

BILLS SUPPLEMENT

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Bill No. 9

Trademarks Bill

THE TRADEMARKS BILL, 2008.

MEMORANDUM.

★ 07 JUN 2008

ACC. No:

CALL No:

1. Policy and principles

The Bill seeks to repeal and replace the existing Trade Marks Act (Cap 217) which has been found to be inadequate and to incorporate new developments in trade marks law and to consolidate into one piece the statute law on trade marks thus making the trade marks law comprehensive and easily accessible.

2. Defects in the existing law

Trademarks are defined as any sign or combination of signs capable of distinguishing goods or services of one undertaking from those of another.

The current law on trademarks in Uganda is the Trademarks Act, Cap. 217, which is based on the United Kingdom Act and which commenced on 1st January, 1953. Due to the passage of time, some aspects of the trademarks law have become outdated, especially in light of the present day policies, international obligations, globalization and technological developments. The Trademarks Act has however not been reformed despite reforms in the original laws from which it is derived. As currently written, the Trademarks Act impedes investment as a result of the inadequate protection that investors are given in case of infringement of their trademarks. There is therefore, the need for radical changes in the law to bring it in line with the current global changes.

3. Large sums of money are invested in devising trademarks to suit a particular product or service and to appeal to a particular market. More large sums go on promoting trademarks or brands through advertising. If protection of trademarks is not adequately provided

for by law, this means that the rightful owner may lose business and goodwill. The effects on the economy may become manifested in few or no new trademarks being created, and the government will definitely lose out on revenue it would have otherwise got from registration of new trademarks. In law, however, trademarks have in recent years been the subject of increasing controversy. This has culminated in the need to reform the trademark law in Uganda.

4. Remedies proposed to deal with defects in existing law

The reform of the trademarks law is geared towards having modern laws supporting a competitive economy in a coherent and accessible form, while providing maximum freedom for participants to perform their proper functions at the same time recognizing the case for high standards and ensuring appropriate protection for all parties. It is further geared towards poverty eradication and promotion of Government policies such as Poverty Alleviation Action Plan (PEAP). These reforms are also geared towards bringing Uganda's legislation in line with her international obligations.

Trademarks today are a vital component of the whole structure of advertising and marketing and are as such a strong feature of the commercial scene. Logos, catchphrases and images all fall within the ambit of the trademark and form a valuable part of the goodwill of the business with which they are associated.

5. The changes required to bring the existing law up to international standards and to make it user friendly requires a new Bill that totally overhauls the existing Trademarks Act, Cap.217.

6. The main guiding principle considered in the reform is to develop a trademarks and service marks law designed to protect consumers from being confused or deceived in the market place, enable investors to market and sell their products using trademarks as signs of quality, and develop a law that will boost consumer confidence in a product that they have come to trust from their knowledge of the product and its trademark.

7. Provisions of the Bill

The Bill comprises nine Parts. It seeks to repeal and replace the existing Trademarks Act, Cap.217 and deals with trademarks protection as described in the following paragraphs—

(1) Definition of trademark

The Bill widens the scope of trade marks under the proposed law by defining the expression "trade marks" in clause 1 to cover the protection of both goods and services. Thus the definition reads as follows—

"trademark" means, a sign or mark or combination of signs or marks capable of being represented graphically and capable of distinguishing goods or services of one undertaking from those of another undertaking.

(2) Registration of trademarks

The Bill provides for the registration of trade marks upon application and the payment of prescribed fees. Under clause 7 of the Bill a trade mark is required to be registered, in respect of particular goods or classes of goods or particular services or classes of services and questions arising as to the class with which goods or services fall shall be determined by the registrar. The Bill provides for two categories of registration of trade marks namely, Part A and Part B and provides separate particulars or attributes qualifying goods and services for registration in each category. (See clauses 8 and 9) The Bill also provides for registration in Part A of the register of certification trademarks under clause 13.

(3) Registration under Part A (clause 8 of the Trademarks Bill)

For a trademark to be registered under Part A of the register, the mark has to be distinctive that is to say, the trademark must be unique in nature which uniqueness is capable of distinguishing the goods and services in respect of which the trademark is registered from goods or services of which no connection subsists.

(4) Qualification for registration under Part A

The trademark under Part A shall contain or consist of at least one of the following—

- (a) name of a company, individual or firm represented in a special or particular manner;
- (b) signature of the applicant for registration or of same predecessor in his or her business;
- (c) an inverted word or inverted words;
- (d) a word or words having no direct reference to the character or quality of the goods or services as the case may be, and not being accordingly to its ordinary signification a geographical name or a surname.

(5) Rights given by registration under Part A

Clause 30 deals with the rights given by registration of goods in Part A and their infringement and **Clause 31** deals with the rights given by registration of services in Part A and their infringement.

(6) Registration under Part B (clause 9 of the Trademarks Bill)

For a trademark to be registered under Part B of the register, the mark should be capable of distinguishing goods or services in respect of which the mark is registered from the goods or services in the case where no connection subsists.

(7) Rights given by regulation under Part B

Clause 32 deals with the rights given by registration of goods in Part B and their infringement and **Clause 33** deals with the rights given by registration of services in Part B and their infringement.

(8) Difference between registration under Part A and B

The difference between registration under Part A and registration under Part B is that under Part A the trademark must be distinctive that is to say, it must be unique but under Part B the trademark only has to be different from another trademark generally. This may be in terms of shape or colour. It only has to be capable of being distinguished from other trademarks.

(9) Certification mark (clause 12 of the Trademarks Bill)

A certification mark is a mark adopted in relation to any goods in respect of origin, material, mode of manufacture, quality, accuracy or other characteristics. A certification mark is registrable under Part A of the register in respect of those goods in the name of that person as owner.

(10) Difference between certification mark and trade mark

A certification mark is different from a trademark. A trademark is defined as a sign or mark or combination of signs or marks capable of being represented graphically and capable of distinguishing goods or services of one undertaking from those of another undertaking.

(11) A certification mark applies only in relation to goods and not services and it is registrable only under Part A because of its distinctiveness in relation to—

- (a) origin;
- (b) mode of manufacture;
- (c) quality;
- (d) accuracy;
- (e) material or other characteristics.

(12) There are instances where a trademark and a certification mark are registered under Part A of the register in respect of the same goods that is to say the trademark may be distinctive and may also have a certification mark in relation to its origin, mode of manufacture, quality or material.

(13) Appeal

A person aggrieved by the decision of the registrar in considering an application is entitled to appeal against the decision to the High Court. (See clause 6)

(14) Length of protection of registration

According to clause 16 of the Bill the initial registration of a trade mark is to last for seven years but the registration may be renewed for ten years at a time.

(15) Effect of registration and action for infringement

Part IV of the Bill prescribes the effect of registration of trademarks and action for infringement.

The Bill in clause 45 and 46 accords priority rights in respect of trade marks registered in the countries of origin of particular goods and services on the basis of reciprocity i.e. that those countries of origin accord the same protection to goods and services originating from Uganda.

(16) Remedies

According to the Bill the remedies available to the owner of a trade mark against an infringement of the trade mark are as follows—

- (a) injunction – clause 83(1);
- (b) prohibition on import of goods bearing infringing trade mark;
- (c) prohibition on export of goods bearing infringing trade mark;
- (d) damages or rendering account of profit – clause 83 (General provision);
- (e) cancellation of invalid trade marks registration – see clause 46, removal of trade mark from registration on proof of prior registration;

- (f) costs – clause 61, power of registrar to award costs in all proceedings if the registrar considers not reasonable.

(17) Records

For the purpose of keeping proper records and to prevent fraud, clauses 2 and 25 provide for keeping on the register of all registered trade marks and particulars of the owners, registered users, notification of assessments and transmission, disclaimers, conditions, limitations and other matters relating to registered trade marks as may be prescribed by regulations made by the Minister.

(18) Electronic register

Since the Bill does not specifically prohibit the use of an electronic register it means the registrar may under clause 2 maintain an electronic register whether as an alternative or complementary to a traditional register.

(19) Security for costs for persons not resident in East Africa

Clause 69 of the Bill requires persons not resident in East Africa to provide security for costs where they give notice of objection to an application for registration under clause 11 or whenever they apply to the registrar under clause 46 for a trade mark to be removed from the register otherwise their applications will be dismissed.

(20) Merging of offences under penal code

The Bill thus incorporates the current provisions of Part XXVII of the Penal Code Act (Cap. 120) relating to trademarks infringement offences.

(21) New offences

In order to protect trade marks the following new offences have been introduced in the Bill—

New offences and penalties to deal with—

- (i) falsifying a registered trade mark provided for under clause 78 of the Bill;

(ii) falsely applying a registered trade mark – clause 79 of Bill;

(iii) manufacture and possession of things used for commission of an offence. (See clause 80, manufacture of dye, block, machine or instrument used in commission of offence).

HON. (DR) E. KHIDDU MAKUBUYA, (MP).

Attorney General And Minister of Justice And Constitutional Affairs.

Bill No. 9

Trademarks Bill

2008

THE TRADEMARKS BILL, 2008.

ARRANGEMENT OF CLAUSES.

Clause.

PART I—PRELIMINARY.

1. Interpretation.

PART II—REGISTER OF TRADEMARKS.

2. Register of trademarks.

3. Copies and extracts from the register.

PART III—PROCEDURE FOR AND DURATION OF REGISTRATION

4. Protectable subject matter.

5. Preliminary advice by registrar as to distinctiveness

6. Application for registration.

7. Trademark to be for particular goods or services

8. Distinctiveness requisite registration under Part A.

9. Capability of distinguishing requisite for registration under Part B

10. Advertisement of application.

11. Objection to registration.

12. Marks registrable as certification marks.

13. Application for registration of a certification mark.

14. Advertisement of application, objection to registration of certification trademarks.

15. Registration.

16. Duration and renewal of registration.

17. Procedure on expiry of period of registration.

18. Status of unregistered trademark.

19. Combined trademarks.

20. Series of trademarks.

21. Powers and restrictions on assignment and transmission of trademarks relating to goods.

22. Powers and restrictions on assignment and transmission of trademarks relating to services.

23. Certain trademarks to be associated so as to be assignable as a whole.

24. Power of registered owner to assign and give receipts.

Clause.

25. Registration of assignments and transmission.
26. Alteration of deposited regulations or expunging or varying of entry in register relating to certification mark.

PART IV—EFFECT OF REGISTRATION AND THE
ACTION FOR INFRINGEMENT

27. Restriction on registration.
28. No action for unregistered trademark.
29. Passing off.
30. Rights given by registration of goods in Part A and infringement.
31. Rights given by registration of services in Part A and infringement.
32. Rights given by registration of goods in Part B and infringement.
33. Rights given by registration of services in Part B and infringement.
34. Infringement by breach of certain restrictions.
35. Saving for vested rights.
36. Saving in respect of use of name, address or description of goods or services.
37. Prohibition of registration of identical and resembling trademarks.
38. Application for registration of identical or resembling trademarks.
39. Concurrent use.
40. Registration in Part A to be conclusive as to validity after seven years.
41. Registrations subject to disclaimer.
42. Registration of jointly owned trademarks.
43. Words used as name or description of an article or substance.
44. Words used as name or description of an activity.
45. Protection of marks registered in a country of origin.
46. Removal of trademark from register on proof of prior registration in country of origin.
47. Associated trademarks.

PART V—USE AND NON-USE OF A TRADEMARK OR
SERVICE MARK.

48. Removal from register and imposition of limitations on ground of non-use.
49. Defensive registration of trademarks relating to goods.

Clause.

50. Defensive registration of trademarks relating to services.
51. Defensive trademarks registered as associated trademarks.
52. Removal of defensive trademarks from the register.
53. Registered user.
54. Variation or cancellation of registration as a registered user.
55. Notification of registration as registered user and or application for variation or cancellation of the registration.
56. Registrar's decision under section 54 and 55 subject to appeal.
57. Proposed use of trademark by corporation to be construed.
58. Use of one of associated or substantially identical trademark equivalent to use of another.
59. Use of trademark for export trade.
60. Use of trademark after change in form of trade connection.

PART VI—LEGAL PROCEEDINGS AND APPEALS.

61. Power of registrar to award costs.
62. Registration to be *prima facie* evidence of validity.
63. Certificate of validity.
64. Trade usage, etc. to be considered.
65. Registrar's appearance in proceedings involving rectification.
66. Court's power to review registration.
67. Procedure in case of option to apply to court or registrar.
68. Payment of costs by the registrar.
69. Security of costs.
70. Powers of court on appeal.
71. Chief Justice to make rules of procedure.

PART VII—EVIDENCE.

72. Mode of giving evidence.
73. Evidence of entries in register.
74. Evidence of entries made or of things done by the registrar.

PART VIII—OFFENCES.

75. Forging or counterfeiting trade mark
76. Falsification of entries in register.
77. Falsely representing a trademark as registered.
78. Falsifying or unlawful removal of a registered trademark.
79. Falsely applying a registered trademark.

Clause.

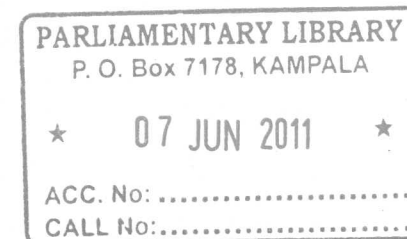
80. Manufacture and possession of dye etc for use in commission of offence.
81. Selling etc goods with false marks.
82. Prohibition of import and export of infringing trademarks
83. Civil remedies.
84. Offences by companies and other bodies.

PART IX—MISCELLANEOUS

85. Penalties and compensation.
86. Inspectors.
87. Entry into premises.
88. Mode of inspection of premises.
89. Inspectors or public officers not personally liable.
90. Suspension of release by customs authorities.
91. Fees.
92. General power to rectify entries in register.
93. Power to expunge or vary registration for breach of condition.
94. Correction of register.
95. Alteration of registered trademark
96. Adaptation of entries in register to amend or substitute classification of goods or services.
97. Recognition of agents.
98. Address for service.
99. Hours of business and excluded days.
100. Provisions as to public holidays.
101. Power of Minister to make regulations.
102. Minister's power to amend Schedule.
103. Repeal and savings.

SCHEDULE

Currency point



A Bill for an Act

ENTITLED

THE TRADEMARKS ACT, 2008

An Act to consolidate the law relating to trademarks; to repeal and replace the Trademarks Act; to provide for the appointment of a registrar; for the registration of trademarks; for the procedure for and duration of registration; for the effect of registration and action for infringement of a trademark; for the use and non use of a trademark; for fees; for legal proceedings and appeals; for trademark offences; for regulations and for related matters.

PART I—PRELIMINARY

1. Interpretation.

(1) In this Act, unless the context otherwise requires—

“assignment” means assignment of rights and liabilities under this Act;

[“board” the board of directors established under the Uganda Registration Services Bureau Act;]

“certification mark” means the mark referred to in section 12;

“court” means the High Court;

“currency point” has the meaning given to it in the Schedule;

“limitation” means any limitation of the exclusive right to the use of a trademark given by the registration of a person as owner of the trademark, including limitation of that right as to mode of use, in relation to goods to be sold or otherwise traded in, in any place in Uganda, or in relation to goods to be exported to any market outside Uganda;

“Minister” means the Minister responsible for justice;

“passing off” means falsely representing one’s own product as that of another in an attempt to deceive potential buyers;

“permitted use” has the meaning assigned to it by section 53 (2);

“register” means the register of trademarks kept under section 2;

“registered trademark” means a trademark that is registered under Part III of this Act;

“registered user” means a person other than the owner of a trademark who is registered to use the trademark under section 53;

“registrar” means an officer designated as registrar of trademarks under the Uganda Registration Services Bureau Act;

“sign or mark” includes any word, symbol, slogan, logo, sound, smell, colour, brand label, name, signature, letter, numeral or any combination of them;

“surname” means a name by which a person is customarily known by members of the community to which he or she belongs;

“trademark” means, a sign or mark or combination of signs or marks capable of being represented graphically and capable of distinguishing goods or services of one undertaking from those of another undertaking;

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

(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.

PART II—REGISTER OF TRADEMARKS.

2. Register of trademarks.

(1) The registrar shall maintain in his or her office a register of trademarks.

(2) The register shall contain—

(a) all registered trademarks with the names, addresses and descriptions of their owners;

(b) registered users, notifications of assignments and transmissions, disclaimers, conditions, limitations and other matters relating to registered trademarks as may be prescribed.

(3) The register shall be divided into two parts called Part A and Part B respectively.

(4) A record of particulars or other matter made using electronic form for the purpose of keeping the register shall be taken to be an entry in the register.

(5) The register shall at all convenient times be open to the inspection of the public, subject to such regulations as may be prescribed.

(6) The register shall be kept under the control and management of the registrar.

(7) Notwithstanding anything in this section, the registrar may keep the records wholly or partly in computer floppies, diskettes or any other electronic form subject to prescribed safeguards.

3. Copies and extracts from the register.

(1) A person who applies for a certified copy of an entry in the register or a certified extract from the register shall be entitled to obtain the copy or extract in documentary form or otherwise on payment of a prescribed fee.

(2) In this section “certified copy” or “certified extract” means a copy or extract certified by the registrar and sealed with the seal of the registrar.

PART III—PROCEDURE AND DURATION OF REGISTRATION**4. Protectable subject matter.**

(1) A sign or combination of signs, capable of distinguishing goods or services of one undertaking from those of other undertakings, shall be capable of constituting a trademark.

(2) Where a sign is not inherently capable of distinguishing the relevant goods or services, qualification for registration shall depend on distinctiveness acquired through use.

(3) A sign shall be capable of graphical representation in order to be registered.

5. Preliminary advice by registrar as to distinctiveness.

(1) A person who intends to apply for the registration of a trademark may obtain advice from the registrar as to whether the proposed trademark appears to the registrar to be inherently adapted to distinguish or capable of distinguishing goods or services of the proposed undertaking from those of other undertakings and the registrar shall advise accordingly.

(2) A person seeking advice under subsection (1) shall apply in the prescribed manner.

(3) If on application for the registration of a trademark as to which the registrar has given advice in the affirmative and within three months after the advice is given the registrar after further investigation or consideration, gives notice to the applicant of

objection on the ground that the trademark is not adapted to distinguish or is not capable of distinguishing, as the case may be, the applicant is entitled within the prescribed period, to him or her any fee paid on the filing of the application.

6. Application for registration.

(1) A person who claims to be the owner of a trademark used or proposed to be used by him or her and is desirous of registering it shall apply in writing to the registrar in the prescribed form for registration in Part A or Part B of the register.

(2) Subject to this Act, the registrar may—

(a) refuse the application; or

(b) accept it absolutely or subject to amendments, modifications, conditions or limitations, as he or she may deem fit.

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

(4) In the case of a refusal or conditional acceptance, the registrar shall, state in writing the grounds for his or her decision.

(5) A person aggrieved by the decision of the registrar may appeal to the court.

(6) An appeal under this section shall be made in the prescribed form and the court shall upon hearing the applicant and the registrar make an order determining whether and subject to what amendments, modifications, conditions or limitations, the application is to be accepted.

(7) Appeals under this section shall be heard only on the grounds stated by the registrar and no further grounds of objection to the acceptance of the application shall be allowed to be made by the registrar other than those stated under subsection (4) except by leave of the court.

(8) Where any further grounds of objection are allowed by the court, the applicant may withdraw his or her application without payment of costs, on giving notice as prescribed.

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

7. Trademark to be for particular goods or services.

(1) A trademark relating to goods shall be registered in respect of particular goods or classes of goods.

(2) A trademark relating to services shall be registered in respect of particular services or classes of services.

(3) A question arising as to the class within which goods or services fall shall be determined by the registrar.

8. Distinctiveness requisite registration under Part A.

(1) In order for a trademark other than a certification mark to be registered in Part A of the register, the trademark shall contain or consist of at least one of the following essential particulars—

- (a) the name of a company, individual or firm, represented in a special or particular manner;
- (b) the signature of the applicant for registration or of some predecessor in his or her business;
- (c) an invented word or invented words;
- (d) a word or words having no direct reference to the character or quality of the goods or services, and not being according to its ordinary signification, a geographical name or a surname; or
- (e) any other distinctive mark, but a name, signature or word or words, other than words within the descriptions in paragraphs (a), (b), (c) and (d), shall not be registrable under this paragraph except upon evidence of its distinctiveness.

(2) For the purposes of this section, “distinctive” means—

- (a) in the case of a trademark relating to goods, adapted in relation to the goods in respect of which the trademark is registered or proposed to be registered, to distinguish goods with which the owner of the trademark is or may be connected, in the course of trade, from goods in the case of which no connection subsists; or
- (b) in the case of a trademark relating to services, adapted in relation to services in respect of which the trademark is registered or proposed to be registered, to distinguish services with which the owner of the trademark is or may be connected in the course of trade, from services with the provision of which he or she is not connected, generally or, where the trademark is registered or proposed to be registered subject to limitations, in relation to use within the extent of the registration.

(3) In determining whether a trademark is adapted to distinguish as goods or services, the registrar or the court may have regard to the extent to which—

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

9. Capability of distinguishing requisite for registration under Part B.

(1) A trademark relating to goods to be registered in Part B of the register shall be capable, in relation to the goods in respect of which it is registered or proposed to be registered, of distinguishing goods with which the owner of the trademark is or may be connected in the course of trade from goods in the case where no connection subsists, generally or, where the trademark is registered or proposed to be registered subject to limitations, in relation to the use within the extent of the registration.

(2) A trademark relating to services to be registered in Part B of the register shall be capable, in relation to services in respect of which it is registered or proposed to be registered, of distinguishing services with the provision of which the owner of the mark is or may be connected in the course of business from services with the provision of which he or she is not so connected generally or, where the trademark is registered or proposed to be registered subject to limitations, in relation to use within the extent of the registration.

(3) In determining whether a trademark is capable of distinguishing goods or services, the registrar or court may have regard to the extent to which—

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

(4) A trademark may be registered in Part B notwithstanding any registration in Part A in the name of the same owner of the same trademark or a part or parts of the trademark.

10. Advertisement of application.

(1) Where an application for registration of a trademark has been accepted absolutely or subject to conditions or limitations, the registrar shall, as soon as possible, cause the application, to be advertised in the prescribed manner and the advertisement shall set forth all conditions and limitations subject to which the application is accepted.

(2) The registrar may cause an application to be advertised before acceptance where—

- (a) it is made under section 8 (1)(e); or
- (b) it is expedient by reason of exceptional circumstances to advertise.

(3) Where an application has been advertised, the registrar may, if he or she thinks fit, advertise it again when it has been accepted but is not obliged to do so.

11. Objection to registration.

(1) A person may, within the prescribed time from the date of advertisement of an application, give notice to the registrar of objection to the registration.

(2) The notice shall be given in writing in the prescribed manner and shall include a statement of the grounds of objection.

(3) The registrar shall send a copy of the notice to the applicant and within the prescribed time after receipt, the applicant shall send to the registrar, in the prescribed manner, a counter statement of the grounds on which he or she relies for his or her application and if he or she does not do so, he or she shall be taken to have abandoned his or her application.

(4) If the applicant sends a counter-statement, the registrar shall furnish a copy of the counter statement to the person giving notice of objection and shall, after hearing the parties, if so required and considering the evidence, decide whether and subject to what conditions or limitations registration is to be permitted.

(5) A person aggrieved by the decision of the registrar may appeal to court.

(6) An appeal under this section shall be made in the prescribed form.

(7) On appeal the court shall, if required, hear the parties and the registrar and shall make an order determining whether and subject to what conditions or limitations registration is to be permitted.

(8) On hearing of an appeal under this section any party, may, either in the manner prescribed or by special leave of the court, bring forward further material for the consideration of the court.

(9) On an appeal under this section no further grounds of objection to the registration of a trademark shall be allowed to be taken by the person objecting or the registrar, other than those stated by the person objecting, except by leave of the court.

(10) Where any further grounds of objection are taken, the applicant is entitled to withdraw his or her application without payment of the costs of the person objecting on giving notice as prescribed.

(11) On hearing the appeal, the court may permit the trademark proposed, to be registered and modified in a manner not substantially affecting its identity and the modified trademark shall be advertised in the prescribed form before being registered.

(12) Where a person who gives notice of an objection or an applicant who sends a counter statement after receipt of a copy of a notice or an appellant, does not reside or carry on business in Uganda, the court or the registrar may require him or her to give security for costs of the proceedings before the court or the registrar relating to the objection or to the appeal, as the case may be, and if the security is not given may treat the objection or application or the appeal as abandoned.

12. Marks registrable as certification marks.

(1) A mark adapted in relation to any goods to distinguish, in the course of trade, goods certified by a person in respect of origin, material, mode of manufacture, quality, accuracy or other characteristic, from goods not certified shall be registrable as a certification mark in Part A of the register in respect of those goods in the name of that person as owner.

(2) A mark shall not be registrable under subsection (1) in the name of a person who carries on a trade in goods of the kind certified.

(3) A mark adapted in relation to any services to distinguish in the course of business services certified by any person in respect of quality, accuracy or other characteristic, from services certified, shall be registrable as a certification mark in Part A of the register in respect of those services in the name of that person.

(4) A mark shall not be registrable under subsection (3) in the name of a person who is connected in the course of business with the provision of services of the kind certified.

(5) In determining whether a mark is adapted to distinguish goods or services, the registrar may have regard to the extent to which—

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

(6) The fact that a mark consists of signs or indications which may serve, in trade, to designate the geographical origin of goods or services shall not preclude it from being registered as a certification trademark in Part A of the register in respect of those goods or services.

(7) Nothing in this Act shall entitle the owner of a certification trademark that consists of signs or indications described in subsection (6) to interfere with or restrain the use by any person of signs or indications the use of which is in accordance with honest practices in industrial or commercial matters.

13. Application for registration of a certification mark.

(1) An application for the registration of a mark under section 12 shall be made to the registrar in writing in the prescribed manner by the person proposed to be registered as the owner.

(2) Sections 6(2) and (4) to (7) shall have effect in relation to an application under this section as they have effect in relation to an application under section 6(1).

(3) In dealing with an application under this section the court shall have regard to similar considerations, so far as relevant, as if the application were an application under section 6 and to any other considerations relevant to applications under this section, including the desirability of securing that a certification mark comprises some indication that it is a certification mark.

(4) An applicant for the registration of a mark under this section shall send to the registrar draft regulations for governing the use of the mark, which shall include provisions as to the cases in which the owner is to certify goods or services and to authorise the use of the mark and may contain other provisions that the registrar may require or permit to be inserted including provisions conferring a right of appeal to the registrar against any refusal of the owner to certify goods or services or to authorise the use of the mark in accordance with the regulations.

(5) The regulations, if approved, shall be deposited with the registrar and shall be open to inspection in the same manner as the register.

(6) The registrar shall consider the application with regard to the following matters—

- (a) whether the applicant is competent to certify the goods or services in respect of which the mark is to be registered;
- (b) whether the draft regulations are satisfactory; and
- (c) whether in all the circumstances the registration applied for would be to the public advantage; and may either—
 - (i) refuse to accept the application; or
 - (ii) accept the application and approve the regulations, without modification or subject to conditions or limitations or to any amendments or modifications of the application or of the regulations, which he or she may think necessary having regard to the matters in this subsection.

(7) Except where the registrar accepts and approves the application without modifications and conditions, he or she shall not decide the matter without giving the applicant an opportunity to be heard.

(8) A person aggrieved by the decision of the registrar under this section may appeal to court.

14. Advertisement of application, objection to registration of certification marks.

(1) Where an application for the registration of a certification mark has been accepted absolutely or subject to conditions and limitations, the registrar shall cause the applicant to advertise it in the prescribed manner and section 11 shall have effect in relation to the registration of the mark as if the application had been an application under section 6(1).

(2) In deciding under the provisions referred to in subsection (1), the registrar shall have regard only to the considerations referred to in section 13(3) and a decision under those provisions in favour of the applicant shall be conditional on the determination in his or her favour by the registrar under subsection 13(2) of any objection relating to the matters referred to in section 13(6).

(3) Where notice of objection is given relating to the matters referred to in section 13(6), the registrar shall, after hearing the parties, decide whether and subject to what conditions and limitations or amendments or modifications of the application or of the regulations, registration is to be permitted.

15. Registration.

(1) When an application for registration of a trademark in Part A or in Part B of the register has been accepted and—

- (a) the application has not been objected to and the time for notice of the objection has expired; or
- (b) the application has been objected to and the objection has been decided in favour of the applicant,

the registrar shall, unless the application has been accepted in error, register the trademark in Part A or Part B, and the trademark, when registered, shall be registered from the date of the application for registration and that date shall be taken to be the date of registration.

(2) Subsection (1) shall, as regards a trademark registered under this Act with the benefit of any enactment relating to international or commonwealth arrangements, have effect subject to the provisions of that enactment.

(3) On the registration of a trademark, the registrar shall issue to the applicant a certificate in the prescribed form of the registration signed by him or her and under the seal of the registrar.

(4) Where registration of a trademark is not completed within twelve months from the date of the application by reason of default on the part of the applicant, the registrar may, after giving notice of the non-completion to the applicant in writing in the prescribed manner, treat the application as abandoned unless it is completed within the time specified for the purpose in the notice.

16. Duration and renewal of registration.

(1) The registration of a trademark shall be for a period of seven years and shall be renewable every ten years upon payment of a prescribed fee.

(2) The registrar shall, on application made by the registered owner of a trademark in the prescribed manner and within the prescribed period, renew the registration of the trademark.

17. Procedure on expiry of period of registration.

(1) At the prescribed time before the expiration of the initial registration of a trademark, the registrar shall send the registered owner notice of the date of expiration of the trademark, the conditions as to payment of the prescribed fees and otherwise for renewal of registration.

(2) Where at the date of expiration of the registration the conditions referred to in subsection (1) have not been complied with, the registrar may remove the trademark from the register, subject to such conditions as to its restoration to the register as may be prescribed.

18. Status of unregistered trademark.

(1) Where a trademark has been removed from the register for non-payment of the fee for renewal, it shall, for the purpose of an application for registration of a trademark during one year next after the date of the removal, be taken to be a trademark that is already on the register.

(2) Subsection (1) shall not have effect where the registrar or the court is satisfied either—

- (a) that there has been no bona fide trade use of the trademark that has been removed during the two years immediately preceding its removal; or
- (b) that no deception or confusion would be likely to arise from the use of the trademark that is the subject of the application for registration by reason of previous use of the trademark that has been removed.

19. Combined trademarks.

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

(2) Each separate trademark must satisfy all the conditions of an independent trademark and shall, subject to sections 23 and 58, have all the incidents of an independent trademark.

(3) Where a trademark or parts of the trademark is registered as separate trademarks in the name of the same owner, they shall be taken to be and shall be registered as, associated trademarks.

20. Series of trademarks.

(1) Where a person who claims to be the owner of several trademarks, in respect of the same goods or services or the same description of goods or services, seeks to register those trademarks and the trademarks resemble each other and the material particulars differ in respect of—

- (a) statements of the goods or services in relation to which they are respectively used or proposed to be used;
- (b) statements of number, price, quality or names of places;
- (c) other matter of a non-distinctive character which do not substantially affect the identity of the trademark; or
- (d) colour,

the trademarks may be registered as a series in one registration.

(2) All trademarks registered under subsection (1) shall be taken to be and shall be registered as associated trademarks.

(3) On application made in the prescribed manner by the registered owner of two or more trademarks registered as associated trademarks, the registrar may dissolve the association if he or she is satisfied that there would be no likelihood of deception or confusion being caused if that trademark 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.

(4) A person aggrieved by the decision of the registrar shall appeal to the court.

21. Powers and restrictions on assignment and transmission of trademarks relating to goods.

(1) A registered trademark relating to goods is assignable and transmissible in connection with the goodwill of a business or not.

(2) A registered trademark relating to goods shall be assignable and transmissible in respect of all the goods in respect of which it is registered or of some of those goods.

(3) Subsections (1) and (2) shall have effect in the case of an unregistered trademark used in relation to any goods as they have effect in the case of a registered trademark registered in respect of any goods, if at the time of the assignment or transmission of the unregistered trademark—

- (a) the mark is or was used in the same business as a registered trademark; and
- (b) the mark was assigned or transmitted at the same time and to the same person as that registered trademark and in respect of goods all of which are goods in relation to which the unregistered trademark was used in that business and in respect of which that registered trademark is or was assigned or transmitted.

(4) Notwithstanding subsections (1), (2) and (3), a trademark shall not be assignable or transmissible in a case in which as a result of an assignment or transmission there would in the circumstances subsist whether under the common law or by registration, exclusive rights in more than one of the persons concerned to the use, in relation to—

- (a) the same goods;
- (b) the same description of goods; or
- (c) goods or descriptions of goods which are associated with each other, of trademarks nearly resembling each other or of identical trademarks, if having regard to the similarity of the goods or the association of goods or descriptions of goods and to the similarity of the trademarks, the use of the trademarks in exercise of those rights, would be likely to deceive or cause confusion.

(5) Where a trademark is or has been assigned or transmitted as in subsection (3), the assignment or transmission shall not be taken to be invalid under this subsection if the exclusive rights subsisting as a result in the persons concerned respectively are, having regard to limitations imposed, not to be exercisable by two or more of those persons in relation to goods to be sold or otherwise traded in, within Uganda otherwise than for export or in relation to goods to be exported to the same market outside Uganda.

(6) The owner of a registered trademark who proposes to assign it in respect of goods 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 issue him a certificate stating whether, having regard to the similarity of the goods or the association of the goods or descriptions of goods and to the similarity of the trademarks referred to in the case, the proposed assignment would or would not be invalid under subsection (4).

(7) A certificate issued shall, unless it is shown that the certificate was obtained by fraud or misrepresentation, be conclusive as to the validity under subsection (4) of the assignment in so far as the validity depends upon the facts set out in the case, but, as regards a certificate in favour of validity, only if application of the registration under section 26 of the title of the person becoming entitled is made within six months from the date on which the certificate is issued.

(8) Where an assignment in respect of goods of a trademark that is at the time of the assignment used in a business dealing in those goods, is made otherwise than in connection with the goodwill of that business, the assignment shall not take effect until the following requirements have been satisfied—

- (a) the assignee must, not later than the expiration of six months from the date on which the assignment is made or within an extended period as the registrar may allow, apply to him or her for directions with respect to the advertisement of the assignment; and
- (b) shall advertise the assignment in the form and manner and within the period as the registrar may direct.

(9) A person aggrieved by the decision of the registrar under this section may appeal to court.

22. Powers and restrictions of assignment and transmission of trademarks relating to services.

(1) A registered trademark relating to services is assignable and transmissible in connection with the goodwill of a business or not.

(2) A registered trademark relating to services is assignable and transmissible in respect of all the services in respect of which it is registered or of some of those services.

(3) Subsections (1) and (2) shall have effect in the case of an unregistered trademark used in relation to services as they have effect in the case of a trademark registered in respect of services, if at the time of the assignment or transmission of the unregistered trademark if—

- (a) it is used in the same business as a registered trademark;
- (b) it is assigned or transmitted at the same time and to the same person as that registered trademark and in respect of services all of which are services in relation to which the unregistered trademark is or was used in that business and in respect of which the registered trademark is or was assigned or transmitted.

(4) Notwithstanding subsections (1), (2) and (3), a trademark is not assignable or transmissible in a case in which as a result of an assignment or transmission, there would, in the circumstances, subsist by registration, exclusive rights subsist in more than one of the persons concerned to the use, in relation to—

- (a) the same services;
- (b) the same description of services; or
- (c) services or descriptions of services which are associated with each other, nearly resembling each other or identical to each other, if having regard to the similarity of the services or the association of the services or descriptions of services, the use of the trademarks in exercise of those rights would be likely to deceive or cause confusion.

(5) Where a trademark is assigned or transmitted under subsection (4), the assignment or transmission shall not be taken to be invalid under this section if the exclusive rights subsisting as a result in the persons concerned respectively are, having regard to limitations imposed on them, such as not to be exercisable by two or

more of those persons in relation to services for use in Uganda in relation to services for use in the same country, territory or place outside Uganda or in relation to services available for acceptance in Uganda.

(6) The owner of a registered trademark who proposes to assign it in respect of any of the 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 issue to him or her a certificate stating whether, having regard to the similarity of the services or the association of the services and goods or descriptions of services and goods and to the similarity of the trademarks referred to in that case, the proposed assignment of the trademark would or would not be invalid under subsection (4).

(7) The certificate issued is unless it is shown that the certificate was obtained by fraud or misrepresentation, conclusive as to the validity under subsection (4) of the assignment in so far as the validity depends upon the facts set out in the case.

(8) As regards a certificate in favour of validity the certificate is conclusive, only if application for the registration under section 26 of the title of the person becoming entitled is made within six months from the date on which the certificate is issued.

(9) Where an assignment in respect of services of a trademark that is at the time of the assignment used in a business of providing those services is made otherwise than in connection with the goodwill of that business, the assignment shall not take effect until—

(a) the assignee shall, not later than the expiration of six months from the date on which the assignment is made or within such extended period, as the registrar may allow, applied to the registrar directions with respect to the advertisement of the assignment; and

(b) the assignment is advertised in a form and manner and within a period as the registrar may direct.

(10) A person aggrieved by the decision of the registrar under this section may appeal to court.

23. Certain trademarks to be associated so as to be assignable as a whole.

Trademarks that are registered as or that are taken to be associated trademarks by virtue of this Act, shall be assignable and transmissible only as a whole and not separately, but they shall for all other purposes be taken to have been registered as separate trademarks.

24. Power of registered owner to assign and give receipts.

Subject to this Act, a person registered as owner of a trademark may, subject to the rights appearing from the register, assign the trademark and give effectual receipts for any consideration for the assignment.

25. Registration of assignments and transmission.

(1) Where a person becomes entitled by assignment or transmission to a registered trademark, he or she shall make an application to the registrar to register his or her title and the registrar shall, on receipt of the application and on proof of title to his or her satisfaction, register him or her as the owner of the trademark in respect of the goods or services of which the assignment or transmission has effect and shall cause particulars of the assignment or transmission to be entered on the register.

(2) A person aggrieved by the decision of the registrar under this section may appeal to court.

(3) Except for the purposes of an appeal under this section or of an application under section 83, a document or instrument in respect of which no entry has been made in the register in accordance with subsection (1), shall not be admitted in evidence in any court in proof of the title to a trademark unless the court otherwise directs.

26. Alteration of deposited regulations or expunging or varying of entry in register relating to certification mark.

(1) The regulations deposited in respect of a certification mark may under section 13, on the application of the registered owner, be altered by the registrar.

(2) The registrar may, before granting an application, cause it to be advertised.

(3) Where it appears to the registrar to be expedient and within the prescribed time from the date of the advertisement if a person gives notice to the registrar of objection to the application, the registrar shall not decide the matter without giving the parties an opportunity of being heard.

(4) On application to the court by an aggrieved person in the prescribed manner and subject to section 66, the registrar or on application by the registrar to the court, the court may make an order as it thinks fit for expunging or varying an entry in the register relating to a certification mark or for varying the deposited regulations, on the ground that—

- (a) the owner is no longer competent, in the case of any of the goods or services in respect of which the trademark is registered, to certify those goods or services;
- (b) the owner has failed to observe a provision of the deposited regulations to be observed on his or her part;
- (c) it is no longer to the public advantage that the trademark should be registered; or
- (d) it is necessary for the public advantage that, if the trademark remains registered, the regulations should be varied.

(5) The registrar shall rectify the register or the deposited regulations in such manner as may be necessary to give effect to an order made under subsection (4)(a).

PART IV—EFFECT OF REGISTRATION AND ACTION FOR INFRINGEMENT

27. Restriction on registration.

(1) The registrar shall not register as a trademark or part of a trademark any matter the use of which would be likely to deceive or would be contrary to law, morality or any scandalous design.

(2) The registrar shall not register as a trademark a word commonly used and accepted as a name of a single chemical element or compound, as distinguished from a mixture, relating to goods in respect of a chemical substance or preparation.

(3) The registration of any word referred to in subsection (2) in force at the commencement of this Act or any such registration after the commencement of this Act shall, notwithstanding section 40, be taken for the purposes of section 83 to be an entry made in the register without sufficient cause or an entry wrongly remaining on the register as the circumstances may require.

(4) This section shall not have effect in relation to a word which is used to denote only a brand or make of the element or compound as made by the owner or a registered user of the trademark, as distinguished from the element or compound as made by others and in association with a suitable name or description open to public use.

(5) A sign shall not be registered as a trademark relating to goods if it consists exclusively of—

- (a) the shape that results from the nature of the goods themselves;
- (b) the shape of goods that is necessary to obtain a technical result; or
- (c) the shape that gives substantial value to the goods.

28. No action for unregistered trademark.

A person may not institute proceedings to prevent or to recover damages for an unregistered trademark.

29. Passing off.

Nothing in this Act shall be taken to affect a right of action against a person for passing off goods or services as the goods or services of another or the remedies in respect of the right of action.

30. Rights given by registration of goods in Part A and infringement.

(1) Subject to sections 35 and 36, the registration before or after the commencement of this Act, of a person in Part A of the register as owner of a trademark other than a certification mark in respect of any goods shall, if valid, give or be taken to have given to that person the exclusive right to the use of the trademark in relation to those goods.

(2) Without prejudice to the general effect of subsection (1), the right conferred by that subsection shall be taken to be infringed by a person who, not being the owner of the trademark or a registered user of the trademark uses by way of permitted use, a mark identical with or so nearly resembling it, as to be likely to deceive or cause confusion in the course of trade in relation to any goods of the same description where the use would result in a likelihood of confusion and in such a manner as to render the use of the mark likely to be taken—

- (a) as a trademark relating to goods; or
- (b) in a case in which the use of the goods or in physical relation to the goods or in any advertising circular or other advertisement issued to the public, as importing a reference to some person having the right as owner or as registered user of the trademark or to goods with which that person is connected in the course of trade.

(3) The right to the use of a trademark given by registration in Part A of the register, shall be subject to conditions or limitations entered on the register and shall not be taken to be infringed by the use of that mark in any mode, in relation to goods to be sold or otherwise traded in a place, in relation to goods to be exported to a market or in any circumstances, to which, having regard to the limitations, the registration does not extend.

(4) The right to the use of a trademark given by registration in Part A of the register shall not be taken to be infringed by the use of that mark by any person who—

- (a) in relation to goods connected in the course of trade with the owner or a registered user of the trademark if, as to those goods or a bulk of which they form part, the owner or the registered user conforming to the permitted use has applied the trademark and has not subsequently removed or obliterated it or has at any time expressly or impliedly consented to the use of the trademark; or
- (b) in relation to goods adapted to form part of or to be accessory to other goods, in relation to which the trademark has been used without infringement of the right given by registration in Part A of the register or might for the time being so used, if the use of the mark is reasonably necessary in order to indicate that goods are adapted and neither the purpose nor the effect of the use of the mark is to indicate otherwise than in accordance with the fact a connection in the course of trade between a person and the goods.

(5) The use of a registered trademark relating to goods, being one of two or more registered trademarks relating to goods which are identical or nearly resemble each other, in exercise of the right to the use of that trademark given by registration in Part A of the register, shall not be taken to be an infringement of the right so given the use of any other of those trademarks.

31. Rights given by registration of services in Part A and infringement.

(1) Subject to sections 35 and 36, the registration of a person as owner of a trademark other than a certification trademark in respect of services, shall, give to that person in Part A of the register the exclusive right to the use of the trademark in relation to those services.

(2) Without prejudice to the general effect of subsection (1), the right conferred by subsection (1) shall be taken to be infringed by a person who, not being the owner of the trademark or a person authorised by the owner for that purpose, uses it in connection with the provision of any services a mark identical with or nearly

resembling it, in relation to services in respect of which it is registered or in relation to services of the same description where the use would result in a likelihood of confusion and in such a manner as to render the use of the mark likely to be taken—

- (a) as a trademark relating to services; or
- (b) in a case in which the use is use at or near the place where the services are available for acceptance or performed or in an advertising circular or other advertisement issued to the public as importing a reference to some person having a right either as owner or by his authorisation under the relevant regulations to use the mark or services with the provision of which that person is connected in the course of business.

(3) The right to the use of a trademark given by registration in Part A of the register shall be subject to conditions or limitations entered on the register and shall not be taken to be infringed by the use of that mark in any mode, in relation to services for use or available for acceptance in a place, country or territory or in any other circumstances, to which, having regard to the limitations, the registration does not extend.

(4) The right to the use of a certification mark given by registration in Part A of the register shall not be taken to be infringed by the use of that mark by a person who—

- (a) in relation to services to which the owner of the mark or a registered user conforming to the permitted use has applied the mark, where the purpose and effect of the use of the mark is to indicate, in accordance with the fact, that those services have been certified by the owner;
- (b) in relation to services the provision of which is connected in the course of business with the owner or the registered user of the mark, where the owner or registered user has at any time expressly or impliedly consented to the use of the mark; or

- (c) in relation to services available for use with other services in relation to which the mark has been used without infringement of the right given by registration or might for the time being be so used, if—

- (i) the use of the mark is reasonably necessary in order to indicate that the services are available for that use; and
- (ii) neither the purpose nor the effect of the use of the mark is to indicate otherwise than in accordance with the fact a connection in the course of business between a person and the provision of those services.

(5) The use of a registered trademark relating to services, being one or two or more registered trademarks relating to services that are identical or nearly resemble each other, in exercise of the right to the use of that trademark given by registration, shall not be taken to be an infringement of the right given to the use of any other of those trademarks.

32. Rights given by registration of goods in Part B and infringement.

(1) Subject to subsection (2), the registration of a person in Part B of the register as owner of a trademark in respect of any goods shall, give or be taken to have given to that person a similar right in relation to those goods as if the registration had been in Part A of the register and section 30 shall have effect in a similar manner in relation to a trademark registered in respect of goods in Part B of the register as they have effect in relation to a trademark registered in Part A of the register.

(2) In an action for infringement of the right to the use of a trademark given by registration in Part B of the register, otherwise than by an act that is taken to be an infringement by virtue of section 34, an injunction or other relief shall not be granted to the plaintiff if the defendant establishes to the satisfaction of the court that—

- (a) the use of which the plaintiff complains is not likely to deceive or cause confusion; or

- (b) the use is not likely to be taken as indicating a connection in the course of trade between the goods and some person having the right either as owner or as registered user of the trademark.

33. Rights given by registration of services in Part B and infringement.

(1) Subject to subsection (2), the registration of a person in Part B of the register as owner of a trademark in respect of any services shall, give to that person a similar right in relation to those services as if the registration had been in Part A of the register and section 31 shall have effect in a similar manner in relation to a trademark registered in respect of services in Part B of the register as they have effect in relation to a trademark registered in Part A of the register.

(2) In an action for infringement of the right to the use of a trademark given by registration in Part B of the register otherwise than by an act that is taken to be an infringement by virtue of section 29, an injunction or other relief shall not be granted to the plaintiff if the defendant establishes to the satisfaction of the court that—

- (a) the use of which the plaintiff complains is not likely to deceive or cause confusion; or
- (b) the use is not likely to be taken as indicating that a person having the right either as owner; or as registered user to use the mark is connected in the course of business with the provision of the services.

34. Infringement by breach of certain restrictions.

(1) Where, by a contract in writing made with the owner or a registered user of a registered trademark relating to goods or services, a purchaser or owner of goods or services, enters into an obligation to the effect that they will not do, in relation to the goods or services an act to which this section applies, the owner of the goods or services having notice of the obligation, does that act or authorises it to be done, in relation to the goods or services, in the course of trade or with a view to any dealing in the course of trade, shall be taken to infringe the right to the use of the trademark given by registration.

(2) Subsection (1) does not apply unless the person referred to as owner became the owner of the goods by purchase for money or money's worth in good faith before receiving notice of the obligation or by virtue of a title derived through another who became the owner.

(3) The acts to which this section applies are—

- (a) the applicant of the trademark upon the goods or services after they have suffered alteration in a manner specified in the contract as respects their state or condition, get-up or packing;
- (b) in a case in which the trademark is upon the goods or services, the alteration, part removal or part obliteration of the trademark;
- (c) in a case in which the trademark is upon the goods or services and there is also other matter, being matter indicating a connection in the course of trade between the owner or registered user and the goods or services, the removal or obliteration wholly or partly, of the trademark unless that other matter is wholly removed or obliterated;
- (d) in a case in which the trademark is upon the goods or services, the application of any other trademark to the goods or services; and
- (e) in a case in which the trademark is upon the goods, the addition to the goods or services of any other matter in writing that is likely to injure the reputation of the trademark.

(3) In this section, references in relation to goods or services to the owner, a registered user and to the registration of a trademark shall be construed respectively, as references to the owner in whose name the trademark is registered, a registered user who is registered and to the registration of the trademark, in respect of those goods or services and the expression "upon" includes in relation to any goods or services a reference to physical relation to the goods or services.

35. Saving of vested rights.

Nothing in this Act shall entitle the owner or a registered user of a registered trademark to interfere with or restrain the use by a person of a trademark identical with or nearly resembling it in relation to goods or services in relation to which that person or a predecessor in title has continuously used that trademark from a date before—

- (a) the use of the trademark in relation to those goods or services by the owner or a predecessor in title; or
- (b) the registration of the trademark in respect of those goods or services in the name of the owner or a predecessor in title, whichever is the earlier or to object on the use being proved to that person being put on the register for that identical or nearly resembling trademark in respect of those goods or services under section 39.

36. Saving in respect of use of name, address or description of goods or services.

The registration of a trademark shall not affect—

- (a) a bona fide use by a person of his or her own name or the name of his or her place of business or of the name of the place of business of any of his or her predecessors in business;
- (b) the bona fide use by a person of any description of the character or quality of his or her goods or services, not being a description that is likely to be taken as importing a reference mentioned in section 30(2)(b) or;
- (c) the bona fide use by a person of a description of the character or quality of his or her services, not being a description that is likely to be taken as importing a reference as mentioned in section 31(2)(b).

37. Prohibition of registration of identical and resembling trademarks.

(1) Subject to section 39, a trademark relating to goods shall not be registered in respect of goods or description of goods that is identical with or nearly resembles a trademark belonging to a different owner and already on the register in respect of—

- (a) the same goods;
- (b) the same description of goods; or
- (c) services or a description of services which are associated with those goods or goods of that description.

(2) Subject to section 38, a trademark relating to services shall not be registered in respect of services or description of services that is identical with or nearly resembles a trademark belonging to a different owner and already on the register in respect of—

- (a) the same services;
- (b) the same description of services; or
- (c) goods or a description of goods which are associated with those services or services of the description.

38. Application for registration of identical or resembling trademarks.

(1) Where separate applications are made by different persons to be registered by the owner as a trademark or if in the case of a trademark relating to—

- (a) goods it contains matter common to the trade or otherwise of a non-distinctive character; or
- (b) services it contains matter common to the provision of services of that description or otherwise of non-distinctive character,

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

- (i) that the owner shall disclaim any right to the exclusive use of any part of the trademark or to the exclusive use of all or any portion of the matter, to the exclusive use of which the registrar or court holds him or her not to be entitled; or

- (ii) that he or she shall make such other disclaimer as the registrar or court may consider necessary for the purpose of defining his or her rights under the registration.

(2) A disclaimer on the register shall not affect rights of the owner of a trademark except where the disclaimer would arise out of the registration of the trademark in respect of which the disclaimer is made.

39. Concurrent use.

The registrar or court may permit the registration by more than one owner, in a case of honest concurrent use or other special circumstances in respect of—

- (a) the same goods or services;
- (b) the same description of goods or services;
- (c) goods and services or descriptions of goods and services which are associated with each other; or
- (d) trademarks that are identical or nearly resemble each other, subject to such conditions and limitations as the registrar or the court may impose.

40. Registration in Part A to be conclusive as to validity after seven years.

(1) In all legal proceedings relating to a trademark registered in Part A of the register including applications under section 94, the original registration in Part A of the register of the trademark 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 trademark contravenes section 27(1).

(2) Notwithstanding sections 32 and 33, subsection (1) does not apply to a trademark registered under Part B of the register.

41. Registration subject to disclaimer.

(1) Where a trademark contains a part that is not separately registered by the owner as a trademark or if—

- (a) in the case of a trademark relating to goods it contains matter common to the trade or otherwise of a non-distinctive character; or
- (b) in the case of a trademark relating to services it contains matter common to the provision of services of that description or otherwise of non-distinctive character,

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

- (i) that the owner shall disclaim any right to the exclusive use of any part of the trademark or to the exclusive use of all or a portion of any such matter, to the exclusive use of which the registrar or court holds him or her not to be entitled; or
- (ii) that he or she shall make such other disclaimer as the registrar or court may consider necessary for the purpose of defining his or her rights under that registration.

(2) A disclaimer on the register shall not affect rights of the owner of a trademark except where the disclaimer arises out of the registration of the trademark in respect of which the disclaimer is made.

42. Registration of jointly owned trademarks.

(1) Where the relation between two or more persons interested in a trademark is that none of them is entitled to use the mark except—

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

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

(2) Subject to subsection (1), nothing in this Act shall authorise the registration of two or more persons who use a trademark independently or propose to so use it, as joint owners.

43. Words used as name or description of an article or substance.

(1) The registration of a trademark shall not be taken to have become invalid by reason only, of a use, after the date of the registration, of a word or words, which the trademark contains or of which it consists as the name or description of an article or substance.

(2) Where—

- (a) there is a well-known and established use of the word or words as the name or description of the article or substance by a person or persons carrying on a trade, not being used in relation to goods connected in the course of trade with the owner or a registered user of the trademark or in the case of a certification mark goods certified by the owner; or
- (b) the article or substance was formerly manufactured under a patent, and a period of two years or more after the expiry of the patent has elapsed and the word or words is or are the only practicable name or description of the article or substance,

subsection (3) shall have effect.

(3) Where the facts mentioned in subsections (2) (a) and (b) are proved with respect to a word or words, then—

- (a) if the trademark consists solely of that word or those words, the registration of the trademark, so far as regards registration in respect of the article or substance in question or any goods of the same description, shall be taken for the purposes of section 93 to be an entry wrongly remaining on the register;

- (b) if the trademark contains that word or those words, the registrar or the court, in deciding whether the trademark shall remain on the register, so far as regards registration in respect of the article or substance in question and of goods of the same description, may in case of a decision in favour of its remaining on the register, require that the owner shall disclaim a right to the exclusive use in relation to that article or substance and goods of the same description of that word or those words.

(4) A disclaimer under subsection (3)(b) on the register shall not affect rights of the owner of a trademark except the rights in respect of which the disclaimer is made.

(5) For the purpose of any other legal proceedings relating to the trademark if—

- (a) the trademark consists only of that word or those words referred to in subsection (3), all rights of the common law or by registration, to the exclusive use of the trademark in relation to the article or substance in question or to goods of the same description; or
- (b) the trademark contains that word or those words and other matter, all rights of the owner to the exclusive use of that word or those words in that relation,

shall be taken to have ceased on the date at which the use mentioned in subsection (1) first became well known and established or at the expiration of the period of two years referred to in subsection (2)(b).

(6) A word which is the commonly used and accepted name of any single chemical element or single chemical compound, as distinguished from a mixture, shall not be registered as a trademark in respect of a chemical substance or preparation.

(7) The registration of any word referred to in subsection (2) in force at the commencement of this Act or any such registration after the commencement of this Act shall, notwithstanding section 40, be taken for the purposes of section 93 to be an entry made in the register without sufficient cause or an entry wrongly remaining on the register as the circumstances may require.

(8) Sub-sections (1) to (4) shall not have effect in relation to a word which is used to denote only a brand or make of the element or compound as made by the owner or a registered user of the trademark, as distinguished from the element or compound as made by others and in association with a suitable name or description open to the public use.

44. Words used as name or description of an activity.

(1) The registration of a trademark relating to services shall not be taken to have become invalid by reason only of any use, after the date of registration, of a word or words, which the trademark contains or of which it consists, as the name or description of some activity.

(2) Where it is proved that there is a well known and established use of the word or words as the name or description of some activity by a person or persons providing services which include that activity, not being used in relation to services with the provision of which the owner or a registered user of the trademark is connected, in the course of business subsection (2) shall have effect.

(3) The facts mentioned in subsection (2) are proved with respect to any word or words, where—

- (a) the trademark consists solely of that word or those words, the registration of the trademark, so far as regards registration in respect of the activity in question, shall be taken for the purposes of section 4 to be an entry wrongly remaining on the register;
- (b) the trademark contains that word or those words and other matter, the registrar or the court, in deciding whether the trademark shall remain on the register, so far as regards registration in respect of the activity in question, may, in case of a decision in favour of its remaining on the register, require that the owner shall disclaim any right to the exclusive use in relation to that activity of that word or those words, that no disclaimer on the register shall affect any rights of the owner of a trademark except where the disclaimer arises out of the registration of the trademark in respect of which the disclaimer is made; and

(c) for the purposes of any other legal proceedings relating to the trademark if—

- (i) the trademark consists solely of that word or those words, all rights of the owner whether under the common law or by registration, to the exclusive use of the trademark in relation to the activity in question; or
- (ii) the trademark contains that word or those words, all rights of the owner to the exclusive use of that word or those words,

shall be taken to have ceased on the date at which the use mentioned in subsection (2) first became well known and established.

45. Protection of marks registered in a country of origin.

(1) Subject to subsection (3), the registrar may refuse to register a trademark relating to goods in respect of goods or description of goods if it is proved to his or her satisfaction by the person opposing the application for registration that the mark is identical with or nearly resembles a trademark which is already registered in respect of—

- (a) the same goods;
- (b) the same description of goods; or
- (c) services or a description of services which are associated with those goods or goods of that description,

in a country or place from which the goods originate.

(2) Subject to subsection (3), the registrar may refuse to register any trademark relating to services in respect of any services or description of services if it is proved to his or her satisfaction by the person opposing the application for registration that the mark is identical with or nearly resembles a trademark which is already registered in respect of—

- (a) the same services;
 - (b) the same description of services; or
 - (c) goods or a description of goods which are associated with those services or services of that description,
- in a country or place from which the services originate.

(3) An application to register shall not be refused under this section where—

- (a) the applicant proves that he or she or his or her predecessors in business have in Uganda, in relation to the goods or services, continuously used the trademark for the registration of which he or she has made application from a date before the date of the registration of the other mark in the country or place of origin; or
- (b) the person objecting does not give an undertaking to the satisfaction of the registrar that he or she will, within three months from the giving of the notice of objection, apply for registration in Uganda of the trademark registered in the country or place of origin and will take all necessary steps to complete the registration.

(4) The protection given under this section in respect of a trade mark in relation to goods and services originating from a country other than Uganda shall only be accorded if the country of origin of the goods and services accords to goods and services originating from Uganda the same treatment.

46. Removal of trademark from register on proof of prior registration in country of origin.

(1) Subject to subsection (3), the court may, on application in writing within seven years from the registration in Uganda of a trademark relating to goods by a person aggrieved by the registration, remove that trademark from the register if it is proved to the satisfaction of the court that the trademark is identical with or nearly resembles a trademark which was, prior to the registration in Uganda of the trademark, registered in respect of—

- (a) the same goods;
 - (b) the same description of goods; or
 - (c) services or a description of services which are associated with those goods or goods of that description,
- in a country or place from which the goods originate.

(2) Subject to subsection (3), the court may, on application in writing made within seven years from the registration in Uganda of a trademark relating to services by a person aggrieved by the registration, remove that trademark from the register if it is proved to the satisfaction of the court that the trademark is identical with or nearly resembles a trademark which was, prior to the registration in Uganda of the trademark referred to subsection (1), registered in respect of—

- (a) the same services;
 - (b) the same description of services; or
 - (c) goods or a description of goods which are associated with those services or services of that description,
- in a country or place from which the services originate.

(3) A trademark shall not be removed from the register under this section in the following cases if—

- (a) the owner of the trademark consented to the registration in Uganda of the trademark referred to in subsection (1); or
- (b) the owner of the trademark registered in Uganda proves that he or she or his or her predecessors in business have continuously used that trademark in Uganda in connection with the goods or services from a date before the date of the registration of the other trademark in the country or place of origin; or
- (c) the applicant does not prove—

- (i) that within the five years immediately preceding the making of the application under this section, there has been bona fide use in connection with goods or services in Uganda of the trademark registered in the country or place or origin;
- (ii) that the special circumstances of the trade or affecting the provision of the goods or services account for the non-use of that trademark in Uganda within the same period; or
- (iii) that the trademark registered in the country or place of origin was first registered there within the period of five years,

and does not give an undertaking to the satisfaction of the registrar that he or she will within three months from the making of the application under this section apply for registration in Uganda of the trademark so registered in the country or place of origin and will take all necessary steps to complete the registration.

(4) The protection given under this section in respect of a trade mark in relation to goods and services originating from a country other than Uganda shall only be accorded if the country of origin of the goods and services accords to goods and services originating from Uganda the same treatment.

47. Associated trademarks.

(1) Where a trademark relating to goods registered or that is the subject of an application for registration, in respect of any goods is identical with another trademark that is registered or is the subject of an application for registration, in the name of the same owner in respect of—

- (a) the same goods or description of goods; or
- (b) services that are associated with those goods or goods of that description or so nearly resembling it as to be likely to deceive or cause confusion if used by a person other than the owner,

the registrar may, at any time, require that the trademarks be entered on the register as associated trademarks.

(2) Where a trademark relating to services that are registered or subject of an application for registration, in respect of services identical with another trademark that is registered or is the subject of an application for registration, in the name of the same owner in respect of—

- (a) the same services or description of services; or
- (b) goods that are associated with those services or services of that description or so nearly resembling it as to be likely to deceive or cause confusion if used by a person other than the owner,

the registrar may at any time require that the trademarks be entered on the register as associated trademarks.

(3) On application made in the prescribed manner by the registered owner of two or more trademarks registered as associated trademarks, the registrar may dissolve the association as regards any of them if he or she is satisfied that there would be no likelihood of deception or confusion being caused if that trademark was used by another person in relation to any of the goods or services in respect of which it is registered and he or she may amend the register accordingly.

(4) A person aggrieved by the decision of the registrar under this section may appeal to the court.

PART V—USE AND NON-USE OF A TRADEMARK.

48. Removal from register and imposition of limitations on ground of non-use.

(1) Subject to sections 49(1), 50(1) and 52(1), a registered trademark may be removed from the register in respect of goods in respect of which it is registered, on application to the court by an aggrieved person and subject to section 67 on an application to the registrar, on the grounds that—

(a) the trademark was registered without a bona fide intention on the part of the applicant for registration that it should be used in relation to those goods or services by him or her or, if it was registered under section 58(1), by a body corporate or registered user concerned and that there has in fact been no bona-fide use of the trademark in relation to those goods or services by any owner up to the date one month before the date of the application; or

(b) at least one month prior to the date of the application a continuous period of three years or more elapsed during which the trademark was a registered trademark and during which there was no bona-fide use in relation to those goods or services by any owner.

(2) Except where—

(a) the applicant has been permitted under section 37 (2) to register an identical or nearly resembling trademark in respect of the goods or services in question; or

(b) the registrar is of the opinion that he or she might properly be permitted to register the a trademark,

the registrar may refuse an application made under subsection (1) in relation to goods or services, if it is shown that there has been, before the relevant date or during the relevant period bona fide use of the trademark by an owner in relation to goods of the same description, being goods in respect of which the trademark is registered.

(3) Where in relation to any goods in respect of which a trademark is registered—

(a) the matters referred to in subsection (1) (b), are shown so far as regards non-use of the trademark in relation to goods to be sold or otherwise traded in a particular place otherwise than for export from Uganda or in relation to goods to be exported to a particular market outside Uganda; and

(b) a person has been permitted under section 37(2) to register an identical or nearly resembling trademark in respect of those goods under a registration extending to use in relation to goods to be sold or otherwise traded in, in that place otherwise than export from Uganda or in relation to goods to be exported to that market or the registrar or the court is of opinion that he or she may properly be permitted to register the trademark,

on application by that person to the court and subject to section 68, to the registrar, as the case may be, the court or registrar may impose on the registration of the trademark limitations as the court or the registrar thinks proper for securing that the registration shall cease to extend to the use of that trademark.

(4) Where in relation to services in respect of which a trademark is registered—

(a) the matters referred to in subsection (1) (b), are shown so far as regards non-use of the trademark in relation to services to be provided or otherwise available for acceptance in Uganda or in relation to services to be exported to a particular market outside Uganda; and

(b) a person has been permitted under section 37 (1), to register an identical or nearly resembling trademark in respect of services under a registration extending to use in relation to services to be for use or available for acceptance in Uganda or for use in that country, territory or place or the court is of the opinion that he or she might be permitted to register the trademark,

on application by that person to the court and subject to section 69, to the registrar the court or registrar may impose on the registration of the trademark limitations as the court or the registrar thinks proper for securing that the registration shall cease to extend to the use of that trademark.

(5) An applicant is not entitled to rely for the purposes of subsection (1)(b), (3) or (4), on any non-use of a trademark that is shown to have been due to special circumstances in the trade and not to an intention not to use or to abandon the trademark in relation to the goods or services to which the application relates.

(6) The use of a trademark by another person shall be recognised as use of the trademark for the purpose of maintaining the registration subject to the control of the trademark owner.

(7) The use of a trademark in the course of trade shall not be unjustifiably encumbered by special requirements, such as use with another trademark, use in a special form or use in a manner detrimental to its capability to distinguish the goods or services of one undertaking from another.

49. Defensive registration of trademarks relating to goods.

(1) Where a trademark relating to goods and consisting of an invented word or invented words or a device or devices or a combination of them, has become so exceptionally well known as respects goods in respect of which it is registered and in relation to which it has been used that the use of that trademark in relation to other goods or to services or both, is likely to detract from its distinctive character in respect of the goods then, notwithstanding—

- (a) that the use would not be likely to be taken as indicating a connection in the course of trade between those other goods or those services or both, as the case may be and a person entitled to use the trademark in relation to the goods; and
- (b) that the owner registered in respect of the goods does not use or propose to use the trademark in relation to other goods or services or both, as the case may be and notwithstanding section 48, the trademark may, on the application in the prescribed manner of the owner registered in respect of the goods, be registered in his or her name in respect of other goods or services or both, as the case may be, as a defensive trademark and while registered, shall not be liable to be taken off the register in respect of those goods or those services under section 48.

(2) In determining whether a trademark relating to goods is exceptionally well known and whether its use in relation to other goods or to services or both, would be likely to detract from its distinctive character in respect of goods for which it is registered, the registrar shall have regard to all related circumstances, including—

- (a) the length of time the trademark has been in use;
- (b) the extent to which it has become well known in relation to the goods in respect of which it is registered;
- (c) the nature of those goods; and
- (d) whether the notoriety of the mark is limited because of its use on goods that do not have wide distribution.

(3) The registered owner of a trademark relating to goods may apply for the registration of a trademark in respect of goods as a defensive trademark notwithstanding that it is already registered in his name in respect of those goods otherwise than as a defensive trademark or may apply for the registration in respect of any goods otherwise than as a defensive trademark notwithstanding that it is already registered in his name in respect of those goods as a defensive trademark, in place of the existing registration.

(4) Subject to this section and to sections 52 and 53, this Act shall apply in respect of the registration of trademarks relating to goods as defensive trademarks and of trademarks so registered as they apply in other cases.

50. Defensive registration of trademarks relating to services.

(1) Where a trademark relating to services and consisting of an invented word or words or a device or devices or a combination of them, has become exceptionally well known in respects of services in respect of which it is registered and in relation to which it has been used that the use of it in relation to other services or to goods or both, is likely to detract from its distinctive character in respect of the services then notwithstanding—

(a) that the use would not be likely to be taken as indicating a connection in the course of business between the provision of those other services or those goods or both, as the case may be and a person entitled to use the trademark in relation to the services; and

(b) that the owner registered in respect of the services does not use or propose to use the trademark in relation to other services or goods or both, as the case may be and notwithstanding section 48,

the trademark may, on the application in the prescribed manner of the owner registered in respect of the services, be registered in his or her name in respect of other services or goods or both, as the case may be, as a defensive trademark and while so registered, shall not be liable to be taken off the register in respect of other services or goods or both, as the case may be under section 48(7).

(2) In determining whether a trademark relating to services is exceptionally well known and whether its use in relation to other services or to goods or both, is likely to detract from its distinctive character in respect of the services for which it is registered, the registrar shall have regard to all related circumstances, including—

- (a) the length of time the trademark has been in use;
- (b) the extent to which it has become well known in relation to the services in respect of which it is registered;
- (c) the nature of those services; and
- (d) whether the notoriety of the mark is limited because of its use in relation to services that are not widely available.

(3) The registered owner of a trademark relating to services may apply for the registration of the trademark in respect of services otherwise than as a defensive trademark or may apply for the registration in respect of any services otherwise than as a defensive trademark notwithstanding that it is already registered in his or her name in respect of those services as a defensive trademark, in place of the existing registration.

(4) Except as otherwise expressly provided in this section, sections 52 and 53 apply in respect of the registration of trademarks relating to services as defensive trademarks and of trademarks registered as they apply in other cases.

51. Defensive trademarks registered as associated trademarks.

A trademark registered as a defensive trademark and that trademark as otherwise registered in the name of the same owner shall, notwithstanding that the respective registrations are in respect of different goods or services, be taken to be and shall be registered as, associated trademark.

52. Removal of defensive trademarks from the register.

(1) On application to the court by an aggrieved person and subject to section 67, to the registrar—

- (a) the registration under section 50(1) of a trademark as a defensive trademark may be cancelled—
 - (i) on the ground that the requirements of section 50(1) are no longer satisfied in respect of goods in respect of which the trademark is registered in the name of the same owner otherwise than as a defensive trademark; or
 - (ii) as regards any goods or services in respect of which it is registered as a defensive trademark on the ground that there is no longer any likelihood that the use of the trademark in relation to those goods or services would detract from its distinctive character in respect of the goods in section 50(1).
- (b) the registration under section 51(1) of a trademark as a defensive trademark may be cancelled—
 - (i) on the ground that the requirements of section 51(1) are no longer satisfied in respect of any services in respect of which the trademark is registered in the name of the same owner otherwise than as a defensive trademark; or

- (ii) as regards any services or goods in respect of which it is registered as a defensive trademark on the ground that there is no longer any likelihood that the use of the trademark in relation to those services or goods would detract from its distinctive character in respect of the services in section 51(1).

(2) The registrar may at any time cancel the registration as a defensive trademark in respect of goods or services or both, of a trademark of which there is no longer any registration in respect of goods or services in the name of the same owner otherwise than as a defensive trademark.

53. Registered user.

(1) Subject to this section, a person other than the owner of a trademark may be registered as a registered user in respect of all or any of the goods or services in respect of which it is registered otherwise than as a defensive trademark with or without conditions or restriction.

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

(3) The permitted use of a trademark shall be taken to be use by the owner of the trademark and shall be taken not to be use by a person other than the owner for the purposes of section 48 and for any other purpose for which the use is material under this Act.

(4) Subject to any agreement subsisting between the parties, a registered user of a trademark is entitled to call upon the owner of the trademark to take proceedings to prevent infringement.

(5) Where the owner refuses or neglects to take proceedings within two months after being called upon, the registered user may institute proceedings for infringement in his or her own name as if he or she were the owner making the owner a defendant.

(6) An owner added as defendant is not liable for any costs unless he or she files a written statement of defence and takes part in the proceedings.

(7) Where it is proposed that a person should be registered as a registered user of a trademark, the owner and the proposed registered user may apply to the registrar in the prescribed manner and shall furnish him or her with a statutory declaration made by the owner or by some person authorised to act on his or her behalf and approved by the registrar—

- (a) giving particulars of the relationship, existing or proposed, between the owner and the proposed registered user, including particulars showing the degree of control by the owner over the permitted use which their relationship will confer and whether it is a term of their relationship that the proposed 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 stating—
 - (i) 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;
 - (i) whether the permitted use is to be for a period or without limit of period and if for a period, the duration of the period,

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

(8) Where the requirements of subsection (7) have been complied with, if the registrar, after considering the information furnished to him or her under that subsection, is satisfied that in all the circumstances the use of the trademark 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 or she is satisfied.

(9) The registrar shall refuse an application under subsection (6) if it appears to him or her that the grant of the application would tend to facilitate trafficking in a trademark.

(10) The registrar shall, if required by an applicant, take steps for securing that the information given for the purposes of an application under subsection (7) other than the matter entered in the register is not disclosed to rivals in trade.

54. Variation or cancellation of registration as a registered user.

(1) Without prejudice to section 83, the registration of a person as a registered user may be—

- (a) varied by the registrar as regards the goods or services in respect of which or any conditions or restrictions subject to which, it has effect, on application in the prescribed manner by the registered owner of the trademark to which the registration relates;
- (b) cancelled by the registrar on application in the prescribed manner by the registered owner or by the registered user or by any of other registered user of the trademark; or
- (c) cancelled by the registrar on application in the prescribed manner by a person on any of the following grounds that—
 - (i) the registered user has used the trademark otherwise than by way of the permitted use or in such a way as to cause or to be likely to cause, deception or confusion;
 - (ii) the owner or the registered user misrepresented or failed to disclose some fact material to the application for the registration or that the circumstances have materially changed since the date of the registration; or

- (iii) 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 or she is interested.

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

55. Notification of registration as registered user and or application for variation or cancellation of the registration.

The registrar shall—

- (a) cause to be notified the registration of a person as a registered user of a trademark to any other registered user of the trademark;
- (b) cause notice of an application under section 54 to be given to the registered owner and each registered user of the trademark not being the applicant;
- (c) give to the applicant on application and to all person to whom the application is notified and who intervene in the proceedings in accordance with the regulations an opportunity of being heard.

56. Registrar's decision under section 54 and 55 subject to appeal.

A person aggrieved by the decision of the registrar under sections 54 and 55 may appeal to the court.

57. Proposed use of trademarks by corporation to be construed.

(1) An application for the registration of a trademark in respect of any goods or services shall not be refused, and permission for the registration shall not be withheld, on the ground only that it appears that the applicant does not use or propose to use the trademark where—

- (a) the court or the registrar is satisfied that a body corporate is about to be constituted and that the applicant intends to assign the trademark to the body corporate with a view to the use the trademark in relation to those goods or services by the body corporate; or

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

(2) Section 48 shall have effect, in relation to a trademark registered under the power conferred by subsection (1)(b), as if for the reference, in section 48(3)(b), to intention on the part of an applicant for registration that a trademark should be used by him or her there were substituted a reference to intention on his or her part that it should be used by the body corporate or registered user concerned.

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

(4) Where a trademark is registered in respect of any goods or services under the power conferred by subsection (1), the name of an applicant who relies on an intention to assign to a body corporate, then, unless within the prescribed period or within such further period not exceeding six months as the registrar may on application being made to him or her in the prescribed manner allow the body corporate which has been registered as the owner of the trademark in respect of those goods or services, the registration shall cease to have effect in respect of the goods or services at the expiration of that period; and the registrar shall amend the register accordingly.

58. Use of one associated or substantially identical trademark equivalent to use of another.

(1) Where under this Act the use of a registered trademark is required to be proved for any purpose, the court or the registrar may, accept the use of an associated registered trademark or of the trademark with additions or alterations not substantially affecting its identity, as an equivalent for the use required to be proved.

- (2) The use of the whole of a registered trademark shall for the purposes of this Act, be taken to be use of a registered trademark, being a part, registered in the name of the same owner by virtue of section 20 (1).

59. Use of trademark for export trade.

The application in Uganda of a trademark relating to goods or services to be exported from Uganda and any other act done in Uganda in relation to goods or services to be so exported which, if done in relation to goods or services to be sold or otherwise traded in within Uganda would constitute use of a trademark, shall be taken to constitute use of the trademark in relation to those goods or services for any purpose for which the use is material under this Act.

60. Use of trademark after change in form of trade connection.

(1) The use of a registered trademark in relation to goods in any form of connection with the course of trade subsisting shall not be taken to be likely to cause deception or confusion on the ground only that the trademark has been or is used in relation to goods between which and that person or a predecessor in title his or her a different form of connection in the course of trade subsisted or subsists.

(2) The use of a registered trademark in relation to services between the provision of which and the person using it in any form of connection in the course of business subsists shall not be taken to be likely to cause deception or confusion on the ground only that the trademark has been or is used in relation to services between the provision of which and that person or a predecessor in title of his or her a different form of connection in the course of business subsisted or subsists.

PART VI—LEGAL PROCEEDINGS AND APPEALS.

61. Power of registrar to award costs.

(1) In all proceedings before the registrar, the registrar may award to any party costs as he or she may consider reasonable and may direct how and which parties are to be paid.

(2) An order made under subsection (1) may, by leave of the court, be enforced in the same manner as a judgment or order of the court to the same effect.

62. Registration to be prima facie evidence of validity.

In all legal proceedings relating to a registered trademark including applications under section 82 the fact that a person is registered as owner of the trademark is *prima facie* evidence of the validity of the original registration of the trademark and of all subsequent assignments and transmissions.

63. Certificate of validity.

(1) In any legal proceeding in which the validity of the registration of a registered trademark comes into question and is decided in favour of the owner of the trademark, the court may certify to that effect.

(2) Where the court certifies under subsection (1), then in any subsequent legal proceeding in which the validity of the registration comes into question, the owner of the trademark on obtaining a final order or judgment in his or her favour shall have his or her full costs, charges and expenses as between advocate and client, unless in the subsequent proceeding the court certifies that he or she ought not to have them.

64. Trade usage, etc. to be considered.

(1) In an action or proceeding in respect of a trademark relating to goods or a trade name, the registrar shall admit evidence of the usages of the trade concerned and of any relevant trademark relating to goods or trade name or get-up legitimately used by other persons.

(2) In an action respect of a trademark relating to services or business name, the registrar shall admit evidence of business usages in the provision of services in question and of any relevant trademark relating to services or business name or get-up legitimately used by other persons.

65. Registrar's appearance in proceedings involving rectification.

(1) In any legal proceeding in which the relief sought includes alteration or rectification of the register, the registrar shall have the right to appear and be heard and shall appear if directed by the court.

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

66. Court's power to review registration.

The court, in dealing with any question of the rectification of the register including all applications under section 83, may review any decision of the registrar relating to the entry in question or the correction sought to be made.

67. Procedure in case of option to apply to court or registrar.

(1) Where under this Act an applicant has an option to make an application whether to the court or to the registrar—

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

(2) A person aggrieved by the decision of the registrar under this section may appeal to the court.

68. Payment of costs by the registrar.

In all proceedings before the court under this Act, the costs of the registrar shall be at the discretion of the court but the registrar shall not be ordered to pay the costs of any of the parties.

69. Security for costs.

(1) Where a person who does not reside or carry on business in East Africa—

- (a) gives notice of objection under section 11; or
- (b) applies to the registrar under section 46 for a trademark to be removed from the register;

the registrar may require the person to give security for costs of the proceedings and may, if security is not given dismiss the proceedings.

(2) A person aggrieved by the decision of the registrar under this section may appeal to the court.

70. Powers of court on appeal.

Where the court hears an appeal for a decision of the registrar under this Act, the court may without prejudice to any other powers conferred on it by this Act—

- (a) confirm the decision of registrar;
- (b) set aside or vary the decision of the registrar or refer the decision to the registrar with such directions as the court may think fit; or
- (c) make such other order as the court may consider.

71. Chief Justice to make rules of procedure

(1) The Chief Justice, in consultation with the Attorney General may make rules as to the practice and procedure to be observed in respect of any jurisdiction which under this Act is exercisable by the High Court and also in respect of any appeals from the exercise of that jurisdiction.

(2) Rules made under this section may, in the case of the High Court, the Court of Appeal and the Supreme Court, apply to the proceedings the rules of practice and procedure applicable to civil proceedings in the High Court, the Court of Appeal or the Supreme Court as the case may be, subject to such modifications as may be specified in the rules.

PART VII—EVIDENCE.

72. Mode of giving evidence.

(1) In any proceeding under this Act before the registrar, the evidence shall be given by statutory declaration in the absence of directions to the contrary, but, in any case in which the registrar thinks fit, he or she may take evidence orally in place of or in addition to evidence by statutory declaration.

(2) The statutory declaration may, where there is an appeal, be used before the court in place of evidence by affidavit; and if used shall have all the incidents and consequences of evidence by affidavit.

(3) Where any part of the evidence is taken orally, the registrar shall, in respect of requiring the attendance of a witness and taking evidence on oath, be in the same position in all respects as a magistrate.

73. Evidence of entries in register.

(1) A copy of an entry in the register purporting to be certified by the registrar and sealed with his or her seal, shall be admitted in evidence in all courts and in all proceedings, without further proof or production of the original.

(2) A person who requires a certified copy under subsection (1) is entitled to obtain it upon payment of the prescribed fee.

74. Evidence of entries made or of things done by the registrar.

A certificate purporting to be signed by the registrar as to an entry, matter or thing that he or she is authorised by this Act to make or do, is *prima facie* evidence of the entry having been made and of the contents and of the matter or thing having been done or not been done.

PART VIII—OFFENCES.

75. Forging or counterfeiting trade mark.

Any person who with intention to defraud or to enable another to defraud any person, forges or counterfeits a trade mark commits an offence and is liable on conviction to a fine not exceeding forty eight currency points or imprisonment not exceeding two years or both.

76. Falsification of entries in register.

Where a person makes or causes to be made a false entry in the register, a writing falsely purporting to be a copy of an entry in the register, produces, tenders, causes to be produced or tendered in evidence the writing, knowing the entry or writing to be false, he or she commits an offence and is liable on conviction to a fine not exceeding one hundred currency points.

77. Falsely representing a trademark as registered.

A person who makes a representation—

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

commits an offence and is liable on conviction to a fine not exceeding one hundred currency points.

78. Falsifying or unlawful removal of a registered trademark.

(1) A person who falsifies or unlawfully removes a trademark that—

- (a) has been applied to goods that are being or are to be, dealt with or provided in the course of trade; or
- (b) has been applied in relation to goods or services that are being or are to be, dealt with or provided in the course of trade,

knowing that the trademark is registered or reckless whether or not the trademark is registered, commits an offence and is liable on conviction to a fine not exceeding forty eight currency points or imprisonment not exceeding two years or both.

(2) For the purposes of subsection (1), a person falsifies a registered trademark if the person—

- (a) alters or defaces it;
- (b) makes any addition to it; or
- (c) partly removes, erases or obliterates it,

without the permission of the registered owner or an authorised user of the trademark, and without being required or authorised to do so by this Act, or without direction from the registrar or an order of a court.

(3) For the purposes of subsection (1) a person unlawfully removes a registered trademark if the person wholly removes, erases or obliterates it—

- (a) without the permission of the registered owner or an authorised user of the trademark; and
- (b) without being required or authorised to do so by the Act, or without a direction from the registrar or an order of the court.

79. Falsely applying a registered trademark.

(1) A person who—

- (a) falsely applies a registered trademark to goods that are being or are to be dealt with or provided in the course of trade; or
- (b) falsely applies a registered trademark in relation to goods or services that are being or are to be dealt with or provided in the course of trade, knowing that the trademark is registered or reckless whether or not the trademark is registered,

commits an offence and is liable on conviction to a fine not exceeding forty eight currency points or imprisonment not exceeding two years or both.

(2) For the purposes of subsection (1) a person falsely applies a registered trademark to goods or in relation to goods or services if the person applies the trademark or a sign substantially identical with it to the goods or in relation to the goods or services—

- (a) without the permission of the registered owner or of an authorised user, of the trademark; and
- (b) without being required or authorised to do so by this Act, or without a direction from the registrar or an order of the court.

80. Manufacture and possession of dye etc for use in commission of offence.

(1) A person who makes a dye, block, machine or instrument—

- (a) knowing that it is likely to be used for or in the course of committing an offence against sections 78 and 79; or
- (b) reckless whether or not it is likely to be used for or in the course of committing an offence against sections 78 and 79, commits an offence.

(2) A person who draws or programs a computer or other device to draw a registered trademark or part of a registered trademark—

- (a) knowing that the trademark or part of the trademark is likely to be used for or in the course of committing an offence against sections 78 and 79; or
- (b) reckless whether or not the trademark or part of a trademark is likely to be used for or in the course of committing an offence against sections 78 and 79,

commits an offence.

(3) A person who intentionally has in his or her possession or disposes of—

- (a) a dye, block, machine or instrument;
- (b) a computer or other device, programmed to draw a registered trademark or part of a registered trademark; or
- (c) a representation of a registered trademark or of part of a registered trademark;

knowing that or reckless whether or not, the dye, block, machine, instrument, computer, device or representation is likely to be used for or in the course of committing an offence against sections 78 or 79 commits an offence.

(4) A person who commits an offence under this section is liable on, to a fine not exceeding forty eight currency points or imprisonment not exceeding two years or both.

81. Selling etc goods with false marks.

A person who intentionally sells goods, exposes goods for sale, has goods in his or her possession for the purpose of trade or manufacture, imports goods into Uganda for the purpose of trade or manufacture or exports goods for purposes of trade or manufacture, knowing that or reckless whether or not

- (a) a falsified registered trademark is applied to them or in relation to them;
- (b) a registered trademark has been unlawfully removed from them; or
- (c) a registered trademark is falsely applied to them or in relation to them.

commits an offence and is liable on conviction to a fine not exceeding forty eight currency points or imprisonment not exceeding two years or both.

82. Prohibition of import and export of infringing trade marks.

(1) The importation into Uganda and the exportation from Uganda of any goods to which has been applied a false trade mark or any trade mark contrary to this Act is prohibited.

(2) A person who contravenes this section commits an offence and is liable on conviction to a fine not exceeding forty eight currency points or imprisonment not exceeding two years of both; and the goods to which the offence relates may be forfeited by order of the court under section 85(4).

83. Civil remedies.

(1) A person whose rights under this Act are in imminent danger of being infringed or are being infringed may institute civil proceedings in the court for an injunction to prevent the infringement or to prohibit the continuation of the infringement.

(2) Upon an *ex-parte* application by a right owner, the court may in chambers make an order for the inspection of or removal from the infringing person's premises or control, of the right infringing materials, which constitute evidence of infringement by that person.

(3) The grant of an injunction under subsection (1) shall not affect the owner's claim for damages in respect of loss sustained by him or her as a result of the infringement of the rights under this Act.

(4) A person who sustains any damage because of the infringement of his or her rights under this Act may claim damages against the person responsible for the infringement whether or not that person has been successfully prosecuted.

84. Offences by companies and other bodies.

(1) Where an offence is committed—

- (a) by a body corporate, every director and the secretary of the body corporate shall be taken to have committed the offence; and
- (b) in the case of a partnership or other body not being a body corporate, every partner or member shall be taken to have committed the offence.

(2) A person shall not be taken to have committed an offence under subsection (1) if he or she proves to the satisfaction of the court that the offence for which he or she is charged was committed by some person other than himself or herself and was without his or her consent or connivance and that he or she exercised all diligence to prevent the commission of the offence as he or she ought to have exercised in the circumstances.

PART IX—MISCELLANEOUS

85. Penalties and compensation.

(1) In addition to any punishment imposed by the court in respect of an offence under this Act in an action for infringement, a relief by way of damages, injunctions, account of profits or otherwise, shall be available to the plaintiff as in any other corresponding proceedings in respect of infringements of other proprietary rights and in that action the court may give such orders as are necessary to—

- (a) enable the plaintiff to obtain evidence of an infringement which he or she intends to adduce at the trial;
- (b) prohibit the defendant from removing his or her assets from the jurisdiction of the court or otherwise wasting them, to the extent that those assets are necessary to satisfy the plaintiff's claim if he or she succeeds at the trial.

(2) In proceedings to which subsection (1) (a) applies—

- (a) a person shall not be excused from answering a question put to that person or complying with an order made under that subsection by reason only that to do so would tend to expose that person or his or her spouse to criminal proceedings under this Act;
- (b) a statement of admission made by a person in answer to a question put or an order made, in accordance with that subsection is not admissible in criminal proceedings brought under this Act against that person or his or her spouse, except that nothing in this paragraph shall render that statement or admission inadmissible in proceedings against that person for perjury or contempt of court.

(4) The court may order that all counterfeits, imitations and all other materials involved in the infringement be forfeited and disposed of as the court may direct.

(5) For the purposes of this Part, "owner of trademark" means the registered owner, an assignee or an exclusive licensee, as the case may be, of the trademark.

86. Inspectors.

(1) The Board shall in consultation with the registrar designate for the purposes of enforcing this Act, such number of inspectors as may be necessary and shall issue to them, in writing or in a prescribed form, certificates of authority to act as inspectors.

(2) In addition to inspectors designated under subsection (1), the registrar may authorise a member from the registry or a police officer to perform the functions of an inspector under this Act.

(3) A person designated or authorized as an inspector under this section shall hold office subject to such conditions as the Board may determine with approval of the Minister.

87. Entry into premises

Subject to this Act, an inspector may, at any reasonable time and on production of his or her certificate of authority, enter any premises, ship, aircraft or vehicle for the purpose of ascertaining whether there is or has been, on or in connection with those premises, ship, aircraft or vehicle any contravention of this Act.

88. Mode of inspection of premises.

(1) For the purpose of ascertaining whether there is or has been a contravention of this Act, an inspector may inspect—

- (a) a substance or article appearing to him or her to be an infringing trademark;
- (b) a container or package appearing to him or her to be used or intended to be used for infringement; or

- (c) a plant or equipment appearing to him or her to be used or intended to be used in connection with the production, reproduction or otherwise manufacture an infringing trademark.

(2) An inspector may seize and detain a substance or article which he or she has reasonable cause to believe to be an infringing trademark of any work or in relation to which or by means of which he or she has reasonable cause to believe that an offence under this Act has been or is being committed and any document which he or she has reasonable cause to believe to be a document which may be required in proceedings under this Act.

(3) Where an inspector seizes any substance or article, he or she shall notify in writing the person from whom it is seized, the fact of that seizure, and shall in that notification specify the item seized.

(4) A person who—

- (a) wilfully obstructs an inspector in the discharge of the inspector's duties;
- (b) wilfully fails to comply with any requirement properly made to him or her by an inspector;
- (c) without reasonable cause fails to give to the inspector any assistance or information which the inspector may reasonably require of him or her for the purpose of the performance of his or her duties under this Act; or
- (d) makes a statement which he or she knows to be false or which he or she does not believe to be true,

commits an offence and is liable on conviction, to a fine not exceeding forty eight currency points or imprisonment not exceeding two years or both.

89. Inspectors or public officers not personally liable.

An inspector or public officer shall not be personally liable for an act done in good faith by him or her in the course of his or her employment and in the execution or purported execution of any duty under this Act.

90. Suspension of release by customs authorities.

(1) An owner or registered user of a trademark who has reasonable grounds for suspecting that some goods imported bear an infringing trademark or that importation may take place, may lodge an application in writing with the competent court or any other competent authority for the suspension by the customs authorities of the release into free circulation of the goods.

(2) An owner or registered user of a trademark who lodges an application under subsection (1) shall provide adequate evidence to satisfy the court or any other competent authority that, under the laws of Uganda, there is *prima facie* an infringement of his or her right and shall supply a sufficiently detailed description of the goods to make them readily recognisable by the customs authorities.

(3) The court or any other competent authority shall inform the applicant within a reasonable period whether they have accepted the application and where determined by the competent authorities, the period for which the customs authorities will take action for the suspension by the customs authorities of the release into free circulation of the goods.

91. Fees.

There shall be paid in respect of applications, registration and other matters under this Act such fees as may be prescribed by the Minister

92. General power to rectify entries in register.

(1) A person aggrieved by an omission, entry, error, defect or an entry wrongly remaining on the register, may apply in the prescribed manner to the court and subject to section 68, to the registrar, and the court or the registrar may make an order for making, expunging or varying the entry as the court or the registrar, as the case may be, may think fit.

(2) The court or the registrar may in any proceeding 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 case of fraud in the registration, assignment or transmission of a registered trademark, the registrar may himself or herself apply to the court under this section.

(4) An order of the court rectifying the register shall direct that the notice of the rectification be served in the prescribed manner on the registrar and the registrar shall, on receipt of the notice, rectify the register accordingly.

93. Power to expunge or vary registration for breach of condition.

On application by a person aggrieved to the court, and subject to section 68, to the registrar or on application by the registrar to the court, the court or the registrar may make such order as the court or the registrar may think fit for expunging or varying the registration of a trademark on the ground of a contravention of or failure to observe a condition entered on the register in relation to the trademark.

94. Correction of register.

(1) The registrar may, on request made in the prescribed manner by the registered owner—

- (a) correct an error in the name, address or description of the registered owner of a trademark;
- (b) enter a change in the name, address or description of the person who is registered as owner of a trademark;
- (c) cancel the entry of a trademark on the register;
- (d) strike out goods or services or classes of goods or services from those in respect of which a trademark is registered; or
- (e) enter a disclaimer or memorandum relating to a trademark which does not in any way extend the rights given by the existing registration of the trademark.

(2) The registrar may, on request made in the prescribed manner by a registered user of a trademark, correct any error or enter any change in a name, address or description of the registered user.

(3) A person aggrieved by the decision of the registrar under this section may appeal to the court.

95. Alteration of registered trademark.

(1) The registered owner of a trademark may apply in the prescribed manner to the registrar for leave to add to or alter the trademark in a manner not substantially affecting the identity of the trademark and the registrar may refuse leave or grant it on terms and subject to limitations as he or she may think fit.

(2) The registrar may cause an application under this section to be advertised in the prescribed manner where it appears to him or her that it is expedient to do so and where he or she does so, if within the prescribed time from the date of the advertisement a person gives notice to the registrar in the prescribed manner of objection to the application, the registrar shall, after hearing the parties, decide the matter.

(3) Where leave is granted, the trademark as altered shall be advertised in the prescribed manner unless it has already been advertised, in the form to which it has been altered, in an advertisement under subsection (2).

(4) A person aggrieved by the decision of the registrar under this section may appeal to the court.

96. Adaptation of entries in register to amend or substitute classification of goods or services.

(1) The Minister may make regulations under section 101, prescribing forms and generally do things as he or she thinks expedient, for empowering the registrar to amend the register whether by making or expunging or varying entries in the register, so far as may be necessary for the purpose of adapting the designation of the goods or services or classes of goods or services in respect of which trademarks are registered to an amended or substituted classification that may be prescribed.

(2) The registrar shall not, in exercise of any power conferred on him or her, under this section make any amendment to the register that would have the effect of adding goods or services or classes of goods or services to those in respect of which a trademark is registered whether in one or more classes immediately before the amendment is to be made or of ante-dating the registration of a trademark in respect of any goods or services.

(3) This subsection shall not have effect in relation to goods or services as to which the registrar is satisfied that compliance with this subsection in relation to the goods or services would involve undue complexity and that the addition or ante-dating, as the case may be, would not affect any substantial quantity of goods or services and would not substantially prejudice the rights of any person.

(4) A proposal for amendment of the register for the purpose referred to in subsection (1)—

- (a) shall be notified to the registered owner of the trademark affected;
- (b) shall be advertised with any modifications;
- (c) may be objected to before the registrar by a person aggrieved on the ground that the proposed amendment contravenes subsection (2).

(5) A person aggrieved by the decision of the registrar under this section may appeal to the court.

97. Recognition of agents.

Where under this Act an act is to be done by or to a person in connection with a trademark or proposed trademark or a procedure relating to the trademark, the act may under and in accordance with the regulations, be done by or to an agent of that person duly authorised in the prescribed manner.

98. Address for service.

Where an applicant for the registration of a trademark or an agent does not reside or carry on business in Uganda he or she shall give the registrar an address for service in Uganda and if he or she fails to do so the registrar may refuse to proceed with the application until the address has been given.

99. Hours of business and excluded days.

(1) Regulations made under section 101 may specify the hour at which the registry shall be taken to be closed on any day for the purposes of the transaction by the public of business under this Act or of any class of business and may specify days as excluded days for those purposes.

(2) Any business done under this Act on any day after the hour specified under subsection (1) in relation to business of that class or on a day which is an excluded day in relation to business of that class shall be taken to have been done on the next following day not being an excluded day; and where the time for doing anything under this Act expires on an excluded day, that time shall be extended to the next following day not being an excluded day.

100. Provision as to public holidays.

Where the last day fixed by this Act or by any regulations for the time being in force, for leaving a document with or paying a fee to the registrar falls on Sunday or a public holiday, it is lawful to leave the document or to pay the fee on the day next following that Sunday or public holiday or holidays, if two or more of them occur consecutively.

101. Power of Minister to make regulations

(1) The Minister may make regulations generally for the better carrying into effect the provisions of this Act.

(2) Without prejudice to subsection (1), the Minister may make regulations—

- (a) prescribing anything required to be prescribed under this Act;

- (b) classifying goods for the purposes of registration of trademarks;
- (c) making or requiring duplicates of trademarks and other documents;
- (d) securing and regulating the publishing and selling or distributing, in a manner as the Minister thinks fit, of copies of trademarks and other documents;
- (e) generally regulating the business of the registrar in relation to trademarks and all things by this Act under the direction or control of the registrar;
- (f) prescribing for the contravention of the regulations a penalty of a fine not exceeding forty eight currency points or imprisonment not exceeding two years or both and regulating in appropriate cases that the court convicting a person under the regulations shall forfeit anything in connection with which the offence is committed.

102. Minister's power to amend Schedule.

The Minister may with approval of cabinet, by statutory instrument, amend the schedule to this Act.

103. Repeal and savings.

(1) The Trademarks Act, and Chapter 37 of the Penal Code Act, Cap. 120 are hereby repealed.

(2) Nothing in this Act shall affect an order, rule, regulation or requirement made, table of fees or certificate issued, notice, decision, determination, direction or approval given, application made or thing done under the Trademarks Act repealed by this Act; and every order, rule, regulation, requirement, table of fees, certificate, notice, decision, determination, direction, approval, application or thing shall, if in force at the commencement of this Act, continue in force and shall, so far as it could have been made, issued, given or done under this Act, have effect as if made, issued, given or done under the corresponding provision of this Act.

(3) A document referring to an enactment repealed by this Act shall be construed as referring to the corresponding provision of this Act.

(4) Nothing in this Act shall be taken to invalidate the original registration of a trademark which immediately before the commencement of this Act was validly on the register.

(5) A trademark which is on the register at the date of the commencement of this Act and which, having regard to an amendment by this Act whether as respects limitations which may be imposed by registration or as respects any other matter, was then a registrable trademark under the repealed Trademarks Act shall not be removed from the register on the ground that it was not registrable under the then Act in force.

(6) Nothing in this Act shall subject a person to liability in respect of an act or thing done before the commencement of this Act to which he or she would not have been subject under the repealed Trademarks Act.

[(7) This section shall be subject to sections 27 and 43.]

SCHEDULE

ss.1, 102

One currency point is equivalent to twenty thousand shillings.

Cross references

1. Penal Code Act, Cap.120
2. Trademarks Act, Cap.217
3. Uganda Registration Services Bureau Act, Cap.210

