

**TRADE MARKS IN SOUTH WEST AFRICA ACT
NO. 48 OF 1973**

[ASSENTED TO 24 MAY, 1973]

[DATE OF COMMENCEMENT: 1 JANUARY, 1974]

(Unless otherwise indicated)

(English text signed by the State President)

ACT

To provide for the registration of trade marks and certification marks in the territory of South West Africa and to provide for incidental matters.

INTRODUCTORY

1. Division of Act into parts.—This Act is divided into seventeen parts which relate to the following matters respectively:

- PART I. Administration (sections 5 to 9).
- PART II. Registrable Trade Marks (sections 10 to 19).
- PART III. Application for Registration (sections 20 to 25).
- PART IV. Opposition (sections 26 to 30).
- PART V. The Register of Trade Marks (sections 31 to 36).
- PART VI. Registration and its Effects (sections 37 to 42).
- PART VII. Infringement (sections 43 to 46).
- PART VIII. Duration and Renewal of Registration (section 47).
- PART IX. Registered Users (section 48).
- PART X. Assignment (sections 49 to 51).
- PART XI. Certification Marks (section 52).
- PART XII. Defensive Trade Marks (section 53).
- PART XIII. Powers and Duties of Registrar (sections 54 to 58).
- PART XIV. Evidence (sections 59 to 62).
- PART XV. Appeals to and Powers of the Court (sections 63 to 69).
- PART XVI. Offences (sections 70 to 72).
- PART XVII. Miscellaneous (sections 73 to 84).

2. Definitions.—(1) In this Act, unless the context otherwise indicates—

“agent” means a person who, in terms of this Act, is entitled to represent another person;

“assignment” means assignment by act of the parties concerned, and “assign” or “assignable” has a corresponding meaning;

“certification mark” means a mark registered or deemed to have been registered under section 52;

“court” means the South-West Africa Division of the Supreme Court of South Africa;

“**device**” means any visual representation or illustration capable of being reproduced upon a surface, whether by printing, embossing or by any other means;

“**legal practitioner**” means an attorney of the Supreme Court of South Africa or an advocate of such Court duly instructed by an attorney or agent to appear before the registrar or his deputy;

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

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

“**Minister**” means the Minister of Economic Affairs;

“**permitted use**” means the permitted use referred to in section 48 (1);

“**prescribed**” means prescribed by or under this Act;

“**register**” means the register of trade marks for South West Africa referred to in section 31;

“**registered trade mark**” means a trade mark registered or deemed to be registered under this Act;

“**registered user**” means a person who is for the time being registered as such under section 48;

“**registrar**” means the registrar of trade marks for South West Africa referred to in section 6 (1);

“**regulation**” means any regulation made and in force under this Act;

“**repealed law**” means those provisions of the Patents, Designs and Trade Marks Proclamation, 1923, which relate to trade marks and which are repealed by this Act;

“**territory**” means the territory of South West Africa;

“**this Act**” includes the regulations;

“**trade mark**”, other than a certification mark, means a mark used or proposed to be used in relation to goods or services for the purposes of—

- (a) indicating a connection in the course of trade between the goods or services and some person having the right, either as proprietor or as a registered user, to use the mark, whether with or without an indication of the identity of that person; and
- (b) distinguishing the goods or services in relation to which the mark is used or proposed to be used, from the same kind of goods or services connected in the course of trade with any other person;

“**transmission**” means transfer by operation of law, devolution on the executor of a deceased person and any other mode of transfer not being assignment, and “**transmit**” or “**transmissible**” has a corresponding meaning.

(2) References in this Act to the use of a mark shall be construed as references to the use of a printed or other visual representation of the mark, and in addition, in the case of a container, use of such container and, in the case of a mark which is capable of being audibly reproduced, the use of an audible reproduction of the mark.

(3) (a) References in this Act to the use of a mark in relation to goods shall be construed as references to the use thereof upon, or in physical or other relation to, goods.

(b) References in this Act to the use of a mark in relation to services shall be construed as references to the use thereof in any relation to the performance of such services.

3. Application of this Act to trade marks registered under the repealed law.—(1) Subject to the provisions of section 80, this Act shall apply to trade marks registered or deemed to be registered under the repealed law and such trade marks shall be deemed to be registered in part A of the register.

(2) Subject to the provisions of subsection (1), all applications and proceedings commenced under the repealed law shall be dealt with in accordance with the provisions of that law: Provided that, in the case of an application for the registration of a trade mark, the registrar may upon a request by the applicant treat the application as an application for registration in part B of the register.

4. Act binds Administration.—This Act shall bind the Administration of the territory.

PART I

ADMINISTRATION

5. Establishment of trade marks office.—(1) There shall be established an office to be called the trade marks office for South West Africa.

(2) If the Minister deems it expedient, the said office may be established outside the territory at a place determined by him.

(3) Any place at which the said office is established under subsection (2) shall for the purposes of the jurisdiction conferred upon the court by this Act be deemed to be situated within the area of jurisdiction of the court, and any offence under this Act committed at such place or at any other place outside the territory where proceedings under this Act are heard and determined by the registrar in terms of section 54, may, notwithstanding the provisions of any other law, be tried by the magistrate's court of the district in which the place in question is situated.

6. Registrar of trade marks for South West Africa.—(1) There shall be an officer styled the registrar of trade marks for South West Africa who shall be appointed subject to the laws governing the public service and who shall, subject to the directions of the Minister, have overall control of the trade marks office for South West Africa.

(2) There may similarly be appointed a deputy registrar and an assistant registrar of trade marks for South West Africa, who shall, subject to the control of the registrar, have all the powers conferred by this Act on the registrar and who shall, whenever the registrar is for any reason unable to fulfil his duties, act temporarily in his stead.

7. Seal of trade marks office for South West Africa.—There shall be a seal of the trade marks office for South West Africa and the impression of the seal shall be judicially noticed.

8. Who may act as trade mark agent.—(1) The registrar shall permit an agent to do on behalf of the person for whom he is agent any act in connection with registration under this Act or any proceedings relating thereto: Provided that no person other than a legal practitioner or a person whose name has been entered in the register contemplated in subsection (2) shall be permitted so to act.

(2) The registrar may in writing authorize any person who, in the opinion of the registrar, is suitably qualified and who is not by virtue of the fact that he is a legal practitioner entitled to act as an agent contemplated in subsection (1), to act as such an agent, and shall keep in the trade marks office for South West Africa a register in which shall be entered the names and addresses of all persons so authorized by him.

9. Unqualified persons not to practise as trade mark agents.—(1) No person may on behalf of any other person perform any act in connection with any registration under this Act or any proceedings relating thereto, or for gain furnish advice in relation to such registration or proceedings, or describe himself as a trade mark agent for the purposes of this Act or hold himself out, or permit himself to be described or held out, as a person who is entitled to undertake the work of a trade mark agent for the purposes of this Act, unless he is a legal practitioner or a person whose name has been entered in the register referred to in section 8 (2).

(2) Any person who contravenes the provisions of subsection (1) shall be guilty of an offence and liable on conviction to a fine not exceeding two hundred rand.

PART II

REGISTRABLE TRADE MARKS

10. Essential particulars of trade marks registrable in part A of register.—(1) In order to be registrable in part A of the register, a trade mark (other than a certification mark) shall contain or consist of a distinctive mark.

(2) A mark which is reasonably required for use in the trade shall not be registrable.

(3) The name of a company, individual or firm not represented in a special or particular manner, a signature other than that of the applicant for registration or of some predecessor in his business, or a word being in its ordinary signification a surname, shall not be registered unless it is proved that it is distinctive.

(4) No registration of a container in terms of subsection (1) shall prevent the *bona fide* use by others of any utilitarian or functional feature embodied in such container.

(5) The registration of a container in terms of subsection (1) may, upon application to the court or, at the option of the applicant and subject to the provisions of section 69, to the registrar by any person interested, be expunged by the court or the registrar, as the case may be, if it is established that the registration is or has become likely to limit the development of any art or industry.

11. Requisites for registration of a trade mark in part B of the register.—(1) In order to be registrable in part B of the register, a trade mark shall, in relation to the goods or services in respect of which it is proposed to be registered, be capable of becoming registrable, through use, in part A of the register in respect of such goods or services.

(2) A trade mark may be registered in part B of the register notwithstanding the registration in part A of the register in the name of the same proprietor of the same trade mark or any part or parts thereof.

12. Meaning of “distinctive”.—(1) For the purposes of section 10 “distinctive” means adapted, in relation to the goods or services in respect of which a trade mark is registered or proposed to be registered, to distinguish goods or services with which the proprietor of the trade mark is or may be connected in the course of trade from goods or services in the case of which no such connection subsists, either generally or, where the trade mark is registered or proposed to be registered subject to limitations, in relation to use within those limitations.

(2) In determining whether a trade mark is distinctive as aforesaid, regard may be had to the extent to which—

- (a) the trade mark is inherently adapted to distinguish; and
- (b) by reason of the use of the trade mark or by reason of any other circumstance, the trade mark is or has become adapted to distinguish.

13. Registration to be in respect of particular goods or classes of goods.—(1) A trade mark shall be registered in respect of a particular class or particular classes of goods or services or in respect of goods or services falling in such class or classes in accordance with the prescribed classification.

(2) Where a trade mark has, either before or after the commencement of this Act, been registered in accordance with the requirements of subsection (1) and, during the subsistence of such registration, the prescribed classification in accordance with which the trade mark was registered as aforesaid is revised or substituted by a new classification, the proprietor of the trade mark shall, upon the renewal of the registration thereof in terms of section 47, apply in the prescribed manner for revision of the class or classes in which the trade mark is registered so as to bring it into conformity with the revised or substituted classification.

(3) If the revised or substituted classification referred to in subsection (2) results in two or more identical trade marks owned by the same proprietor which were under the previous registration registered in separate classes, falling within a single class, such marks shall, if they have the same registration date, be consolidated as one registration in the revised or substituted class, or if as a result of the revised or substituted classification a trade mark is required to be recorded in more than one class, such mark shall be deemed to be separately registered in each class in which the mark is so recorded and shall be treated as a separate trade mark for the purposes of renewal thereof in each class.

14. What registrable trade mark may not contain.—The registrar may refuse to register a trade mark which contains any of the following:

- (a) the arms or seal of the territory; or
- (b) any word, letter or device indicating Government patronage; or
- (c) any mark specified in the regulations as being a prohibited mark for the purposes of this section.

15. Name or representation of person.—Where application is made for registration of a trade mark which consists of or includes the name or any representation of a person, the registrar may require the applicant to furnish him with the consent of that person or, where such person is deceased, of his or her legal representative, to the name or representation appearing in the trade mark.

16. Prohibition of registration of certain matter.—(1) It shall not be lawful to register as a trade mark or part of a trade mark any matter the use of which would be likely to deceive or cause confusion or would be contrary to law or morality or would be likely to give offence or cause annoyance to any person or class of persons or would otherwise be disentitled to protection in a court of law.

(2) If, in the opinion of the registrar, a trade mark will, in use, be likely to deceive as to the character or quality of some, but not all, of the goods or services included in the specification, the registrar may, notwithstanding the provisions of subsection (1) and of section 36, upon receipt of an undertaking by the proprietor of the trade mark that he will limit the use of the trade mark to goods or services in relation to which such use will, in the opinion of the registrar, not be likely to deceive, register the trade mark in respect of all the goods or services included in the specification.

17. Prohibition of registration of trade marks resembling each other.—(1) Subject to the provisions of subsection (2), no trade mark shall be registered if it so resembles a trade mark belonging to a different proprietor and already on the register that the use of both such trade marks in relation to goods or services in respect of which they are sought to be registered, and registered, would be likely to deceive or cause confusion.

(2) In the case of honest concurrent use or of other special circumstances which may make it proper to do so, the registrar may, on application in the prescribed manner, register, subject to such conditions and limitations, if any, as he may think it right to impose, trade marks the registration of which would otherwise be in contravention of the provisions of subsection (1).

(3) When separate applications are made by different persons to be registered as proprietors respectively of trade marks that so resemble each other that the use of such trade marks in relation to goods or services in respect of which they are respectively sought to be registered would be likely to deceive or cause confusion, the registrar may refuse to register any of them until the rights of those persons have, upon application in the prescribed manner, been determined by him, or have been settled by agreement in a manner approved by him.

18. Registration subject to disclaimer.—If a trade mark—

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

the registrar or the court, in deciding whether the trade mark shall be entered or shall remain on the register, may require, as a condition of its being entered or remaining on the register—

- (i) that the proprietor shall disclaim any right to the exclusive use of any such part of the trade mark, or to the exclusive use of all or any portion of any such matter as aforesaid, to the exclusive use of which the registrar or the court holds him not to be entitled; or
- (ii) that the proprietor shall make such other disclaimer or memorandum as the registrar or the court may consider necessary for the purpose of defining his rights under the registration:

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

19. Requirements in regard to blank spaces.—If a trade mark contains any blank space or spaces apparently intended for added matter, the registrar may, in deciding whether the trade mark shall be entered on the register, require, as a condition of its being entered on the register, that the blank space or spaces shall, in use, be occupied only by matter of a wholly descriptive or non-distinctive character or by a trade mark registered in the name of the same proprietor in respect of the same goods or by a trade mark of which he is a registered user in respect of the same goods with the consent of the proprietor of such trade mark, provided that, in both cases, use of such trade mark is not likely to deceive or cause confusion.

PART III

APPLICATION FOR REGISTRATION

20. Application for registration.—(1) Any person claiming to be the proprietor of a trade mark used or proposed to be used by him and who is desirous of registering it, shall apply to the registrar in the prescribed manner for registration, and the application shall be accompanied by the fee prescribed.

(2) Subject to the provisions of this Act, the registrar may refuse the application or may accept it absolutely or subject to such amendments, modifications, conditions or limitations (if any) as he may deem fit.

(3) In the case of an application for registration of a trade mark (other than a certification mark) in part A of the register, the registrar may, if the applicant agrees, instead of refusing the application, treat it as an application for registration in part B of the register and deal with the application accordingly.

(4) In the case of a refusal or conditional acceptance of the application, the registrar shall, on application by the applicant in the prescribed manner and on payment of the prescribed fee, state in writing the grounds for his decision and the data used by him in arriving thereat, and the decision shall be subject to appeal to the court.

(5) The provisions of section 63 shall *mutatis mutandis* apply to an appeal under this section, and on the appeal the court shall, if so required, hear the applicant and the registrar, and shall make an order determining whether and, if so, subject to what amendments, modifications, conditions or limitations (if any) the application is to be accepted.

(6) Appeals under this section shall be heard on the data so stated by the registrar, and such further data as may have been laid before him by the applicant, and no further grounds of objection to the acceptance of the application shall be allowed to be taken by the registrar, other than those so stated by him, except by leave of the court hearing the appeal, and where any further grounds of objection are so taken, the applicant shall be entitled, on giving notice as prescribed, to withdraw his appeal without payment of costs.

(7) The registrar or the court, as the case may be, may at any time, whether before or after acceptance of the application, correct any error in or in connection with the application, or may permit the applicant to amend his application upon such terms as the registrar or the court, as the case may be, may think fit.

21. Advertisement of accepted application.—When an application for registration of a trade mark has been accepted, whether absolutely or subject to conditions or limitations, the applicant shall, as soon as may be after acceptance, cause the application as accepted to be advertised in the prescribed manner, and the advertisement shall set forth all conditions and limitations subject to which the application has been accepted: Provided that the registrar may require an application to be advertised in the prescribed manner before acceptance if it relates to a mark in respect of which proof that it is distinctive is required in terms of section 10 (3), or in any other case where it appears to him that it is expedient by reason of any exceptional circumstances so to do, and where an application has been so advertised the registrar may, if he thinks fit, require it to be advertised again when it has been accepted.

22. Registration of parts of trade mark.—Where the proprietor of a trade mark claims to be entitled to the exclusive use of any part thereof separately, he may apply to register the whole and any such part as separate trade marks.

23. Rights in relation to parts of trade mark.—Each separate trade mark referred to in section 22 shall comply with all the conditions of an independent trade mark and shall, subject to the provisions of sections 38 (4) and 39 (2), have all the rights attached to an independent trade mark.

24. Proposed use of trade mark by body corporate to be constituted.—(1) No application for the registration of a trade mark in respect of any goods or services shall be refused, nor shall permission for such registration be withheld, on the ground only that it appears that the applicant does not use or propose to use the trade mark—

(a) if the registrar is satisfied that a body corporate is about to be constituted, and that the applicant intends to assign the trade mark to the body corporate

with a view to the use thereof in relation to those goods or services by the body corporate: Provided that the trade mark shall not be registered unless and until the registrar has been placed in a position to register the assignment in terms of section 51 simultaneously with registration of the trade mark; or

- (b) if the application is accompanied by an application for the registration of a person as a registered user of the trade mark, and the registrar is satisfied that the proprietor intends it to be used by that person in relation to those goods or services and the registrar is also satisfied that that person will be registered as a registered user thereof immediately after the registration of the trade mark.

(2) The provisions of section 36 shall have effect, in relation to a trade mark registered under the power conferred by subsection (1) of this section, as if for the reference in subsection (1) (a) of that section to an intention on the part of an applicant for registration that a trade mark should be used by him, there were substituted a reference to an intention on his part that it should be used by the body corporate or registered user concerned.

(3) The registrar may, as a condition of the exercise of the power conferred by subsection (1) in favour of an applicant who relies on an intention to assign to a body corporate as aforesaid, require him to give security for the costs of any proceedings relative to any opposition or appeal by him, and, in default of such security being duly given, may treat the application as abandoned.

25. Non-completed applications.—(1) If, by reason of default on the part of the applicant, after acceptance of the application, the registration of a trade mark has not been completed within six months from the date of such acceptance, the registrar shall give notice of the non-completion to the applicant, and, if at the expiration of thirty days from that notice or of such further time as the registrar may allow, the registration is not completed, the application shall be deemed to have been abandoned.

(2) If the application is not accepted and the applicant, having been advised of the registrar's objections to the application, fails to take any action within three months of the date of such advice, the application shall be deemed to have been abandoned.

PART IV

OPPOSITION

26. Opposition to registration.—(1) Any person (hereinafter referred to as the objector) may, within two months from the date of the advertisement of the application in terms of section 21, or within such further period as the registrar may allow, serve on the applicant at his address for service and lodge at the trade marks office a notice of opposition to the registration of the trade mark, setting out the grounds on which he relies to support his notice, and proof of service to the satisfaction of the registrar shall be furnished.

27. Lodging of counterstatement by applicant.—(1) Within one month after the lodging of notice of opposition, or within such further period as the registrar may allow, the applicant may serve on the objector at his address for service and lodge at the trade marks office a counterstatement setting out the grounds on which he relies in support of his application, and proof of service to the satisfaction of the registrar shall be furnished.

(2) If the applicant fails so to lodge a counterstatement, he shall be deemed to have abandoned his application.

28. Informal proceedings before registrar.—(1) The registrar shall, with the consent of both parties, and on payment of the fee prescribed, consider the notice of opposition and the counterstatement thereto, and shall reconsider the application and the acceptance thereof, and shall then, with or without hearing the parties, as they may agree, decide—

- (a) to reject the application; or
- (b) to register the trade mark; or
- (c) that he is prepared to register the trade mark subject to such amendments, modifications, conditions or limitations as he may deem fit; or
- (d) to direct that the normal opposition procedure as hereinafter prescribed be followed.

(2) If the registrar decides in terms of subsection (1) (c) that he is prepared to register the trade mark subject to such amendments, modifications, conditions or limitations as he may deem fit, and the applicant does not accept such amendments, modifications, conditions or limitations within such period as the registrar may determine, the applicant shall be deemed to have abandoned his application.

(3) The registrar shall be entitled to take into consideration such admissions as either or both of the parties may be prepared to make, even if such admissions are not included in the notice of opposition or counterstatement.

(4) No order shall be made in respect of the costs of the proceedings under this section.

(5) No appeal shall lie against a decision of the registrar given under this section.

29. Formal hearing of opposed applications.—(1) In the event of the proceedings not being determined in accordance with the provisions of section 28, or in the event of the registrar directing that the normal opposition procedure be followed, evidence may be adduced by the parties in the prescribed manner.

(2) The registrar shall fix a day for the hearing of the application and shall give notice thereof to the applicant and the objector at their respective addresses for service.

(3) On the day so fixed, or on any other day to which the hearing is adjourned, the registrar shall, on payment of the fee prescribed, hear the applicant and the objector and their respective witnesses (if any) unless the evidence has been submitted in affidavit form and the registrar does not require or permit evidence to be given *viva voce*, and shall decide whether the application is to be refused or whether it is to be granted either with or without modifications or conditions.

(4) The registrar may make such order as to the costs of the proceedings as may seem just and his order shall be enforceable in all respects as if it were a judgment of a single judge of the court.

(5) The decision of the registrar shall be subject to appeal to the court and the provisions of section 63 shall *mutatis mutandis* apply.

30. Appeal against registrar's decision.—(1) On appeal the court shall hear the parties and the registrar, if he desires to be heard, and shall make an order determining whether and subject to what conditions (if any) registration is to be permitted.

(2) On the hearing of an appeal under this section any party may, by special leave of the court, bring forward further evidence for the consideration of the court.

(3) (a) On an appeal under this section no further grounds of objection to the registration of a trade mark shall be allowed to be taken by the objector or the registrar, other than those so stated as aforesaid by the objector, nor shall the applicant be entitled to raise any further grounds in support of his application, except by special leave of the court.

(b) If any party, by special leave of the court, raises any further grounds and the other party decides in the light thereof not to pursue the proceedings, the court shall make such order as to costs as it may deem fit.

(4) The court may in its discretion require the appellant to give security for the costs of the proceedings relative to the appeal and, in default of such security being given, treat the appeal as abandoned.

(5) In the case of proceedings under this Part, the registrar may in his discretion require either or both parties to give security for the costs of the proceedings and, in default of such security being given, may treat the opposition or application as abandoned.

PART V

THE REGISTER OF TRADE MARKS

31. The register.—(1) There shall be kept at the trade marks office a register of trade marks in which shall be entered particulars of—

- (a) all applications to register trade marks and all registrations of trade marks with the names and addresses of their proprietors and of all registered users thereof, together with the date of registration and the date of expiration of the registration;
- (b) notifications of assignments, transmissions and disclaimers; and
- (c) any other matters relating to registered trade marks which may be prescribed.

(2) The register shall be comprised of two parts called respectively part A and part B.

(3) The register kept under the repealed law and existing at the commencement of this Act shall be incorporated with and form part of part A of the register kept under this Act.

(4) The register shall comprise all trade marks which are registered or are deemed to be registered under this Act and shall indicate whether they are registered in part A or part B of the register.

(5) The register shall, on payment of the prescribed fees, and subject to the provisions of this Act, be open at all convenient times during office hours to inspection by the public.

(6) A certified copy of an entry in any register kept under this Act, shall, subject to any special provisions to the contrary contained in this Act, be given to any person who applies for such a copy and pays the prescribed fee.

32. Amendment of register.—(1) The registrar may correct any error in the register made by an official of his office.

(2) The registrar may, on request made in the prescribed manner by the registered proprietor of a trade mark, and on payment of the fee prescribed, amend or alter the register by—

- (a) correcting any error in the name or address of the registered proprietor of the trade mark; or
- (b) altering the name or address or address for service of the registered proprietor who has changed his name or address or address for service; or
- (c) cancelling the registration of the trade mark; or
- (d) striking out any goods or services or classes of goods or services from those in respect of which the trade mark is registered; or
- (e) entering a disclaimer or memorandum relating to the trade mark which does not in any way extend the rights given by the registration of the trade mark.

(3) The registrar may, on request made in the prescribed manner by the registered proprietor or a registered user of a trade mark, and on payment of the fees prescribed, correct any error in the register relating to such trade mark or enter therein any change in the name or address of such registered user.

(4) Any decision of the registrar under this section shall be subject to appeal to the court.

33. General power to rectify entries in register.—(1) Any person aggrieved by the non-insertion in or omission from the register of any entry, or by any entry made in the register without sufficient cause or by any entry wrongly remaining on the register, or by any error or defect in any entry in the register, may apply to the court or, at the option of the applicant and subject to the provisions of section 69, on payment of the fees prescribed in the prescribed manner, to the registrar, for the desired relief and thereupon the court or the registrar, as the case may be, may make such order for making, expunging or varying the entry as to it or him may seem fit.

(2) The court or the registrar, as the case may be, may in any proceedings under this section decide any question that it may be necessary or expedient to decide in connection with the rectification of the register.

(3) In the event of the registrar being satisfied that any entry relating to the registration, assignment or transmission of a trade mark has been secured by fraud or misrepresentation or that any such entry was made without sufficient cause or wrongly remains on the register, he shall also have *locus standi* to apply to the court under the provisions of this section.

(4) Any order of the court rectifying the register shall direct that notice of the rectification shall be served on the registrar, and the registrar shall, on receipt of the notice together with the application on the form prescribed, rectify the register accordingly.

(5) The power to rectify the register conferred by this section shall include power to alter a registration in part A of the register to a registration in part B of the register.

34. Alteration of registered trade mark.—(1) The registered proprietor of a trade mark may, on payment of the fee prescribed, apply in the prescribed manner to the registrar for leave to add to or alter the trade mark in any manner not substantially affecting the identity thereof, and the registrar may refuse leave or may grant it on such terms and subject to such limitations as he may think fit.

(2) (a) The registrar shall require the applicant to advertise the application in the prescribed manner and, if within the prescribed period from the date of the advertisement any person lodges a notice of opposition to the application in the prescribed manner with the registrar, the registrar shall, after hearing the parties, if they wish to be heard, decide the matter.

(b) The provisions of sections 26 to 30 inclusive shall *mutatis mutandis* apply to any proceedings under this section.

35. Power to expunge or vary registration for breach of condition.—If the registered proprietor or registered user of a trade mark contravenes or fails to observe any condition entered in the register in relation thereto, the court or the registrar, as the case may be, may on application to the court, or, at the option of the applicant and subject to the provisions of section 69, to the registrar by any person aggrieved, or on application to the court by the registrar, make such order for expunging or varying the registration of the trade mark as to it or him may seem fit.

36. Removal from register and imposition of limitation on ground of non-use.—(1) Subject to the provisions of sections 16 (2) and 53, a registered trade mark may, on application to the court, or, at the option of the applicant and subject to the provisions of section 69, to the registrar by any person aggrieved, be taken off the register in respect of any of the goods or services in respect of which it is registered, on the ground either—

- (a) that the trade mark was registered without any *bona fide* intention on the part of the applicant for registration that it should be used by him in relation to those goods or services, and that there has in fact been no *bona fide* use of the trade mark in relation to those goods or services by any proprietor thereof for the time being up to the date one month before the date of the application; or
- (b) that up to the date one month before the date of the application a continuous period of five years or longer elapsed during which the trade mark was a registered trade mark and during which there was no *bona fide* use thereof in relation to those goods or services by any proprietor thereof for the time being; or
- (c) subject to such notice as the court or the registrar, as the case may be, shall direct, and subject to the provisions of the regulations, that, in the case of a trade mark registered in the name of a body corporate, or in the name of a natural person, such body corporate has been dissolved, or such natural person has died, not less than two years prior to the date of the application and that no application for registration of an assignment of such trade mark has been made in terms of section 51:

Provided that (except where the applicant has been permitted under section 17 (2) to register a resembling trade mark in respect of the goods or services in question or where the registrar or the court, as the case may be, is of opinion that he may properly be permitted so to register such a trade mark), the registrar or the court may refuse an application made under paragraph (a) or (b) of this subsection in relation to any goods or services, if it is shown that there has been, before the relevant date or during the relevant period, as the case may be, *bona fide* use of the trade mark by any proprietor thereof for the time being in relation to goods or services in respect of which the trade mark is registered: Provided further that the registrar or court may refuse an application made under paragraph (c) of this subsection in relation to any goods or services if it is shown that the trade mark is used or proposed to be used in relation to such goods or services by a successor in title of the registered proprietor.

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

PART VI

REGISTRATION AND ITS EFFECTS

37. Registration.—(1) When an application for registration of a trade mark in part A or in part B of the register has been accepted and advertised in the prescribed manner and either—

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

the registrar shall register the trade mark in part A or part B, as the case may be, of the register as on the date of the lodging of the application for registration, and that date shall

for the purposes of this Act be deemed to be the date of the registration: Provided that where the registrar is satisfied that the trade mark has been accepted in error or that, in the special circumstances of the case, the trade mark should not be registered or should be registered subject to conditions or limitations or to additional or different conditions or limitations, he may withdraw the acceptance and proceed as if the application had not been accepted.

(2) On registration of a trade mark, the registrar shall issue to the applicant in the prescribed form a certificate of the registration thereof sealed with the seal of the trade marks office.

38. Certain trade marks to be associated so as to be assignable and transmissible as a whole only.—(1) Trade marks that are registered as, or that are deemed by virtue of this Act to be, associated trade marks shall only be assignable or transmissible together and not separately, but they shall for all other purposes be deemed to be registered as separate trade marks.

(2) If a trade mark that is registered or is the subject of an application for registration so resembles another trade mark that is registered or is the subject of an application for registration in the name of the same proprietor that the use of both such trade marks by different persons in relation to goods or services in respect of which they are respectively registered or proposed to be registered would be likely to deceive or cause confusion, the registrar may at any time require that the trade marks shall be entered in the register as associated trade marks.

(3) Any decision of the registrar under subsection (2) shall be subject to appeal to the court.

(4) When a trade mark and any part or parts thereof are by virtue of section 22 registered as separate trade marks in the name of the same proprietor, they shall be deemed to be, and shall be registered as, associated trade marks.

(5) Any association of a trade mark with any other trade mark registered in the name of the same proprietor shall be deemed to be an association with all marks associated with that other trade mark, unless the registrar or the court otherwise decides.

(6) On application made in the prescribed manner by the registered proprietor of two or more trade marks registered as associated trade marks, the registrar may, on payment of the fee prescribed, dissolve the association as regards any of them if he is satisfied that there would be no likelihood of deception or confusion being caused if that trade mark were used by another person in relation to any of the goods or services in respect of which it is registered, and may amend the register accordingly.

(7) Any decision of the registrar under subsection (6) shall be subject to appeal to the court.

39. Use of one associated or substantially identical trade mark equivalent to use of another.—(1) When under the provisions of this Act use of a registered trade mark is required to be proved for any purpose, the registrar or the court, as the case may be, may, if and so far as he or it deems fit, accept proof of the use of an associated registered trade mark or of the trade mark with additions or alterations not substantially affecting its identity, as equivalent to proof of the use required to be proved.

(2) The use of the whole of a registered trade mark shall for the purposes of this Act be deemed to be the use also of any registered trade mark being a part thereof, registered in the name of the same proprietor by virtue of section 22.

40. Limitation of trade mark as to particular colours.—(1) A trade mark may be limited in whole or in part to a particular colour or colours and, in case of an application for the registration of a trade mark, the fact that the trade mark is so limited shall be taken into consideration by any tribunal in deciding whether it is distinctive or not.

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

41. Words used as name or description of an article or substance.—(1) If a trade mark consists of a word which has become generally recognized by the public as the only practicable name or description for any article or substance or service for which it is registered and has commonly been so used by persons carrying on business in relation to such article or substance or service (not being use in relation to goods or service connected in the course of trade with the proprietor or a registered user of the trade mark, or, in the case of a certification mark, goods or services certified by the proprietor), the registration of such trade mark shall for the purposes of section 33 be deemed to be an entry wrongly remaining on the register for the article or substance or service in question.

(2) If a trade mark contains a word to which the circumstances contemplated in subsection (1) are applicable, the registrar or the court, in deciding whether such trade mark shall remain on the register for the article or substance or service in question may, as a condition of its remaining on the register, require a disclaimer to be entered of any right to the exclusive use of such word in relation to the said article, substance or service, and such disclaimer shall be deemed to have been made under the provisions of section 18.

(3) The provisions of subsections (1) and (2) shall apply respectively to trade marks consisting of or containing a word which is the only practicable name or description of an article or substance for which such trade mark was registered, if such article or substance was the subject of letters patent in the territory which have expired or lapsed.

42. Registration in part A of register to be conclusive as to validity after seven years.—In all legal proceedings relating to a trade mark registered in part A of the register (including applications under section 33), the original registration of the trade mark in part A of the register shall, after the expiration of seven years from the date of that registration, be taken to be valid in all respects, unless—

- (a) that registration was obtained by fraud; or
- (b) the trade mark offends against the provisions of either section 16 or section 41.

PART VII

INFRINGEMENT

43. Registration a condition precedent to an action for infringement.—No person shall be entitled to institute any proceedings to prevent, or to recover damages for, the infringement of a trade mark not registered under this Act: Provided that nothing in this Act shall affect the rights of any person, at common law, to bring an action against any other person for passing off goods or services as those of another person.

44. Infringement.—(1) Subject to the provisions of subsections (2) and (3) of this section and section 45 and 46, the rights acquired by registration of a trade mark shall be infringed by—

- (a) unauthorized use as a trade mark, in relation to goods or services in respect of which the trade mark is registered, of a mark so closely resembling it as to be likely to deceive or cause confusion; or

- (b) unauthorized use in the course of trade, otherwise than as a trade mark, of a mark so closely resembling it as to be likely to deceive or cause confusion, if such use is in relation to or in connection with goods or services for which the trade mark is registered and is likely to cause injury or prejudice to the proprietor of the trade mark:

Provided that in the case of a trade mark registered in part B of the register, no interdict or other relief shall, for the purposes of paragraph (a) of this subsection, be granted if the defendant establishes to the satisfaction of the court that the use of which the proprietor of the registered trade mark complains is not likely to be taken as indicating a connection in the course of trade between the goods or services and some person having the right either as proprietor or as registered user to use the trade mark.

(2) The right to the use of a trade mark given by registration shall be subject to any conditions or limitations entered in the register, and shall not be infringed by the use of any such mark as aforesaid in any mode in respect of or in relation to goods to be sold or otherwise traded in or services to be performed in any place, or in relation to goods to be exported to any market, or in any other circumstances, to which, having regard to any such limitations, the registration does not extend.

(3) The use of a registered trade mark, being one of two or more registered trade marks that are identical or closely resemble each other, shall in the exercise of the right to the use of that trade mark given by registration, not be deemed to be an infringement of the right so given to the use of any other of those trade marks.

45. Saving of vested rights.—Nothing in this Act shall entitle the proprietor or a registered user of a registered trade mark to interfere with or retain the use by any person of a trade mark identical with or closely resembling it in relation to goods or services in relation to which that person or a predecessor in title of his has continuously used that trade mark from a date anterior—

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

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

46. Saving of use of name, address or description of goods.—No registration of a trade mark shall interfere with—

- (a) any *bona fide* use by a person of his own name or of the name of his place of business, or of the name of any of his predecessors in business, or of the name of any such predecessor's place of business; or
(b) the use by any person of any *bona fide* description of the character or quality of his goods or services.

PART VIII

DURATION AND RENEWAL OF REGISTRATION

47. Duration and renewal of registration.—(1) The registration of a trade mark shall be for a period of ten years, but may be renewed from time to time in accordance with the

provisions of this section: Provided that in the case of a trade mark registered before the commencement of this Act, the provisions of this subsection shall have effect with the substitution of a period of fourteen years for the said period of ten years.

(2) The registrar shall, on application made by the registered proprietor of a registered trade mark in the prescribed manner and within the prescribed period, renew the registration of the trade mark for a period of ten years from the date of expiration of the original registration or of the last renewal of registration, as the case may be, which date is in this section referred to as "the expiration of the last registration".

(3) At the prescribed time before the expiration of the last registration of a trade mark, the registrar shall send notice in the prescribed manner to the registered proprietor at his address for service, of the date of expiration and the conditions as to payment of fees and otherwise upon which a renewal of registration may be obtained, and, if at the expiration of the period prescribed in that behalf those conditions have not been duly complied with, the registrar may remove the trade mark from the register subject to such conditions, if any, as to its restoration to the register as may be prescribed.

(4) Where a trade mark has been removed from the register for non-payment of the fee for renewal, it shall nevertheless, for the purpose of any application for the registration of a trade mark during one year next following the date of the expiration of the last registration, be deemed to be a trade mark that is already on the register: Provided that the foregoing provisions of this subsection shall not have effect where the registrar is satisfied either—

- (a) that there was no *bona fide* trade use of the trade mark that has been removed, during the two years immediately preceding the date of the expiration of the last registration; or
- (b) that, notwithstanding any such use, no deception or confusion is likely to arise from the use of the trade mark that is the subject of the application for registration.

PART IX

REGISTERED USERS

48. Registered users.—(1) (a) Subject to the provisions of this section, a person other than the proprietor of a trade mark may be registered as a registered user thereof in respect of all or any of the goods or services in respect of which it is registered (otherwise than as a defensive trade mark), and either with or without conditions or restrictions.

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

(2) The permitted use of a trade mark shall be deemed to be use by the proprietor thereof, and shall not be deemed to be use by a person other than the proprietor for the purposes of section 36 or for any other purpose for which such use is material under this Act or at common law.

(3) Subject to any agreement subsisting between the parties, a registered user of a trade mark shall be entitled to call upon the proprietor thereof to institute proceedings to prevent infringement thereof, and, if the proprietor refuses or neglects to do so within two months after being so called upon, the registered user may institute proceedings for infringement in his own name as if he were the proprietor, making the proprietor a defendant, but a proprietor so cited as a defendant shall not be liable for any costs unless he enters an appearance and takes part in the proceedings.

(4) Where it is proposed that a person should be registered as a registered user of a trade mark, the proprietor and the proposed registered user shall apply in writing to the registrar in the prescribed manner, and the application shall be accompanied by the prescribed fee, and they shall furnish him with a sworn declaration made by the proprietor, 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 proprietor and the proposed registered user, including particulars showing the degree of control by the proprietor over the permitted use which their relationship will confer and whether it is a term of their relationship that the proposed registered user shall be the sole registered user or that there shall be any other restriction as to persons for whose registration as registered users application may be made;
- (b) stating the goods or services in respect of which registration is proposed;
- (c) stating any conditions or restrictions proposed with respect to the characteristics of the goods or services, to the mode or place of permitted use, or to any other matter; and
- (d) stating whether the permitted use is to be for a period or without limit of period, and, if for a period, the duration thereof,

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

(5) When the requirements of subsection (4) have been complied with, and if the registrar, after considering the information furnished to him under that subsection, is satisfied that in the circumstances the use of the trade mark in relation to the proposed goods or services or any of them by the proposed registered user, subject to any conditions or restrictions which the registrar thinks proper, would not be contrary to the public interest, the registrar may register the proposed registered user as a registered user in respect of the goods or services as to which he is so satisfied.

(6) The registrar shall refuse an application under the provisions of this section if it appears to him that the grant thereof would tend to facilitate trafficking in a trade mark.

(7) The registrar shall, if so required by an applicant, take steps to ensure that information furnished for the purposes of an application under the provisions of this section (other than matters entered in the register), is not disclosed to rivals in trade.

(8) Without prejudice to the provisions of section 33, the registration of a person as a registered user—

- (a) may be varied by the registrar as regards the goods or services in respect of which it has effect, or any conditions or restrictions relating to it, on application in writing in the prescribed manner and on payment of the prescribed fee by the registered proprietor of the trade mark to which the registration relates;
- (b) may be cancelled by the registrar on application in writing in the prescribed manner and on payment of the prescribed fee by the registered proprietor or by such registered user or by any other registered user of the trade mark;
- (c) may be cancelled by the registrar on application in writing in the prescribed manner and on payment of the prescribed fee by any person on any of the following grounds, that is to say:

- (i) that the registered user has used the trade mark otherwise than by way of the permitted use, or in such a way as to deceive or cause confusion, or to be likely to deceive or cause confusion;
 - (ii) that the proprietor or the registered user mis-represented, or failed to disclose, some fact material to the application for registration, or that the circumstances have materially changed since the date of the registration;
 - (iii) that the registration ought not to have been effected, having regard to rights vested in the applicant by virtue of a contract in the performance of which he is interested;
- (d) may be cancelled where the trade mark in respect of which such person has been registered has been assigned and application has in terms of section 51 (1) been made for registration of the assignment.

(9) Provision shall be made by regulation for the notification of the registration of a person as a registered user to the registered proprietor of the trade mark and for the advertisement thereof, and for the notification of an application under subsection (8) to the registered proprietor and each registered user (not being the applicant) of the trade mark, and for affording the applicant in such an application, and all persons who intervene in the proceedings in accordance with such regulations, an opportunity of being heard.

(10) The registrar may at any time cancel the registration of a person as a registered user of a trade mark, in respect of any goods or services in respect of which the trade mark is no longer registered.

(11) Any decision of the registrar under the provisions of this section shall be subject to appeal to the court.

(12) Nothing in this section shall confer on a registered user of a trade mark any assignable or transmissible right to the use thereof.

(13) The expression "permitted use" in subsection (2) shall be deemed to include the use of a trade mark before any person has been entered in the register as the registered owner thereof, if—

- (a) an application to register the person who has so used the trade mark, as a registered user of the trade mark is made within one year after the commencement of this Act; and
- (b) that person has used the trade mark in connection with goods or services in respect of which he is so registered, and, if the registration is effected subject to any conditions or limitations, he has used the trade mark in a manner substantially in accordance with such conditions and limitations.

PART X

ASSIGNMENT

49. Powers of and restrictions on assignment and transmission.—(1) Notwithstanding any rule of law to the contrary, a registered trade mark shall be, and shall be deemed always to have been, assignable and transmissible either in connection with or without the goodwill of the business concerned in the goods or services for which it has been registered.

(2) A registered trade mark shall be, and shall be deemed always to have been, assignable and transmissible in respect of either all the goods or services in respect of which it is registered, or was registered, as the case may be, or some (but not all) of those goods or services.

(3) The provisions of subsections (1) and (2) shall have effect in the case of an unregistered trade mark used in relation to any goods or services as they have effect in the case of a registered trade mark registered in respect of any goods or services if at the effective

date of the assignment or transmission of the unregistered trade mark it is or was used in the same business in which a registered trade mark is or was used, and if it is or was assigned or transmitted at the same date and to the same person as that registered trade mark is or was assigned or transmitted and in respect of goods or services all of which are goods or services in relation to which the unregistered trade mark is or was used in that business and in respect of which that registered trade mark is or was assigned or transmitted.

(4) Notwithstanding anything in subsections (1), (2) and (3) contained, a trade mark shall not be, or be deemed to have been, assignable or transmissible in a case in which, as a result of an assignment or transmission, there would in the circumstances subsist, or have subsisted, whether under the common law or by registration, exclusive rights in more than one of the persons concerned to the use of trade marks which so resemble each other that the use thereof by different persons in relation to the goods or services in respect of which such exclusive rights subsist or would have subsisted would be, or would have been, likely to deceive or cause confusion: Provided that where a trade mark is, or has been, assigned or transmitted in such a case as aforesaid, the assignment or transmission shall not be deemed to be, or to have been, invalid under this subsection if the exclusive rights subsisting as a result thereof in the persons concerned respectively are, or were, having regard to the limitations imposed thereon, such as not to be exercisable by two or more of those persons in relation to goods to be sold, or otherwise traded in, or services to be performed, within the territory (otherwise than for export therefrom) or in relation to goods to be exported to the same market outside the territory.

(5) The proprietor of a registered trade mark who intends to assign it in respect of any goods or services in respect of which it is registered may submit to the registrar in the prescribed manner a statement of case setting out the circumstances, and the registrar may on payment of the fee prescribed issue to him a certificate stating whether, having regard to the goods or services and the trade marks referred to in the statement of case, the proposed assignment of the first-mentioned trade mark would or would not be invalid under subsection (4), and a certificate so issued shall, subject to the provisions of this section as to appeal, and unless it is shown that the certificate was obtained by fraud or misrepresentation, be conclusive as to the validity or invalidity under the said subsection of the assignment in so far as such validity or invalidity depends upon the facts set out in the statement of case, but, as regards a certificate in favour of validity, only if application for registration of the title of the person becoming entitled is made under section 51 within six months from the date on which the certificate is issued.

(6) Notwithstanding anything in subsections (1), (2) and (3) contained, a trade mark shall not be assignable or transmissible in a case in which, as a result of an assignment or transmission thereof, there would in the circumstances subsist, whether under the common law or by registration, an exclusive right in one of the persons concerned to the use of the trade mark limited to use in relation to goods to be sold, or otherwise traded in, or services to be performed, in a place or places in the territory, and an exclusive right in another of those persons to the use, in relation to goods to be sold, or otherwise traded in, or services to be performed, in another place or other places in the territory, of a trade mark so resembling the first-mentioned trade mark that the use in the same place of both such marks in relation to the goods or services in respect of which such exclusive rights respectively subsist would be likely to deceive or cause confusion: Provided that on application in the prescribed manner by the proprietor of a trade mark who intends to assign it, or of a person who claims that a trade mark was transmitted to him or to a predecessor in title of his after the commencement of this Act, the registrar, if he is satisfied that in all the circumstances

the use of the trade marks in the exercise of the said rights would not be contrary to the public interest, may, on payment of the fee prescribed, approve the assignment or transmission, and an assignment or transmission so approved shall not be deemed to be, or to have been, invalid under this subsection or under subsection (4) of this section, provided that in the case of a registered trade mark application under section 51 for the registration of the title of the person becoming entitled is made within six months from the date on which the approval is given or, in the case of a transmission, was made before that date.

(7) Notwithstanding anything contained in subsections (1) and (2) and subject to the provisions of subsections (4) and (6), where a trade mark which is the subject of a pending application for registration has subsequent to the date of the application been assigned or transmitted, the registrar may, on application in the prescribed manner and subject to such conditions as he may deem necessary, allow, on payment of the fee prescribed, the person or persons entitled to such trade mark by reason of such assignment or transmission, to be substituted as applicant or applicants for registration of the trade mark.

(8) Any decision of the registrar under this section shall be subject to appeal to the court.

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

51. Registration of assignments and transmissions.—(1) Where a person becomes entitled by assignment or transmission to a registered trade mark, he shall make application to the registrar on the form prescribed to register his title, and the registrar shall on receipt of the application together with the fee prescribed and of proof of title to his satisfaction, register him as the proprietor of the trade mark in respect of 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.

(2) Every application to register an assignment or transmission in terms of subsection (1) shall recite the effective date of such assignment or transmission and, if application is made more than twelve months after such date, the applicant shall be liable to pay such penalty as may be prescribed.

(3) Any decision of the registrar under this section shall be subject to appeal to the court.

(4) Except for the purposes of an appeal under this section or of an application under section 33, a document or instrument in respect of which no entry has been made in the register in accordance with the provisions of subsection (1) of this section, shall not be admitted in evidence in any court in proof of the title to a trade mark unless the court otherwise directs.

PART XI

CERTIFICATION MARKS

52. Certification marks.—(1) 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 or performance, quality, accuracy or any other characteristic, as the case may be, from goods or services not so certified, shall, on application in the manner provided for in this section, and subject to the provisions thereof, be registrable as a trade mark in part A of the register in respect of such first-mentioned goods or services, in the name, as proprietor thereof, of that person: Provided that a mark may not be so registered in the name of a person who carries on a trade in goods or services of the kind in question.

(2) An application for the registration of a mark under this section shall be made to the registrar in the prescribed manner, and may be made by any government or provincial authority or any person desiring to be registered as the proprietor thereof.

(3) In determining whether a mark is adapted to distinguish goods or services as is contemplated in subsection (1), regard may be had to the extent to which—

- (a) the mark is inherently adapted so to distinguish the goods or services in question; and
- (b) the mark is in fact adapted so to distinguish, by reason of the use thereof or of any other circumstances, the goods or services in question.

(4) There shall be submitted to the registrar rules (which shall thereupon become part of the application) stating the circumstances in which the proprietor concerned is to certify goods or services as contemplated in subsection (1) and to authorize the use of such mark, and otherwise governing the use thereof.

(5) The provisions of subsections (2) and (4) to (7), both inclusive, of section 20, shall have effect in relation to an application under subsection (2) of this section as they have effect in relation to an application under subsection (1) of the said section 20.

(6) In the exercise of his powers under subsection (5) of this section the registrar shall have regard to the same considerations, so far as they are relevant, to which he would have regard if the application were an application under section 20 (1) and to any other relevant considerations, including—

- (a) the desirability of ensuring that a certification mark shall comprise some indication that it is such a mark;
- (b) the competency of the applicant to certify the goods or services in respect of which the mark is to be registered;
- (c) the adequacy of the rules in question; and
- (d) the advantage of the public,

and may call to his assistance one or more persons, who shall perform the prescribed functions.

(7) The rules referred to in subsection (4) shall after the acceptance of the application be open to inspection in the same manner as the register.

(8) The provisions of sections 21, 25, 26 to 30, both inclusive, and 37, shall have effect in relation to an application under subsection (2) of this section as they have effect in relation to an application under section 20 (1).

(9) The rules referred to in subsection (4) may, on the application of the registered proprietor concerned, be altered by the registrar.

(10) The registrar may require an application under subsection (9) to be advertised in the prescribed manner in any case where it appears to him to be expedient so to do, and if, where the registrar requires an application to be so advertised, any person gives, within the prescribed time, notice to the registrar of opposition to the application, the provisions of sections 26 to 30, both inclusive, shall *mutatis mutandis* apply, in so far as they can be applied.

(11) Subject to the provisions of this section, the provisions of this Act, except the provisions of sections 24 and 48, subsections (4) to (7), both inclusive, of section 49, and section 73 shall, except in so far as is otherwise provided in this Act, and in so far as they can be applied, apply to a certification mark.

(12) The power to order rectification of the register conferred by section 33 shall include, in relation to certification marks, rectification on the ground—

- (a) that, in the case of any goods or services in respect of which the mark is registered, the proprietor is no longer competent to certify those goods or services as is contemplated in subsection (1);

- (b) that the proprietor has failed to observe a provision of the rules which it was his duty to observe;
- (c) that it is no longer to the advantage of the public that the mark should be registered; or
- (d) that the advantage of the public demands that, if the mark remains registered, the rules in question should be varied.

(13) A certification mark shall not be assignable or transmissible otherwise than with the consent of the registrar, who may grant his consent subject to such terms and conditions as he may think fit.

(14) Subject to the provisions of section 69, the court may, on the application of the registrar or of any person aggrieved, and the registrar may, on the application of any person aggrieved, make such order as it or he thinks fit for varying the rules which govern the use of such mark.

(15) There shall be a right of appeal to the court in the prescribed manner against refusal by a registered proprietor of a certification mark to certify goods or services, or to authorize the use of the certification mark, in accordance with such rules.

(16) A person called to assist the registrar in terms of subsection (6) shall be entitled to the prescribed remuneration.

PART XII

DEFENSIVE TRADE MARKS

53. Defensive registration of well-known trade marks.—(1) Where the registrar is of opinion that, by reason of the extent of use or of any other circumstances, a trade mark registered in part A of the register would, if used in relation to goods or services other than the goods or services in respect of which it is registered, be likely to be taken as indicating a connection in the course of trade between the first-mentioned goods or services and the proprietor of the registered trade mark, then, notwithstanding that the proprietor does not use or propose to use the trade mark in relation to the first-mentioned goods or services and notwithstanding anything in section 36 contained, the trade mark may, on application by the proprietor in the prescribed manner, and on payment of the fee prescribed, be registered in his name in respect of the first-mentioned goods or services as a defensive trade mark, and such a trade mark, while so registered, shall not be liable to be taken off the register under section 36 in respect of those goods or services.

(2) The registered proprietor of a trade mark may apply in the prescribed manner for the registration thereof in respect of any goods or services as a defensive trade mark, notwithstanding that it is already registered in his name in respect of those goods or services otherwise than as a defensive trade mark, or may apply for the registration thereof in respect of any goods or services otherwise than as a defensive trade mark notwithstanding that it is already registered in his name in respect of those goods or services as a defensive trade mark, in each case in lieu of the existing registration.

(3) A trade mark registered as a defensive trade mark and that trade mark as otherwise registered in the name of the same proprietor shall, notwithstanding that the respective registrations are in respect of different goods or services, be deemed to be, and shall be registered as, associated trade marks.

(4) On application to the court or, at the option of the applicant and subject to the provisions of section 69, to the registrar by any person aggrieved, the registration of a trade mark as a defensive trade mark may be cancelled on the ground that the requirements of subsection (1) of this section are no longer satisfied in respect of any goods or services in respect of which the trade mark is registered in the name of the same proprietor otherwise than as a defensive trade mark, or may be cancelled with regard to any goods or services

in respect of which it is registered as a defensive trade mark on the ground that there is no longer any likelihood that the use of the trade mark in relation to those goods or services would be taken as indicating a connection such as is mentioned in subsection (1) of this section.

(5) The registrar may at any time cancel the registration as a defensive trade mark of a trade mark of which there is no longer any registration in the name of the same proprietor otherwise than as a defensive trade mark.

(6) Except as otherwise expressly provided in this section, the provisions of this Act shall apply *mutatis mutandis* in respect of the registration or cancellation or the registration of trade marks as defensive trade marks and of trade marks so registered as they apply in other cases.

PART XIII

POWERS AND DUTIES OF REGISTRAR

54. Venue of proceedings.—The place where any proceedings before the registrar under this Act are to be heard and determined in any particular case shall be determined by the registrar after consultation with the party or parties concerned, and such proceedings shall be heard and determined by him at that place.

55. General powers of registrar.—(1) The registrar may, for the purposes of this Act—

- (a) receive evidence and determine whether and to what extent it shall be given by affidavit or *viva voce* upon oath;
- (b) summon witnesses and issue commissions *de bene esse*;
- (c) order discovery or inspection, and require the due production of documents;
- (d) consider any interlocutory or other matters as may seem expedient;
- (e) award costs against any party to any proceedings before him,

and generally the registrar shall in connection with any proceedings before him have all such powers and jurisdiction as are possessed by a single judge in a civil action before the court.

(2) Where express provision is not contained in this Act on any matter of procedure, the registrar shall have recourse to the rules governing procedure in the court.

(3) Whenever by this Act any period is specified within which any act or thing is to be done, the registrar may, unless otherwise expressly provided, extend the period either before or after its expiration.

56. Power of registrar to allow amendment of any document.—(1) The registrar may at any time before registration of a trade mark permit the amendment of any document relating to any application or proceedings before him on such terms as to costs or otherwise as he thinks just.

(2) If rights in a trade mark which is the subject of a pending application have been acquired by a body corporate subsequent to the date of application, the registrar may, on good cause shown and on payment of the fee prescribed, permit amendment of the application by the substitution of the name of the body corporate as applicant for registration notwithstanding that such body corporate was not in existence at the date of the application.

57. Duty of registrar in exercising discretionary power.—Whenever any discretionary power is by this Act given to the registrar, he shall not exercise that power adversely to an applicant without giving that applicant an opportunity of being heard personally or by his agent.

58. Taxation of costs awarded by registrar.—Any costs awarded by the registrar shall be taxed by a taxing officer of the court, and payment thereof may be enforced in the same manner as if they were costs allowed by a judge of the court.

PART XIV

EVIDENCE

59. Register to be prima facie evidence.—Any register kept under this Act shall be *prima facie* evidence of any matters directed or authorized by this Act to be inserted in that register.

60. Certificates of registrar to be prima facie evidence.—(1) A certificate purporting to be under the hand of the registrar as to any entry, matter or thing which he is authorized by this Act to make or do, shall be *prima facie* evidence of the entry having been made and of the contents thereof and of the matter or thing having been done or left undone.

(2) Printed or written copies or extracts purporting to be copies of or extracts from any register or book or document relating to trade marks and kept in the trade marks office and certified by the registrar and sealed with the seal of that office, shall be admitted in evidence in all courts and proceedings without further proof or production of the originals.

61. Registration to be prima facie evidence of validity.—In all legal proceedings relating to a registered trade mark (including applications under section 33 of this Act) the fact that a person is registered as proprietor of the trade mark shall be *prima facie* evidence of the validity of the original registration of the trade mark and of all subsequent assignments and transmissions thereof.

62. Certification of validity.—In any legal proceedings in which the validity of the registration of a registered trade mark is in issue and is decided in favour of the proprietor of the trade mark, the court may certify to that effect, and if it so certifies, then in any subsequent legal proceedings in which the validity of the registration of that trade mark is in issue, the proprietor of the trade mark, on obtaining a final order or judgment in his favour, shall be entitled to his full costs, charges and expenses as between attorney and client, unless in the subsequent proceedings the court certifies otherwise.

PART XV

APPEALS TO AND POWERS OF THE COURT

63. Appeal against decisions of the registrar to the court and powers of the court.—(1) In addition to any right of appeal specifically conferred in respect of proceedings under this Act, any party to any proceedings before the registrar, other than proceedings under section 28, may appeal to the court against any decision or order pursuant to such proceedings.

(2) Subject to the provisions of subsection (5), an appeal against the decision of the court in any appeal to it under this Act shall lie to the appellate division of the Supreme Court.

(3) In addition to any other powers conferred upon it by this Act, the court may in relation to such appeal—

- (a) confirm, vary or reverse the order or decision appealed against, as justice may require;
- (b) if the record does not furnish sufficient evidence or information for the determination of the appeal, remit the matter to the registrar with instructions in regard to the taking of further evidence or the setting out of further information;

- (c) order the parties or either of them to produce at some convenient time in the court of appeal such further proof as shall to it seem necessary or desirable; or
- (d) take any other course which may lead to the just, speedy and, as far as may be possible, inexpensive settlement of the case; and
- (e) make such order as to costs as justice may require.

(4) (a) Every appeal to the court shall be noted and prosecuted in the manner prescribed by law for appeals to it against a civil order or decision of a single judge of the court, save that the period within which such appeal shall be noted shall be three months after the date of the order or decision and that the appeal shall be prosecuted within six weeks of the date upon which it was noted: Provided that the court may, on application and on good cause shown, allow such extension of time for noting or prosecuting the appeal as may be necessary.

(b) Every appeal to the appellate division of the Supreme Court shall be noted and prosecuted in the manner prescribed by law for appeals to such division in civil proceedings save that no special leave to appeal to such division shall be necessary.

(5) The parties to proceedings before the registrar shall be deemed to be parties to civil proceedings for the purposes of section 20 (3) of the Supreme Court Act, 1959 (Act No. 59 of 1959), and the appellate division of the Supreme Court shall have jurisdiction to hear and determine an appeal against an order or decision of the registrar without any intermediate appeal first having been heard and determined by the court, if the said parties lodge with the registrar notice in writing of their consent thereto on the form prescribed and pay the prescribed fee.

64. Power to order production of certificate of registration.—In addition to any other powers conferred upon it by this Act, the court may in relation to any application or appeal under this Act order any party to deliver to the court or to the registrar the certificate of registration of any trade mark.

65. Notice to registrar of application to court.—Before any application is made to the court for an order involving the performance of any act by the registrar or affecting any entry in the register, the applicant shall in the manner prescribed give the registrar at least fourteen days' notice before the hearing of such application: Provided that the registrar may, in his discretion, waive such notice or accept such shorter notice as he may in the circumstances deem sufficient.

66. Registrar's appearance in proceedings involving rectification of register.—(1) In any legal proceedings in which the relief sought includes alteration or rectification of the register, the registrar shall have the right to appear and be heard, and shall appear if so directed by the court.

(2) Unless otherwise directed by the court, the registrar, in lieu of appearing and being heard, may submit to the court a statement in writing signed by him, giving particulars of the proceedings before him in relation to the matter in issue or of the grounds of any decision given by him affecting such matter or of the practice of the trade marks office in like cases or of such other matters relevant to the issues and within his knowledge as registrar, as he thinks fit, and the statement shall be deemed to form part of the evidence in the proceedings.

67. Court's power to review registrar's decision.—The court, in dealing with any question of the rectification of the register (including all applications under the provisions of section 33), shall have power to review any decision of the registrar relating to the entry in question or the correction sought to be made.

68. Discretion of court in appeals.—In any appeal against a decision of the registrar to the court under this Act, the court shall have power to exercise the same discretionary powers as under this Act are conferred upon the registrar.

69. Procedure in cases of option to apply to court or registrar.—Where under any provision of this Act an applicant has an option to make an application either to the court or to the registrar—

- (a) if proceedings concerning the trade mark in question are pending before the court, the application must be made to the court;
- (b) if in any other case the application is made to the registrar, he may at any stage of the proceedings refer the application to the court, or he may after hearing the parties determine the question between them subject to an appeal to the court.

PART XVI

OFFENCES

70. Penalty for making false entries in registers, or making, producing or tendering false copy.—Any person who—

- (a) makes or causes to be made a false entry in any register kept under this Act; or
- (b) makes or causes to be made a writing falsely purporting to be a copy of an entry in any such register; or
- (c) produces or tenders or causes to be produced or tendered as evidence any such entry or copy thereof knowing the same to be false,

shall be guilty of an offence and liable on conviction to a fine not exceeding two hundred rand or to imprisonment for a period not exceeding twelve months or to both such fine and such imprisonment.

71. Penalty for making false statements for the purpose of deceiving or influencing registrar or other officer.—Any person who—

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

makes a false statement or representation knowing the same to be false, shall be guilty of an offence and liable on conviction to a fine not exceeding two hundred rand or to imprisonment for a period not exceeding twelve months or to both such fine and such imprisonment.

72. Penalty for falsely representing a trade mark as registered.—(1) Any person who makes a representation—

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

shall be guilty of an offence and liable on conviction to a fine not exceeding one hundred rand.

(2) For the purposes of this section, the use in the territory in relation to a trade mark of the word “registered” or of any abbreviation thereof or of any other word or letter which might reasonably be construed as referring to registration, shall be deemed to import a reference to registration in the register except—

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

PART XVII

MISCELLANEOUS

73. Trade mark not to be deemed to be deceptive or confusing in certain cases.— The use of a registered trade mark in relation to goods between which and the person using the trade mark a form of connection in the course of trade subsists, shall not be deemed to be likely to deceive or cause confusion on the ground only that the trade mark has been or is used in relation to goods between which and that person or a predecessor in title of that person a different form of connection in the course of trade subsisted or subsists.

74. Use of trade mark for export trade.—(1) The application of a trade mark in the territory to goods to be exported from the territory, and any other act done in the territory in relation to goods to be so exported which, if done in relation to goods to be sold or otherwise traded in within the territory, would constitute use of a trade mark therein, shall be deemed to constitute use of the trade mark in relation to those goods for any purpose for which such use is material under this Act or at common law.

(2) Subsection (1) shall be deemed to have had effect in relation to an act done before the date of the commencement of this Act as it has effect in relation to an act done after that date, but shall not affect a determination of a court which was made before that date or the determination of an appeal against a determination so made.

75. Payment of prescribed fees to be made before acts done or documents issued.— Whenever under this Act any prescribed fee is payable in respect of any application, registration, matter or document, the registrar may refuse to perform the act or to receive or to issue the document (as the case may be) until the fee payable in respect thereof is paid.

76. Address for service.—(1) With every application or notice of opposition under this Act, the applicant or objector, as the case may be, shall furnish an address (not being a post box number) acceptable to the registrar as an address for service which shall, for all the purposes of the application or the notice of opposition, be deemed to be the address of the applicant or of the objector (as the case may be), and all documents in relation to the application or notice of opposition may be served by leaving them at or sending them to the address for service of the applicant or of the objector, as the case may be.

(2) Any address for service may with the approval of the registrar be changed by notice to the registrar on the form prescribed.

(3) The address for service furnished by an applicant in terms of this section shall be deemed to be the *domicilium citandi et executandi* of such applicant for the purposes of any proceedings relating to any entry made in the register in pursuance of the application.

77. Circulation of periods of time.—Where any period of time is specified by this Act as running from the doing of any act, it shall be reckoned as commencing on the day next following the doing of that act.

78. Persons under disability.—If any person is, by reason of minority, lunacy or other disability, incapable of making any declaration or doing any act required or permitted by this Act, then the guardian, curator or other legal representative (if any) of such person or if there be none, any person appointed by the court upon petition on behalf of the person under disability or on behalf of any other person interested in the making of such declaration or the doing of such act, may make the declaration or a declaration as nearly corresponding thereto as circumstances permit, and do the act in the name and on behalf of the person under disability, and all acts done by such substitute shall, for the purposes of this Act, be as effectual as if done by the person for whom he is substituted.

79. Fees, regulations, forms and classification of goods.—(1) The Minister in consultation with the Minister of Finance may prescribe a tariff, not inconsistent with this Act, of the fees which shall be payable to the registrar in respect of any application, registration, matter or document, and the fees shall be payable as so prescribed.

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(2) The Minister may make regulations, not inconsistent with this Act, as to all matters, including forms and a schedule of classification of goods or services, which by this Act are required or permitted to be prescribed by regulation or which are necessary or convenient for giving effect to the provisions of this Act or for the conduct of any business relating to the trade marks office established by this Act.

80. Transitional provisions.—(1) Subject to the provisions of sections 3 and 81 the validity of any entry relating to a trade mark on the register of trade marks existing at the commencement of this Act shall be determined in accordance with the laws in force at the date of such entry.

81. Retrospective effect of certain provisions.—Sections 48 and 49, and those provisions of this Act which relate to registered users and assignments, shall be deemed to have come into operation on 1 January 1948.

82. Application in Eastern Caprivi Zipfel.—This Act and any amendment thereof shall apply also in the Eastern Caprivi Zipfel.

83. Repeal and amendment of laws.—(1) Sections 10 to 13 inclusive of the Patents, Designs and Trade Marks Proclamation, 1923, of the territory, and so much of the remainder of that Proclamation as relates to trade marks, are hereby repealed.

(2) The said Proclamation is hereby amended—

- (a) by the substitution in section 24 for the words “Designs and Trade Marks” of the words “and Designs”; and
- (b) by the deletion in the preamble of the words “and Trade Marks”.

84. Short title and commencement.—This Act shall be called the Trade Marks in South West Africa Act, 1973, and shall come into operation on 1 January 1974.