

THE TRADE MARKS ACT, 1981

(Act No. 6 of 1981)



I ASSENT

SOBHUZA II

King of Swaziland

28th April, 1981

AN ACT entitled

An Act to provide for the registration and protection of trade marks for goods and services and for other purposes incidental thereto.

ENACTED by the King and the Parliament of Swaziland.
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PART I

PRELIMINARY

Short title, commencement and application.

1. (1) This Act may be cited as the Trade Marks Act, 1981 and shall come into operation on such date as the Minister may, by Notice in the Gazette, appoint.

(2) Save as otherwise provided this Act shall apply to all trade marks, whether registered before or after the commencement of this Act.

Interpretation.

2. In this Act, unless the context otherwise requires —

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

“Convention” means the Paris Convention for the Protection of Industrial Property of March 20, 1883, and any revisions thereof to which the Government of Swaziland is or may become a party;

“international classification” means the classification according to the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Trade Marks, of June 15, 1957, as revised from time to time;

“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 the mode of use, as to use in relation to goods or services to be sold or otherwise traded in any place in Swaziland or as to use in relation to goods or services to be exported to any market outside Swaziland;

“Minister” means the Minister responsible for Justice;

“pending trade mark” means a trade mark which is the subject of an application for registration;

“Register” means the Register of Trade Marks kept under the provisions of this Act;

“registered trade mark” means a trade mark which is actually on the Register;

“registered user” means a person who is registered as such under section 42;

“Registrar” means the Registrar of Trade Marks appointed under section 4;

“Regulations” means Regulations made under section 14;

“trade mark” means any visible sign used or proposed to be used upon, in connection with or in relation to goods or services for the purpose of distinguishing in the course of trade or business the goods or services of a person from those of another;

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

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

“use of a trade mark” means, subject to section 29 and 30, use thereof in relation to goods or services in a printed or other visible representation;

“visible sign” means any sign which is capable of graphic reproduction including a word, name, brand, device, heading, label, ticket, signature, letter, number, relief, stamp, seal, vignette, emblem, or any combination thereof.

PART II

ADMINISTRATION, THE REGISTER, FUNCTIONS AND POWERS OF THE REGISTRAR, FEES AND POWERS OF THE MINISTER

Establishment of Trade Marks Office.

3. There shall be established under the direction of the Minister an office to be called the Trade Marks Office.

Officers.

4. The Minister shall appoint —

- (a) a Registrar of Trade Marks who shall exercise the powers and perform the duties assigned to the Registrar by this Act and who shall be responsible for its administration;

- (b) a Deputy Registrar of Trade Marks who shall, subject to the direction of the Registrar, have all the powers conferred by this Act on the Registrar;
- (c) such other officers as may be necessary for carrying out the provisions of this Act.

Seal of Trade Marks Office.

5. The Registrar of Trade Marks shall maintain a seal which shall be affixed to certificates and other documents as required by this Act.

Register of Trade Marks.

6. (1) There shall be kept at the Trade Marks Office a record called the Register of Trade Marks wherein shall be entered all registered trade marks together with —

- (a) the names, addresses and trade or business descriptions of their proprietors;
- (b) notifications of assignments and transmissions;
- (c) the names and addresses of all registered users;
- (d) disclaimers, conditions and limitations; and
- (e) such other matters relating to registered trade marks as may be prescribed.

(2) Subject to this Act, the Register shall, at all convenient times, be open to inspection by the public, and certified copies of any entry in the Register shall be given to any person requiring them on payment of the prescribed fee.

Evidence.

7. (1) A certificate sealed and signed by the Registrar and certifying that any entry which he is required or authorised by or under this Act to make has or has not been made, or that any other act which he is so required or authorized to perform has or has not been done, shall be prima facie evidence of the matters contained therein.

(2) A copy of any entry in the 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, shall be admissible in evidence without further proof and without production of the original.

Hearing before exercise of discretion.

8. 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, the registered proprietor of the trade mark in question or a person having given notice of opposition without (if duly requested so to do within the prescribed time) giving to the applicant or the registered proprietor or a person having given notice of opposition, as the case may be, an opportunity of being heard.

Proceedings before Registrar.

9. Subject to section 10, evidence in any proceedings before the Registrar under this Act shall be given by affidavit, but the Registrar may, if he thinks fit in any particular case, take oral evidence on oath in lieu of or in addition to such evidence and may allow any witness to be cross-examined on his affidavit or oral evidence.

Oaths and Affirmation.

10. Any person who is required under this Act to take any oath or to swear an affidavit may, in lieu thereof, make an affirmation or declaration in accordance with the law relating to affirmations or declarations in Swaziland.

Power to Award Costs.

11. In all proceedings before the Registrar under this Act, the Registrar shall have the power to award to any party such costs as he may consider reasonable and to direct how and by which parties they are to be paid, and any such award may be enforced in the same manner as a judgement or order of the High Court.

Fees.

12. Where under this Act or the Regulations —

- (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; or
- (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
- (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.

Publication in the Gazette.

13. Anything required to be published under this Act or the Regulations shall be published in the Gazette.

Regulations.

14. (1) The Minister may make Regulations, not inconsistent with this Act, 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.

(2) Without prejudice to the generality of subsection (1), Regulations made by the Minister may provide for —

- (a) regulating the practice under this Act, including the service of documents;
- (b) making or requiring copies of trade marks and other documents;
- (c) regulating the publishing and selling or distributing of copies of trade marks and other documents;
- (d) the fees which shall be payable in respect of any application, registration or any other matter under this Act.

PART III

ACQUISITION OF THE EXCLUSIVE RIGHT TO A TRADE MARK

Acquisition of the Exclusive Right.

15. (1) The exclusive right to the use of a trade mark, as defined in section 29, shall be acquired by registration in accordance with this Act.

(2) Registration of a trade mark shall only be granted to a person who has fulfilled the conditions for registration.

Classification of Registration.

16. Trade Marks shall be registered in respect of particular goods or services in one or more classes of the International Classification and any question arising as to the class within which any goods or services fall shall be determined by the Registrar, whose decision shall be final and shall not be questioned in any Court.

PART IV

REQUIREMENTS FOR REGISTRATION

Distinctiveness.

17. (1) In order for a trade mark to be registrable it shall be of a distinctive character.

(2) For the purpose of subsection (1) a trade mark shall be deemed to be of a distinctive character if it is capable, in relation to the goods or services in respect of which it is registered or proposed to be registered, of distinguishing goods or services with which its proprietor is or may be connected in the course of trade or business from goods or services 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.

(3) In determining under subsection (2) whether a trade mark is capable of distinguishing the goods or services in question regard shall be had to the extent to which—

- (a) the trade mark is inherently capable of distinguishing such goods or services;
- (b) by reason of the use of the trade mark or of any other circumstances, the trade mark is, in fact, capable of distinguishing such goods or services.

Effect of limitation or absence of colour.

18. (1) 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 so limited shall be taken into consideration in deciding on the distinctive character of the trade mark.

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

Disclaimer.

19. If a trade mark contains matter common to the trade or otherwise of a non-distinctive character, in deciding whether the trade mark shall be registered or, if already registered, shall remain on the Register, it may be required as a condition of its being registered or remaining on the Register —

- (a) that the applicant or 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 he is not entitled; or
- (b) that the applicant or the proprietor shall make such other disclaimer as is considered necessary for the purposes of defining his rights under the registration, 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.

Prohibition of Registration.

20. The following shall not be registrable —

- (a) trade marks the use of which would be contrary to law or morality or which would be likely to deceive or cause confusion as to the nature, geographical or other origin, manufacturing process, characteristics, or suitability for their purpose, of the goods or services concerned;

- (b) trade marks which consist solely of the shape, configuration or colour of the goods or the containers thereof;
- (c) trade marks which are identical with, or imitate the armorial bearings, flags and other emblems, initials, names or abbreviations or initials of the name, or official sign or hallmark of any State or of any intergovernmental international organization or of any organization created by an international convention, unless authorized by the competent authority of that State or international organization;
- (d) trade marks which constitute reproductions, in whole or in part, imitations translations or transcriptions, liable to create confusion, of trade marks or business or company names which are well known in Swaziland and belong to third parties.

PART V

APPLICATION PROCEDURE, EXAMINATION, OPPOSITION AND REGISTRATION

Application for registration of trade mark.

21. (1) Any person who or whose proposed registered user uses or proposes to use a trade mark may apply for the registration of the trade mark.

(2) The application shall be made in writing to the Registrar as prescribed and shall include:-

- (a) the name and address of the applicant;
- (b) the trade or business description of the applicant;
- (c) a reproduction of the trade mark;
- (d) the particular goods or services in respect of which registration of the trade mark is applied for, listed under the applicable classes of the International Classification;
- (e) an address for service within Swaziland, accompanied by a power of attorney in favour of a trade mark agent resident and practising in Swaziland;
- (f) a declaration that the applicant or his proposed registered user is using or proposes to use the trade mark in Swaziland.

Priority under the Convention.

22. (1) Any person who has applied for protection for any trade mark in a country to which the Convention applies or his legal representative or assignee (if such assignee is also so qualified), shall be entitled to claim the benefit of that earlier application and its registration date in Swaziland shall be deemed to be the same date as the date of the application in that other country, provided that the application for registration is made within six months from the date of the earlier application.

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

(3) The application for the registration of a trade mark under this section shall be made in the same manner as is required in the case of an application under this Act subject to such other requirements as may be prescribed.

Information as to Foreign Application.

23. (1) The applicant shall, at the request of the Registrar, furnish him within the prescribed time limit, with the date and number of any application for a trade mark or registration filed with a national industrial property office of another country or with a regional industrial property office having comparable requirements for registration (in this Act referred to as "a foreign application" or "a foreign registration") relating to the same or essentially the same trade mark as that in the application filed with the registrar.

(2) The applicant shall, at the request of the Registrar, furnish him within the prescribed time limit with the following documents relating to one or more of the foreign applications or registrations referred to in subsection (1) —

- (a) a copy of any communication received by the applicant concerning the results of any search or examination carried out in respect of the foreign application;
- (b) a copy of the trade mark as registered;
- (c) a copy of any final decision rejecting the foreign application or refusing the registration requested in the foreign application or invalidating the foreign registration.

(3) The documents furnished under this section shall be used solely for the purpose of facilitating the examination of the application filed with the Registrar or of the registration entered in the Register on the basis of that application.

(4) The applicant shall have the right to submit comments on the documents furnished under this section.

Joint Proprietors.

24. (1) 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 to use it except—

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

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

(2) Subject to subsection (1), nothing in this Act shall be construed as authorizing the registration of a trade mark in respect of two or more persons who use a trade mark independently, or propose so to use it, as joint proprietors thereof.

Registration of parts and of series of trade marks.

25. (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 parts as separate trade marks and each separate trade mark shall satisfy all the conditions of an independent trade mark and shall, if registered and subject to section 34(3)(d), have the validity and effect 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 services or closely related goods or services which, while resembling each other in the material particulars thereof, yet differ in respect of —

- (a) statements of the goods or services in relation to which they are respectively used or proposed to be used or;

- (b) statements of number, price, quality or names of places or;
- (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.

Examination.

26. (1) Upon the filing of an application for registration and the payment of the prescribed fee, the Registrar shall cause an examination to be made as to—

- (a) the application's conformity with the formal requirements of this Act and the Regulations; and
- (b) whether the trade mark is registrable in accordance with Part IV and the Regulations.

(2) If upon the examination it appears that the applicant is entitled to the registration of his trade mark, the Registrar shall accept the application therefor and cause the trade mark to be advertised in the Gazette.

(3) If upon the examination the Registrar objects to the application, he shall notify the applicant in writing of the objections and shall allow him time, as prescribed, to submit his observations or to request a hearing and if the applicant fails to pursue his application within the time allowed, he shall be deemed to have withdrawn his application.

(4) Where the Registrar under subsection (3) notifies the applicant of his objections, he may, following representations by the applicant, accept the application subject to such amendments, modifications, conditions or limitations as he may think fit and if the applicant does not object to such conditional acceptance and amends his application accordingly, the Registrar shall cause the application to be advertised in the Gazette:

Provided that the Registrar may cause an application to be advertised before acceptance in any case where he considers there are exceptional circumstances for so doing.

(5) In the case of refusal of the application or conditional acceptance to which the applicant objects the Registrar shall, if required, advise the applicant in writing of the grounds of his decision including any documents relating thereto.

Opposition.

27. (1) Any person may, within the time prescribed from the date of the advertisement of an application, give notice to the Registrar of opposition to the registration, on the grounds that such application does not satisfy the requirements of Part IV.

(2) In addition to the grounds referred to in subsection (1) any of the following shall also constitute grounds for the purpose of opposition to the registration of a trade mark—

- (a) where the trade mark resembles, in such a way as to be likely to deceive or cause confusion, an unregistered trade mark used earlier in Swaziland by a third party in relation to the same goods or services or closely related goods or services, provided that an application for the registration of the earlier used unregistered trade mark is filed at the same time as the notice of opposition;
- (b) where the trade mark resembles, in such a way as to be likely to deceive or cause confusion, a business or company name already used in Swaziland by a third party;

- (c) where the trade mark is filed by the agent or the representative of a third party who is the proprietor of the trade mark in another country, without the authorization of such proprietor, unless the agent or representative justifies his action.

(3) The notice of opposition under this section 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 submit to the Registrar, in the prescribed manner, a counter-statement of the grounds on which he relies for his application, and if the applicant does not do so, he shall be deemed to have abandoned his application.

(5) If the applicant submits a counter-statement as required by subsection (4), the Registrar shall furnish a copy thereof to the person 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.

(6) On an appeal from any decision of the Registrar under this section the High Court 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 published in the Gazette before being registered.

Registration.

28. (1) When an application for registration of a trade mark 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 opposition has been decided in favour of the applicant;

the Registrar shall, unless the application has been accepted in error, register the trade mark, and the trade mark, when registered, shall be registered as of the date on which the application for registration was received, and that date shall be deemed, for the purposes of this Act, to be the date of registration:

Provided that the provisions of this subsection relating to the date as on 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 priority under the Convention, have effect subject to the provisions of the Convention.

(2) On the registration of a trade mark, the Registrar shall cause to be issued to the applicant a certificate of registration thereof in the prescribed form and every such registration shall be published in the Gazette.

PART VI

DURATION AND RENEWAL OF REGISTRATION

Term of Registration and Renewal.

29. (1) The registration of a trade mark shall be for a period of ten years from the date of registration but may be renewed from time to time in accordance with this section.

(2) Subject to subsection (4), 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 ten years from the date of expiration of the original registration or of the last renewal of registration which date is referred to in this section as "the expiration of the last registration", provided that the registered proprietor—

- (a) submits a statement confirming those goods or services covered by the registration in respect of which there has been bona fide use of the trade mark in Swaziland at any time during the three years immediately preceding the expiration of the last registration, together with a reproduction of the trade mark which has been used as aforesaid; or
- (b) established, to the satisfaction of the Registrar, that special circumstances prevented use of the trade mark in respect of any of the goods or services covered by the registration during the said period and confirms that there has been no intention to abandon the trade mark in respect of those goods or services;

(3) For the purpose of subsection (2) —

- (a) the use of the whole of a registered trade mark shall be deemed to be equivalent to the use of any registered trade mark being a part thereof, registered in the name of the same proprietor by virtue of section 25(1);
- (b) where a trade mark has been used in relation to some, but not all, of the goods or services in respect of which it is registered, such use shall be deemed to be equivalent to the use of the trade mark in relation to all closely related goods or services in respect of which it is registered;
- (c) where a trade mark is applied to goods or services to be exported from Swaziland, such use shall be deemed to be equivalent to the use of the trade mark in relation to those goods or services in Swaziland;
- (d) the use of an associated registered trade mark, or of the trade mark with additions or alterations not substantially affecting its identity, may be accepted as an equivalent for the use of the trade mark.

(4) The renewal referred to in subsection (2) shall be effected in respect of all goods or services covered by subsection (2)(a) and (b) and subsection (3)(b).

PART VII

EFFECT OF REGISTRATION, INFRINGEMENT & UNLAWFUL ACTS

Unregistered Trade Mark.

30. 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 or services as the goods or services of another person, or the remedies in respect thereof.

Exclusive Right.

31. Subject to this Act and any limitations or conditions entered in the Register, the registration of a trade mark shall, if valid, give or be deemed to have given the registered proprietor thereof the exclusive right to the use of the trade mark in relation to the goods or services in respect of which it is registered, including sale, importation and offer for sale or importation.

Infringement.

32. (1) The exclusive right referred to in section 31 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 sign either —

- (a) identical with or so nearly resembling it as to be likely to deceive or cause confusion, in the course of trade or business, in relation to any goods or services in respect of which it is registered or in relation to any closely related goods or services and in such manner as to render the use of the sign likely to be taken either —

- (i) as being used as a trade mark or business or company name; or

- (ii) in a case in which the use is upon the goods or in physical relation thereto, or in relation to services, 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 as a registered user to use the trade mark, or to goods or services with which such person as aforesaid is connected in the course of trade or business;

or

(b) identical with or nearly resembling it in the course of trade or business in any manner likely to impair the distinctive character or acquired reputation of the trade mark.

(2) The exclusive right referred to in section 31 shall, subject to subsection (3), also 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 permitted use, does any of the following acts in the course of trade in respect of goods purchased from the proprietor of the trade mark or a registered user —

- (a) applying the trade mark upon the goods after they have under-gone alteration as respects their state or condition, get-up or packing;
- (b) where the trade mark is upon the goods, altering or obliterating it, whether wholly or partly;
- (c) where 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, removing or obliterating, whether wholly or partly, the trade mark unless that other matter is wholly removed or obliterated;
- (d) where the trade mark is upon the goods, applying any other trade mark to the goods or adding to the goods any other matter in writing that is likely to injure the acquired reputation of the trade mark.

(3) The exclusive right given by registration under section 31 shall not be deemed to be infringed by the use of any such trade mark by any person —

- (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 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 such 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 registered if the use of the trade mark is reasonably necessary in order to indicate that the goods are so adapted; or

in relation to goods which have been sold or offered for sale in Swaziland under the trade mark by the proprietor or any associated company of the proprietor, wherever incorporated, or with the proprietor's consent, unless the condition of the goods is modified or impaired after they have been sold or offered for sale.

(4) For the purpose of this section, reference to the use of a sign by a person not being the proprietor thereof or a registered user using by way of the permitted use shall be construed as including reference to the audible use of a sign.

Right to continue use.

33. 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 or services, in relation to which that person or his predecessor in title has continuously used that trade mark from a date anterior —

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

Bona Fide Use of Name or Description and Removal on grounds of non-use.

34. (1) No registration of a trade mark shall interfere with —

- (a) the bona fide use by any person of his own name or of the name of the geographical location of his business, or of the name of any of his predecessors in business; or
- (b) the use by any person of any bona fide description of the character or quality of his goods or services, not being a description that would be likely to be taken as importing any such reference as is mentioned in section 32(1)(a)(ii).

(2) A registered trade mark may be removed from the Register in respect of any of the goods or services in respect of which it is registered on application by any aggrieved person to the Registrar on the ground that up to one month prior to the filing of the application a continuous period of three years or longer has elapsed during which the registered proprietor has not used the trade mark in relation to those goods or services:

Provided that failure to use the trade mark shall not be taken into account where —

- (a) it is attributable solely to special circumstances preventing use of the trade mark and not to any intention to abandon or not to use the trade mark; or
 - (b) the non-use is within five years from the date of the registration determined in accordance with section 28(1).
- (3) For the purposes of subsection (2) —
- (a) the use of the whole of a registered trade mark shall be deemed to be equivalent to the use of any registered trade mark, being a part thereof, registered in the name of the same proprietor by virtue of section 25(1);

- (b) where a trade mark has been used in relation to some, but not all, of the goods or services in respect of which it is registered, such use shall be deemed to be equivalent to the use of the trade mark in relation to all closely related goods or services in respect of which it is registered;
- (c) where a trade mark is applied to goods or services to be exported from the country, such use shall be deemed to be equivalent to the use of the trade mark in relation to those goods or services in Swaziland;
- (d) the use of the trade mark with additions or alterations not substantially affecting its identity, may be accepted as an equivalent for the use of the trade mark.

Power of Registrar to permit amendment of application, etc.

35. (1) The Registrar may at any time before registration of a trade mark permit the applicant to amend his application or any document relating to the application or proceedings before him on such terms as to costs as he may determine.

(2) If rights in a trade mark which is the subject of a pending application have been lawfully acquired by any person (including a body incorporate) other than the applicant on or after the date of application, the Registrar may, if satisfied that it is proper to do so and on payment of the prescribed fee, permit the applicant or such other person to amend the application by the substitution of the name of that other person as applicant for registration.

Alteration of registered trade mark.

36. (1) The registered proprietor of a trade mark may, on payment of the prescribed fee and in the prescribed manner, apply to the Registrar for leave to add to or alter the trade mark in any manner not substantially affecting the character thereof.

(2) An application under this section shall be published in the Gazette and sections 26, 27 and 28 shall, mutatis mutandis, apply thereto.

Rectification.

37. Any person aggrieved by the non-insertion in or omission from the Register of an 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 to the Registrar, and the Registrar may make such order for making, expunging or varying the entry as he may determine.

Fraud in the Registration, Renewal, Assignment or Transmission.

38. In case of fraud in the registration, renewal, assignment, or transmission of a registered trade mark, the Registrar may himself rectify the Register as he may determine.

Breach of condition.

39. The Registrar may make such order as he 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.

Correction of the Register.

40. (1) The Registrar may, on application made in the prescribed manner by the registered proprietor —

- (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;
- (c) cancel the entry of a trade mark in the Register;
- (d) strike out any goods or services from those in respect of which a trade mark is registered;
- (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 application 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.

PART VIII

ASSIGNMENTS AND TRANSMISSIONS

Assignments and transmissions.

41. (1) Notwithstanding any law to the contrary, a pending trade mark or a registered trade mark shall be, and shall be deemed always to have been, assignable and transmissible in respect either of all the goods or services in respect of which it is applied for, registered, or was registered as the case may be, or of some, but not all, of those goods or services.

(2) An assignment or transmission shall be invalid if the assignment or transmission is likely to deceive or cause confusion, particularly in regard to the nature, origin, manufacturing process, characteristics, or suitability for their purpose, of the goods or services in relation to which the trade mark is intended to be used or is being used.

(3) A person entitled by assignment or transmission to a pending trade mark or to a registered trade mark shall make application to the Registrar in the prescribed manner to register his title.

(4) On receipt of an application referred to in subsection (3) in respect of a registered trade mark, the Registrar shall cause the particulars of the assignment or transmission to be entered in the Register and where the application is in respect of a pending trade mark, the particulars of the assignment or transmission shall be provisionally recorded, and, upon registration of the trade mark, shall be entered in the Register.

(5) Assignments and transmissions of pending trade marks or of registered trade marks shall have no effect against third parties until the particulars thereof are entered in the Register.

(6) 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.

PART IX

REGISTERED USERS

Registered Users.

42. (1) Subject to section 43, 44 and 45, a person other than the proprietor of a registered trade mark may be registered as a registered user thereof in respect of all or any of the goods or services in respect of which it is registered.

(2) The use of a trade mark by a registered user thereof in relation to goods or services with which he is connected in the course of trade or business and in respect of which for the time being the trade mark remains registered, in compliance with any conditions or restrictions to which his registration is subject, shall be permitted use of the trade mark.

(3) The permitted use of a trade mark shall be deemed to be used by the proprietor thereof, and shall be deemed not to be used by a person other than the proprietor.

(4) Subject to any agreement subsisting between the parties, a registered user of a trade mark shall be entitled to request the proprietor thereof to take proceedings to prevent infringement thereof and, if the proprietor refuses or prevent infringement thereof and, if the proprietor refuses or neglects to do so within two months after being so requested the registered user may institute proceedings for infringement in his own name as if he were the proprietor, joining the proprietor as a defendant.

Registration of Registered User.

43. (1) When it is proposed that a person be registered as a registered user of a trade mark an application therefor shall be made in the prescribed manner jointly by the registered proprietor and the proposed registered user who shall furnish the Registrar —

- (a) either with information that the proposed registered user is wholly controlled by the registered proprietor and that there is no other contractual relationship between the parties, or with a copy of the licence contract between the parties and
- (b) with a statement containing —
 - (i) the identity of the registered trade mark;
 - (ii) the name and address of the registered proprietor;
 - (iii) the name and address of the proposed registered user;
 - (iv) the goods or services in respect of which the registered user is proposed to be registered;
 - (v) the restrictions on use, if any, by the proposed registered user; and
 - (vi) the period of permitted use.

(2) When the requirements of subsection (1) have been complied with and the Registrar, after considering the information furnished to him under that subsection, is satisfied that in all the circumstances the proposed use of the trade mark by the proposed registered user, subject to any conditions or restrictions which he thinks proper, would not be contrary to the public interest, he may register the proposed registered user as a registered user in respect of the goods or services as to which he is so satisfied.

Guarantee of control.

44. (1) A licence contract shall be invalid in the absence of relations or stipulations between the registered proprietor of the trade mark and the proposed registered user, ensuring effective control by the registered proprietor of the quality of the goods or services of the proposed registered user in relation to which the trade mark is to be used.

(2) In the absence of any provision to the contrary in the licence contract, the grant of a licence shall not prevent the registered proprietor from granting further licences to third parties or from using the trade mark himself.

(3) The grant of an exclusive licence shall prevent the registered proprietor from granting further licences to third parties and from using the trade mark himself.

(4) In the absence of any provision to the contrary in the licence contract, the registered user shall be entitled to use the trade mark during the whole duration of the registration, including renewals, in the entire geographical area of Swaziland, and in respect of all the goods or services for which the trade mark is registered, subject to any conditions of limitations entered in the Register.

Approval of licence contracts.

45. The Minister may, taking into account the national needs of Swaziland, its economic development and any other relevant factors by order, provide that, on pain of invalidity, licence contracts or any categories of them, and amendments or renewal of such contracts, shall require his approval.

Variation and Cancellation.

46. Without prejudice to section 37, the registration of a person as a registered user —

- (a) may be varied by the Registrar on the joint application in writing in the prescribed manner of the registered proprietor and the registered user who shall, in amending a previous registration of the licence contract, take into account the facts, procedures, Regulations, and any other requirements considered at the time of the previous registration of the licence contract between the registered proprietor and the then proposed registered user;
- (b) may be cancelled by the Registrar on the joint application in writing in the prescribed manner of the registered proprietor and the registered user.

Prohibition of assignments and sub-licences.

47. A licence shall not be assignable to a third party and the registered user shall not be entitled to grant sub-licences.

PART X

APPEALS AND LEGAL PROCEEDINGS

Appeals.

48. Except as otherwise provided in this Act, a person aggrieved by the decision of the Registrar may appeal therefrom to the High Court (hereinafter referred to as "the Court") and the High Court Rules shall apply to such appeal.

Reference to the High Court by Registrar.

49. 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 persons concerned, refer such matter to the High Court for a decision and shall thereafter, in relation to such matter, act in accordance with the decision of the Court.

Validity of Registration.

50. 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 mark and of all subsequent assignments and transmissions thereof.

Certification of Validity.

51. In any legal proceedings 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 Court may certify to that effect.

Registrar's Right to Appear.

52. (1) In any legal proceedings 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 Court.

(2) Unless otherwise directed by the Court, the Registrar, in lieu of appearing and being heard, may submit to the Court a statement in writing, signed by him, giving particulars of any 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 proceedings.

Court's power of Review.

53. The Court, 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.

Court's Discretion.

54. In any appeal from a decision of the Registrar to the Court, the Court shall have and exercise the same discretionary powers as under this Act are conferred upon the Registrar.

PART XI

OFFENCES AND PENALTIES

Falsification of Entries on Register.

55. Any person who makes or causes to be made a false entry in the Register, or a writing falsely purporting to be a copy of an entry in the Register, or who produces or tenders in evidence any such writing, knowing the entry or writing to be false, shall be guilty of an offence.

Falsely representing a Trade Mark as Registered.

56. (1) Any person shall be guilty of an offence if he knowingly makes a representation —
- (a) with respect to a trade mark not being a registered trade mark to the effect that **it is a registered trade mark**;
 - (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;
 - (c) to the effect that a registered trade mark is registered in respect of any goods or services 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 in the Register, the registration does not give that right.

(2) For the purposes of this section, the use in Swaziland in relation to a trade mark of the word "registered" or the symbol R, or of any other word or symbol referring, whether expressly or impliedly, to registration, shall be deemed to import a reference to a registration in the Register, except —

- (a) where that word or symbol is used in physical association with other words delineated in characters at least as large as those in which that word or symbol is delineated and indicating that the reference is to registration as a trade mark under the law of a country outside Swaziland 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") or symbol is of itself such as to indicate that the reference is to such registration as is referred to in paragraph (a); or
- (c) where that word or symbol is used in relation to a trade mark registered as a trade mark under the law of a country outside Swaziland and in relation to goods or services to be exported to that country;

Deceiving the Registrar or other Officer.

(1) Any person who —

- (a) for the purpose of deceiving the Registrar or any other Officer of the Trade Marks Office in the performance of any function under 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 false, shall be guilty of an offence.

(2) Any person who has made a statement or representation whether orally or in writing, not knowing it to be false, for the purpose or procuring or influencing the doing or omission of anything in relation to this Act or any matter thereunder, shall advise the Registrar forthwith of such falsity on becoming aware of it and if he fails to do so he shall be guilty of an offence.

Penalties.

58. Any person who is convicted of an offence under this Act shall be liable to a fine of E2000 or to imprisonment for six months or both.

PART XII

TRANSITIONAL AND OTHER PROVISIONS

Reclassification of existing trade marks.

59. Every trade mark which, on the commencement of this Act, is registered and classified under a classification other than the International Classification shall, upon application for the renewal thereof under section 29, be reclassified in accordance with the International Classification.

Validity of Existing Registration.

60. (1) Subject to this section, the validity of the original registration of any trade mark in the Register of Trade Marks existing at the commencement of this Act shall be determined in accordance with the law in force at the date of that registration, and any such trade mark shall retain its original date of registration but for all other purposes shall be deemed to have been registered under this Act.

(2) No trade mark which had been registered at the commencement of this Act shall be removed from the Register on the ground that it was not registrable under the law in force at the date of its registration and the trade mark shall remain in force in Swaziland for the remainder of the unexpired period for which it was in force under the previous law.

(3) Nothing in this Act shall be construed as invalidating the original registration of a trade mark which immediately before the commencement of this Act was validly registered.

(4) Where a person is registered as a registered user of a trade mark on an application made within one year from the commencement of this Act, section 42(3) shall have effect in relation to any previous use (whether before or after the commencement of this Act) of the trade mark by that person, being use in relation to the goods or services in respect of which he is registered and, where he is registered subject to conditions or restrictions, being use such as to comply substantially therewith, as if that previous use had been permitted use.

Pending applications, proceedings, etc.

61. All applications for registration of trade marks and all other matters relating to trade marks which, on the commencement of this Act, are pending shall be governed by this Act and as if they had been made or arisen, as the case may be, under this Act.

Registration of Trade Marks Agents.

62. (1) Any person desirous of acting as an agent for an applicant, proprietor, registered user or other person concerned in any proceeding or matter before or affecting the Registrar under this Act and the Regulations, shall apply to the Registrar in the prescribed manner to be entered on the Register of Trade Marks Agents to be kept by the Registrar.

(2) The qualifications for a person to be entered on the Register of Trade Marks Agents shall be as prescribed.

Disapplication of Patents, Designs and Trade Marks Act, 1936.

63. The Patents, Designs and Trade Marks Act, 1936, shall, upon the commencement of this Act, cease to apply to trade marks.
