinks fit, direct that it shall be advertised again when it has been accepted, but shall not be bound so to do.

- (2) Any person may, within the prescribed time from the date of the advertisement of an application, give notice to the Registrar of opposition to the registration.
- (3) The notice shall be given in writing in the prescribed manner and shall include a statement of the grounds of opposition.
- (4) The Registrar shall send a copy of the notice to the applicant and, within the prescribed time after receipt thereof, the applicant shall send to the Registrar, in the prescribed manner a counter-statement of the grounds on which he relies for his application, and if he does not do so, he shall be deemed to have abandoned his application.
- (5) If the applicant sends a counter-statement as aforesaid, the Registrar shall furnish a copy thereof to the persons giving notice of opposition, and shall, after hearing the parties, if so required, and considering the evidence, decide whether, and subject to what conditions or limitations, if any, registration is to be permitted.

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- (6) An appeal shall lie for any decision of the Registrar under this section.
- (7) An appeal under this section shall be made in the prescribed form and manner, and on the appeal the Tribunal shall, if required, hear the parties and the Registrar, and shall make an order determining whether, and subject to what conditions or limitations, if any, registration is to be permitted.
- (8) On the hearing of an appeal under this section, any party may, either in the manner prescribed or by special leave of the Tribunal, bring forward further material for the consideration of the Tribunal.
- (9) On an appeal under this section, no further grounds of objection to the registration of a trade mark shall be allowed to be taken by the opponent or the Registrar, other than those so stated as aforesaid by the opponent, except by leave of the Tribunal. Where any further grounds of objection are taken, the applicant shall be entitled to withdraw his application without payment of the costs of the opponent on giving notice as prescribed.
- (10) On an appeal under this section, the Tribunal may, after hearing the Registrar, permit the trade mark proposed to be registered to be modified in any manner not substantially affecting the identity thereof, but in any such case the trade mark as so modified shall be advertised in the prescribed manner before being registered.

24.

(1) When an application for registration of a trade mark has been accepted, and either:-

Registration.

- (a) the application has not been opposed and the time for notice of opposition has expired; or
- (b) the application has been opposed and the opposition has been decided in favour of the applicant,

the Registrar shall, unless the application has been accepted in error or unless the Tribunal otherwise directs, register the trade mark, and the trade mark, when registered, shall be registered as of the date of the application for registration, and that date shall be deemed, for the purposes of this Act, to be the date of registration.

Provided that the foregoing provisions of this subsection, relating to the date as of which a trade mark shall be registered and to the date to be deemed to be the date of registration, shall, as respects a trade mark registered under this Act with the benefit of any enactment relating to international arrangements, have effect subject to that enactment.

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

25.

- (1) The registration of a trade mark shall be for a period of seven years, but may be renewed from time to time in accordance with this section.
- (2) The Registrar shall, on application made by the registered proprietor of a trade mark in the prescribed manner and within the prescribed period, renew the registration of the trade mark for a period of fourteen years from the date of expiration of the original registration or of the last renewal of registration, which date is in this section referred to as “the expiration of the last registration”.
- (3) At the prescribed time before the expiration of the last registration of a trade mark, the Registrar shall send notice in the prescribed manner to the registered proprietor of the date of expiration and the conditions as to payment of fees and otherwise upon which a renewal of registration may be obtained and, if at the expiration of the time prescribed in that behalf those conditions have not been duly complied with, the Registrar may remove the trade mark from the register, subject to such conditions, if any, as to its restoration to the register as may be prescribed.
- (4) Where a trade mark has been removed from the register for non-payment of the fee for renewal, it shall, nevertheless, for the purpose of any application for the registration of a trade mark during one year next after the date of the removal, be deemed to be a trade mark that is already on the register.

**Duration
renewal
and
of
registration**

Provided that the foregoing provisions of this subsection shall not have effect where the Registrar, or the Tribunal in the event of an appeal from a decision of the Registrar, is satisfied either:-

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

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

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

Each separate trade mark must satisfy all the conditions of an independent trade mark and shall, subject to section 28(3) and section 35(2), have all the incidents of an independent trade mark.

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

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

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

PART V ASSIGNMENT AND TRANSMISSION

- 27.** (1) Notwithstanding any rule or law to the contrary, a registered trade mark shall be, and shall be deemed always to have been, assignable and transmissible either in connection with the goodwill of a business or not.
- (2) A registered trade mark shall be, and shall be deemed always to have been, assignable and transmissible in respect either of all the goods in respect of which it is registered, or was registered, as the case may be, or of some (but not all) of those goods.
- (3) Subsections (1) and (2) shall have effect in the case of an unregistered trade mark used in relation to any goods as they have effect in the case of a registered trade mark registered in respect of any goods, if at the time of the assignment or transmission of the unregistered trade mark it is or was used in the same business as a registered trade mark and if it is or was assigned or transmitted at the same time and to the same person as that registered trade mark and in respect of goods all of which are goods in relation to which the unregistered trade mark is or was used in that business and in respect of which that registered trade mark is or was assigned or transmitted.

Powers of and restrictions on, assignment and transmission.

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

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

- (5) The proprietor of a registered trade mark who proposes to assign it in respect of any goods in respect of which it is registered may submit to the Registrar in the prescribed manner a statement of case setting out the circumstances, and the Registrar may issue to him a certificate stating whether, having regard to the similarity of the goods and of the trade marks referred to in the case, the proposed assignment of the first-mentioned trade mark would or would not be invalid under subsection (4), and a certificate so issued shall, subject to the provisions of this section as to appeal and unless it is shown that the certificate was obtained by fraud or misrepresentation, be conclusive as to the validity or invalidity under subsection (4) of the assignment in so far as such validity or invalidity depends upon the facts set out in the case, but, as regards a certificate in favour of validity, only if application for the registration under section 30 of the title of the person becoming entitled is made within six months from the date on which the certificate is issued.
- (6) Notwithstanding anything in subsections (1) to (3) inclusive, a trade mark shall not, on or after the commencement of this Act, be assignable or transmissible in a case in which as a result of an assignment or transmission thereof there would in the circumstances subsist, whether under the common law or by registration, an exclusive right in one of the persons concerned to the use of the trade mark limited to use of the trade mark limited to use in relation to goods to be sold or otherwise traded in in a place or places in Malawi and an exclusive right in another of those persons to the use of a trade mark nearly resembling the first-mentioned trade mark or of an identical trade mark in relation to the same goods or description of goods limited to use in relation to goods to be sold or otherwise traded

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in in another place or other places in Malawi and an exclusive right in another of those persons to the use of a trade mark nearly resembling the first-mentioned trade mark or of an identical trade mark in relation to the same goods or description of goods limited to use in relation to goods to be sold or otherwise traded in in another place or other places in Malawi

Provided that on application in the prescribed manner by the proprietor of a trade mark who proposes to assign it, or of a person who claims that a trade mark has been transmitted to him or to a predecessor in title of his own or after the commencement of this Act, in any such case, the Registrar, if he is satisfied that in all the circumstances the use of the trade marks in exercise of the said rights would not be contrary to the public interest, may approve the assignment or transmission, and an assignment or transmission so approved shall not be deemed to be, or to have been, invalid under this subsection or under subsection (4), so, however, that in the case of a registered trade mark this provision shall not have effect unless application for the registration under section 30 of the title of the person becoming entitled is made within six months form the date on which the approval is given or, in the case of a transmission, was made before that date.

- (7) Where an assignment in respect of any goods of a trade mark that is at the time of the assignment used in a business in those goods is made, on or after the commencement of this Act, otherwise than in connection with the goodwill of that business, the assignment shall not take effect until the following requirements have been satisfied, that is to say, the assignee must, not later than the expiration of six months from the date on which the assignment is made or within such extended period, if any, as the Registrar may allow, apply to him for directions with respect to the advertisement of the assignment and must advertise it in such form and manner and within such period as the Registrar may direct.
- (8) An appeal shall lie from any decision of the Registrar under this section.

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

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

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

shall be entered on the register as associated trade marks.

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- (3) Where a trade mark and any part or parts thereof are, by virtue of section 26(1), registered as separate trade marks in the name of the same proprietor, they shall be deemed to be, and shall be registered as, associated trade marks.
- (4) All trade marks that are, by virtue of section 26(2), registered as a series in one registration shall be deemed to be, and shall be registered as, associated trade marks.
- (5) On application made in the prescribed manner by the registered proprietor of two or more trade marks registered as associated trade marks, the Registrar may dissolve the association as respects any of them if he is satisfied that there would be no likelihood of deception or confusion being caused if that trade mark were used by another person in relation to any of the goods in respect of which it is registered and may amend the register accordingly.
- (6) An appeal shall lie from any decision of the Registrar under this section.

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

Power of registered proprietor to assign and give receipts.

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

Registration of assignments and transmissions.

- (2) An appeal shall lie from any decision of the Registrar under this section.
- (3) Except for the purposes of an appeal under this section or of an application under section 37, a document or instrument in respect of which no entry has been made in the register in accordance with subsection (1) shall not be admitted in evidence in any court in proof of the title to a trade mark unless the court otherwise directs.

31. (1) Subject to section 32, a registered trade mark may be taken off the register in respect of any of the goods in respect of which it is registered on application by any person aggrieved to the Tribunal or, at the option of the applicant and subject to section 64, to the Registrar, on the ground either:-

Removal from register and imposition of limitation.

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

Provided that (except where the applicant has been permitted under section 17(2) to register an identical or nearly resembling trade mark in respect of the goods in question or where the Tribunal or the Registrar, as the case may be, is of opinion that he might properly be permitted so to register such a trade mark) the Tribunal or the Registrar may refuse an application made under paragraph (a) or (b) in relation to any goods, if it is shown that there has been, before the relevant date or during the relevant period, as the case may be, *bona fide* use of the trade mark by any proprietor for the time being in relation to goods of the same description, being goods in respect of which the trade mark is registered.

- (2) Where, in relation to any goods in respect of which a trade mark is registered:-
 - (a) The matters referred to in subsection (1)(b) are shown so far as regards non-use of the trade mark in relation to goods to be sold or otherwise traded in in a particular place in Malawi (otherwise than for export from Malawi) or in relation to goods to be exported to a particular market outside Malawi: and
 - (b) A person has been permitted under section 17(2) to register an identical or nearly resembling trade mark in respect of those goods under a registration extending to use in relation to goods to be sold or otherwise traded in in that place (otherwise than for export from Malawi) or in relation to goods to be exported to that market or the Tribunal or the Registrar is of opinion that he might properly be permitted so to register such a trade mark;

on application by that person to the Tribunal or, at the option of the applicant and subject to section 64, to the Registrar, the Tribunal or the Registrar may impose on the registration of the first mentioned trade mark such limitations as the Tribunal or the Registrar thinks proper for securing that that registration shall cease to extend to such

use as last aforesaid.

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- (3) An application shall not be entitled to rely for the purposes of subsection (1)(b), or for the purposes of subsection (2), on any non-use of a trade mark that is shown to have been due to special circumstances in the trade and not to any intention not to use or to abandon the trade mark in relation to the goods to which the application relates.

32.

- (1) Where a trade mark registered in Part A of the register has become so well known as respect any goods in respect of which it has been used that the use thereof in relation to other goods would be likely to be taken as indicating a connection in the course of trade mark in relation to the first mentioned goods, then, notwithstanding that the proprietor registered in respect of the first-mentioned goods does not use or propose to use that trade mark in relation to those other goods and notwithstanding anything in section 31, the trade mark may, on the application in writing in the prescribed manner of the proprietor registered in respect of the first-mentioned goods be registered in Part D of the register in his name in respect of those other goods as a defensive trade mark and, while so registered, shall not be liable to be taken off the register in respect of those goods under section 31.

**Defensive
registration of
well-known trade
marks.**

- (2) The registered proprietor of a trade mark may apply for the registration thereof in respect of any goods as a defensive trade mark, notwithstanding that it is already registered in his name in respect of those goods otherwise than as a defensive trade mark, or may apply for the registration thereof in respect of any goods otherwise than as a defensive trade mark, notwithstanding that it is already registered in his name in respect of those goods as a defensive trade mark, in lieu in each case of the existing registration.
- (3) A trade mark registered as a defensive trade mark and that trade mark as otherwise registered in the name of the same proprietor shall, notwithstanding that the respective registrations are in respect of different goods, be deemed to be, and shall be registered as, associated trade marks.
- (4) On application by any person aggrieved to the Tribunal or at the option of the applicant and subject to section 64, to the Registrar, the registration of a trade mark as a defensive trade mark may be cancelled on the ground that the requirements of subsection (1) are no longer satisfied in respect of any goods in respect of which the trade mark is registered in the name of the same proprietor otherwise than as a defensive trade mark or may be cancelled as respects any goods in respect of which it is registered as a defensive trade mark on the ground that there is no longer any likelihood that the use of the trade mark in relation to those goods would be taken as giving the indication mentioned in subsection (1).

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- (5) The Registrar may at any time cancel the registration as a defensive trade mark of a trade mark of which there is no longer any registration in the name of the same proprietor otherwise than as a defensive trade mark.
- (6) Except as otherwise expressly provided in this section the provisions of this Act shall apply in respect of the registration of trade marks as defensive trade marks and of trade marks so registered as they apply in other cases and the provisions of section 9 relating to the infringement of a trade mark registered in Part A of the register shall apply to the infringement of any defensive trade mark registered in terms of this section if that registration is valid.

Registered users.

- 33.** (1) Subject to this section, a person other than the proprietor of a trade mark registered in either Part A or Part B of the register may be registered as a registered user thereof in respect of all or any of the goods in respect of which it is registered (otherwise than as a certification or defensive trade mark) and either with or without conditions or restrictions.

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

- (2) The permitted use of a trade mark shall be deemed to be use by the proprietor and shall be deemed not to be use by a person other than the proprietor for the purposes of section 31 and for any other purpose for which such use in material under this Act or under any other law.
- (3) Subject to any agreement subsisting between the parties, a registered user of a trade mark shall be entitled to call upon the proprietor thereof to take proceedings to prevent infringement thereof, if the proprietor refuses or neglects to do so within two months after being so called upon, the registered user may institute proceedings for infringement in his own name as if he were the proprietor, making the proprietor a defendant.

A proprietor so added as defendant shall not be liable for any costs unless he enters an appearance and takes part in the proceedings.

- (4) Where it is proposed that a person should be registered as a registered user of a trade mark, the proprietor and the proposed registered user must apply in writing to the Registrar in the prescribed manner and must furnish him with an affidavit or a solemn declaration made by the proprietor or by some person authorized to act on his behalf and approved by the Registrar:-

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- (a) Giving particulars of the relationship existing or proposed between the proprietor and the proposed registered user, including particulars showing the degree of control by the proprietor over the permitted use which their relationship will confer and whether it is a term of their relationship that the proposed registered user shall be the sole registered user or that there shall be any other restriction as to persons for whose registration as registered users application may be made;
- (b) Stating the goods in respect of which registration is proposed;
- (c) Starting any conditions or restrictions proposed with respect to the characteristics of the goods, to the mode or place of permitted use or to any other matter; and
- (d) Stating whether the permitted use is to be for a period or without limit of period and, if for a period, the duration thereof;

and with such further documents, information or evidence as may be required under the regulations or by the Registrar.

- (5) When the requirements of subsection (4) have been complied with, if the Registrar, after considering the information furnished to him under that subsection, is satisfied that in all the circumstances the use of the trade mark in relation to the proposed goods or any of them by the proposed registered user, subject to any conditions or restrictions which the Registrar thinks proper, would not be contrary to the public interest, the Registrar may register the proposed registered user as a registered user in respect of the goods as to which he is so satisfied subject as aforesaid.
- (6) The Registrar shall refuse an application under the foregoing provisions of this section if it appears to him that the grant thereof would tend to facilitate trafficking in a trade mark.
- (7) The Registrar shall, if so required by an applicant, take steps for securing that information given for the purposes of an application under the foregoing provisions of this section (other than matter entered in the register) is not disclosed to rivals in trade.
- (8) Without prejudice to section 37, the registration of a person as a registered user:-

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- (a) May be varied by the Registrar as regards the goods in respect of which or any conditions or restrictions subject to which it has effect, on the application in writing in the prescribed manner of the registered proprietor of the trade mark to which the registration relates;
- (b) May be cancelled by the Registrar on the application in writing in the prescribed manner of the registered proprietor or of the registered user or of any other registered user of the trade mark; or
- (c) May be cancelled by the Registrar on the application in writing in the prescribed manner of any person on any of the following grounds, that is to say:-
 - (i) That the registered user has used the trade mark otherwise than by way of the permitted use or in such a way as to cause or to be likely to cause deception or confusion;
 - (ii) That the proprietor or the registered user misrepresented or failed to disclose some fact material to the application for the registration or that the circumstances have materially changed since the date of the registration.
- (9) Provision shall be made by regulations for the notification of the registration of a person as a registered user to any other registered user of the trade mark, and for the notification of an application under subsection (8) to the registered proprietor and each registered user (not being the applicant) of the trade mark, and for giving to the applicant on such an application, and to all persons to whom such an application is notified and who intervene in the proceedings in accordance with the regulations an opportunity of being heard.
- (10) The Registrar may at any time cancel the registration of a person as a registered user of a trade mark in respect of any goods in respect of which the trade mark is no longer registered.
- (11) An appeal shall lie from any decision of the Registrar under this section.
- (12) Nothing in this section shall confer on a registered user of a trade mark any assignable or transmissible rights to the use thereof.

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

Proposed use of trade mark by corporation to be constituted, etc.

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- (a) If the Registrar is satisfied that a body corporate is about to be constituted and that the applicant intends to assign the relation to those goods by the corporation; or
 - (b) If the application is accompanied by an application for the registration of a person as a registered user of the trade mark and the Registrar is satisfied that the proprietor intends it to be used by that person in relation to those goods and the Registrar is also satisfied that that person will be registered as a registered user thereof immediately after the registration of the trade mark.
 - (2) Section 31 shall have effect, in relation to a trade mark registered under the power conferred by subsection (1) as if for the reference, in section 31(1)(a) to intention on the part of an applicant for registration that a trade mark should be used by him there were substituted a reference to intention on his part that it should be used by the corporation or registered user concerned.
 - (3) When a trade mark is registered in respect of any goods under the power conferred by subsection (1) in the name of an applicant who relies on intention to assign to a corporation as aforesaid, then, unless within such period as may be prescribed or within such further period not exceeding six months as the Registrar may on application being made to him in the prescribed manner allow, the corporation has been registered as the proprietor of the trade mark in respect of those goods, the registration shall cease to have effect in respect thereof at the expiration of that period, and the Registrar shall amend the register accordingly.
 - (4) An appeal shall lie from any decision of the Registrar under this section.
- 35.** (1) Where under this Act use a registered trade mark is required to be proved for any purpose, the Registrar, or the Tribunal in the event of an appeal from a decision of the Registrar, may, if and so far as the Registrar or the Tribunal thinks right, accept use of an associated registered trade mark, or of the trade mark with additions or alterations not substantially affecting its identity, as an equivalent for the use required to be proved.
- Use of one of associated or substantially identical trade marks equivalent to use of another.**
- (2) The use of the whole of a registered trade mark shall for the purposes of this Act, be deemed to be also a use of any registered trade mark, being a part thereof, registered in the name of the same proprietor by virtue of section 26(1).

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- 36.** The application in Malawi of a trade mark to goods to be exported from Malawi and any other act done in Malawi in relation to goods to be so exported which, if done in relation to goods to be sold or otherwise traded in in Malawi, would constitute use of a trade mark therein shall be deemed to constitute use of the trade mark in relation to those goods for any purpose for which such use is material under this act or under any other law

Use of trade mark
for export trade.

PART VII RECTIFICATION AND CORRECTION OF THE REGISTER

- 37.** (1) Any person aggrieved by the non-insertion in or omission from the register of any entry, or by any entry made in the register without sufficient cause, or by any entry wrongly remaining on the register, or by any error or defect in any entry in the register, may apply in the prescribed manner to the Tribunal or, at the option of the applicant and subject to section 64, to the Registrar, and the Tribunal or the Registrar may make such order for making, expunging or varying the entry as the Tribunal or the Registrar may think fit.
- (2) The Tribunal or the Registrar may in any proceeding under this section decide any question that it may be necessary or expedient to decide in connection with the rectification of the register.
- (3) In case of fraud in the registration, assignment of transmission of a registered trade mark, the Registrar may himself apply to the Tribunal under this section.
- (4) Any order of the Tribunal rectifying the register shall direct that notice of the rectification shall be served in the prescribed manner on the Registrar, and the Registrar shall on receipt of the notice rectify the register accordingly.
- (5) The power to rectify the register conferred by this section shall include power to remove a registration in Part A of the register to Part B.

General power to
rectify entries in
register.

- 38.** On application by any person aggrieved to the Tribunal or, at the option of the applicant and subject to section 64, to the Registrar or on application by the Registrar to the Tribunal, the Tribunal or the Registrar may make such order as the Tribunal or the Registrar may think fit for expunging or varying the registration of a trade mark on the ground of any contravention of or failure to observe a condition entered on the register in relation thereto.

Power to expunge
or vary
registration for
breach of
condition.

- 39.** (1) The Registrar may, in request made in the prescribed manner by the registered proprietor:-

Correction of
register.

- (a) correct any error in the name, address or description of the registered proprietor of a trade mark;
- (b) enter any change in the name, address or description of the

person who is registered as proprietor of a trade mark;

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- (c) cancel the entry of a trade mark on the register;
 - (d) strike out any goods or classes of goods from those in respect of which a trade mark is registered; or
 - (e) enter a disclaimer or memorandum relating to a trade mark which does not in any way extend the rights given by the existing registration of the trade mark.
 - (2) The Registrar may, on request made in the prescribed manner by a registered user of a trade mark, correct any error or enter any change in the name, address or description of the registered user.
 - (3) An appeal shall lie from any decision of the Registrar under this section.
- 40.** (1) The registered proprietor of a trade mark may apply in the prescribed manner to the Registrar for leave to add to or alter the trade mark in any manner not substantially affecting the identity thereof, and the registrar may refuse leave or may grant it on such terms and subject to such limitations as he may think fit.
- Alteration of registered trade mark.**
- (2) The Registrar may direct that an application under this section shall be advertised in the prescribed manner in any case where it appears to him that it is expedient so to do, and where he does so, if within the prescribed time from the date of the advertisement any person gives notice to the Registrar in the prescribed manner of opposition to the application, the Registrar shall, after hearing the parties if so required, decide the matter.
 - (3) An appeal shall lie from any decision of the Registrar under this section.
 - (4) Where leave as aforesaid is granted, the trade mark as altered shall be advertised by the proprietor in the prescribed manner, unless it has already been advertised, in the form to which it has been altered, in an advertisement under subsection (2).
- 41.** (1) The Minister may from time to time make such regulations, prescribe such forms and generally do such things as may be expedient, for empowering the Registrar to amend the register, whether by making or expunging or vary in entries therein, so far as may be requisite for the purpose of adapting the designation therein of the goods or classes of goods in respect of which trade marks are registered to any amended or substituted classification that may be prescribed.
- Adaptation of entries in register to amended or substituted classification of goods.**

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- (2) The Registrar shall not, in exercise of any power conferred on him for the purpose aforesaid, make any amendment of the register that would have the effect of adding any goods or classes of goods to those in respect of which a trade mark is registered (whether in one or more classes) immediately before the amendment is to be made or of ante-dating the registration of a trade mark in respect of any goods:

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

- (3) A proposal for the amendment of the register for the purpose aforesaid shall be notified to the registered proprietor of that trade mark affected, shall be subject to appeal by the registered proprietor to the Tribunal, shall be advertised by the proprietor with any modifications, and may be opposed before the Registrar by any person aggrieved on the ground that the proposed amendment contravenes subsection (2), and an appeal shall lie from any decision of the Registrar on any such opposition.

PART VIII CERTIFICATION TRADE MARKS

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

Certification trade marks.

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

- (2) In determining whether a mark is adapted to distinguish as aforesaid, the Registrar, or the Tribunal in the event of an appeal from a decision of the Registrar, may have regard to the extent of which:-
- (a) The mark is inherently adapted to distinguish as aforesaid in relation to the goods in question; and
- (b) By reason of the use of the mark or of any other circumstances, the mark is in fact adapted to distinguish as aforesaid in relation to the goods in question.

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- (3) Subject to subsection (4) to (6) inclusive and sections 12 and 12, the registration of a person as proprietor of a certification trade mark in respect of any goods shall, if valid, give to that person the exclusive right to the use of the trade mark in relation to those goods, and, without prejudice to the generality of the foregoing words, that right shall be deemed to be infringed by any person who, not being the proprietor of the trade mark or a person authorized by him under the regulations in that behalf using it in accordance therewith, uses a mark identical with it or so nearly resembling it as to be likely to deceive or cause confusion in the course of trade in relation to any goods in respect of which it is registered and in such manner as to render the use of the mark likely to be taken either:-
- (a) As being use as a trade mark; or
 - (b) In a case in which the use is use upon the goods or in physical relation thereto or in an advertising circular or other advertisement issued to the public, as importing a reference to some person having the right either as proprietor or by his authorization under the relevant regulations to use the trade mark or to goods certified by the proprietor.
- (4) The right to the use of a certification trade mark given by registration as aforesaid shall be subject to any conditions or limitations entered on the register and shall not be deemed to be infringed by the use of any such mark as aforesaid in any mode, in relation to goods to be sold or otherwise traded in in any place, in relation to goods to be exported to any market or in any other circumstances to which having regard to any such limitations, the registration does not extend.
- (5) The right to the use of a certification trade mark given by registration as aforesaid shall not be deemed to be infringed by the use of any such mark as aforesaid by any person:-
- (a) In relation to goods certified by the proprietor of the trade mark if, as to those goods or a bulk of which they form part, the proprietor or another in accordance with his authorization under the relevant regulations has applied the trade mark and has not subsequently removed or obliterated it or the proprietor has at any time expressly or impliedly consented to the use of the trade mark; or
 - (b) In relation to goods adapted to form part of or to be accessory to other goods in relation to which the trade mark has been used without infringement of the right given as aforesaid or might for the time being be so used, if the use of the mark is reasonably necessary in order to indicate that the goods are so adapted and neither the purpose nor the effect of the use of the mark is to indicate otherwise than in accordance with the fact that the goods are certified by the

proprietor.

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

- (6) Where a certification trade mark is one of two or more registered trade marks that are identical or nearly resemble each other, the use of any of those trade marks in exercise of the right to the use of that trade mark given by registration shall not be deemed to be an infringement of the right so given to the use of any other of those trade marks.
- (7) There shall be deposited at the Trade Mark Office in respect of every trade mark registered under this section regulations approved by the Registrar for governing the use thereof, which shall include provisions as to the cases in which the proprietor is to certify goods and to authorize the use of the trade mark and may contain any other provisions that the Registrar may require or permit to be inserted therein (including provisions conferring a right of appeal to the Registrar against any refusal of the proprietor to certify goods or to authorize the use of the trade mark in accordance with the regulations). Regulations so deposited shall be open to inspection in like manner as the register.
- (8) A certification trade mark shall not be assignable or transmissible otherwise than with the consent of the Registrar.
- (9) The First Schedule shall have effect with respect to the registration of a mark under this section and to marks so registered.
- (10) In this section, “**person**” includes the Minister responsible for the administration of any Ministry or Government department which has been authorized or established to certify goods in respect of origin, material, mode of manufacture, quality, accuracy or other characteristic.
- (11) Marks which, immediately before the 1st January, 1964, were registered under the former trade marks legislation as certification trade marks shall be deemed to be registered as certification trade marks in Part C of the register.

PART IX

FUNCTIONS OF REGISTRAR IN RELATION TO CERTAIN EVIDENCE, DOCUMENTS AND POWERS

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

Preliminary advice
by Registrar as to
distinctiveness.

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- (2) Any such person who is desirous of obtaining such advice must make application to the Registrar therefore in the prescribed manner.
- (3) If on application for the registration of a trade mark as to which the Registration has given advice as aforesaid in the affirmative, made within three months after the advice is given, the Registrar, after further investigation or consideration, gives notice to the applicant of objection on the ground that the trade mark is not adapted to distinguish or capable of distinguishing, as the case may be, the applicant shall be entitled, on giving notice of withdrawal of the application within the prescribed period, to have repaid to him any fee paid on the lodging of the application.
- 44.** Where any discretionary or other power is given to the Registrar by this Act or the regulations, he shall not exercise that power adversely to the applicant for registration or the registered proprietor of the trade mark in question (if duly required so to do within the prescribed time) giving to the applicant or registered proprietor an opportunity of being heard.
- 45.** (1) A certificate purporting to be signed by the Registrar and certifying that any entry which he is authorized by or under this Act to make has or has not been made, or that any other thing which he is so authorized to do has or has not been done, shall be prima facie evidence of the matters so certified
- (2) A copy of any entry in any register or of any document kept in the Trade Marks Office or of any trade mark or an extract from any such register or document, certified by the Registrar and sealed with the seal of the Patent Office, shall be admitted in evidence without further proof and without production of the original.
- 46.** The Registrar shall, on the request of any person and on payment of the prescribed fee, furnish copies of any documents which are open to public inspection and which are lodged at the Trade Marks Office or particulars from the register or furnish a certificate in respect thereof.
- 47.** In all proceedings before the Registrar under this Act, the Registrar shall have power to award to any party such costs as he may consider reasonable and to direct how and by what parties they are to be paid. Any costs awarded by the Registrar shall be taxed by a taxing officer of the Tribunal and payment thereof may be enforced in the same manner as if they were costs allowed by the Tribunal.
- 48.** (1) Subject to section 79, evidence in any proceedings before the Registrar under this Act shall be given by affidavit, so,
- Hearing before exercise of Registrar's discretion.
- Evidence of certain entries and documents.
- Requests for information as to trade mark.
- Power of Registrar to award costs.
- Proceedings before Registrar.

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- (2) The powers, rights and privileges of the Registrar in proceedings before him under this Act shall be the same as those conferred upon commissioners by the Commissions of Inquiry Act and sections 9, 10 and 12 of that Act and so much of the regulations made under it as are applicable shall, *mutatis mutandis*, apply in relation to the hearing and determination of any matter before the Registrar under this Act and to any person summoned to give evidence or giving evidence before him.

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- 49.** The Registrar may in any proceeding held before him decide the hours, times and places at which he will sit and he may adjourn any proceedings for such time and to such place as he may think fit.

Power of Registrar to fix time and place of sitting, etc.

- 50.** No advertisement or notice, other than a notice issued under the authority of the Minister, shall be published by any person under this Act unless it is in the prescribed form and the Registrar has approved the contents of such advertisement or notice, and no advertisement or notice which has not been so approved shall have any force or effect for the purposes of this Act.

Advertisements to be approved by Registrar.

PART X APPEALS AND LEGAL PROCEEDINGS

- 51.** (1) Where this Act provides for an appeal from a decision of the Registrar, such appeal shall be made to the Tribunal.

Patents Tribunal to hear appeals.

- (2) For the purposes of this Act, the Minister shall appoint a Registrar of the Tribunal and such other officers thereof as he may deem necessary.
- (3) The Tribunal shall in connection with any proceedings before it under this Act have all the powers of the High Court and without prejudice to the foregoing and to the other powers conferred upon it by this Act, the Tribunal shall have power to make any order for the purpose of securing the attendance of any person, the discovery or production of any documents, or the investigation or punishment of any contempt of court which the High Court as aforesaid has power to make.
- (4) The procedure and practice of the Tribunal shall, save as otherwise provided for by rules made under this Part, be those prevailing in the High Court, in so far as the same are applicable, and if any matter should arise which is not contemplated by either such procedure, practice or rules, the Tribunal may give instructions regarding the course to be pursued which instructions shall be binding on all parties.
- (5) Upon appeal to the Tribunal, the Tribunal:-
- (a) Confirm, set aside or vary the order or decision in question;
- (b) Exercise any of the powers which could have been exercised by the Registrar in proceedings in connection with which the

appeal is brought.
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- (c) Make such order as to costs as it may think fit.
- (6) For the purpose of this Act, the Tribunal shall sit at such times and places as it may appoint.
- (7) In any proceedings before it, the Tribunal may, subject to section 79, accept evidence by affidavit or take oral evidence on oath and allow any witness to be cross-examined on his affidavit or oral evidence.
- 52.** In any proceedings before the Tribunal under this Act, the parties to such proceedings may appear in person or be represented and appear by a legal practitioner, and in any case where the Tribunal deems fit, it may grant to the Registrar leave to intervene, and he may thereafter appear or be so represented. **Right of audience.**
- 53.** The Minister may make rules for regulating generally the practice and procedure of the Tribunal and with respect to appeals or references to such Tribunal as to the time within which any requirement of the rules is to be complied with, as to the costs and expenses of and incidental to any proceedings in such Tribunal, as to the fees to be charged in respect of proceedings therein, as to the fees to be paid to assessors, and in particular may make rule providing for the summary determination of any appeal which appears to the Tribunal to be frivolous or vexatious or to be brought for the purpose of delay. **Rules.**
- 54.** The Tribunal may appoint any person with special expert knowledge to act as an assessor in an advisory capacity in any case where it appears to such Tribunal that such knowledge is required for the proper determination of the case. **Assessors.**
- 55.** Appeals under this Part, whether from decisions of the Registrar, or orders or decisions of the Tribunal, shall be brought within three months after the date of the decision or order in question or within such further time as the Tribunal or High Court may allow upon application by the appellant concerned. **Time for appeals.**
- 56.** When any matter to be decided by the Registrar under this Act appears to him to involve a point of law or to be of unusual importance or complexity, he may, after giving notice to the parties, refer such matter to the Tribunal for a decision and shall thereafter, in relation to such matter act in accordance with the decision of that Tribunal or any decision substituted therefore on appeal to the High Court. **References to Tribunal by Registrar.**
- 57.** In all legal proceedings relating to a registered trade mark (including applications under section 37) the fact that a person is registered as proprietor of the trade mark shall be *prima facie* evidence of the validity of the original registration of the trade mark and of all subsequent assignments and transmissions thereof. **Registration to be prima facie evidence of validity.**

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- 58.** In any legal proceeding in which the validity of the registration of a registered trade mark comes into question and is decided in favour of the proprietor of the trade mark, the High Court or Tribunal may certify to that effect, and if it so certifies, then, in any subsequent legal proceeding in which the validity of the registration comes into question, the proprietor of the trade mark, on obtaining a final order or judgment in his favour, shall have his full costs, charges and expenses as between solicitor and client or attorney and client, unless in the subsequent proceeding the High Court or Tribunal certifies that he ought not to have them.
- 59.** Any action or legal proceeding relating to the infringement or passing off or passing off of a trade mark shall be brought in the High Court.
- 60.** In any action or proceeding relating to a trade mark or trade mark or trade name, the Tribunal or the Registrar, as the case may be, shall admit evidence of the usages of the trade concerned and of any relevant trade mark or trade name or get-up legitimately used by other persons.
- 61.** (1) In any legal proceeding in which the relief sought includes alteration or rectification of the register, the Registrar shall have the right to appear and be heard, and shall appear if so directed by the Tribunal.
- (2) Unless otherwise directed by the Tribunal, the Registrar, in lieu of appearing and being heard, may submit to the Tribunal a statement in writing signed by him, giving particulars of the proceedings before him in relation to the matter in issue or of the grounds of any decision given by him affecting it or of the practice of the Trade Marks Office in like cases or of such other matters relevant to the issues, and within his knowledge as Registrar, as he thinks fit, and the statement shall be deemed to form part of the evidence in the proceeding.
- 62.** The Tribunal, in dealing with any question of the rectification of the register (including all applications under section 37) shall have power to review any decision of the Registrar relating to the entry in question or the correction sought to be made.
- 63.** In any appeal from a decision of the Registrar to the Tribunal, the Tribunal shall have and exercise the same discretionary powers as under this Act are conferred upon the Registrar.
- 64.** Where under any of the foregoing provisions of this Act an applicant has an option to make an application either to the Tribunal or to the Registrar and such application is made to the Registrar, the Registrar may, at any stage of the proceedings, refer the application to the Tribunal or may, after hearing the parties, determine the question between them, subject to appeal to the Tribunal.

Certification of validity.

Infringement or passing off action to be heard in High Court

Trade usage, etc., to be considered.

Registrar's appearance in proceedings involving rectification.

Tribunal's power to review Registrar's decision.

Discretion of Tribunal in appeals.

Procedure on causes of option to apply to Tribunal or Registrar.

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- 65.** (1) When a party to proceedings before the Registrar or the Tribunal or an appellant is resident outside Malawi, the Registrar or the Tribunal may order such party or appellant to give security, within such time as may be directed, for the costs of the proceedings or appeal.
- (2) If the party or appellant ordered to give security for costs fails to do so within the time directed, the Registrar or the Tribunal may treat the proceedings or appeal as abandoned.
- (3) Where a bond is to be given as security for costs, it shall, unless the Registrar or the Tribunal otherwise directs, be given to the party requiring the security.
- (4) Unless otherwise agreed between the parties, any costs awarded in terms of section 51(5) shall be taxed by the Registrar of the Tribunal in accordance with rules made under this Part which taxation shall be subject to appeal to the Tribunal, and any such costs may be recovered by action in a court of competent jurisdiction.
- 66.** In all proceedings before the Tribunal under this Act, the costs of the Registrar shall be in the discretion of the Tribunal, but the Registrar shall not be ordered to pay the costs of any other of the parties.
- 67.** (1) Any party to any proceedings before the Tribunal may appeal in accordance with rules made under this Part from any order or decision of such Tribunal to the High Court.
- (2) Upon the hearing of an appeal under the provisions of this section, the High Court may, without prejudice to its other powers:-
- (a) confirm, set aside or vary the order of decision in question;
 - (b) remit the proceedings to the Tribunal with such instructions for further consideration, report, proceedings or evidence as the High Court may think fit to give;
 - (c) exercise any of the powers which could have been exercised by the Tribunal in the proceedings in connection with which the appeal is brought.
 - (d) Make such order it may think just as to the costs of the appeal or of earlier proceedings in the matter before the Tribunal.

Security for costs
and taxation of
costs.

Costs of Registrar.

Appeals to High
Court.

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PART XI OFFENCES AND PENALTIES

- 68.** Any person who makes or causes to be made a false entry in the register, or a writing purporting to be a copy of an entry in the register, or who produces or tenders or causes to be produced or tendered in evidence any such writing, knowing the entry or writing to be false, shall be guilty of an offence.

Falsification false representing a trade mark as registered.

- 69.** (1) Any person who makes a representation:-

Penalty for falsely representing a trade mark as registered.

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

Shall be liable to a fine of £50 and to imprisonment for six months.

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

- (a) where that word is used in physical association with other words delineated in character at least as large as those in which that word is delineated and indicating that the reference is to registration as a trade mark under the law of a country outside Malawi, being a country under the law of which the registration referred to is in fact in force;
- (b) where that word (being a word other than the word “registered”) is of itself such as to indicate that the reference is to such registration as last aforesaid; or
- (c) where that word is used in relation to a mark registered as a trade mark under the law of another country and in relation to goods to be exported to that country.

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70. (1) Any person who:-

Deceiving or
influencing the
Registrar or an
officer.

- (a) for the purpose of deceiving the Registrar or any other officer of the Trade Marks Office in the execution of this Act; or
- (b) for the purpose of procuring or influencing the doing or omission of anything in relation to this Act or any matter thereunder,

makes or submits a false statement or representation, whether orally or in writing, knowing the same to be guilty of an offence.

- (2) Any person who, 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 relating to this Act or any matter thereunder and who on becoming aware that such statement or representation was false, fails to advise the Registrar forthwith of such falsity shall be guilty of an offence.

71. Any person who, after having been sworn, wilfully gives false evidence before the Registrar or the Tribunal concerning the subject matter of the proceeding in question, knowing such evidence to be false or not knowing or believing it to be true, shall be guilty of an offence.

Witness giving
false evidence.

72. Save where otherwise provided in this Act, any person who is guilty of an offence under this Act shall be liable to a fine of £500 and to imprisonment for three years.

Penalties.

73. (1) Any person who qualifies under Article 2 or 3 of the Convention and who has applied for protection for any trade mark in a convention country or his legal representative or assignee (if such assignee is also so qualified) shall be entitled to registration of his trade mark in priority to other applicants; and the registration shall have the same date as the date of the application in the convention country:-

Convention
arrangements.

Provided that:-

- (a) the application for registration is made six months from the date of the application for protection in the convention country;
- (b) nothing in this section shall entitle the proprietor of a trade mark to recover damages for infringements happening prior to the actual date on which his trade mark is registered in Malawi.

- (2) Where applications have been made for the registration of a trade mark in two or more convention countries, the period of six months referred to in subsection (1) shall be reckoned from the date on which the earlier or earliest of those applications was made.

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- (3) The application for the registration of a trade mark under this section must be made in the same manner as is required in the case of any ordinary application under this Act.

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

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

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

Jointly owned trade marks.

- (a) on behalf of both or all of them; or
- (b) in relation to an article with which both or all of them are connected in the course of trade;

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

Subject as aforesaid, nothing in this Act shall authorize the registration of two or more persons who use a trade mark independently, or propose so to use it, as joint proprietors thereof.

76. (1) Any application, notice or document authorized or required under this Act to be lodged, made or given at the Trade Marks Office or to the Registrar or to any other person may be delivered by hand or sent by registered post.

Lodging and authentication of documents.

- (2) No authentication shall be required in respect of any document lodged in the Trade Marks Office under this Act or used in proceedings before the Tribunal.

77. All moneys necessary for the purpose of this Act shall be paid out of moneys provided for the purpose by Parliament.

Express administration.

78. (1) Where under this Act:-

Provisions as to fees.

- (a) a fee is payable in respect of the performance of any act by the Registrar, the Registrar shall not perform that act until the fee has been paid.
- (b) A fee is payable in respect of the doing of any act by any person other than the Registrar, the act shall be deemed not

to have been done until the fee has been paid; or

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- (c) A fee is payable in respect of the lodging of a document, the document shall be deemed not to have been lodged until the fee has been paid.
- (2) All fees shall be paid at the Trade Marks Office in such manner as the Registrar, with the approval of the Minister, may accept.
- 79.** Any person who is required under this Act to take any oath or swear to the truth of any affidavit may, in lieu thereof, make an affirmation or declaration in accordance with the law relating to affirmations or declarations. **Oaths and affirmations.**
- 80.** (1) The Minister may, when he deemed fit, direct the publication by the Registrar of a journal, to be referred to as the Trade Marks Journal, containing particulars of applications for the registration of trade marks and other proceedings or matters arising under this Act, together with such reports of cases and other relevant matters as the Minister may deem fit. **Trade Marks Journal.**
- (2) The Registrar shall make provision for selling copies of the Trade Marks Journal at such price and in such manner as the Minister may direct.
- 81.** (1) The Minister may make regulations prescribing anything which under this Act is to be prescribed and generally for the better carrying out of the objects and purposes of this Act or to give force or effect to its provisions or for its better administration. **Power to make regulations.**
- (2) Without derogation from the generality of subsection (1), regulations made by the Minister may provide:-
- (a) for regulating the practice under this Act, including the service of documents;
 - (b) for classifying goods for the purposes of registration of trade marks;
 - (c) for prohibiting the registration of any mark on the grounds of morality, public policy or other good and sufficient reason;
 - (d) for making or requiring duplicate representations of trade marks and other documents;
 - (e) for securing and regulating the publishing and selling or distributing, in such manner as he thinks fit, of copies of trade marks and other documents;
 - (f) for the fees which may be charged in relation to the conduct of trade mark business by trade mark agents;

- (g) for the professional conduct of trade mark agents;

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- (h) generally for regulating the business of the Trade Marks Office in relation to trade marks and all things by this Act placed under the direction or control of the Registrar.
- (3) The Minister may also prescribe a tariff, not inconsistent with this Act, of the fees which shall be payable in respect of any application, registration and other matters under this Act and the fees shall be payable as so prescribed.

PART XIII APPLICATION

- 82.** Save as otherwise provided in this Part, this Act shall apply in respect of all trade marks, including trade marks registered before the date of commencement of this Act, and in respect of all applications for the registration of trade marks, including applications made before that date:

Application of Act.

Provided that:-

- (a) a trade mark registered before that date shall not be liable to be taken off the register except upon some ground upon which it would have been so liable in terms of the relevant repealed legislation under which it was registered and shall, unless it is so removed in terms of this Act, lapse on the date of the expiration of the last registration thereof in terms of that legislation unless renewed in terms of section 25;
- (b) fees for the renewal of any trade mark registered before the date of commencement of this Act shall be paid in accordance with the scale of fees prescribed for the renewal of trade marks registered under this Act.

PART XIV TRADE MARK AGENTS

- 83.** (1) Subject to section 85, the Registrar shall keep a register of trade mark agents in which he shall:-

**Registration of
trade mark agents.**

- (a) register the name of every person who is accepted for registration in terms of subsection (2);
- (b) show against the name of every person registered under paragraph (a) such particulars as he may from time to time deem necessary; and
- (c) enter all changes relating to registrations.

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- (2) Any person who, within six months after the date* of commencement of the Trade Marks Amendment Act, 1962, satisfies the Registrar that for a continuous period of two years immediately before such date he was ordinarily resident in the Federation of Rhodesia and Nyasaland and was performing the functions mentioned in section 87(1) may make application to the Registrar in the prescribed manner to be registered as a trade mark agent, and the Registrar shall arrange such registration if he is satisfied that there is no good reason why it should not be arranged and that the applicant is not a person whose name could be removed from the register of trade mark agents under section 84(1)(b), (c) or (f).

- 84.** (1) The Registrar may remove from the register of trade mark agents the name of any trade mark agent upon proof to his satisfaction that such trade mark agent:-

**Removal of names
from register of
trade mark agents.**

- (a) has died;
- (b) has become of unsound mind;
- (c) has been adjudged or otherwise declared bankrupt or insolvent under any law, or has made an assignment to or composition with his creditors;
- (d) has ceased to reside in Malawi, or has ceased to maintain a place of business therein;
- (e) has applied for his name to be so removed;
- (f) has, after being convicted, in Malawi or elsewhere, of the crime of theft, fraud, forgery or uttering a forged document or perjury, been sentenced to to serve a term of imprisonment without the option of a fine, whether such sentence is suspended or not, and has not received a free pardon;
- (g) having been entitled to practise as a trade mark agent has ceased to be so entitled, or has ceased to practice as such.

An appeal shall lie from any decision of the Registrar made under this subsection.

- (2) Subject to this section and such procedure as may be prescribed, the Tribunal may order the Registrar to remove the name of any trade mark agent from the register of trade mark agents or may suspend any trade mark agent from practicing as such for such time as it thinks fit if it is satisfied, after due inquiry, that such person has been guilty of conduct discreditable to a trade mark agent or has been guilty of a breach of any regulations prescribed for the conduct of trade mark agents.

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- (3) No order shall be made by the Tribunal in terms of subsection (2) unless the trade mark agent concerned has been given notice of any allegation made against him and has had an opportunity to adduce evidence and to be heard.
- (4) Where the name of any trade mark agent has been removed from the register of trade mark agents under subsection (1) or (2), his name shall be restored to that register except by direction of the Tribunal, which may further direct that such restoration shall be made either without fee or on payment of such fee as it may fix, and the Registrar shall restore the name accordingly.

85. Any person entitled to practise as a legal practitioner and any patent agent may practise and describe himself as a trade mark agent and perform the functions set out in section 87 without being registered as a trade mark agent.

Privileges of legal practitioners and patent agents.

86. (1) No person who is not:-

Entitlement to practise as a trade mark agent.

- (a) ordinarily resident in Malawi and registered as a trade mark agent; or
 - (b) such a person as is described in section 85;
- shall practise as a trade mark agent.

- (2) A person shall be deemed to practise as a trade mark agent if he performs any of the functions of a trade mark agent set out in section 87 or if he carries on within Malawi the business of applying for or obtaining for others trade marks in Malawi or elsewhere.
- (3) No person who is not a trade mark agent shall describe himself as, or hold himself out to be, a trade mark agent, trade mark attorney or attorney for trade marks, nor shall he permit himself to be so described or held out.
- (4) Any person who contravenes this section shall be guilty of an offence.

87. (1) Subject to this Act, a trade mark agent may act as agent on behalf of any person in connection with any matter or proceeding before the Registrar under this Act and may draw and sign all documents and make all communications between an applicant and the Trade Marks Office and may represent an applicant at all attendances before the Registrar.

Trade mark agents and their functions.

- (2) A trade mark agent shall not be guilty of an offence under any law prohibiting the preparation for reward of certain documents by persons not legally qualified, by reason only of the preparation by him of any document relating to trade marks for use in the Trade Marks Office or required in any proceedings under this Act before the

**Prohibition of
certain acts by
trade mark agents.**

- 88.** (1) No trade mark agent shall have an interest either as a partner or manager or otherwise in more than one firm of trade mark agents in Malawi.
- (2) No trade mark agent shall practise under a name or title which includes the name of any person who is not or was not:-
- (a) In his lifetime ordinarily resident in Malawi; or
 - (b) Registered or entitled to practise as a trade mark agent under this Act.
- (3) No person shall practise as a trade mark agent if he is a party to:-
- (a) A contract of partnership; or
 - (b) An arrangement providing for the sharing or paying over of any professional fees,
- Relating to the business of a trade mark agent with any person who is prohibited from practicing as a trade mark agent.
- (4) Any person who contravenes this section shall be guilty of an offence.

Section 42.

SCHEDULE
CERTIFICATION TRADE MARKS

- 1.** (1) An application for the registration of a trade mark under section 42 must be made to the Registrar in writing in the prescribed manner by the person proposed to be register as the proprietor thereof.
- (2) An applicant for the registration of a mark under the said section 42 shall transmit to the Registrar draft regulations for governing the use thereof as such time before the decision of the Registrar on the application as he may require in order to enable him to consider the draft.
- (3) Subject to this Act, the Registrar may refuse the application or may accept it and approve the regulations either without modification any amendments or modifications of the application or of the regulations, which he thinks requisite.
- (4) Section 22(5) to (8) inclusive shall have effect in relation to an application under section 42 as they have effect in relation to an application under section 22(1).

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- (5) In dealing with an application under section 42, the Registrar, or the Tribunal in the event of an appeal from a decision of the Registrar, shall have regard to the like considerations, so far as relevant, as if the application were an application under section 22 and to any other considerations relevant to applications under section 42, including the desirability of securing that a certification trade mark shall comprise some indication that it is such a trade mark, and including also the following matters, that is to say:-
- (a) whether the applicant is competent to certify the goods in respect of which the mark is to be registered.
 - (b) Whether the draft regulations are satisfactory; and
 - (c) Whether in all the circumstances the registration applied for would be to the public advantage.
2. When an application has been accepted, the applicant shall, as soon as may be after such acceptance, advertise the application as accepted in the prescribed manner, and section 23(2) to (10) inclusive shall have effect in relation to the registration of the mark as if the application had been an application under section 22.
3. (1) The regulations deposited in respect of a certification trade mark may, on the application of the registered proprietor, be altered by the Registrar.
- (2) The Registrar may direct that an application for an alteration under this paragraph shall be advertised in any case where it appears to him that it is expedient so to do, and where an application has been so advertised, if within the prescribed time from the date of the advertisement any person gives notice to the Registrar of opposition to the application, the Registrar shall not decide the matter without giving the parties an opportunity of being heard.
4. (1) On the application in the prescribed manner of any person aggrieved or of his own motion, the Registrar (subject to section 44) may make such order as he thinks fit for expunging or varying any entry in the register relating to a certification trade mark or for varying the deposited regulations on the ground:-
- (a) that the proprietor is no longer competent, in the case of any of the goods in respect of which the trade mark is registered, to certify those goods;
 - (b) that the proprietor has failed to observe a provision of the deposited regulations to be observed on his part;
 - (c) that it is no longer to the public advantage that the trade mark should be registered; or

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- (d) that it is requisite for the public advantage that, if the trade mark remains registered, the regulations should be varied.
- (2) An appeal shall lie from any decision of the Registrar under this paragraph.
- 5.** Notwithstanding anything in section 47 the Registrar shall not have any jurisdiction to award costs to or against any party on an appeal to him against a refusal of the proprietor of a certification trade mark to certify goods or to authorize the use of the trade mark.
- 6.** The following provisions of this Act shall not have effect in relation to a certification trade mark, that is to say, section 9, 11, 14, 22 and 23 (except as expressly applied by this Schedule), section 27(4) to (8) inclusive, sections 31 to 34 inclusive, section 74 and any provisions the operation of which is limited by the terms thereof to registration in Part B of the register.
