

ACTS SUPPLEMENT

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Act 8

Geographical Indications Act

2013

THE GEOGRAPHICAL INDICATIONS ACT, 2013.

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THE GEOGRAPHICAL INDICATIONS ACT, 2013.

An Act to provide for the protection and registration of geographical indications; to provide for the duration of protection of geographical indications; to provide for the appointment of a registrar; for remedies for infringement or prohibited use of geographical indications; and for related matters.

DATE OF ASSENT: 2nd October, 2013.

Date of Commencement: See section 1.

BE IT ENACTED by Parliament as follows:

PART I—PRELIMINARY.**1. Commencement.**

This Act shall come into force on a date to be appointed by the Minister by statutory instrument.

2. Interpretation.

In this Act, unless the context otherwise requires—

“certification mark” means a mark on a commercial product which legally enables bounding and indicates the following—

- (a) the existence of a legal follow up or product certification agreement between the manufacturer of a product and an organisation that possesses accreditation by a national government for both testing and product certification;

- (b) legal evidence that the product was successfully tested in accordance with a nationally accredited standard;
- (c) legal assurance that the accredited certification organisation has ensured that the item that was successfully tested is identical to that which is offered for sale;
- (d) legal assurance that the successful test has resulted in a certification listing which is considered public information and sets out the tolerances and conditions for use of a certified product to enable bounding; and
- (e) legal assurance that the manufacturer is regularly audited by the certification organisation at unannounced intervals to ensure the maintenance of the original standard that was employed in the manufacture of the test specimen that passed the test;

“commercial use” means any use in connection with the sale, rental, lease, barter or any other transaction involving valuable consideration or offering or advertising of items;

“court” means the High court;

“currency point” has the value given to it in the Schedule to this Act;

“geographical indication” means any indication which identifies goods as originating in a particular country, region or locality where a given quality, reputation or other characteristic of the goods is essentially attributable to its geographic origin;

“goods” means a natural or agricultural product or animal product or a product of handcraft or industry;

“Minister” means the minister responsible for justice;

“producer” means—

- (a) a producer of agricultural products or a person exploiting natural products;
- (b) a manufacturer of products of handicraft or industry;
and
- (c) a trader dealing in the products referred to in paragraphs (a) and (b).

“register” means the register of geographical indications maintained under section 7;

“registrar” means the registrar of geographical indications designated under section 6;

“substantially similar” means the existence of common or similar elements with a protected geographical indication to the extent that it leads to confusion of the public or that portion of the public concerned with the product;

“unfair competition” means any act of competition contrary to honest practices in industrial or commercial matters;

“use” means use in any way, including without limitation, use as part of or in connection with—

- (a) any transaction, including a purchase, sale, gift, or exchange;
- (b) any importing or exporting;
- (c) any advertisement; or
- (d) any other related activity.

PART II—PROTECTION OF GEOGRAPHICAL INDICATIONS

3. Reference to description or presentation of goods.

In this Act, a reference to the description or presentation of goods includes a reference to a name, address, place, sign, design, trademark or other matter used in relation to the goods whether or not it appears—

- (a) on a container, wrapping or label or on the goods;
- (b) on a document relating to the use, or a transaction involving the transport of the goods; or
- (c) in an advertisement relating to the goods.

4. Similarity of geographical indications and prohibitions.

(1) A person shall not use a geographical indication in the designation or presentation of goods—

- (a) where the designation or presentation suggests that the goods originate in a geographical area other than the true place of origin;
- (b) where the use constitutes an act of unfair competition; and
- (c) where the goods do not originate in the territory indicated by the geographical indication, even where the true origin of the goods is indicated or the geographical indication is used in translation or accompanied by expressions such as “kind”, “type”, “style”, “limitation”.

(2) The following acts as they relate to geographical indications are prohibited—

- (a) use of geographical indications of such a nature as to create confusion with the establishment, the goods or the industrial or commercial activities of a competitor;

- (b) false allegations, in the course of trade, about geographical indications where the allegations are of such a nature as to discredit the establishment, the goods or the industrial or commercial activities of a competitor; or
- (c) geographical indications or allegations regarding geographical indications, the use of which in the course of trade is likely to mislead the public as to the nature, the manufacturing process, the characteristics, the suitability for their purpose or the quality of the goods.

(3) The following differences shall not be taken to prevent a geographical indication from being substantially similar to another geographical indication—

- (a) translation into a different language;
- (b) grammar or spelling; or
- (c) type, font, colour or incorporation with graphical elements of other aspects of presentation.

5. Exclusion from Protection.

(1) The following shall not be protected as a geographical indication—

- (a) an indication that does not comply with the definition of a geographical indication under section 2;
- (b) an indication that is contrary to public order or morality;
- (c) an indication which is contrary to public interest, in particular national security, nutrition, health, environmental conservation, or the development of other vital sector of the national economy;
- (d) an indication which ceases to be protected in its country of origin;
- (e) an indication which misleads or deceives the public as to the characteristic, nature, quality, place of origin, process of production of the product or its use;

- (f) a name which conflicts with the name of a plant variety or an animal breed and as a result is likely to mislead the consumer as to the origin of the product;
- (g) a name where, in the light of a trademark's reputation and renown and the length of time it has been used, registration is liable to mislead the consumer as to the true identity of the product.
- (h) a name that has become generic.

(2) For the purposes of sub section(5)1(h), 'a name that has become generic' means the name of a product which, although it relates to the place or the region where the product was originally produced or marketed, has become the common name of the product in Uganda.

(3) A name wholly or partially homonymous with that of a name already registered under this Act may be registered with due regard for local and traditional usage and the actual risk of confusion.

(4) For purposes of this section, "a homonymous name" means a name for a different region or locality that is spelt or pronounced in the same way as a name already registered as a geographical indication.

(5) Notwithstanding sub-section(3)—

- (a) a homonymous name which misleads the consumer into believing that products come from another region or locality shall not be registered even if the name is accurate as far as the actual place of origin of the product is concerned;
- (b) the use of a registered homonymous name shall be subject to there being a sufficient distinction in practice between the homonym registered subsequently and the name already on the register, having regard to the need to treat the producers concerned in an equitable manner and not to mislead the consumer.

6. Registrar of Geographical Indications and other officers.

(1) The Registrar General appointed under the Uganda Registration Services Bureau Act, Cap. 210 shall be the registrar of geographical indications for the purpose of this Act.

(2) The Board of Directors of the Uganda Registration Services Bureau shall appoint such number of officers as may be necessary for the efficient discharge of the duties and functions of the registrar of geographical indications under this Act.

(3) The officers appointed under subsection (2) shall perform such duties and functions and exercise such powers as the registrar may lawfully perform or exercise under this Act.

(4) The registrar may delegate to any officer appointed under subsection (2) the exercise or performance of any of the functions or duties conferred to him or her under this Act.

(5) The registrar shall have a seal which he or she shall affix to all certificates issued by him or her and all such other documents that he may deem fit to seal under this Act.

(6) When the seal is lawfully affixed to a document and the same is duly authenticated by the registrar, it shall be judicially and officially noticed.

7. Register of geographical indications.

(1) The registrar shall establish and maintain a register of geographical indications and shall receive applications for registration.

(2) A geographical indication shall be entered on the register where—

- (a) the indication identifies the goods to which the indication pertains and identifies the goods as originating in a particular country, region or locality;

- (b) a given quality, reputation or other characteristic of the goods is essentially attributable to its geographic origin;
- (c) as applied to the goods identified in the application, the indication does not contravene the provisions of this section; and
- (d) an application for registration is filed with the registrar in the prescribed form.

(3) In determining whether a geographical indication is registrable, the registrar shall consider quality, reputation or other characteristics attributable to natural factors or human factors or a combination of natural factors and human factors.

(4) The name of the place of origin of goods may be a traditional or historical name of the country, region or locality that is the place of origin of the goods.

(5) Registration of a geographical indication shall be prima facie evidence that the owner of the registration is entitled to use the registered geographical indication on the goods described in the application and that the goods originate from the place stated in, and have the qualities described in the registration.

8. Application for registration.

(1) An application for the registration of a geographical indication shall be made in the prescribed form and shall be accompanied by the prescribed fee.

- (2) The application referred to in subsection (1) shall specify—
 - (a) the name, address and nationality of the applicant and the capacity in which the applicant is applying for registration;
 - (b) the geographical indication for which registration is sought;
 - (c) the geographical areas to which the geographical indication applies;
 - (d) the goods for which the geographical indication applies; and

- (e) the quality, reputation or other characteristic of the goods for which the geographical indication is used.

(3) The following shall have the right to file an application to register a geographical indication—

- (a) a legal entity carrying on an activity as producers, farmers, artisans or whatever the case may be in the geographical area specified in the application, with respect to the product specified in the application;
- (b) a group of representative producers; or
- (c) in respect to an indication with national character, any competent authority as provided for under the regulations.

(4) An application for registration of a geographical indication may be filed by an agent.

(5) Where an applicant's ordinary residence or principal place of business is outside Uganda, he shall be represented by an agent.

9. Examination of application.

(1) The registrar shall cause the examination of the application referred to in section 8 in accordance with regulations made under this Act and where the conditions for registration referred in section 8 are met, shall accept the application.

(2) Where the registrar finds that conditions for registration have not been met, the applicant may be invited to supplement or amend the application, in accordance with regulations made under this Act.

(3) Where an application for registration of geographical indication has been accepted absolutely or subject to conditions or limitations, the registrar shall as soon as possible, cause the application, to be published in the prescribed manner for 60 days and the publication shall set forth all conditions and limitations, subject to which the application is accepted.

(4) Where an application for registration has been accepted, and either—

- (a) the application has not been opposed and the time for notice of opposition has expired; or
- (b) the application has been opposed and the opposed application has been decided in favour of the applicant, the registrar shall enter the geographical indication on the register and issue a certificate of registration.

(5) Where an application for registration has been rejected, the registrar shall give reasons for rejection.

(6) A person whose application has been rejected shall have a right to reapply.

10. Objection to registration of a geographical indication.

(1) A person may, within the prescribed time from the date of publication of an application, give notice of objection to the registration of a geographical indication to the registrar.

(2) The notice shall be given in writing in the prescribed manner and shall include a statement on the grounds of objection.

(3) The registrar shall send a copy of the notice to the applicant and within the prescribed time after receipt, the applicant shall send to the registrar, in the prescribed manner, a counter statement of the grounds on which he or she relies for his or her application and if he or she does not do so, he or she shall be taken to have abandoned his or her application.

(4) If the applicant sends a counterstatement, the registrar shall furnish a copy of the counter statement to the person giving the statement of objection and shall, after hearing the parties, if so required and considering the evidence, decide whether and subject to what conditions or limitations registration is to be permitted.

(5) A person aggrieved by the decision of the registrar may appeal to court.

(6) An appeal under this section shall be made in a prescribed form.

(7) On appeal, the court shall, if required, hear the parties and shall make an order determining whether and subject to what conditions or limitations registration is to be permitted.

(8) On hearing of an appeal under this section, any party, may, either in the manner prescribed or by special leave of court, bring forward further material for the consideration of the court.

(9) On appeal under this section, no further grounds of objection to the registration of a geographical indication shall be allowed to be taken by the person objecting or the registrar, other than those stated by the person objecting, except by leave of court.

(10) Where any further grounds of objection are taken, the applicant shall be entitled to withdraw his or her application without payment of the costs of the person objecting on giving notice as prescribed.

(11) On hearing the appeal, the court may permit the geographical indication proposed, to be registered and modified in a manner not substantially affecting its identity and the modified geographical indication shall be published in the prescribed form before being registered.

(12) Where a person who gives notice of an objection or an applicant who sends a counter statement after receipt of a copy of a notice or an appellant, does not reside or carry on business in the East African Community, the court or the registrar may require him or her to give security for costs of proceedings before the court or the registrar relating to the objection or to the appeal, as the case may be, and if the security is not given may treat the objection or application or the appeal as abandoned.

11. Appeal from decision of registrar.

An applicant whose application is rejected by the registrar may appeal to the court in a manner prescribed by the regulations under this Act.

12. Removal from register or alteration of conditions.

(1) A person may apply to the registrar for the removal from the register or alteration of the conditions of registration of a registered geographical indication.

(2) The application referred to in subsection (1) shall be in the prescribed form, shall set out the reasons for the proposed removal or alteration and shall be accompanied by the prescribed fee.

13. Procedure for invalidation of geographical indication.

(1) A person may apply to the court to invalidate a geographical indication on the ground that one or more of the conditions for protection have not been met or have ceased to exist.

(2) The procedure for invalidation of a geographical indication shall be in a manner prescribed by the regulations under this Act.

14. Right to institute proceedings.

(1) Any interested party may institute proceedings in court to prevent the unlawful use of a geographical indication.

(2) The owner of a registered geographical indication has the right to—

- (a) demand that a person who is unlawfully using a geographical indication discontinue its use;
- (b) remove the unlawfully used geographical indication or a geographical indication that is substantially similar, from the goods, their packaging, forms and other documentation;

- (c) demand for the destruction of the imprints of geographical indication or marking that is substantially similar to it; or
- (d) if it is impossible to perform the acts referred to in paragraphs (a) to (c), withdraw and destroy the goods or their packaging.

(3) The owner of a registered geographical indication is entitled to demand from any person who infringes on his or her rights, compensation for the infringement suffered.

15. Term of protection.

(1) Registration of a geographical indication shall be effective for a period of ten years from the date of registration.

(2) Registration may be renewed for a period of ten years for an unlimited number of times, by filing an application for renewal during the final year of the term.

(3) An application for renewal shall be made in the prescribed form and shall be accompanied by the prescribed fee.

16. Use of name of place of origin.

Notwithstanding section 14—

- (a) a person holding the right to use the name of the place of origin of goods is entitled to put the name on goods, packaging, advertisements, signboards, billboards or otherwise to the commercial use of the name in connection with those goods;
- (b) the name of the place of origin of goods may be registered by several persons either jointly or independently of each other; and
- (c) the right to use the name of the place of origin of goods shall belong to the persons referred to in paragraph (b) and the persons may mark the goods with the name of the place of origin of the goods where the marking is not in contravention of section 17.

17. Prohibition of licence or assignment of geographical indication or name of place of origin.

(1) The right to use a geographical indication shall not be subject to licence or assignment.

(2) The owner of a registered geographical indication may transfer the registration with that part of the business to which it pertains, subject to the following conditions—

(a) the transfer shall be in writing and a request to transfer the registration shall be filed with the registrar; and

(b) the transfer shall be reviewed in accordance with regulations made under this Act to determine that all material conditions remain unchanged except for the identity of the entity producing the goods that are subject to the registration; and where no differences are noted, the transfer will be recorded and a corrected certificate issued,

and if not, the transfer will be refused, subject to the right of the new owner of the business to file an original application to register the geographical indication.

(3) The right to use the name of the place of origin of goods shall not be subject to transfer, licence or assignment.

18. Prohibition of registration of exclusive geographical name as a trademark.

(1) The registrar of trademarks shall refuse to register a mark that consists exclusively of a geographical name unless the mark is determined to be distinctive by the registrar of trademarks or by the court.

(2) The registration of a trademark for wines which contains or consists of a geographical indication identifying wines, or of a trademark for spirits which contains or consists of a geographical indication identifying spirits, shall be refused or invalidated by the registrar on the registrar's motion or at the request of an interested party with respect to the wines or spirits not having that origin.

19. Protection of certification mark.

(1) A certification mark shall be subject to the protection provided for geographical indications.

(2) An application to register a certification mark may, upon the request of the applicant, be freely converted to an application to register a geographical indication.

(3) An application to register a geographical indication may, upon request of the applicant, be freely converted to an application to register a certification mark.

(4) The conversion of an application under subsection (2) or (3) is subject, in each case, to the payment of the prescribed fee and examination in accordance with regulations made under this Act for the registration requested.

20. Use of person's name.

This Act shall not prevent a person from using, in the course of trade, that person's name or the name of the person's predecessor-in-title, except where the name is used in such a manner as to mislead the public.

PART III—REMEDIES FOR UNLAWFUL USE OF GEOGRAPHICAL INDICATIONS**21. Civil action.**

(1) Except as expressly provided to the contrary, any person who uses, in Uganda, a geographical indication in a manner specified under section 4 is liable in a civil action by any person aggrieved by use or by the owner of the geographical indication.

(2) A person aggrieved by the use of a geographical indication referred to in subsection (1) is entitled to request that the court issue an order—

- (a) prohibiting the defendant from further use of the geographical indication; and
- (b) where applicable, granting any of the remedies specified under section 24.

(3) The owner of a geographical indication is entitled to recover—

- (a) the defendant's profits attributable to the infringement; and
- (b) any damages he or she has sustained attributable to the infringement.

(4) There shall be no double recovery for profits under subsection (3)(a) and damages under subsection (3)(b).

(5) In assessing profits, the plaintiff shall be required to prove the defendant's sales only and the defendant shall prove all elements of cost or deduction.

(6) In assessing damages, the court may enter a judgment for a sum above the amount found as actual damages not exceeding three times the amount.

(7) Where the court finds that the amount of recovery based on profits is either inadequate or excessive, the court may, in its discretion, enter judgment for the sum as it determines is fair according to the circumstances of the case.

22. Orders of court.

Except as expressly provided to the contrary, the use in Uganda of a geographical indication in a manner specified under section 4 shall be punishable as follows—

- (a) for commercial use, by a fine not exceeding forty eight currency points;
- (b) for repeated offences, the court may order a fine not exceeding one hundred and forty currency points; and
- (c) by imprisonment for a term not exceeding two years where the court finds that—
 - (i) the offence has resulted in harm to individuals or damage to property; or
 - (ii) the person committing the offence has previously been fined for contravening section 4.

23. Prohibition of importation and exportation of goods infringing geographical indication.

(1) A person shall not import into Uganda or export from Uganda any goods to which has been applied a false geographical indication or any geographical indication contrary to this Act.

(2) A person who contravenes this section commits an offence and is liable on conviction to a fine not exceeding two thousand currency points or imprisonment not exceeding ten years or both; and the goods to which the offence relates may be delivered or forfeited by order of the court under section 24.

24. Remedies.

(1) The court may make an order for the seizure, confiscation, forfeiture or disposal of items upon which a geographical indication is placed or used in contravention of section 4, including materials and implements, the predominant use of which has been in the commission of violation, without compensation or any payment to the person from whom they have been taken.

(2) Where the court in a civil action finds that a registered geographical indication has been used in contravention of section 18, the court may make an order requiring the delivery of the following items to the court or to the plaintiff for destruction—

- (a) labels;
- (b) signs;
- (c) prints;
- (d) products;
- (e) packages;
- (f) wrappers;
- (g) receptacles;
- (h) advertisements; and
- (i) other material in the defendant's possession or control that bear the registered geographical indication.

(3) The court shall, in addition to an order in subsection (1) and (2), make an order requiring the delivery of a counterfeit or copy of the registered geographical indication including any materials and implements, the predominant use of which has been the contravention, without compensation to the owner or any payment to the person from whom they have been taken.

(4) The court may order the closure of business, the predominant activity of which has involved the contravention of section 4.

(5) The court may issue a public notice of the order referred to in subsection (4) by publication in a newspaper of wide circulation.

(6) The court may permit the business referred to in subsection (4) to be reopened upon proof by the owner of the business that he or she has taken steps to conduct the activities of the business without contravening section 4.

25. Suspension of importation of goods in violation.

(1) A person who has reason to suspect that goods may be imported in contravention of section 4 may file a written petition to the court for a temporary order requiring the Uganda Revenue Authority to suspend the importation of the goods.

(2) Subsection (1) shall not apply to the importation of small quantities of goods of a non-commercial nature.

(3) The owner, importer or consignee of goods the entry of which has been prohibited under this section may appeal to court.

(4) The temporary order referred to in subsection (1) shall not be effective until the petitioner submits a bond, warranty, surety or other security in an amount sufficient to indemnify the owner, importer or consignee of the goods for any damage for wrongful detention of the goods.

(5) An order suspending importation shall not have continuing effect unless proceedings leading to a decision on the merits of the case is filed by a person other than the defendant, in court within ten working days following notice to the petitioner and the importer of the goods.

(6) The court may extend the period referred to in subsection (5) by an additional ten working days.

PART IV—MISCELLANEOUS

26. Fees.

There shall be paid in respect of applications, registration and other matters under this Act, such fees as may be prescribed by the Minister by statutory instrument.

27. Regulations.

(1) The Minister shall make regulations prescribing all matters that are required or permitted by this Act to be prescribed for giving effect to the purposes of this Act.

(2) Notwithstanding the Interpretation Act, regulations made under this section may prescribe in respect of a contrivention of the regulations, that the offender is liable to a fine not exceeding forty eight currency points, or to imprisonment for a term not exceeding two years, or both.

28. Power of Minister to amend Schedule.

The Minister may, with the approval of Cabinet, by statutory instrument, amend the Schedule to this Act.

SCHEDULE.

S. 2, 22, 23, 26

CURRENCY POINT

A currency point is equivalent to twenty thousand shillings.

Cross References

Interpretation Act, Cap. 2