

# ACTS OF GHANA

## FOURTH REPUBLIC

Trademarks (Amendment) Act, 2014 Act 876

### ARRANGEMENT OF SECTIONS

#### Section

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### ACT

#### ENTITLED

#### TRADEMARKS (AMENDMENT) ACT, 2014 ACT 876

AN ACT to amend the Trademarks Act, 2004 (Act 664) to reconcile renewal periods for the registration of trademarks, provide for the international registration of trademarks and for related purposes.

DATE OF ASSENT: *24th April, 2014*

PASSED by Parliament and assented to by the President:

Section 1 of Act 664 amended

1. The Trademarks Act, 2004 (Act 664) referred to as the principal enactment is amended by the substitution for section 1 of "Meaning of a trademark"
  1. (1) A "trademark" means a sign or combination of signs capable of distinguishing the goods or services of one undertaking from the goods and services of another undertaking.
  2. (2) A trademark may consist of
    - (a) words, personal names, designs, letters, colours, numerals, shapes, holograms, sounds or a combination of any of these elements, or
    - (b) slogans, where they are not long enough to be protected by copyright.
- 3) A reference in this Act to a trademark includes a reference to a collective mark or certification mark".

Section 2 of Act 664 amended

3. The principal enactment is amended by the substitution for section 2 of

"Meaning of collective mark and certification mark

2. (1) A collective mark is a sign of an association of manufacturing, trading or service enterprise that serves to distinguish the goods or services of the members of the association from those of other enterprises.

(2) A certification mark is a sign or combination of signs capable of designating any specific characteristic, including quality, origin or methods of production, material, mode of manufacture of goods or performance of services.

(3) An application for the registration of a certification mark shall

(a) designate the sign as a certification mark; and

(b) be accompanied by the rules governing its use

(4) Subsection (3) applies to all certification marks, including certification marks owned by government agencies."

#### Section 3 of Act 664 repealed

3. The principal enactment is amended by the repeal of section 3.

#### Section 4 of Act 664 amended

4. Section 4 of the principal enactment is amended by the substitution for subsection (2) of "(2) The application shall

(a) be accompanied with a reproduction of the trademark and a list of the goods or services for which the registration of the trademark is requested, using the International Classification; and

(b) state that the trademark is being used by the applicant or with the consent of the applicant in relation to the goods or services or that the applicant has a bonafide intention that the trademark should be used."

#### Section 5 of Act 664 amended

5. The principal enactment is amended by the substitution for section 5 of

"Grounds for refusal of registration

5. A trade mark shall not be registered if,

(a) it is a trade name or sign that belongs to the public domain except where the trade name or sign has become accepted as a trademark for the goods or services for which they are claimed;

(b) it is incapable of

(i) distinguishing the goods or services of one enterprise from the goods or services of another enterprise or devoid of a distinctive character,

(ii) designating the characteristics of the goods or services or shapes that constitute the nature of the goods or shapes of the goods or of their packaging that are technically necessary;

(c) it is contrary to public order or morality;

(d) it is likely to mislead the public or trade circles with particular reference to the geographical origin of the goods or services, their nature or characteristics such as the kind, quality, intended purpose, the time of production of the goods or rendering of the service;

(e) it is identical to or is an imitation of or contains as an element, an armorial bearing, flag, emblem, name, abbreviation or initials of the name, official sign or hallmark adopted by a State, intergovernmental organisation or organisation created by an international convention unless authorised by the competent authority of that State or organisation;

(f) it is identical to or confusingly similar to or constitutes a translation of a trade mark or trade name which is well known in the country for identical or similar goods or services of another enterprise or the trade mark is well known and registered in the country for goods or services which are not identical or similar to those under application but the use of the trade mark will indicate a connection between those goods or services and the owner of the well known trade mark and the interests of the owner of the well known trade mark are likely to be damaged by the use of the trade mark; or

(g) the trade mark is identical to a trade mark of another owner already on the register or identical to a trade mark the subject of an application with an earlier filing or priority date for the same goods or services or closely related goods or services or if it resembles that trade mark so closely that it is likely to deceive or cause confusion."

#### Section 6 of Act 664 amended

6. Section 6 of the principal enactment is amended by the repeal of paragraph (b) of subsection (1).

#### Section 15 of Act 664 amended

7. Section 15 of the principal enactment is amended by the insertion after subsection (5) of

"(6) The owner of a trademark may transfer the trademark in whole or in part for the goods or services for which it has been registered.

(7) Unless otherwise agreed, a transfer of an enterprise shall imply a transfer of its trademark rights."

#### Section 16 of Act 664 amended

8. Section 16 of the principal enactment is amended by the insertion after subsection (2) of

"(3) A licence contract concerning

- (a) the registration of a mark; or
- (b) an application for registration

shall provide for effective control by the licensor of the quality of the goods or services of the licensee in connection with which the mark is used, where the control is appropriate or necessary.

(4) A licence contract is not valid if

- (a) that licence contract does not provide for quality control; or
- (b) the quality control is not effectively carried out.

(5) A Court may declare the mark as abandoned by the owner.

(6) Abandonment is a defence in infringement proceedings."

#### Section 26 of Act 664 amended

9. Section 26 of the principal enactment is amended by the insertion after subsection (4) of

"(5) A person who for the purpose of gain for that person or any other person or with intent to cause loss to any other person and without the consent of the owner of a registered trademark

(a) applies a sign or mark which is identical or likely to be mistaken for a registered trademark

- (i) to goods or the packaging of goods;
- (ii) for labelling goods;
- (iii) for advertising goods; or

(iv) as a business paper in relation to goods;

(b) is in possession of goods with a sign or mark which is identical or likely to be mistaken for a registered trademark with intent to sell, offer or expose for sale, hire, distribute or for any purpose of trade;

(c) manufactures goods which are identical or designed to deceive or be mistaken for a registered trademark; or

(d) is in possession of goods with intent to do an act specified under paragraph (a); or

(e) has an article in the possession, custody or control of that person in the course of business, knowing or having reason to believe that that article is, has been, or will be used to produce goods, the labelling or packaging goods, as a business paper in relation to goods, or for advertising goods,

commits an offence and is liable on summary conviction to a fine of not less than two thousand five hundred penalty units and not more than seven thousand penalty units or to a term of imprisonment of not less than five years and not more than fifteen years or to both.

(6) A person charged with an offence under subsection (5) in relation to the following is not entitled to bail:

- (a) foods, drugs, medical devices, household chemicals or cosmetics;
- (b) vehicle and machine parts; or
- (c) electrical appliances.

#### Section 32A inserted

10. The principal enactment is amended by the insertion after section 32 of a new 32A

##### "Forfeiture and destruction of counterfeit or pirated goods

32A (1) Where in connection with an investigation or prosecution of an offence under this Act a person finds

(a) goods or the packaging of goods which bears a sign identical to or likely to be mistaken for a registered trade mark,

(b) a material bearing a sign intended to be used for labelling or packaging of goods, as a business paper in relation to goods or for advertising goods; or

(c) articles specifically designed or adapted for making copies of a registered trademark

that person may apply to the Court for an order for the forfeiture of the goods, material or articles.

(2) An application under subsection (1) may be made

(a) where proceedings have been brought in a court for a relevant offence relating to any or all of the goods, material or articles; or

(b) where an application for the forfeiture of the goods, material or articles has been made to a court.

(3) Where an application is made under this section, the Court shall make an order for

(a) the forfeiture of the goods, materials or articles if it is satisfied that a relevant offence has been committed in relation to the goods, materials or articles; and

(b) the destruction of the goods, materials or articles in accordance the order.

(4) Subject to subsection 3 (b) the Court may release the goods, materials or articles to a person on condition that that person

(a) causes the offending sign to be erased, removed or obliterated, and

(b) complies with any order to pay costs which has been made against that person.

(5) A person aggrieved by an order or decision of the Court may appeal against that order or decision.

(6) For the purposes of this section a "relevant offence" means an offence in relation to the unauthorised use of a trade mark in relation to goods or under Part III of Trade Descriptions and Fraudulent Marks or any offence involving dishonesty or deception. "

#### **Section 51 of Act 664 amended**

11. The principal enactment is amended in section 51 by the addition of a new subsection (3)

"(3) Regulations made under this section may provide for giving effect to the provisions of the Madrid Protocol and may, in particular provide for

(a) applications for international registrations by way of the Trademark Office as Office of origin;

(b) procedures to be followed where the basic application or registration fails or ceases to be in force;

(c) procedure to be followed where the office receives from the International Bureau, a request for extension of protection to Ghana;

(d) effect of a successful request for extension of protection to Ghana;

(e) transformation of an application for an international registration, into a national application for registration;

(f) communication of information to the Inter- national Bureau; and

(g) payment of fees and amounts prescribed in respect of applications for international registration, extensions of protection and renewals.

#### **Section 52 of Act 664 amended**

12. Section 52 of the principal enactment is amended by the addition of the following in the interpretation section:

"Madrid Protocol" means the Protocol relating to the Madrid Agreement concerning the International Registration of Marks, as adopted at Madrid on 27th June, 1989;

"International Bureau" has the meaning given by Article 2 (1) of the Protocol;

"International Trademark" means a trademark which is entitled to protection in Ghana under that Protocol; and

"Well-known trademark" means the trademark of a person who is

(a) a national of a country that is a party to the Paris Convention; or

(b) domiciled in or has a real and effective commercial establishment in a country that is a party to the Paris Convention and the trademark is recognised or known in the relevant public sector as belonging to that person.

#### **Section 53 of Act 664 amended**

13. Section 53 of the principal enactment is amended by the substitution for subsection (4) of

"(4) Marks registered under Act 270 shall be renewed for ten years from the date of expiration of the original registration or of the last renewal of registration and after renewal shall be reclassified in accordance with the international classification."

#### **Section 54 inserted**

14. The principal enactment is amended by the addition of a new section 54.

##### **International registration**

"54. The provisions of

(a) any International Treaty in respect of Trademarks, to which the country is a party; and

(b) the Third Schedule shall apply to matters dealt with under this Act."

#### **Third Schedule to Act 664 inserted**

15. The principal enactment is amended by the addition of a new Third Schedule.

##### **Third Schedule (Section 54)**

#### **SPECIAL PROVISIONS RELATING TO PROTECTION OF TRADE MARKS THROUGH INTERNATIONAL REGISTRATION UNDER THE MADRID PROTOCOL**

IA. The provisions of this Part apply to international applications and international registrations under the Madrid Protocol.

IB. In this Part, unless the context otherwise requires

"application in relation to a Contracting State or a Contracting Organisation" means an application made by a person who is a citizen of or is domiciled in, or has a real and effective industrial or commercial establishment in, that Contracting State or a State which is a member of that Contracting Organisation and for the purposes of this clause, 'real and effective industrial or commercial establishment' means any establishment where some bona fide industrial or commercial activity takes place and need not necessarily be the principal place of business;

"basic application" means an application for the registration of a trade mark filed under section 4 and which is used as a basis for applying for an international registration;

"basic registration" means the registration of a trade mark under section 7 and which is used as a basis for applying (or an international registration);

"Common Regulations" means the Regulations concerning the implementation of the Madrid Protocol;

"Contracting Organisation" means a Contracting Party that is an international organisation;

"Contracting Party" means a Contracting State or Contracting Organisation party to the Madrid Protocol;

"Contracting State" means a country party to the Madrid Protocol;

"international application" means an application for international registration or for extension of the protection resulting from an international registration to any Contracting Party;

"International Bureau" means the International Bureau of the World Intellectual Property Organisation;

"international registration" means the registration of a trade mark in the register of the International Bureau effected under the Madrid Protocol;

"Madrid Agreement" means the Madrid Agreement Concerning the International Registration of Marks adopted at Madrid on the 14th day of April 1981, as subsequently revised and amended; and

"Madrid Protocol" means the Protocol relating to the Madrid Agreement Concerning the International Registration of Marks adopted at Madrid on the 27th day of June, 1989 as amended from time to time.

K. An international application shall be dealt with by the Trade Marks Registry.

ID. (1) Where an application for the registration of a trade mark has been made under section 4 or a trade mark has been registered under section 7, the applicant or the registered owner may make an international application on the form prescribed by the Common Regulations for international registration of that trade mark.

(2) A person holding an international registration may make an international application on the form prescribed by the Common Regulations for extension of the protection resulting from the registration to any other Contracting Party.

(3) An international application under sub-section (1) or sub-section (2) shall designate the Contracting Parties where the protection resulting from the international registration is required.

(4) The Registrar shall certify in the prescribed manner that the particulars appearing in the international application correspond to the particulars appearing, at the time of the certificates, in the application under section 4 or the registration under section 7 and shall indicate the date and number of that application or the date and number of that registration as well as the date and number of the application from which that registration resulted as the case may be, and shall within the prescribed period forward the international application to the International Bureau for registration, also indicating the date of the international application.

(5) Where at any time before the expiry of a period of five years of an International registration, whether the registration has been transferred to another person or not, the application under section 4 or the registration under section 7, as the case may be, has been withdrawn or cancelled or has expired or has been finally refused in respect of all or some of the goods or services listed in the international registration, the protection resulting from such international registration shall cease to have effect.

(6) Where an appeal is made against the decision of registration and an action requesting for withdrawal of application or an opposition to the application has been initiated before the expiry of the period of five years of an international registration, any final decision resulting into withdrawal, cancellation, expiration or refusal shall be deemed to have taken place before the expiry of five years of the international registration.

(7) The Registrar shall during the period of five years beginning with the date of international registration, transmit to the International Bureau every information referred to in sub-section (5).

(8) The Registrar shall notify the International Bureau the cancellation to be effected to an international registration keeping in view the current status of the basic application or the basic registration, as the case maybe.

IE. (1) The Registrar shall, after receipt of an advice from the International Bureau about any international registration where Ghana has been designated, keep a record of the particulars of that international registration in the prescribed manner.

(2) Where, after recording the particulars of any international registration referred to in sub-section (1), the Registrar is satisfied that in the circumstances of the case the protection of trade mark in Ghana shall not be granted or such protection should be granted subject to conditions or limitation or to conditions additional to or different from the conditions or limitations subject to which the international registration has been accepted, the Registrar may, after hearing the applicant, refuse grant of protection and inform the International Bureau in the prescribed manner within eighteen months from the date on which the advice referred to in sub-section (1) was received.

(3) Where the Registrar finds nothing in the particulars of an international registration to refuse grant of protection under sub-section (2), the Registrar shall within the prescribed period cause the international registration to be advertised in the prescribed manner.

(4) The provisions of sections 5 to 16 and 18 to 22 shall apply in relation to an international registration as if the international registration were an application for registration of a trade mark under section 4.

(5) When the protection of an international registration has not been opposed and the time for notice of opposition has expired, the Registrar shall within a period of eighteen months of the receipt of advice under sub-section (1) notify the International Bureau of its acceptance of extension of protection of the trade mark under the international registration and, in case the Registrar fails to notify the International Bureau, it shall be deemed that the protection has been extended to the trade mark.

(6) Where a registered proprietor of a trade mark makes an international registration of that trade mark that designates Ghana, the international registration from the date of the registration shall be deemed to replace the registration held in Ghana without prejudice to any right acquired under the previously held registration and the Registrar shall, upon request by the applicant, make necessary entry in the Register referred to in sub-section (1).

(7) A holder of international registration of a trade mark who designates Ghana and who has not been extended protection in Ghana shall have the same remedy which is available to any person making an application for the registration of a trade mark under section 4 and which has not resulted in registration under section 7.

(8) Where at any time before the expiry of a period of five years of an international registration, whether the registration has been transferred to another person or not, the related basic application or, as the case may be, the basic registration in a Contracting Party other than Ghana has been withdrawn or cancelled or has expired or has been finally refused in respect of all or some of the goods or services listed in the international registration, the protection from the international registration in Ghana shall cease to have effect.

IF. (1) From the date of the international registration of a trade mark where Ghana has been designated or the date of the recording in the register of the International Bureau about the extension of the protection resulting from an international registration of a trade mark to Ghana, the protection of the trade mark in Ghana shall be the same as if the trade mark had been registered in Ghana.

(2) The indication of classes of goods and services given by the applicant shall not bind the Registrar with regard to the determination of the scope of the protection of the trade mark,

IG. (1) The international registration of a trade mark at the International Bureau shall be for a period of ten years and may be renewed for a period of ten years from the expiry of the preceding period.

(2) Subject to payment of a surcharge prescribed by the rules, a grace period of six months shall be allowed for renewal of the international registration.

IH. The Trademark Registry shall process an international application in accordance with,

(a) the Protocol and regulation made under the Madrid agreement concerning the international agreement of marks and the Protocol relating to the agreement; and

(b) the administrative instructive instructions made under the regulations referred to under (a)."

Date of Gazette notification: 25th July, 2014.