

## Zimbabwe Act To amend the Trade Marks Act [*Chapter 26:04*]

Enacted by the President and the Parliament of Zimbabwe.

### Short Title and Date of Commencement

1.—(1) This Act may be cited as the Trade Marks Amendment Act, 2001.

(2) This Act shall come into operation on a date to be fixed by the President by statutory instrument.

### Amendment of Section 2 of Cap. 26:04

2. Section 2 of the Trade Marks Act [*Chapter 26:04*] (hereinafter called “the principal Act”) is amended in subsection, (1)—

(a) by the repeal of the definition of “mark” and the substitution of—

““mark” means any sign which can be represented graphically and is capable of distinguishing the goods or services of one undertaking from those of other undertakings;”;

(b) by the repeal of the definition of “Tribunal” and the substitution of—

““Tribunal” means the Intellectual Property Tribunal established by section 3 of the Intellectual Property Tribunal Act [*Chapter 26:08*];”.

### Amendment of Section 5 of Cap. 26:04

3. Section 5 of the principal Act is amended by the repeal of subsection (2) and the substitution of—

“(2) The Register shall be divided into the following Parts—

(a) Part A, for the registration of distinctive marks that are registrable in terms of section *twelve*; and

(b) Part B, for the registration of marks that are capable of distinguishing goods and services, as provided in section *thirteen*; and

(c) Part C, for the registration of certification marks as provided in Part IX; and

(d) Part D, for the registration of defensive trade marks as provided in section *thirty-two*; and

(e) such other Parts as the Controller may from time to time determine, for the registration of such other classes of marks as may be provided for by or in terms of this Act.”.

### Amendment of Section 6 of Cap. 26:04

4. Section 6 of the principal Act is amended in the proviso by the insertion after “other person” of “for unlawful competition or”

### Amendment of Section 8 of Cap. 26:04

5. Section 8 of the principal Act is amended—

(a) by the repeal of subsection (1) and the substitution of—

“(1) Subject to this section and to sections *ten* and *eleven*, a registered trade mark shall be infringed by any unauthorised use in the course of trade, whether as a trade mark or otherwise, of a mark that is identical to the registered trade mark or so nearly resembling it as to be likely to deceive or cause

confusion, where that mark is used in relation to the same or similar goods or services as those in respect of which the trade mark is registered.”;

(b) by the insertion after subsection (5) of the following subsection—

“(6) Where a mark that is identical to a registered trade mark is used as a trade mark in respect of the same goods or services as those in respect of which the registered mark is registered, it shall be presumed for the purposes of this section, unless the contrary is proved, that such use is likely to deceive or cause confusion.”.

#### **New Sections Inserted in Cap. 26:04**

6. The principal Act is amended by the insertion after section 9 of the following sections—

##### **“Entitlement to and Nature of Civil Remedies for Infringement**

**9A.**—(1) Subject to this Act, an infringement of a registered trade mark shall be actionable at the suit of the proprietor and any registered user of the mark.

(2) Subject to this Act, in any proceedings for an infringement of a registered trade mark there shall be available to the plaintiff all such remedies by way of damages, interdict, attachment, the rendering of account, the delivery of improperly marked goods or of articles used or intended to be used for marking goods or otherwise, as are available in respect of the infringement of any other proprietary right.

##### **Forum in which Remedies for Infringement May be Sought**

**9B.** Proceedings in respect of an infringement of a registered trade mark may be instituted—

(a) in the Tribunal; or

(b) in the High Court; or

(c) subject to the jurisdictional limits provided for in the Magistrates Court Act [*Chapter 7:10*], in a magistrates court:

Provided that the Tribunal shall not have jurisdiction to entertain criminal proceedings.

##### **Damages in Infringement Proceedings**

**9C.**—(1) Damages for an infringement of a registered trade mark may, at the option of the person seeking them, be calculated on the basis of the amount that a registered user would reasonably have been expected to pay under the circumstances for his use of the trade mark concerned:

Provided that, if the person seeking damages intends to exercise this option, he shall give notice of his intention, in writing, to any registered user of the trade mark concerned.

(2) In determining the amount of damages in proceedings for an infringement of a registered trade mark, the Tribunal or court shall take the following factors into account, in addition to all other material considerations—

(a) the extent and nature of the infringement; and

(b) the amount which could be payable to the proprietor in respect of the use of the trade mark by some other person.

(3) Where in proceedings for an infringement of a registered trade mark it is established that an infringement was committed and the Tribunal or court, having regard to—

(a) the flagrancy of the infringement; and

(b) any benefit shown to have accrued to the person responsible for the infringement as a result of it; is satisfied that effective relief would not otherwise be available to the plaintiff or applicant, the Tribunal or court shall have power to award such additional damages as it thinks fit.

(4) Where in proceedings for an infringement of a registered trade mark it is established that an infringement was committed but that at the time of the infringement the person responsible for it was not aware and had no reasonable grounds for suspecting that he was not entitled to engage in the infringing activity, the plaintiff or applicant shall not be entitled under this section to any damages against that person in respect of the infringement.

#### **Anton Piller Orders**

**9D.**—(1) If a person who has instituted or intends instituting proceedings for an infringement of a registered trade mark satisfies the Tribunal or a court that, *prima facie*—

(a) he has a cause of action against another person which he intends to pursue; and

(b) the other person has in his possession documents or other things of whatsoever nature which constitute evidence of great importance in substantiation of that cause of action; and  
(c) there is a real and well-founded apprehension that the documents or other things may be hidden, destroyed or rendered inaccessible before discovery can be made in the usual way; the Tribunal or court, as the case may be, may make such order as it considers necessary or appropriate to secure the preservation of the documents or things as evidence.

(2) An order in terms of subsection (1) may be granted without notice to the person who is allegedly in possession of the documents or other things to which the order relates, and the Tribunal or court may sit *in camera* for the purpose of hearing an application for such an order; Provided that the Tribunal or Court shall not grant an order without such notice unless it is satisfied that there is a real possibility that the documents or things will be hidden, destroyed or rendered inaccessible if notice is given.

(3) An order in terms of subsection (1) may be granted on such conditions, including the giving of security by the applicant, as the Tribunal or court may fix.

(4) This section shall not be taken to limit any power a court may have under its ordinary jurisdiction to grant orders such as are referred to in this section.

#### **Protection of Familiar Foreign Marks**

**9E.**—(1) In this section—

“familiar foreign mark” means a mark which is well known in Zimbabwe as being the mark of a person who—

(a) is a national of a Convention country; or

(b) is domiciled in, or has a real and effective industrial or commercial establishment in, a Convention country; whether or not that person carries on business or has any goodwill in Zimbabwe.

(2) On application by the proprietor of a familiar foreign mark, the Tribunal or a court of competent jurisdiction may prohibit the use in Zimbabwe of a trade mark which constitutes, or the essential part of which constitutes, a reproduction, imitation or translation of the familiar foreign mark, where the trade mark is being or will be used in relation to—

(a) goods or services which are identical or similar to the goods or services in respect of which the familiar foreign mark is well known in Zimbabwe, where such use is likely to deceive or cause confusion; or

(b) goods or services which are not similar to those in respect of which the familiar foreign mark is well known in Zimbabwe, if—

(i) the use of the trade mark in relation to those goods or services would indicate a connection between them and the proprietor of the familiar foreign mark; and

(ii) the interests of the proprietor of the familiar foreign mark are likely to be injured by such use; and

(iii) the familiar foreign mark is registered as a trade mark in the Convention country concerned.”.

(3) The proprietor of the familiar foreign mark shall, within a month of instituting infringement procedures, apply for the registration of the said mark in Zimbabwe.

#### **Amendment of Section 14 of Cap. 26:04**

**7.** Section 14 of the principal Act is amended by the insertion after subsection (2) of the following subsection—

“(2a) Without derogation from subsection (1) or (2), the Registrar shall, on his own initiative or at the request of an interested party, refuse or invalidate the registration of a trademark which contains or

consists of a geographical indication with respect to goods not originating in the territory indicated, if use of the indication in the trademark for such goods, in Zimbabwe is of such a nature as to mislead the public as to the true place of origin.”.

**Amendment of Section 15 of Cap. 26:04**

8. Section 15 of the principal Act is amended in subsection (1) by the insertion after paragraph (b) of the following paragraph—

“or

(c) could, if it were registered, be the subject of an order under section *nine E* prohibiting its use on the ground that it is a reproduction, imitation or translation of a familiar foreign mark as defined in that section.”:

**New Section Inserted in Cap. 26:04**

9. The principal Act is amended by the insertion after section 15 of the following section—

**“Prohibition of Registration of State Emblems, etc.**

15A. A mark cannot be validly registered if it is identical with, or is an imitation of or contains as an element, an armorial bearing, flag and other emblem, a name or abbreviation, or initials of the name of, or official sign or hallmark adopted by any State, intergovernmental organisation or organisation created by an international convention, unless authorised by the competent authority of that State or organisation.”.

**Amendment of Section 24 of Cap. 26:04**

10. The principal act is amended by the insertion after subsection (3) of the following proviso—

“Provided that a period of grace of six months shall be allowed for the late payment of the renewal fee.”.

**Amendment of Section 31 of Cap. 26:04**

11. Section 31 of the principal Act is amended in subsection (3) by the insertion after “special circumstances in the trade” of “or to other circumstances, such as Government action, that arise independently of the will of the proprietor of the trade mark,”.

**New Sections Substituted for Sections 64 to 69 of Cap. 26:04**

12. Sections 64 to 69 of the principal Act are repealed and the following sections are substituted—

**“Appeals from Registrar**

64. Where this Act provides for an appeal against a decision of the Registrar, the appeal shall be made to the Tribunal in accordance with this Part and the Intellectual Property Tribunal Act [*Chapter 26:06*].

**Time for Appeals**

65. An appeal referred to in section *sixty four* shall be lodged with the Tribunal within two months after the appellant was notified of the decision or order against which the appeal is brought or within such further time as the Tribunal may for good cause allow.

**Powers of Tribunal on Appeal**

**66.** Without derogation from section 8 of the Intellectual Property Tribunal Act [*Chapter 26:06*], in any appeal under this Act the Tribunal may—

- (a) confirm, set aside or vary the order or decision against which the appeal is brought;
- (b) exercise any of the powers which could have been exercised by the Registrar in the proceedings in connection with which the appeal is brought.

#### **References to Tribunal by Registrar**

**67.**—(1) If it appears to the Registrar that any matter to be decided by him under this Act involves a point of law or to be of unusual importance or complexity, he may, after giving notice to the parties, refer the matter to the Tribunal for decision, and thereafter in relation to that matter he shall act in accordance with the decision of the Tribunal or any decision substituted therefor on appeal to the Supreme Court.

(2) Where a matter has been referred to the Tribunal in terms of subsection (1), the Registrar and the parties shall be entitled to be heard by and appear before the Tribunal before any decision is made in the matter.”.

#### **New Section Substituted for Section 72 of Cap. 26:04**

**13.** Section 72 of the principal Act is repealed and the following section is substituted—

##### **“Counterclaim for Rectification of Register in Proceedings for Infringement**

**72.** In any proceedings for an infringement of a registered trade mark, the defendant or respondent may counterclaim for the rectification of the Register and, if he does so—

- (a) he shall, within the time-limit for the deliver of the counterclaim, serve it on the Registrar with a copy of any notice, summons or other document by which the proceedings were instituted; and
- (b) the Registrar shall be entitled to take part in the proceedings without delivering a defence, affidavit or other notice or pleading:

Provided that he shall, appear in the proceedings if directed to do so by the court concerned or he Tribunal, as the case may be.”.

#### **Repeal of Section 76 of Cap. 26:04**

**14.** Section 76 of the principal Act is repealed.

#### **Repeal of Section 78 of Cap. 26:04**

**15.** Section 78 of the principal Act is repealed.

#### **Repeal of Section 80 of Cap. 26:04**

**16.** Section 80 of the principal Act is repealed.

#### **New Section Substituted for Section 86 of Cap. 26:04**

**17.** Section 86 of the principal Act is repealed and the following is substituted—

##### **“Restriction on Importation or Exportation of Counterfeit Trade Mark Goods**

**86.**—(1) In this section—

“counterfeit trade mark goods” means any goods which bear without authorisation a trade mark which—

(a) is identical to a registered trade mark; or  
(b) cannot be distinguished in its essential aspects from a registered trade mark; and thereby infringes the rights of the proprietor of the registered trade mark; “proprietor”, in relation to a registered trade mark, includes a registered user of the trade mark.

(2) If the proprietor of a registered trade mark, by written notice to the Director of Customs and Excise—

(a) informs the Director that he is the proprietor of the trade mark; and  
(b) satisfies the Director that there are reasonable grounds to suspect that counterfeit trade mark goods have been or may be imported into or exported from Zimbabwe; and  
(c) requests the Director to treat the counterfeit trade mark goods referred to in paragraph (b) as prohibited goods; and  
(d) describes the goods concerned with sufficient particularity to make them readily identifiable;

the Director shall forthwith comply with the request and ensure that no such goods are imported into or exported from Zimbabwe, and that any such goods that have been imported but not yet entered are not released to the importer:

Provided that the Director need not comply with such a request until the proprietor furnishes him with security in such form and for such amount as the Director may require to secure the fulfilment of any liability and the payment of any expense which he may incur as a result of the detention of any goods to which the request relates or as a result of anything done by him in relation to goods so detained.

(3) Where a request has been made under subsection (1) and has not been withdrawn, the importation into or exportation from Zimbabwe of any goods to which the request relates shall be prohibited for a period of ten working days from the date on which the Director of Customs and Excise complies with the request: Provided that—

(i) if within that period the proprietor has instituted proceedings for an order in terms of subsection (4), or proceedings for any other order leading to a decision on the merits of the matter, the importation or exportation of the goods concerned shall continue to be prohibited until the determination of those proceedings or until the court or tribunal concerned orders otherwise;  
(ii) this subsection shall not apply to the importation or exportation of a single article by a person for his personal and private use.

(4) If the proprietor of a registered trade mark satisfies the Tribunal or a court that—

(a) he is the proprietor of the trade mark; and  
(b) there are reasonable grounds to suspect that counterfeit trade mark goods have been or may be imported into or exported from Zimbabwe;

the Tribunal or court may issue an order directing the Director of Customs and Excise to prevent the importation or exportation, as the case may be, of those goods.

(5) An order under subsection (4)—

(a) shall describe the goods concerned with sufficient particularity to make them readily identifiable; and  
(b) may be granted subject to conditions, including the giving of security by the applicant and the inspection of the goods concerned.

(6) For so long as an order under subsection (4) is in force, the Director of Customs and Excise shall treat the goods to which the order relates as if—

(a) they were prohibited from importation in terms of section 47 of the Customs and Excise Act [*chapter 23:02*]; or

(b) their exportation was prohibited for the purpose of section 61 of the Customs and Excise Act [Chapter 23:02]; as the case may be.

(7) The Director of Customs and Excise shall take all necessary steps to inform an importer or exporter or intended importer or exporter of goods whose importation or exportation is prohibited by virtue of this section of the reasons for the prohibition.

(8) While any goods are detained pursuant to a request or an order under this section—

(a) the proprietor at who see instance the request or order was made;

(b) the importer of the goods;

shall be given an adequate opportunity to inspect the goods in order to determine whether or not they are counterfeit trade mark goods.

(9) Notwithstanding anything in the Customs and Excise Act [Chapter 23:02], a person shall not be liable to any penalty under that Act, other than forfeiture of the goods, as a result of their importation or exportation being prohibited by virtue of this section.”.

#### **Amendment of Section 97 of Cap. 26:04**

**18.** Section 97 of the principal Act is amended—

(a) by the insertion after subsection (4) of the following subsections—

“(4a) An application in terms of this Act for the registration of a trade mark which is already registered in a Convention country—

(a) of which the applicant is a national; or

(b) in which the applicant is domiciled or in which he has a real and effective industrial or commercial establishment; shall be accepted unless the trade mark concerned—

(i) is of such a nature as to infringe rights lawfully acquired by any person in Zimbabwe; or

(ii) is not distinctive as referred to in section *twelve* or capable of distinguishing goods or services as referred to in section *thirteen*; or

(iii) consists exclusively of signs which—

A. serve, in trade, to designate the kind, quality, quantity, intended purpose, value, place of origin or time of production of the goods or services to which the trade mark relates; or

B. have become customary in the established practices of the trade in Zimbabwe; or

(iv) is contrary to morality or public order; or

(v) is likely to deceive.

(4b) Subsection (4a) shall apply notwithstanding that the mark sought to be registered in Zimbabwe may differ from the trade mark already registered in a Convention country in respect of elements that do not alter its distinctiveness and do not affect its identity in the form in which it was registered there.”;

(b) in subsection (5) by the insertion after “proof of application” of “or registration”.

#### **New Section Inserted in Cap. 26:04**

**19.** The principal Act is amended by the insertion after section 97 of the following section—

#### **“Banjul Protocol on Marks**

**97A.—(1)** In this section—



“Protocol” means the Banjul Protocol on Marks within the framework of the African Regional Industrial Property Organisation (ARIPO), adopted between the 15th to the 19th November, 1993.

- (2) Words or expressions to which a meaning has been assigned in the Protocol shall bear the same meaning when used in this section.
- (3) Subject to this section, the Protocol shall have the force of law within Zimbabwe.
- (4) Any trade mark which has been registered by the ARIPO Office in accordance with the Protocol and in respect of which Zimbabwe has been designated—
  - (a) shall have the same effect, *mutatis mutandis*, as a trade mark registered under this Act; and
  - (b) shall be accorded the same protection, *mutatis mutandis*, as a trade mark registered in accordance with section *ninety-seven*.
- (5) Subsection (4) shall apply to trade marks registered by the ARIPO Office before the date this Act comes into effect in accordance with the Protocol: Provided that the proprietor of any such mark shall not be entitled to damages or any other remedy for infringement of copyright in the mark which took place before that date.
- (6) The Minister shall cause a statutory instrument to be published in the *Gazette* setting out the provisions of the Protocol and any regulations made under the Protocol, and shall amend the statutory instrument whenever necessary to record any amendment of the Protocol or those regulations.”.

#### **New Section Inserted in Cap. 26:04**

**20.** The principal Act is amended by the insertion after section 100 of the following section—

#### **“Collective Marks**

**100A.—(1).** In this section—

“collective mark” means a mark that is capable of distinguishing, in the course of trade, goods or services of persons who are members of an association from goods or services of persons who are not members of the association.

- (2) On application by the association concerned, a collective mark shall be registrable in such Part of the Register as the Controller may determine in terms of paragraph (e) of subsection (2) of section *five*.
- (3) Subject to subsection (2) and to any regulations made in terms of section *one hundred and four*, Part V shall apply, *mutatis mutandis*, to applications for the registration of collective marks, to their registration and to the duration and renewal of their registration.
- (4) Subject to this section, this Act shall apply, *mutatis mutandis*, to registered collective marks in the same way as it applies to registered trade marks.”.

#### **Amendment of Section 104 of Cap. 26:04**

**21.** Section 104 of the principal Act is amended in subsection (2)—

(a) by the insertion after paragraph (e) of the following paragraph—

“(e) the provision of services by the Trade Marks Office, including the provision of information regarding marks, and the fees and charges payable for such services;”;

(b) by the insertion after paragraph (i) of the following paragraph—

“(j) giving effect to any international treaty or agreement which relates to trade marks and to which Zimbabwe is a party.”.

#### **Minor Amendments to Cap. 26:04**

22. The provisions of the principal Act specified in the first column of the Schedule are amended to the extent set out opposite thereto in the second column.

SCHEDULE (Section 22)

MINOR AMENDMENTS TO TRADE MARKS ACT [*Chapter 26:04*]

| <i>Provision</i> | <i>Extent of Amendment</i>   |
|------------------|--|
| Section 51(1)(b) | By the insertion after “subsection (1)” of “or (2a)”.  |
| Section 71       | By the deletion of “High Court or Tribunal” (a) where it occurs for the first time and the substitution of “court or the Tribunal, as the case may be, which gave the decision”; (b) where it occurs for the second time and the substitution of “court or Tribunal, as the case may be,”. |
| Section 73       | By the deletion of— (a) “action or” and the substitution of “legal”; (b) “Tribunal” and the substitution of “court, the Tribunal”.   |
| Section 78       | By the repeal of subsection (4).   |
| Section 87       | By the deletion of “is, upon representations made to him, satisfied that the use of the trade mark constitutes a forgery” and the substitution of “is satisfied that the goods are counterfeit trademark goods as defined in subsection (1) of that section”.                              |
| Section 95       | By the deletion of “or the Tribunal”.  |