

MALAWI GOVERNMENT

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Act

No. 2 of 2018

I assent

PROF. ARTHUR PETER MUTHARIKA

PRESIDENT

24 January, 2018

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An Act to regulate matters relating to registration and protection of trademarks, well known marks, collective marks, certification marks, geographical indications and for matters connected therewith and incidental thereto.

ENACTED by the Parliament of Malawi as follows—

PART I—PRELIMINARY

Short title and commencement 1. This Act may be cited as the Trademarks Act, 2018 and shall come into operation on a date appointed by the Minister by notice published in the *Gazette*.

Interpretation 2. In this Act, unless the context otherwise requires—
“Appeals Tribunal” means the Appeals Tribunal established under section 62;

“Commissioner General” means the Commissioner General of the Malawi Revenue Authority appointed pursuant to section 3 of the Malawi Revenue Authority Act;

Cap 41:02

“geographical indication” means an indication which identifies goods or products as originating in the territory of a country, region or locality in that territory, where a given quality, reputation or other characteristic of a product is essentially attributable to its geographical origin and in a case where such goods are manufactured goods, one of the activities of either the production or of processing or preparation of the goods concerned takes place in such territory, region or locality, as the case may be;

“international instrument” means any convention, treaty, protocol or agreement between states;

“limitation” means any limitation of the exclusive right to the use of a trademark given by a person at the time of registration as owner thereof, including limitations of that right as to mode of use, and use in relation to goods to be sold or services to be performed;

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

“Register” means the register of trademarks kept pursuant to section 6;

“register of trademarks agents” means the register of trademark agents kept pursuant to section 75;

“trademark” means—

(a) any sign or mark which is capable of being represented graphically; or

(b) in relation to non-visual signs or marks, any sign or mark that is sufficiently described in a clear, precise, intelligible and objective manner, and it is capable of distinguishing the goods or services of one undertaking from those of other undertakings. and

(c) serve marks

“Trademarks Office” means the Trademarks Office established under section 3; and

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

PART II—TRADEMARKS OFFICE

- Establishment of the Trademarks Office
- 3.—(1) There is hereby established under the direction of the Minister, an office to be called the Trademarks Office.
- (2) The Trademarks Office shall have a seal which shall be used for purposes prescribed under this Act.
- Registrar
- 4.—(1) There shall be appointed a Registrar of Trademarks who shall be responsible for registration of trademarks and the day to day management of the Trademarks Office.
- (2) The Officer for the time being holding or acting in the office of the Registrar General shall be the Registrar of Trademarks.
- Appointment of other officers in the Trademarks Office
5. There shall be appointed—
- (a) one or more deputy Registrars of Trademarks who shall, subject to the supervision of the Registrar, have all the powers conferred by this Act on the Registrar; and
- (b) such examiners and other officers as the Minister may consider necessary for carrying out this Act.
- Register
- 6.—(1) The Registrar shall maintain a Register of trademarks.
- (2) The following shall be entered in the Register—
- (a) registered trademarks; and
- (b) such particulars as may be prescribed for transactions affecting a registered trademark including renewals, notifications of assignments and transmissions, names, addresses and descriptions of all registered users, disclaimers, conditions and limitations.
- (3) Any person may, upon payment of the prescribed fee, and in accordance with any conditions which may be prescribed, search, inspect or make a copy or obtain an extract of the Register.

PART III—REGISTRATION OF TRADEMARKS AND RELATED MATTERS

- Application for registration of a trademark
- 7.—(1) A person shall submit an application for registration of a trademark to the Registrar in the prescribed form.
- (2) Subject to any limitation set out in this Act, the application for registration of a mark a trademark made pursuant to subsection (1) shall be signed by an applicant and contain—
- (a) a request for registration of the mark as a trademark;
- (b) the name and address of the applicant;
- (c) the goods or services for which registration is related;
- (d) a representation of the mark; and

(e) a declaration of use or intention to use the mark as a trademark.

(4) Subject to this Act, the Registrar may—

(a) accept the application without limitations;

(b) accept the application subject to any amendments, modifications, conditions or limitations as he considers appropriate; or

(c) refuse to grant the application.

(5) The Registrar shall make a decision in subsection (4) within thirty days of receiving the application.

8.—(1) A mark shall not be registered as a trademark if it—

Grounds for
refusal of
registration

(a) is incapable of distinguishing goods or services of one enterprise or business from those of another enterprise or business;

(b) is identical with, or similar to, another registered trademark or other well known mark whose application for registration as a trademark was filed prior to the filing date of the application for the goods concerned which are similar or identical to the goods covered by the prior application;

(c) consists solely of a mark indicating the common name of the goods or services for which the application is made;

(d) is contrary to public order or morality;

(e) is likely to mislead the public in particular trade circles, as regards the geographical origin of the goods or services concerned, or their nature or characteristics;

(f) is identical to, an imitation of, or contains, as an element, armorial bearing, flag or other emblem, a name, abbreviation or initials of, or official sign or hallmark adopted by any state, inter-governmental organization or organization created by an international convention, unless the competent authority of that State or organization has given authorization for such bearing, flag, emblem, name, abbreviation or initials, official sign or hallmark to be used by an applicant for a registration of a mark as trademarks;

(g) is identical to, similar to, or constitutes a translation of, a trademark or trade name which is well known in Malawi for identical or similar goods or services of another enterprise, or if it is well known, and registered in Malawi for goods or services which are not identical or similar to those in respect of which registration is applied for—

(i) the use of that mark in relation to those goods or services would indicate a connection between those goods or services and the owner of the well known mark; and

(ii) the interests of the owner of the well known mark are likely to be prejudiced by such use.

Advertisement
of an
application

9.—(1) Where the Registrar accepts an application for registration of a trademark whether absolutely or subject to conditions or limitations, the Registrar shall, as soon as possible, after payment of the prescribed fee, advertise the application in the prescribed manner.

(2) The advertisement referred to in subsection (1) shall specify all conditions or limitations subject to which the application is accepted.

(3) The Registrar may direct that an application be advertised before acceptance where it appears to him that it is expedient to do so due to an exceptional circumstance, and where this is to be done, the Registrar may, if he considers appropriate, direct that the application be advertised again after it is accepted.

The Advertisement shall be made by notice in the *Gazette* journal end in one newspaper of under circulation

Opposition to
an application

10.—(1) Any person may, within thirty days from the date of the advertisement of an application pursuant section 9, give notice to the Registrar of the person's opposition to the registration of the trademark.

(2) The notice of opposition shall be issued in the prescribed form and shall include a statement of the grounds of opposition.

(3) The Registrar shall send a copy of the notice of opposition to the applicant and the applicant shall, within thirty days after receipt thereof, send to the Registrar, in the prescribed manner and time, a counter-statement stating the grounds on which he relies for his application.

(4) Where the applicant, without good reason, fails to send the counter-statement to the Registrar within the prescribed time, the applicant shall be deemed to have abandoned the application.

(5) If the applicant sends a counter-statement, the Registrar shall furnish a copy thereof to the person who gave notice of the opposition.

(6) The Registrar shall call for a hearing of the parties to consider the evidence for and against registration of a mark as a trademark and decide whether, and subject to what conditions or limitations, if any, registration of the mark will be permitted.

(7) The Registrar shall make a decision regarding the opposition to registration of a trademark within thirty days from the date of conclusion of the hearing held pursuant to subsection (6).

11.—(1) When the Registrar accepts an application for registration of a trademark and either-

Registration
of a
trademark

(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 Tribunal otherwise directs, register the trademark, and the registration shall be with effect from the date of filling the application for registration which shall be deemed to be the date of registration.

(2) The Registrar shall, on the registration of a trademark and upon payment of the prescribed fee, issue to the applicant, a certificate of registration in the prescribed form, and under the seal of the Trademarks Office.

(3) Where the applicant fails to complete registration processes of a trademark within twelve months from the date of the application, the Registrar shall treat the application as abandoned.

12.—(1) On registration of a mark as a trademark, an owner of the registered trademark shall have the exclusive right to use the trademark in respect of the goods or services for which the trademark was registered.

Rights
conferred by
registration

(2) The rights of the owner shall be effective from the date of filing of the application for registration.

13.—(1) A registered trademark shall not be infringed by the use of another registered trademark in relation to goods or services for which the latter is registered following honest concurrent use of the previously registered trademark for a period of five years during which the owner of the rights in the registered trademark has had knowledge of such use by the latter.

Infringement
of a
trademark

(2) The following acts shall not constitute infringement of a trademark—

(a) the use of the trademark by a person in his own name or address, the name of his place of business, the name of any of his predecessors in business, or the name of any such predecessor's place of business;

(b) the use of the trademark where it is necessary to indicate the kind, quality, quantity, intended purpose, value, geographical

origin, time of production of goods or, of rendering of services, or other characteristics of goods or services;

(c) the use of the trademark where it is necessary to indicate the intended purpose of a product or service, including spare parts or accessories; or

(d) the importation into, or the distribution, sale in Malawi, of goods to which the trademark has been applied by or with the consent of the owner thereof:

Provided that the use is in accordance with honest practices in industrial or commercial matters.

Exhaustion of rights

14. The rights conferred by registration of a trademark may not be invoked to prevent a third party from using, in the course of trade, goods lawfully bearing the trademark after the goods have been put on the market in Malawi or abroad by the owner or by a person acting with the owner's consent or having an economic tie to the owner:

Provided that the goods and the packaging or wrapping in direct contact with the goods are not deteriorated or altered.

Use of unregistered mark

15.—(1) An owner or licensee of a registered trademark shall not interfere or restrain the use by another person of a trademark identical to, or nearly resembling the registered trademark which that other person or predecessor in title has continuously used prior to the registration of the trade mark.

(2) A person shall not be entitled to institute any proceedings to prevent or to recover damages for the infringement of an unregistered trademark, but nothing in this Act shall affect the right 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.

(3) Where on an application for the registration of a trademark, it appears to the Registrar that there is an earlier trademark or right in the Register but the applicant has shown to the satisfaction of the Registrar that there has been honest concurrent use of the trademark for which registration is sought, the Registrar shall not refuse to accept the application by reason of the earlier trademark or right unless objection on that ground is raised in opposition proceedings by the owner of that earlier trademark or right.

Registration subject to disclaimer

16.—(1) If a trademark contains—

(a) a part not separately registered by the owner as a trademark; or

(b) a matter common to the trade for which trademark is associated or otherwise of a non- distinctive character,

the Registrar, or the Appeals Tribunal in the event of an appeal from a decision of the Registrar, in deciding whether the trademark shall be entered or remain on the Register, may require, as a condition of its being on the Register, that the owner—

(i) disclaim any right to the exclusive use of any such part of the trademark or to the exclusive use of all or any portion of such trademark; or

(ii) make such other disclaimer as the Registrar or the Appeals Tribunal may consider necessary for the purposes of defining the owner's rights for purposes of registration.

(2) No disclaimer in the Register shall affect any rights of the owner of a trademark except such rights as may arise out of the registration of the trademark, in respect of which the disclaimer is made.

17.—(1) A trademark may be limited in whole or in part, to one or more specified colours, and in any such case, the fact that there is a colour limitation shall be taken into consideration by the Registrar, or by the Appeals Tribunal in the event of an appeal from a decision of the Registrar, in deciding on the distinctive character of the trademark.

Limitation as to colour and absence thereof

(2) Where a trademark is registered without limitation of colour, it shall be deemed to be registered for all colours.

18.—(1) Goods and services shall, for purposes of registration, be classified in accordance with the Nice Classification as amended from time to time.

Classification

(2) For purposes of this section—

“Nice Classification” means a classification adopted in the Nice Agreement Concerning the International Classification of Goods and Services for the purposes of the Registration of Marks of June 15, 1957, as revised at Stockholm on July, 14 1967 and at Geneva on May 13, 1977, and as amended at Geneva on September, 28, 1979.

19.—(1) Where an owner of a trademark claims to be entitled to the exclusive use of any part thereof separately, he may apply to register the whole or any such part, as separate trademarks.

Registration of parts of trademarks and of trade marks as series

(2) Each separate trademark shall satisfy all the conditions, and have all the qualities of an independent trademark.

(3) The Registrar may register trademarks as a series in one registration where a person claims to be the owner of several trademarks, in respect of the same goods or description of goods or services, which, while resembling each other in 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;

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

(c) colour; or

(d) other matters of a non-distinctive character which do not substantially affect the identity of the trademark.

Assignment
and
transmission
of a trademark

20.—(1) An owner of a registered trademark may transmit a trademark by assignment, testamentary disposition or operation of law in the same way as any other personal or moveable property.

(2) A registered trademark shall be also transmissible either in connection with the goodwill of a business, or independently.

(3) An assignment or other transmission of a registered trademark may be limited only to apply—

(a) in relation to some, but not all the goods or services for which the trademark is registered; or

(b) in relation to the use of the trademark in a particular manner or a particular locality.

(4) An assignment of a registered trademark, or an assent relating to a registered trademark shall not be effective unless it is in writing and signed by, or on behalf of, the assignor or a personal representative, as the case may be.

(5) This section shall also apply to an assignment of a trademark by way of security.

(6) A registered trademark may be the subject of a charge.

(7) Nothing in this Act shall be construed as affecting the assignment or other transmission of an unregistered trademark as part of the goodwill of a business.

Associated
trademarks to
be assignable
and
transmissible
as a whole

21.—(1) Trademarks that are registered as, or that are deemed to be associated trademarks under this Act, shall be assignable and transmissible only as a whole and not separately, but they shall for all other purposes be deemed to have been registered as separate trademarks.

(2) Where a trademark that is registered, or is the subject of an application for registration in respect of any goods, is identical to

another trademark that is registered, or is the subject of an application for registration, in the name of the same owner in respect of the same goods or description of goods, or so nearly resembles it as to be likely to deceive or cause confusion if used by a person other than the owner, the Registrar, may at any time, require that the trademarks be entered in the Register as associated trademarks.

(3) Where a trademark and any part thereof are registered as separate trademarks in the name of the same owner, they shall be deemed to be, and shall be registered as associated trademarks.

(4) All trademarks that are registered as a series in one registration shall be deemed to be, and registered as associated trademarks.

(5) On application made in the prescribed manner by a registered owner of two or more trademarks registered as associated trademarks, the Registrar may dissolve the association in respect of any of the trademarks if he is satisfied that there would be likelihood of deception or confusion if those trademarks were used by another person in relation to any of the goods in respect of which the trademarks were registered and may amend the Register accordingly.

22.—(1) Where a person becomes entitled to a registered trademark by assignment or transmission, he shall apply to the Registrar to register his title to the trademark.

Registration
of
assignments
and
transmission

(2) The Registrar shall, on receipt of the application under subsection (1) and upon being satisfied with the proof of title, register the person as the owner of the trademark for the goods or services in respect of which the assignment or transmission has effect, and shall cause particulars of the assignment or transmission to be entered in the Register.

(3) Except for the purposes of an appeal or an application for rectification under section 27, a document or instrument in respect of which no entry has been made in the Register in accordance with subsection (1) shall not be admitted as evidence in any court as proof of title to a trademark unless the court otherwise directs.

23.—(1) A person may, by agreement with an owner of a registered trademark, be registered as a licensee in respect of all or any goods or services for which the trademark is registered.

Registration
as licensee

(2) A licence in relation to a registered trademark—

(a) shall provide for effective control by the licensor of the quality of the goods or services of the licensee in connection with which the trade mark is used; and

(b) may provide for conditions and restrictions to which the licensee shall comply with (in this Act referred to as the “permitted use”).

(3) Where the licence does not provide for quality control or where such quality control is not effectively carried out, the licence shall not be valid.

(4) The permitted use of the trademark shall be deemed to be use by the owner for the purposes of section 15 and for any other purposes for which such use is material under this Act or any other law.

(5) Subject to any agreement subsisting between parties, a licensee of a trademark shall be entitled to call upon the owner of the trademark to take proceedings to prevent infringement of the trademark and, if the owner refuses or neglects to do so within sixty days after being so called, the licensee may institute proceedings in his own name for infringement as if he were the owner of the trademark and may make the owner a defendant.

(6) Where there is a proposal to register a person as a licensee of a trademark, the owner and a proposed licensee of the trademark shall submit a written application to the Registrar in the prescribed form and with an affidavit or a solemn declaration made by the owner or by some person authorized to act on his behalf, and approved by the Registrar—

(a) giving particulars of the relationship existing or proposed between the owner and the proposed licensee, including particulars showing the degree of control by the owner over the permitted use which their relationship will confer and whether it is a term of their relationship that the proposed licensee shall be the sole licensee or that there shall be other restriction as to persons who may be registered as licencees;

(b) stating the goods in respect of which the licence is proposed;

(c) stating any conditions or restrictions proposed with respect to the characteristics of the goods, mode or place of permitted use or to any other matter;

(d) stating whether the permitted use is to be for a period and duration thereof; and

(e) with such further documents, information or evidence as the Registrar may require.

(7) The Registrar may register the proposed licensee as a licensee in respect of the specified goods or services, if after considering the

information furnished to him under subsection (6), the Registrar is satisfied that, in all the circumstances, the use of the trademark in relation to the proposed goods or services by the proposed licensee, subject to any conditions or restrictions which the Registrar considers appropriate in the circumstances, would not be contrary to public interest.

(8) The Registrar shall, if so required by an application, take steps to ensure that information given for the purpose of an application under this section, other than matters entered in the Register, is not disclosed to trade rivals of the applicant.

(10) The registration of a person as a licensee may be—

(a) varied by the Registrar in relation to the goods or services in respect of which the licence applies or in relation to the permitted use subject to which the licence was granted, on application by the owner of the trademark in the in the prescribed form;

(b) cancelled by the Registrar on the application in the prescribed form by the owner of the trade mark or by the licensee of the trade mark; or

(c) cancelled by the Registrar on the application in the prescribed form by any person on any of the following grounds—

(i) that the licensee has used the trademark otherwise than by way of the permitted use or in such way as to cause or to be likely to cause deception or confusion;

(ii) that the owner or the licensee misrepresented or failed to disclose some material facts in the application for the registration or that there has been material change in circumstances since the date of registration; or

(iii) that the registration ought not to have been effected, having regard to rights vested in the application by virtue of a contract in the performance of which that person is interested.

(11) The Registrar may, at any time, cancel the registration of a person as a licensee of the trademark in respect of any goods or services in respect of which the trademark is no longer registered.

(12) The registration of a collective mark, a geographical indication or an application thereof, shall not be the subject matter of a licence.

(13) A licensee of a trademark may only assign or transmit a trademark with the permission of the registered owner.

Duration of
rights and
renewals

24.—(1) The registration of a trademark shall be for a period of ten years but may be renewed from time to time in accordance with this section.

(2) The Registrar shall, on application made by the owner of a registered trademark in the prescribed form, renew the registration of the trademark for further periods of ten years from the date of expiry of the registration.

(3) Where a trademark is removed from the Register for failure of renewal, it shall nevertheless, for the purpose of any application for the registration of a trademark during a period of six months after the date of removal, be deemed to be a trademark that is already in the Register.

(4) Subsection (3) shall not apply where the Registrar or the Tribunal in the event of an appeal from the decision of the Registrar, is satisfied either that—

(a) there has been no trade use of the trademark that has been removed during the three years immediately preceding its removal; or

(b) no deception or confusion would likely arise from the use of the trademark that is the subject of an application for registration by reason of any previous use of the trademark that has been removed.

(5) The Registrar may, on application by the owner of the trademark within a period of one year after removal, restore a trademark the in Register unless if it was not used in the three years preceding its removal.

Removal of
trademark for
non-use

25. The Registrar may on application by any interested person, remove a trademark from the Register if he is satisfied that the trademark has not been used in relation to the goods or services for a continuous period of five years after registration.

Use of one of
associated or
substantially
identical
trademarks
equivalent to
use of another

26.—(1) Where under this Act, use of a registered trademark is required to be proved for any purpose, the Registrar, or the Appeals Tribunal in the event of an appeal from a decision of the Registrar, may accept use of an associated registered trade mark, or of the trademark with additions or alterations which do not substantially affect the identity, and use of the trademark.

(2) The use of the whole of a registered trademark shall, for the purposes of this Act, be deemed to be a use of any registered trademark, being a part thereof, registered in the name of the same owner.

PART IV—RECTIFICATION AND REMOVAL OF ENTRIES IN THE REGISTER

27.—(1) An interested party may apply for the rectification of an error or omission in the Register.

Rectification
and
correction of
the Register

(2) An application for rectification shall be made to the Registrar except in cases where proceedings concerning a trademark in question are pending before the Appeals Tribunal and the consideration, of the application shall await conclusion of the matters by the Appeals Tribunal.

(3) Where the application is made to the Registrar, the Registrar may, at any stage of the proceedings, refer the application to the Appeals Tribunal.

(4) Except where the Registrar or the Appeals Tribunal directs otherwise, the rectification of an error or omission in the Register shall be to the effect that the error or omission in question shall be deemed never to have been made.

(5) The Registrar may, on request made in the prescribed manner by the owner of a registered trademark, or a licensee, correct any error or enter any change in a name or address in the Register.

(6) The Registrar may remove from the Register, any matter appearing to him to have ceased to have effect.

28 The Registrar may, on application by any interested party, make such order as he considers appropriate for removal of, or variation in, the registration of a trademark on the ground of any contravention of, or failure to observe, a condition entered in the Register in relation to the registered trademark.

Removal or
variation
registration of
a trademark
for breach of
condition

29.—(1) The owner of a registered trademark may apply in the prescribed manner, to the Registrar, for leave to alter a trademark in any manner not substantially affecting the identity of the trademark.

Alteration of
registered
trademarks

(2) The Registrar may grant or refuse leave, or grant the leave on such terms, and subject to such limitations, as he considers appropriate.

(3) The Registrar shall advertise the application for alteration made under subsection (1), in the prescribed manner and if, within the prescribed time from the date of the advertisement, any person gives notice to the Registrar in the prescribed manner, of opposition to the application, the Registrar shall, after hearing the parties, if so required, make a decision on the matter.

- Owner or applicant to be heard before decision is made by Registrar
- 30.** The Registrar shall, prior to making a decision that may affect the rights of the owner or applicant for registration of a trademark, give the owner or applicant an opportunity to be heard.
- Evidence of certain entries and documents
- 31.—(1)** A certificate purporting to be signed by the Registrar certifying that an entry which he is authorized by this Act to make, has or has not been made, or that any other thing which he is so authorized to do has or has not, been done, shall be prima facie evidence of the matters so certified.
- (2) A copy of any entry in any register, or any document kept in the Trademarks Office, or any trademark or an extract from such register or document, certified by the Registrar and sealed with the seal of the Trademark Office, shall be admissible as evidence in any proceedings without further proof and without production of the original document.
- Request for information
- 32.** The Registrar shall, on the request of any person and on payment of the prescribed fee, furnish copies of any document lodged with the Trademarks Office or particulars from the Register which are open to public inspection or furnish a certificate in respect thereof.
- Advertisements to be approved by the Registrar
- 33.** Any advertisement or notice issued under this Act, other than a notice issued under the authority of the Minister, shall, before being published by any person, be in the prescribed form and be approved by the Registrar.

PART V—INFRINGEMENT OF TRADEMARKS AND UNFAIR COMPETITION

- Infringement of a trademark
- 34.** A person who is not an owner of a registered trademark infringes the rights of an owner of the registered trademark if he—
- (a) affixes the registered trademark or a similar distinctive sign, on goods or goods associated with the services for which the trademark was registered, or on containers, wrapping or packaging of such goods which creates a confusion with regard to the identity of the goods;
- (b) suppresses or distorts, for commercial purposes, the trademark after it has been affixed on the goods for which the trademark has been registered;
- (c) produces, sells, offers for sale, distributes or stocks labels, containers, wrapping, packaging or any other material on which the trademark is reproduced;

(d) refills or re-uses for commercial purposes, labels, containers, wrapping, packaging or any other material bearing the trademark;

(d) uses, in the course of trade, a sign that is identical or similar to the registered trade mark in respect of any goods or services, where such use may cause confusion or association with the registered trademark; or

(f) uses in the course of trade, a sign identical or similar to, the trademark in respect of any goods or services where such use may cause unfair—

(i) economic prejudice to the owner through dilution of the distinctive character or advertising value of the trademark; or

(ii) advantage being taken from the reputation of the registered trademark or of its holder.

35. Where a trademark registered in terms of this Act has been infringed, a court may grant the owner—

Remedies for infringement of a trademark

(a) an injunction;

(b) an order for removal of the infringing mark from all material or where the infringing mark is inseparable or incapable of being removed from the material, an order that all such material be delivered up to the owner;

(c) an order for destruction of any infringing product, article or product of which the infringing product forms an inseparable part;

(d) an order for seizure and forfeiture of any material and implements used in the creation of the infringing goods;

(e) damages, or an account of the profits derived from the infringement, including expenses incurred in curtailing the infringement; or

(f) in lieu of damages, at the option of the owner, a reasonable royalty which would have been payable by a licensee for the use of the trademark concerned, including any use which took place after advertisement of the grant of an application for registration and which, if it took place after registration, would amount to infringement of the rights acquired by registration.

36.—(1) The Court may, on application by—

Acts of unfair competition

(a) a right holder protected under this Act;

(b) a competent authority;

(c) an interested person or association; or

(d) an interested producer, manufacturer or trader, grant an application to prevent an act of unfair competition, award

damages or grant any other remedy as the court may consider appropriate.

(2) For purposes of this Act, an “act of unfair competition” means an act which is contrary to honest practices in industrial or commercial matters.

(3) Notwithstanding subsection (2), the following shall constitute acts of unfair competition—

(a) any act of such a nature as to create confusion by any means whatever, with the establishment, goods or the industrial or commercial activities of a competitor; or

(b) the making of a false allegation in the course of trade of such a nature as to discredit the establishment, goods, or industrial or commercial activities of a competitor.

Cap. 48:09 (4) This provision shall apply in addition to provisions on unfair competition provided in the Competition and Fair Trading Act.

PART VI—WELL KNOWN, COLLECTIVE AND CERTIFICATION MARKS

Protection of
well known
marks

37. The Registrar shall not register a mark registered as a trademark if the mark is identical to, confusingly similar to or constitutes a translation of a trademark—

(a) or a trade name which is well known in Malawi as the trade mark of a person other than the applicant seeking registration and is used for identical or similar goods or services; or

(b) which is registered with respect to goods or services which are not similar to those with respect to which registration is applied for:

Provided that—

(i) use of the trademark in relation to those goods or services would indicate a connection between those goods or services and the owner of the well-known mark; and

(ii) the interests of the owner of the well-known mark are likely to be damaged by such use.

Factors for
determining
well known
marks

38.—(1) In determining whether a trademark is a well known mark, the Registrar shall take into account any circumstances from which it may be inferred that the mark is well known.

(2) Notwithstanding the generality of subsection (1), the Registrar may consider any of the following factors in determining whether a trademark is well known—

(a) degree of knowledge or recognition of the mark in the relevant sector of the public;

(b) duration, extent and geographical area of any use of the mark;

(c) duration, extent and geographical area of any promotion of the mark, including advertising or publicity and the presentation, at fairs or exhibitions, of the goods or services to which the mark applies;

(d) duration and geographical area of any registrations or any applications for registration of the mark to the extent that they reflect use or recognition of the mark;

(e) record of successful enforcement of rights in the mark, in particular, the extent to which the mark is recognized as well known by competent authorities;

(f) commercial value associated with the mark;

(g) degree of inherent or acquired distinctiveness of the mark;

(h) degree of exclusivity of the mark and the nature and extent of use of the same or a similar mark by third parties;

(i) nature of the goods or services and the channels of trade for the goods or services that bear the mark; or

(j) degree to which the reputation of the mark symbolises quality of goods for which the registration is associated.

39.—(1) The Registrar may, on application, register a mark as a collective mark.

Registration
of collective
marks

(2) An application for registration of a collective mark shall designate the mark sought to be registered as a collective mark and the application shall be accompanied by a copy of rules governing the use of the mark.

(3) For the purposes of subsection (2), “rules” means the rules made by a person under whose control the collective mark may be used.

(4) The registered owner of a collective mark shall notify the Registrar, in writing, of any changes made in respect of the rules governing the collective mark within sixty days of such changes taking place.

(5) Subject to subsections (2), (3) and (4), this Act shall apply to collective marks and where the term “trademark” is used in the Act, it shall be construed to include the term “collective mark”.

(6) For purposes of this section, a “collective mark” means a mark that is capable of distinguishing, in the course of trade, goods or services of persons who are members of an association from

goods or services of persons who are not members of such association.

Registration
of
certification
marks

40.—(1) The Registrar may, on application, register a mark as a certification mark as prescribed in the First Schedule hereto.

(2) A certification mark shall not be registrable in the name of a person who carries on a trade in goods or services of the kind certified.

(3) For purposes of this section, a “certification mark” means a mark adapted to distinguish, in the course of trade, goods or services, certified by any person, in respect of origin, material, mode of manufacture, quality, accuracy and, performance of services or other characteristic, from goods or services not so certified.

PART VII—GEOGRAPHICAL INDICATIONS

Application
for
registration of
a
geographical
indication

41. A person may make an application to the Registrar for registration of a geographical indication, in the prescribed form which shall contain—

(a) a request, in writing, that the geographical indication be registered;

(b) details of the geographical indication for which registration is sought;

(c) a description of the geographical area to which the geographical indication applies;

(d) the particulars or a description of the goods to which the geographical indication applies;

(k) the quality, reputation or other characteristics of the goods for which the geographical indication is used;

(l) a certified copy of the rules governing the use of the geographical indication;

(m) such fees as may be prescribed; and

(n) such other particulars as may be prescribed by the Minister.

Acceptance
and
advertisement
of an
application

42.—(1) Subject to section 43, the Registrar shall, if he is satisfied that an application made pursuant to section 41 complies with the requirements of this Part, accept an application to register a geographical indication and shall, within such time and in such manner as may be prescribed, publish that application in the Journal.

(2) The advertisement shall be in accordance with section 9.

- 43.** A geographical indication shall not be registered if it is—
- Grounds for
refusal of
registration
- (a) incapable of distinguishing goods as originating from a particular territory, region or locality or does not possess characteristics attributed to that territory, region or locality in which those goods originate from;
- (b) contrary to public order or morality;
- (c) likely to mislead the public or those in the trade as regards the geographical origin of the goods concerned, their nature or characteristics;
- (d) in respect of goods, identical with the term usually used in common language as the common name for such goods in Malawi;
- (e) not protected, has ceased to be protected or has fallen into disuse in its country of origin; or
- (f) identical or similar to an existing registered trademark or geographical indication that is likely to confuse the public.

44.—(1) Where the Registrar is satisfied that an application for the registration of a geographical indication satisfies the requirements of this Act, and the application has not been opposed within the prescribed period, or where it is opposed, the Registrar decides in the applicant's favour, the Registrar shall—

Registration
of
geographical
indications

- (a) register the geographical indication in the Register;
- (b) issue to the applicant, a certificate of registration; and
- (c) publish in the Journal, a reference to the registration of the geographical indication.

(2) Where the requirements for the registration of a geographical indication are not satisfied, or an application for the registration of a geographical indication is successfully opposed, the Registrar shall refuse to register the geographical indication.

(3) The Registrar may subject the registration of a geographical indication to conditions that the Registrar considers appropriate.

45.—(1) The registration of a geographical indication shall give to the registered owner or authorized user thereof,—

Rights
conferred by
registration

- (a) the exclusive right to the use of the geographical indication in relation to the goods in respect of which the geographical indication is registered; and
- (b) the right to obtain relief by way of injunction, award of damages or any other remedy as the court may consider appropriate in respect of infringement of the geographical indication as provided for under this Act.

(2) The exclusive right to the use of a geographical indication given under subsection (1)(a) shall be subject to any condition or limitation to which the registration is subject.

(3) Notwithstanding anything contained in any written law, a right to a registered geographical indication shall not be the subject matter of assignment, transmission, licensing, pledge, mortgage or any such other agreement unless it is assigned, transmitted, licensed, pledged or mortgaged to a producer who will produce the goods or carry out an activity within the geographical area specified in the Register and who shall not dilute the characteristic features of the geographical indication.

Infringement of
a geographical
indication

46. A registered geographical indication shall be infringed by a person who, not being an authorized user thereof,—

(a) uses the geographical indication by any means, in the designations or presentation of goods that indicates or suggests that such goods originate from a geographical area other than the true place of origin of such goods in a manner which misleads the public as to the geographical origin of such goods even where the geographical indication used is accompanied by disclaimers or expressions such as “kind”, “type”, “style”, “imitation” or “the like”;

(b) uses the registered geographical indication for goods produced in the geographical area specified in the Register in respect of the geographical indication not possessing the quality, reputation or other characteristic specified in the Register; or

(c) uses a geographical indication identifying—

(i) wines for wines, or any such product as may be prescribed, not originating in the place indicated by the geographical indication in question; or

(ii) spirits for spirits, or any such product as may be prescribed, not originating in the place indicated by the geographical indication in question.

PART VII—OFFENCES AND PENALTIES

Falsification of
entries in the
Register

47. A person who—

(a) 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

(b) produces or tenders, or causes to be produced or tendered in evidence any such writing,

commits an offence and shall, on conviction, be liable to a fine of K3,000,000.00 and to imprisonment for five years.

48.—(1) A person who makes a representation—

(a) that a trademark which is not registered, is a registered trademark;

(b) with respect to a part of a registered trademark not being a part separately registered as a trademark to the effect that it is so registered;

(c) to the effect that a registered trademark is registered in respect of any goods or services in respect of which it is not registered; or

(c) to the effect that the registration of a trademark gives an exclusive right to the use thereof in any circumstances in which, having regard to any limitation entered on the register, the registration does not give such right,

commits an offence and shall, on conviction, be liable to a fine of K10,000,000 and imprisonment for ten years.

(2) For the purposes of this section, the use in Malawi in relation to trademark of the word “registered” or of any other word referring, whether expressly or impliedly, to registration, shall be deemed to import a reference to registration in the Register, except where the word—

(a) is used in physical association with other words delineated in characters at least as large as those in which the word is delineated, indicating that the reference is to registration as a trademark under the law of a country outside Malawi, being a country under the law of which the registration referred to is in fact in force;

(b) is, being a word other than the word “registered”, of itself such as to indicate that the reference is to such registration as last aforesaid; or

(c) is used in relation to a mark registered as a trademark under the law of another country and in relation to goods to be exported to that country.

49. A person who—

(a) for the purpose of deceiving the Registrar or any other officer in the Trademarks Office, in the implementation of this Act; or

(b) for the purpose of procuring or influencing the doing or omission of anything in relation to this Act,

False
representation
of a
registered
trademark

Deceiving or
influencing
the Registrar

makes or submits a false statement or representation, whether orally or in writing, knowing the same to be false, commits an offence and shall, on conviction, be liable to a fine of K3,000,000.00 and imprisonment for seven years.

Forgery of
geographical
indications

50. A person who, knowingly and with intent to deceive, performs any of the acts referred to in section 47, commits an offence and shall, on conviction be liable to a fine of K1,000,000.00 in the case of an individual, and imprisonment for five years or to a fine of K5,000,000.00 in the case of a body corporate.

Forgery of
trademarks
and other
prohibited acts

51.—(1) A person who—

(a) forges a registered trademark or falsely applies to goods or in relation to services, any registered trademark or any mark so nearly resembling a registered trademark so as to be calculated to deceive;

(b) falsely applies a registered trademark to goods or in relation to services;

(c) makes a die, block, machine or other instrument for the purpose of forging, or of being used for forging a registered trademark;

(d) disposes of, or has in his possession, a die, block, machine or other instrument, for the purpose of forging, or of being used for forging, a registered trademark;

(e) without the consent of the owner of a registered trademark;—

(i) makes, imports or has in his possession, any device for applying that registered trademark to goods or in relation to services or representation of that registered trademark;

(ii) makes any reproduction, replica or representation of that registered trade mark; or

(iii) imports any reproduction, replica, or representation of that registered trademark otherwise than on goods and services to which they have been applied; or

(f) makes, imports or has in his possession—

(i) any device for applying to any goods or in relation to any services, a mark so nearly resembling a registered trademark that is likely to deceive or cause confusion;

(ii) any reproduction, replica or representation of a mark, so nearly resembling a registered trademark, that is likely to deceive or cause confusion, for the purpose of applying it to goods or in relation to services;

(iii) any covering bearing a mark so nearly resembling a registered trademark that is likely to deceive or cause confusion in relation to goods and services,

commits an offence, and shall, on conviction, be liable to a fine of K5,000,000.00 and imprisonment for ten years.

(2) In addition to the penalty in subsection (1), the court shall order the seizure or destruction of any goods or any instruments used in the commission of the offence or make an order stopping the provision of services to which the offence relates.

(3) It shall be a sufficient defence to any charge under subsection (1)(b) and (c) where an accused person proves that—

(a) in the ordinary course of his business, he was employed on behalf of other persons—

(i) to make dies, blocks, machines or other instruments for making or being used in making trademarks;

(ii) to apply trademarks to goods or in relation to services; or

(iii) that in the case which is the subject of the charge, he was so employed by some other person and was not interested in the goods or services by way of profit or commission dependent on the sale of the goods or performance of the services; or

(b) on request made by a police officer, he gave to the police officer information in his power with respect to the person on whose behalf the trade mark was applied.

52.—(1) A person who sells, imports, exports, lets for hire or distributes goods or performs any services to which—

(a) a forged registered trademark is applied; or

(b) a registered trademark is falsely applied,

commits an offence, and shall, on conviction, be liable to a fine of K5,000,000.00 and imprisonment for ten years.

(2) It shall be a defence to any charge under subsection (1) if the person concerned proves that he took all reasonable precautions against committing an offence under this section, and on request made by a police officer or customs officer, he gave to the officer all the information in his possession with respect to the person from whom he obtained such goods.

53. Any person who, within Malawi, procures, counsels, aids, abets or is accessory to the commission outside Malawi of any offence which, if committed within Malawi, would be an offence under this Part, commits an offence, and shall, on conviction, be liable to a fine of K5,000,000.00 and imprisonment for ten years.

Prohibition
of sale or
importation
of goods
with forged
trademarks

Aiding and
abetting
commission
of offences
outside
Malawi

- Witness giving false evidence** **54.** Any person who, wilfully gives false evidence before the Registrar or the Appeals Tribunal in any proceedings knowing such evidence to be false or not knowing or believing it to be true, commits an offence, and shall, on conviction be liable to a fine of K1,000,000 and imprisonment for three years.
- Importation of infringing goods** **55.—(1)** An owner or licensee of a registered trademark may give notice in writing to the Commissioner General that he is the owner or a licensee of a registered trademark.
- (2) On receipt of the notice, the Commissioner General shall take all necessary steps to ensure that imported goods, materials or articles do not infringe the registered trademark.
- (3) When a notice is in force under this section, the importation of the goods to which the notice relates, otherwise than by a person for his private and domestic use, is prohibited, but a person shall not, by reason of the prohibition, be liable to any penalty other than forfeiture of the goods.
- (4) In addition to the notice given under subsection (4), the owner or licensee of the registered trademark may, from time to time, inform the Commissioner General that, in relation to the registered trademark, infringing goods, materials or articles are expected to arrive in Malawi and in such notice request the Commissioner General to treat the goods as prohibited goods.
- (5) When giving notice under subsection (5), the owner or licensee shall specify the time and the place where the infringing goods, materials or articles are expected to arrive in Malawi.
- Commissioner General may prescribe rules on notice requirements** **56.—(1)** The Commissioner General may in consultation with the Registrar, prescribe rules on the form in which notice is to be given under section 55 and require a person giving notice to—
- (a) furnish the Commissioner General with such information or evidence as may be specified in the rules when giving notice under section 55; and
- (b) comply with such other conditions as may be specified in the rules.
- (2) The rules made pursuant to subsection (1) may, in particular, require a person giving the notice to—
- (a) furnish sufficient information and particulars of a trademark;
- (b) pay such fees in respect of the notice as may be specified by the rules;

(c) give such security as may be so specified in respect of any liability or expense which the Commissioner General may incur in the process of protecting the trademark; or

(d) indemnify the Commissioner General against any such liability or expense, whether security has been given or not.

57. Where the Commissioner General or officer who exercises functions in relation to imported goods obtains information relating to infringing goods, material or articles, the Commissioner General may authorize the disclosure of that information for the purpose of facilitating the exercise, by any authorised person, of any function in connection with the investigation or prosecution of an offence under this Act.

Commissioner
General to
disclose
information

PART IX—INTERNATIONAL REGISTRATION OF TRADEMARKS

58. Where Malawi ratifies or accedes to any international instrument relating to trademarks, the Minister shall, by notice published in the *Gazette*, declare that Malawi has become a member to a particular instrument with effect from the date stated in such notice and shall list the international instrument in the Second Schedule hereto.

Treaty
arrangements

59. The Minister may make regulations for the procedures relating to registration of trademarks under international instruments to which Malawi is a Party.

Power to
make
regulations
giving effect
to treaties

60. Registration of trademarks in Malawi pursuant to the Banjul Protocol shall be made in accordance with the Third Schedule hereto.

Registration
under the
Banjul
Protocol

61. Registration of trademark in Malawi pursuant to the Madrid Protocol, shall be made in accordance with the Fourth Schedule hereto.

Registration
under the
Madrid
Protocol

PART X—APPEALS AND OTHER LEGAL PROCEEDINGS

62.—(1) There is hereby established an Appeals Tribunal which shall hear appeals from decisions of the Registrar.

Establishment
of Appeals
Tribunal

(2) The Appeals Tribunal shall be presided over by a single Judge appointed by the Chief Justice.

(3) The Appeals Tribunal shall develop its own rules but where such rules are not developed, the Appeals Tribunal shall apply the rules of the High Court Commercial Division.

(4) Any person aggrieved by a decision of the Registrar under this Act may, within thirty days of such decision, lodge an appeal with the Appeals Tribunal.

(5) If a person is further aggrieved by the decision of the Appeals Tribunal, he may within twenty one days, appeal to the Supreme Court of Appeal.

Infringement or passing off of a trade mark

63. Any action or legal proceeding relating to the infringement or passing off of a trademark shall be presided over by the Commercial Division in the High Court.

Registrar's original jurisdiction

64. Where an applicant wishes to make an application under any provisions of this Act, the application shall first be made to the Registrar.

Reference to Appeals Tribunal by Registrar

65. Where the Registrar determines that any matter to be decided by him under this Act involves a point of law or is of unusual importance or complexity, he may, after giving notice to the parties, refer the matter to the Appeals Tribunal for a decision and shall thereafter, in relation to the matter, act in accordance with the decision of the Appeals Tribunal or any decision substituted therefor, on appeal to the Supreme Court.

Proceedings before the Registrar

66.—(1) Subject to section 70, evidence in any proceedings before the Registrar under this Act, shall be given by affidavit but the Registrar may, if he considers it appropriate in any particular case, take oral evidence as aforesaid in *lieu* of, or in addition to, such evidence as aforesaid and may allow any witness to be cross-examined on his affidavit or oral evidence.

Cap. 18:01

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

(3) A party may, in any proceedings before the Registrar under this Act, be represented by a legal practitioner.

Power of Registrar to fix time and place

67. The Registrar may, in any proceeding before him decide the time and places at which he will sit and he may adjourn any proceedings for such time and to such place as he considers appropriate.

Registration to be *prima facie* evidence of validity

68. In any legal proceeding relating to a registered trademark, the fact that a person is registered as owner of the trademark shall be *prima facie* evidence of the validity of the original registration of the trademark and of all subsequent assignments and transmissions thereof.

69. In any legal proceeding relating to a trademark or trade name, the Appeals Tribunal or the Registrar, shall admit evidence of the usages of the trademark concerned and of any relevant trademark or trade name or get-up legitimately used by other persons.

Market
survey
evidencce

70.—(1) In any legal proceeding in which the relief sought includes alteration or rectification of the Register, the Registrar shall have the right to appear and be heard in such proceedings, and shall appear if so directed by the Appeals Tribunal.

Registrar's
appearance in
proceedings

(2) Unless otherwise directed by the Appeals Tribunal, the Registrar, in lieu of appearing and being heard, may submit to the Appeals Tribunal, a statement in writing signed by him, giving particulars of the—

(a) proceedings before him in relation to the matter in issue;

(b) the grounds for any decision given by him in relation to that matter;

(c) the practice of the Trademarks Office in like cases; or

(d) such other matters relevant to the issues, and within his knowledge as Registrar, as considers appropriate,

and the statement shall be deemed to form part of the evidence in the proceeding.

71. In any appeal from a decision of the Registrar to the Appeals Tribunal, the Appeals Tribunal shall in adjudicating on the matter, have and exercise the same discretionary powers as are conferred upon the Registrar under this Act .

Discretion of
the Appeals
Tribunal

72.—(1) When an appellant or a party to proceedings before the Registrar or the Appeals Tribunal is resident outside Malawi, the Registrar or the Appeals Tribunal may direct the appellant or party to give security, within such time as may be directed, for the costs of the proceedings or appeal.

Security for
costs

(2) If the appellant or a party is ordered to give security for costs and fails to do so within the time directed, the Registrar or the Appeals Tribunal may treat the proceedings or appeal as abandoned.

(3) Where a bond is to be given as security for costs, it shall, unless the Registrar or the Appeals Tribunal otherwise directs, be given to the party requiring the security.

(4) Unless otherwise agreed between the parties, any costs awarded in terms of section 73 shall be taxed by the Registrar of Trademarks in accordance with rules made under this Part.

(5) The taxation shall be subject to appeal to the Appeals Tribunal, and any such costs may be recovered by action in a court of competent jurisdiction.

Power to
award and tax
costs

73.—(1) In all proceedings before the Registrar under this Act, the Registrar shall have power to award to any party, such costs as he may consider reasonable and to direct how the payment is to be made.

(2) Any costs awarded by the Registrar shall be taxed by the Registrar and payment thereof may be enforced in the same manner as if they were costs allowed by the Appeals Tribunal.

PART XI—TRADEMARK AGENTS

Trademark
agents

74.—(1) Subject to subsection (2), where an act has to be done under this Act by a person in connection with the registration of a trademark, geographical indication, collective mark, certification mark or of any other thing which may be done under this Act, such person may either do it himself or through a trademark agent.

(2) Where an applicant's ordinary place of residence or principal place of business is outside Malawi, he shall be represented by a trademark agent resident and entitled to act as such in Malawi.

(3) A person shall be qualified to act as a trademark agent if the person is resident in Malawi and—

(a) is a legal practitioner entitled to practice in the High Court of Malawi; or

(b) is admitted to practice as a trademark agent before the Institute of Patents and Trademark Agents of Malawi.

Trademark
agents
register

75.—The Registrar shall keep a register of trademark agents in Malawi and may remove from the register of trademark agents, the name of any trademark agent upon proof to the Registrar's satisfaction, that the trademark agent has—

(a) died;

(b) become of unsound mind;

(c) been adjudged or otherwise declared bankrupt or insolvent under any law, or has made an assignment to or composition with his creditors;

(d) ceased to reside or maintain a place of business in Malawi;

(e) applied for his name to be so removed from the register;

(f) been convicted, in Malawi or elsewhere, of an offence and sentenced to serve a term of imprisonment without the option of a fine, whether such sentence is suspended or not; or

(g) having been entitled to practise as a trademark agent, has ceased to be so entitled, or to practice as such.

PART XII—MISCELLANEOUS

76.—(1) Where the relations between two or more persons interested in a trademark are such that none of them is entitled, as between himself and the other, or others, to use it except— Jointly owned trademarks

(a) on behalf of both, or all of them; or

(c) in relation to an article with which both or all of them are connected in the course of trade,

those persons may be registered as joint owners of the trademark, and this Act shall have effect in relation to any rights to the use of the trademark 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 authorize the registration of two or more persons who use a trademark independently, or propose so to use it, as joint owners thereof.

77.—(1) Any application, notice or document authorized or required under this Act to be lodged, made or given at the Trademarks Office, the Registrar or any other person, may be delivered by hand, sent electronically or by registered post. Lodging and authentication of documents

(2) The Minister may make regulations for the lodging and authentication of documents sent electronically.

78.—(1) Where under this Act, a fee is payable in respect of— Fees

(a) performance of any act by the Registrar, the Registrar shall not perform that act until the fee has been paid;

(b) 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) lodging of a document, the document shall be deemed not to have been lodged until the fee has been paid.

(2) All fees shall be paid at the Trademarks Office in such manner as the Registrar, with the approval of the Minister, may prescribe.

79. Any person who is required under this Act to take any oath or swear to the truth of any affidavit may, in lieu thereof, make an affirmation or declaration in accordance with the Oaths, Affirmations and Declarations Act. Oaths and affirmation

Trademarks
Journal

80.—(1) The Registrar shall publish the Trademarks Journal at least once every month.

(2) When publishing the Trademarks Journal, the Registrar shall ensure that the Journal uses Internationally Agreed Numbers for Identification of Data.

(3) The Trademarks Journal shall contain the following information—

- (a) particulars of applications for registration of trademarks;
- (b) particulars of applications accepted by the Registrar;
- (c) rulings made by the Registrar;
- (d) notices of opposition to trade mark applications; and
- (e) any other matters arising under this Act.

(4) The Registrar shall sell copies of the Trademarks Journal at such price and in such a manner as the Minister may prescribe.

Regulations

81.—(1) The Minister may make regulations prescribing anything which, under this Act is to be prescribed and generally, for the implementation of this Act.

(2) Notwithstanding the generality of subsection (1), regulations made by the Minister may provide for—

- (a) the service of documents;
 - (b) classification of goods or services for the purposes of registration of trademarks;
 - (c) prohibition of the registration of any mark on the grounds of morality, public policy or other good and sufficient reason;
 - (d) making or requiring duplicate representations of trademarks and other documents;
 - (e) security and regulation of the publication and sale or distribution of copies of trademarks and other documents;
 - (f) fees which may be charged in relation to the conduct of trademark business by trademark agents;
 - (g) the professional conduct of trademark agents;
 - (h) the notification of the registration of a person as a licensee;
 - (i) procedures for the international registration of trademarks;
- and
- (h) the business of the Trademarks Office.

(3) The Minister shall also prescribe fees which shall be payable in respect of any application, registration and other matters under this Act and the fees shall be payable as so prescribed.

(4) Notwithstanding section 21 of the General Interpretation Act, regulations made pursuant to this section may provide for offences whose penalties may not exceed a fine of K1,000,000.00 and imprisonment for three years. Cap. 1:01
Cap 1:01

82. The Trademarks Act is hereby repealed. Repeal of
Cap. 49:01

83.—(1) Trademarks registered under the repealed Trademarks Act shall remain in force until their expiry and shall be deemed to have been registered under this Act. Savings

(2) Trademarks already registered and due for renewal shall, on renewal, be reclassified in accordance with international classification as provided under this Act.

(3) The Registrar may, in case of trademarks registered in Part B of the Register under the repealed Trademarks Act, and on application by the owner of such trademark and who, having shown that the mark has acquired distinctiveness through use, register that mark in the Register.

(4) Any regulations made under the repealed Trademarks Act shall, unless inconsistent with the provisions of this Act, remain in force and shall have the same effect as if they were made under this Act.

(5) Any document referring to any provision of the repealed Trademarks Act shall be construed as referring to the corresponding provision of this Act.

FIRST SCHEDULE

s.40

CERTIFICATION MARKS RULES ARRANGEMENT OF RULES

PARAGRAPHS

1. Application for registration
2. Submission of draft rules
3. Rules to indicate use of certification marks
4. Acceptance of rules
5. Factors to be considered on registration of certification marks
6. Certification marks not to be registered in certain cases
7. Advertisement of an application

PARAGRAPHS

8. Certification mark not to be registered without rules
 9. Alteration of rules
 10. Alteration of rules to be advertised
 11. Variation of rules
 12. Registrar with no authority to award costs for refusal for use of certification mark
 13. Certification mark not assignable
 14. Revocation of certification mark
- Application for registration
1. An application for the registration of a certification mark under section 40 shall be made in writing in the prescribed form to the Registrar by a person proposed to be registered as the owner thereof.
- Submission of draft rules
2. On application, an applicant for the registration of a certification mark under section 40 shall transmit to the Registrar, draft rules for governing the use thereof at such time, as the Registrar may require in order to enable him to consider the draft, before the Registrar makes a decision on the application.
- Rules to indicate use of certification marks
3. The rules submitted pursuant to paragraph 2, shall indicate;—
 - (a) persons authorized to use a mark;
 - (b) the characteristics to be certified by the mark;
 - (c) how a certifying body is to test those characteristics and to supervise the mark;
 - (d) the fees, if any, to be paid in connection with the operation of the mark; and
 - (e) the procedure for resolving disputes relating to the mark..
- Acceptance of rules
4. The Registrar may refuse an application or may accept it and approve the rules in whole, or subject to any conditions, limitations, amendments or modifications of the application of the rules, which he considers appropriate.
- Factors to be considered on registration of certification marks
5. In dealing with an application under section 40, the Registrar, or the Appeals Tribunal in the event of an appeal from a decision of the Registrar, shall have regard to like consideration, so far as relevant, as if the application were an application made under section 7 and to any other considerations relevant to applications under section 40, including the desirability of securing that a certification mark shall comprise some indication that it is such a certification mark, and including whether—

- (a) the applicant is competent to certify the goods in respect of which the mark is to be registered;
- (b) the draft rules comply with paragraph (3) and are not contrary to public policy or morality; and
- (c) in all circumstances, the registration applied for would be in the public interest.
6. A certification mark shall not be registered if the owner carries on a business involving the supply of goods or services of the kind certified. Certification marks not to be registered in certain cases
7. When an application has been accepted, the applicant shall, as soon as possible thereafter, advertise the application as accepted in the prescribed manner, and section 9 shall have effect in relation to the registration of the mark as if the application had been an application under section 7. Advertisement of an application
8. A certification mark shall not be registered unless the regulations governing the use of the mark have been deposited together with the application to register the mark Certification mark not to be registered without regulations
9. The rules deposited in respect of a certification mark may, on application by the registered owner, be altered by the Registrar. Alteration of rules
10. The Registrar may direct that an application for an alteration under rule 9 shall be advertised in any case where it appears to him that it is expedient so to do, and where an application has been so advertised, if within the prescribed time from the date of the advertisement, any person gives notice to the Registrar of opposition to the application, the Registrar shall not decide the matter without giving the parties an opportunity to be heard. Alteration of rules to be advertised
11. On application, in the prescribed form by any aggrieved person or on his own motion, the Registrar may make such order as he considers appropriate for removing or varying any entry in the Register relating to a certification mark or for varying the deposited rules on the ground that— Variation of rules
- (a) the owner is no longer competent, in the case of any of the goods or services in respect of which the certification mark is registered, to certify those goods or services;
- (b) the owner has failed to observe a provision of the deposited rules;
- (c) it is no longer to the public interest that the certification mark should be registered; or

- (d) that it is requisite for the public interest that, if the certification mark remains registered, the rules should be varied.
12. Notwithstanding anything in section 73, the Registrar shall not have any jurisdiction to award costs to, or against any party on an appeal to him against a refusal of the owner of a certification mark to certify goods or services or to authorize the use of the trade mark.
13. A certification mark shall not be assignable or transmissible otherwise than with the consent of the Registrar
14. The registration of a certification mark may be revoked on the ground that—
- (a) the owner has begun to carry on a business involving the supply of goods or services of the kind certified;
- (b) the manner in which the certification mark has been used by the owner has caused it to become liable to mislead the public by its character or significance, in particular, if it is likely to be taken as something other than a certification mark;
- (c) the owner has failed to observe or to secure the observance of the rules governing the use of the certification mark;
- (d) an amendment of the rules has been made so that the rules no longer comply with paragraph 3 or are contrary to public policy or morality; or
- (e) the owner is no longer competent to certify the goods or services for which the mark is registered.

Registrar with
no authority
to award
costs for
refusal of use
of trade mark

Certification
mark not
assignable

Revocation of
certification
mark

SECOND SCHEDULE

s. 58

INTERNATIONAL INSTRUMENTS TO WHICH MALAWI IS A PARTY

1. The Banjul Protocol on Marks Within the Framework of the African Regional Intellectual Property Organization (ARIPO), as revised from time to time.
2. The Paris Convention for the Protection of Industrial Property, as revised from time to time.
3. The Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks, as revised from time to time.
4. The Vienna Agreement Establishing the Classification of the Figurative Elements of Marks as revised from time to time.
5. The Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks.

THIRD SCHEDULE

s. 60

INTERNATIONAL REGISTRATION OF MARKS UNDER THE AFRICAN REGIONAL
INTELLECTUAL PROPERTY ORGANIZATION (ARIPO) BANJUL PROTOCOL ON MARKS

PARAGRAPHS

1. Interpretation
2. Application for registration
3. Verification of particulars in application
4. Examination of application
5. Notification of designation for registration and refusal
6. Publication of acceptance of registration of a mark and opposition
7. Cancellation of registration
8. Form and procedure for registration to be in accordance with regulations

1. In this Schedule, unless the context otherwise requires— Interpretation
 “ARIPO Journal” means the Journal published by the Office;
 “Office” means the African Regional Intellectual Property Organization (ARIPO); and
 “Protocol” means the African Regional Intellectual Property Organization (ARIPO) Banjul Protocol On Marks.

2.—(1) All applications for the registration of a mark under the Protocol shall be filed either directly with the Office or with the Trademarks Office. Application for registration

(2) Where an application is filed with the Trademarks Office, the Trademarks Office shall transmit the application to the Office within thirty days of receiving the application.

(3) An applicant shall be represented by a trademarks agent where an application is filed with the Trademarks Office but the applicant’s principal place of business or ordinary residence is not in Malawi.

3.—(1) The application made pursuant to paragraph 2 shall indicate the goods or services in respect of which protection of a mark is claimed, including the corresponding class or classes provided for under the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks. Verification of particulars in application

(2) The Trademarks Office shall check that the applicant has made an indication of the class or classes and that indication is correct and where the applicant does not give such indication or the

indication is not correct, the Office shall classify the goods or services under the appropriate class or classes of the Nice Agreement on payment of a classification fee.

Examination of application 4. An application for registration of a mark in which Malawi is a designated state shall be examined in accordance with this Act.

Notification of designation for registration and refusal 5.—(1) Where the Trademarks Office is notified that Malawi is a designated state, the Trademarks office may, before the expiration of twelve months from the date of the notification, make a written communication to the Office that, that if a mark is registered by the Office, that registration shall have no effect in Malawi on the basis of any grounds, both absolute and relative, including the existence of third party rights.

(2) Where the Trademarks Office makes the notification under subparagraph (1) it shall give reasons for the refusal.

(3) The Trademarks Office shall give an applicant an opportunity to respond to the communication in subparagraph (1) and accord the applicant an opportunity to be heard on appeal in accordance with Part X of the Act.

Publication of acceptance of registration of a mark and opposition 6.—(1) An application in which Malawi is a designated state which is accepted by the Trademarks Office shall be registered by the Office and published as accepted by Malawi in the ARIPO Journal.

(2) Any person may, after the publication under subparagraph (1) but before the registration of a mark, give a notice of opposition to the application for registration in Malawi.

(3) The opposition made under subparagraph (2) shall be in accordance with section 10 of the Act.

4) The Trademarks Office shall transmit to the Office, an opposition made at any time after publication of a mark in the Marks Journal where Malawi is designated, but before registration.

(5) The opposition to the application made pursuant to subparagraph (4) shall be in accordance with section 10 of the Act.

Cancellation of registration 7.—(1) Section 9 shall apply on cancellation of a registration of a mark in Malawi whether based on non-use or any other grounds.

(2) Where registration has been cancelled, the Trademarks Office shall, within one month of cancellation, notify the Office which shall publish this fact in the ARIPO Journal.

Procedure for registration 8. All other procedures relating to the process of registration of a mark where Malawi has been designated shall be in accordance with the regulations made by the Administrative Council.

FOURTH SCHEDULE

s. 61

INTERNATIONAL REGISTRATION OF MARKS UNDER THE PROTOCOL RELATING TO THE
MADRID AGREEMENT CONCERNING THE INTERNATIONAL REGISTRATION OF MARKS

PARAGRAPHS

PART I—PRELIMINARY

1. Interpretation
2. Language of communication

PART II—APPLICATION FOR INTERNATIONAL REGISTRATION

3. Application and examination of international application in respect of which the Trademarks Office is the office of generation
4. Verification of particulars in an application
5. Certification
6. Handling fee
7. Ceasing of effect of basic application or basic registration

PART III—INTERNATIONAL REGISTRATION IN RESPECT OF WHICH
MALAWI IS DESIGNATED AS A CONTRACTING PARTY

8. Statement of grant of protection
9. Provisional refusal of protection
10. Advertisement and opposition of application
11. Provisional refusal based on an opposition
12. Final decision following notification of a provisional refusal
13. Further decision affecting protection of a mark
14. Effect of international registration
15. Invalidation of international registration
16. Recordings in the International Register
17. Collective and certification marks
18. Replacement of registration
19. Transformation
20. Regulations on the international registration of marks
21. Conflict between this Act and the Madrid Protocol

PART I—PRELIMINARY

1. In this Schedule, unless the context otherwise requires— Interpretation
 “applicant” means a natural person or legal entity in whose name an international application is filed;
 “basic application” means an application for registration of a mark, filed with the Registrar under the Act, and which is used as

a basis for the filing of an international application under the Madrid Protocol;

“basic registration” means a mark registered by the Registrar under this Act, and which is used as the basis for the filing of an international application under the Madrid Protocol;

“Common Regulations” means the Common Regulations under the Madrid Agreement and the Madrid Protocol promulgated by the World Intellectual Property Organization (WIPO);

“Contracting Party” means any country or intergovernmental organization which is a party to the Madrid Protocol or any country party to both the Madrid Agreement and the Madrid Protocol;

“designated Contracting Party” is the Contracting Party to the Madrid Protocol that is designated in the international application or in the subsequent designation;

“holder” means a natural person or legal entity in whose name an international registration is recorded in the International Register;

“International application” means an application to obtain registration of a mark under the Madrid Protocol filed through the Trademarks Office as the Office of origin;

“International Bureau” means the International Bureau of WIPO;

“international registration” means a trade mark registration effected under the Madrid Agreement or the Madrid Protocol or both, as the case may be;

“International Register” means the official collection of data concerning international registrations of marks maintained by the International Bureau;

“invalidation” means a decision by the competent authority, whether administrative or judicial, of Malawi revoking or cancelling the effects, in the territory of Malawi, of an international registration with regard to all or some of the goods or services covered by the designation of Malawi;

“Madrid Agreement” means the Madrid Agreement Concerning the International Registration of Marks of April 14, 1891, as revised at Stockholm on July 14, 1967, and amended on September 28, 1979;

“Madrid Protocol” means the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks, adopted in Madrid, Spain, on June 27, 1989;

“office of origin” means the intellectual property office of a Contracting Party where the international application was filed;

“subsequent designation” means the request for extension of protection (“territorial extension”) under Article 3ter(2) of the Madrid Protocol and includes such designation as recorded in the International Register, and “WIPO” means the world intellectual property organisation.

2. Any communication, including an international application, for transmission to the International Bureau through the office of the Registrar, shall be in English.

Language of communication

PART II—APPLICATION FOR INTERNATIONAL REGISTRATION

3.—(1) A person seeking international registration of a trademark, shall file a basic application with the Registrar for transmittal to the International Bureau.

Application and examination of international applications in respect of which the Trademarks Office is the office of origin

(2) Where an international application is filed with the Registrar for transmittal to the International Bureau, the Registrar shall verify that the Trademarks Office be considered as the office of origin in respect of that application, and that the relevant particulars appearing in the international application correspond to the relevant particulars appearing in the basic application or basic registration, as the case may be, in accordance with the provisions of the Madrid Protocol and the Common Regulations.

4.—(1) Where an international application is filed with the Trademarks Office for transmission to the International Bureau, the Trademarks Office shall verify that Malawi qualifies as the country of origin under the Madrid Protocol in respect of that application, and that the particulars appearing in the international application corresponds to the relevant particulars appearing in the basic application or basic registration, as the case may be, in accordance with the provisions of the Madrid Protocol and the Common Regulations.

Verification of particulars in an application

(2) Where the international application complies with the prescribed requirements, the Trademarks Office shall so certify in the application indicating the date on which it was received, and shall, upon payment of the prescribed handling fee by the applicant, forward the application to the International Bureau.

(3) Where the international application does not meet the prescribed requirements, the Trademarks Office shall not forward it to the International Bureau, and shall inform the applicant accordingly.

Certification 5.—(1) Where an international application complies with the prescribed requirements, the Registrar shall certify the international application, indicating the date on which the international application was received, and shall forward the international application to the International Bureau.

(2) Where the international application does not comply with the prescribed requirements, the Registrar shall not forward the international application to the International Bureau, and shall inform the applicant accordingly.

Handling fee 6. An applicant shall pay the prescribed handling fee to the Registrar for the certification and transmittal to the International Bureau of an international application originating in Malawi.

Ceasing of effect of basic application or basic registration 7. Where, in accordance with Article 6 of the Madrid Protocol, a basic application the registration resulting from such application, or basic registration, ceases to have effect, the Registrar shall inform the International Bureau accordingly and shall request the cancellation of the international registration in respect of the goods and services affected.

PART III—INTERNATIONAL REGISTRATION IN RESPECT OF WHICH MALAWI IS A DESIGNATED CONTRACTING PARTY

Statement of grant of protection 8. Where an application for international registration of a trademark is received by the Trademarks Office from the International Bureau and all procedures before the Registrar have been completed and there is no ground for the Registrar to refuse protection, the Registrar shall, as soon as possible and before the expiry of the refusal period applicable under Article 5 of the Madrid Protocol, send to the International Bureau a statement to the effect that protection is granted to the mark in Malawi.

Provisional refusal of protection 9.—(1) Where the Registrar finds that, in accordance with the Act, the mark that is the subject of an international registration designating Malawi cannot be protected, the Registrar shall, before the expiry of the refusal period applicable under Article 5 of the Madrid Protocol, notify to the International Bureau of a provisional refusal of protection, complying with the requirements of the Madrid Protocol and the Common Regulations.

(2) The holder of the international registration shall enjoy the same remedies as if the mark had been filed for registration directly with the Registrar.

10.—(1) Where Malawi has been designated in an international registration, the Registrar shall advertise the international registration as provided in the Act.

Advertisement and opposition of application

(2) Opposition to the international registration shall be in accordance section 10 of the Act *mutatis mutandis*.

11.—(1) Where an opposition is filed with the Registrar in respect of an international registration designating Malawi, the Registrar shall, before the expiry of the refusal period applicable under Article 5 of the Madrid Protocol, notify that fact to the International Bureau as a provisional refusal based on an opposition, in accordance with the provisions of the Madrid Protocol and the Common Regulations.

Provisional refusal based on an opposition

(2) The holder of the international registration concerned shall enjoy the same remedies as if the mark had been filed for registration directly with the Registrar.

12.—(1) Where the Registrar has notified to the International Bureau of a provisional refusal of protection in accordance with paragraphs 9 or 11 and all the procedures before the Trademarks Office have been completed, and the provisional refusal has been either totally or partially withdrawn, the Registrar shall send to the International Bureau, either—

Final decision following notification of a provisional refusal

(a) a statement to the effect that the provisional refusal has been withdrawn and that protection of the mark is granted in Malawi for all the goods and services for which protection has been requested; or

(b) a statement indicating the goods and services for which protection of the mark is granted in Malawi.

(2) Where the Registrar after having sent to the International Bureau a notification of total or provisional refusal in accordance with paragraphs 9 or 11, and all the procedures before the Trademarks Office having been completed, the Registrar decides to confirm such refusal of protection of the mark in Malawi for all the goods and services for which protection has been requested, the Registrar shall send to the International Bureau, a statement to that effect.

13. Where, following the sending of a statement in accordance with paragraph 11, there is a further decision which affects the protection of a mark in Malawi, the Registrar shall, to the extent that the Registrar is aware of that decision, send to the International Bureau a further statement indicating the goods and services for which the mark is protected in Malawi.

Further decision affecting protection of a mark

- Effect of an international registration
- 14.—(1) An international registration designating Malawi shall have the same effect, as from the date of the international registration, as if an application for the registration of the mark had been filed directly with the Registrar under this Act.
- (2) If —
- (a) no refusal is notified by the Registrar to the International Bureau in accordance with the Madrid Protocol and the Common Regulations;
- (d) a refusal has been so notified but has been subsequently withdrawn; or
- (c) a statement of grant of protection is sent by the Registrar, the protection of the mark in Malawi shall be the same as if the mark had been registered directly by the Registrar on the date of the international registration.
- Invalidation of international registration
15. Where the effect of an international registration is invalidated in Malawi and the invalidation is no longer subject to appeal, the Registrar shall notify the International Bureau in accordance with the relevant provisions of the Madrid Protocol and the Common Regulations:
- Provided that the Registrar is aware of that decision.
- Recordings in the International Register
16. Any recording made in the International Register in respect of an international registration, shall, to the extent that it applies to Malawi as a designated Contracting Party, have the same effect as if it had been recorded by the Registrar in the Register.
- Collective and certification marks
17. Where an international registration designating Malawi is a collective mark or a certification mark, the rules governing the use of such collective mark or certification mark shall be submitted directly, by the holder of that international registration, to the Registrar, within the prescribed time limit.
- Replacement
- 18.—(1) Where—
- (a) a mark registered in Malawi is also the subject of an international registration, and the protection resulting therefrom extends to Malawi;
- (b) the same person is recorded as holder of the registration in Malawi and of the international registration;
- (c) all the goods and services listed in the registration in Malawi are also listed in the international registration of a trademark in respect of Malawi, and
- (d) the extension of that international registration to Malawi took effect after the date of registration of the mark in Malawi,

the holder of the international registration may request the Registrar to take note of that international registration in the register.

(2) A request filed with the Registrar in accordance with paragraph 1 shall be made in the prescribed form and accompanied by the prescribed fees.

(3) Where the Registrar has taken note of an international registration in accordance with sub paragraph (1)(a), the Registrar shall notify the International Bureau accordingly.

(4) The notification in paragraph (3) shall indicate the following—

(a) the number of the international registration in question;

(b) where only some of the goods and services listed in the international registration are concerned, those goods and services;

(c) the filing date and number of the application for registration of the mark in Malawi;

(d) the registration date and number of the registration in Malawi;

(e) the priority date, if any, of the registration in Malawi; and

(f) information relating to other rights acquired by virtue of the registration in Malawi.

19.—(1) Where an international registration designating Malawi Transformation is cancelled at the request of the office of origin in accordance with Article 6(4) of the Madrid Protocol, in respect of all or some of the goods and services listed in the international registration, the holder of the trademark which was the subject of the international registration may, within ninety days from the date on which the international registration was cancelled, make an application to the Registrar for registration of the same trademark in respect of an application for goods and services covered by the list of goods and services contained in the international registration for which protection has been requested in Malawi.

(2) Subject to subparagraphs (3) and (4), the provisions applicable to a trademark application filed directly with the Registrar shall apply *mutatis mutandis* to an application resulting from transformation.

(3) An application resulting from transformation shall be made in the prescribed form and shall, in addition, include the following—