

ACT

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THE TRADE MARKS ACT, 2014

ARRANGEMENT OF SECTIONS

PART I—PRELIMINARY

1. Interpretation.

PART II—REGISTRATION OF TRADE MARKS

2. Application for registration.
3. Registration of trade mark.
4. Conditions of application.
5. Grounds for refusal of registration of mark.
6. Examination and opposition to registration of trade mark.
7. Registration certificate
8. Application for registration of collective marks.
9. Rights conferred by registration.
10. Term of protection of trade mark.
11. Renewal of trade mark.
12. Invalidation of trade mark.
13. Invalidation of collective mark.
14. Removal of trade mark from register for non-use.
15. Change in ownership.
16. Licence contract.
17. Representation of applicants.

PART III—TRADE NAMES AND UNFAIR COMPETITION

18. Trade names
19. Acts of unfair competition.

PART IV—TRADE MARKS REGISTRY

20. Trade Marks Registry
21. Register of trade marks.
22. Rectification or correction of register.
23. Publication.
24. Corrections of errors and extension of time.

PART V—TRADE DESCRIPTION AND FRAUDULENT MARKS

25. Trade description and fraudulent marks.
26. Application of marks and descriptions

ii

27. Forging trade mark.
28. Offences relating to trade marks and trade descriptions.
29. Defences.
30. Informant to give notice to Commissioner-General.
31. Proof of place of origin.
32. Limitation of prosecutions.
33. Implied warranty on sale of marked goods.
34. Forfeiture of unclaimed goods.
35. Definition.

PART VI—PROVISIONS RELATING TO POWERS AND DUTIES OF REGISTRAR AND TO LEGAL PROCEEDINGS

36. Power of Registrar to award costs, etc.
37. Registration to be *prima facie* evidence of validity.
38. Certificate of validity.
39. Costs of Registrar in Tribunal proceedings.
40. Registrar's appearance in proceedings.
41. Appeal to Tribunal.
42. Procedure in cases of option to apply to Tribunal or Registrar.
43. Mode of taking evidence for proceedings before Registrar.
44. Evidence of entries in register.
45. Evidence of things done by Registrar.

PART VII—MISCELLANEOUS PROVISIONS

46. Conservatory provisions and measures.
47. Civil remedies.
48. Criminal sanctions
49. Compensation to victim of offence.
50. Settlement of disputes.
51. Application of international and regional treaties and agreements.
52. Falsification of entries in register
53. Offence of false representation of registration.
54. Penalty for unlawful use of official badges.
55. Possible cause of deception.
56. Jointly owned trade marks.
57. Trusts and equities.
58. Offences by bodies of persons.
59. Regulations
60. Repeal of Cap. 244 and Cap. 245 and savings.

SCHEDULE—Article 4 of Paris Convention.

SIGNED this 17th day of September, 2014.

DR. ERNEST BAI KOROMA,
President.



No. 8



2014

Sierra Leone

THE TRADE MARKS ACT, 2014.

Short title.

**Being an Act to make provision for the protection,
registration and regulation of trade marks, trade names, and for
other related matters**

[] Date of com-
mencement.

ENACTED by the President and Members of Parliament in this
present Parliament assembled.

PART I—PRELIMINARY

Interpretation.

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

“Agency” means the Intellectual Property Agency to be established under an Intellectual Property Agency Act;

“collective mark” means a visible sign capable of distinguishing, from the goods or services of other enterprises the origin or any other common characteristic including the quality of goods or services of different enterprises which use the sign under the control of a registered owner;

“international classification” means the classification according to the Nice Agreement concerning the International Classification of Goods and Services for the purposes of the Registration of Marks, of June 15, 1957;

“Minister” means the Minister responsible for trade marks;

“Paris Convention” means The Paris Convention for the Protection of Industrial Property (1976).

“Registrar” means the Registrar of Trade Marks;

“trade mark” means any sign or combination of signs capable of distinguishing the goods or services of one undertaking from the goods or services of other undertakings including words such as personal names, letters, numerals and figurative elements;

“trade name” means the name or designation identifying and distinguishing an enterprise;

“Tribunal” means the Intellectual Property Tribunal to be established under an Intellectual Property Agency Act.

PART II—REGISTRATION OF TRADE MARKS

2. (1) Any person claiming to be proprietor of a trade mark may by himself or his agent, apply to the Registrar for the registration of the trade mark. Application for re-registration.

(2) The application shall be made in the prescribed form and shall be accompanied by not less than three representations of the trade mark and by a stereo-type block of such representations.

3. Registration of a trade mark by any person confers an exclusive right to the use of the trademark by that person. Registration of trade mark.

4. (1) An application shall be accompanied with a reproduction of the trade mark and a list of the goods and services for which the registration of the trade mark is requested using the international classification. Conditions of application.

(2) The application may contain a declaration claiming the priority of an earlier national or regional application filed by the applicant or the predecessor in title of the applicant as provided for in article 4 of the Paris Convention set out in the Schedule in or for any state party to the Convention or in or for any member of the World Trade Organisation.

(3) The Registrar may require the applicant to provide within the prescribed time a copy of the earlier application certified as correct by the office with which it was filed.

(4) Where the Registrar finds that the requirements under subsection (3) have not been met, the declaration shall cease to have effect.

(5) The applicant may withdraw an application at any time during its pendency.

5. No mark shall be registered as a trade mark, if—

(a) it is a trade name;

(b) it is incapable of distinguishing the goods or services of one enterprise from the goods or services of another enterprise;

Grounds for refusal of registration of mark.

- (c) it is contrary to public order or morality;
- (d) it is likely to mislead the public or trade circles with particular reference to the geographical origin of the goods or services, their nature or characteristics;
- (e) it is identical to or is an imitation of or contains, as an element, an armorial bearing, flag, emblem, name, abbreviation or initials of the name, official sign or hallmark adopted by a State, intergovernmental organisation or organisation created by an international convention unless authorised by the competent authority of that State or organisation;
- (f) it is identical to or confusingly similar to or constitutes a translation of a trade mark or trade name which is well known in the country for identical or similar goods or services of another enterprise, or the trademark is well known and registered in the country for goods or services which are not identical or similar to those under application but the use of the trade mark will indicate a connection between those goods or services and the owner of the well known trade mark and the interests of the owner to the well known trade mark are likely to be damaged by the use of the trade mark;
- (g) it is identical to a trade mark of another owner already on the register or identical to a trade mark the subject of an application with an earlier filing or priority date for the same goods or services or closely related goods or services or if it resembles that trade mark so closely that it is likely to deceive or cause confusion.

Examination
and opposi-
tion to registr-
ation of trade
mark

6. (1) The Registrar shall examine whether the application complies with the requirements of sections 4 and 5.

(2) If the Registrar finds that the requirements of sections 4 and 5 have been complied with, the Registrar shall cause the application to be published in the Gazette so that any interested person may file a notice of opposition to the registration within the prescribed period and in the prescribed manner.

(3) A person may, within three months, or such further time, not exceeding nine months in all, as the Registrar may allow, from the date of the publication of the application, give notice to the Registrar of his opposition to the registration.

(4) A notice under subsection (3) shall be given in writing, and in duplicate, and shall include a statement of the grounds of the opposition.

(5) The Registrar shall send a copy of the notice under subsection (3) to the applicant, and within one month after the receipt of the notice, or such further time, not exceeding three months in all, as the Registrar may allow, the applicant shall send to the Registrar a counter statement, in duplicate, of the grounds on which he relies in his application, and, if he does not do so, he shall be deemed to have abandoned his application.

(6) The Registrar shall send a copy of the counter statement to the person who filed the notice of opposition and shall after hearing the parties decide whether the trade mark should be registered.

(7) The applicant has, until the registration of the trade mark, the same privileges and rights when an application is published as the applicant would have if the trade mark had been registered; but it shall however be a valid defence to an action in respect of an act done after the application has been published, if the alleged infringer establishes that the trade mark could not validly have been registered at the time the act was done.

7. The Registrar shall register the trade mark, publish a ^{Registration} reference to the registration and issue the applicant with a certificate ^{certificate} of registration if -

- (a) the registration has not been opposed within the prescribed time limit; or

- (b) the registration has been opposed but the opposition was decided in favour of the applicant.

Application for registration of collective mark

8. (1) An application for registration of a collective mark shall designate the trade mark as a collective mark and be accompanied with a copy of the regulations governing the use of the collective mark.

(2) Sections 4, 5, 6, 7, 9, 10, 11 and 14 shall, with the necessary changes apply to collective marks.

(3) The registered owner of a collective mark shall notify the Registrar of any changes made in the regulations.

Rights conferred by registration.

9. (1) A person other than a registered owner of a trade mark shall not without the written permission of the owner use the mark.

(2) The registered owner may institute action before the Tribunal against any person who infringes a registered trade mark by—

- (a) using the registered mark without permission; or
- (b) performing acts which make it likely that infringement may occur.

(3) No person shall knowingly infringe the rights of the owner of a registered trade mark by using a trade mark in relation to goods or services for which the trade mark was registered without the written consent of the owner.

(4) The right of the registered owner under this section shall, in addition to any other remedies, extend to the use of a sign similar to the registered trade mark and use in relation to goods or services similar to those for which the mark has been registered where confusion may arise in the public.

(5) Where there is use of an identical sign for identical goods or services, a likelihood of confusion shall be presumed.

(6) The rights conferred by registration of a mark shall not extend to acts in respect of articles which have been put on the market in any country by the registered owner or with the consent of the owner.

(7) Paragraph (f) of section 5 shall apply with such modification as may be required in any action instituted by the owner of a well-known trade mark against any person in respect of the unlawful use of the well-known trade mark.

(8) A person who infringes the right of a registered owner of a trade mark by knowingly using a trade mark for goods or services without the consent of the registered owner commits an offence and is liable on conviction to a fine not exceeding Le100 million or a term of imprisonment not exceeding seven years or to both.

10. The registration of a trade mark is for a period of ten years from the filing date of the application for registration. Term of protection of trade mark.

11. (1) The registration of a trade mark may be renewed for consecutive periods of ten years upon payment of the fee prescribed for renewal. Renewal of trade mark.

(2) A grace period of six months is allowed for the late payment of the renewal fee upon payment of the prescribed surcharge.

12. (1) The Tribunal shall invalidate the registration of a trade mark if, the person requesting the invalidation proves that any requirement for registration has not been complied with. Invalidation of trade mark.

(2) The Tribunal may invalidate the registration of a trademark if, because of the inactivity of the owner it has become the common name in the trade for goods or services for which it is registered.

(3) The invalidation of the trade mark is effective from the date of registration.

(4) The Registrar shall record the invalidation and publish it as soon as possible in the *Gazette*.