

## CHAPTER 217

### THE TRADEMARKS ACT.

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## CHAPTER 217

### THE TRADEMARKS ACT.

*Commencement:* 1 January, 1953.

#### **An Act relating to the registration of trademarks.**

#### PART I—PRELIMINARY.

##### **1. Interpretation.**

- (1) In this Act, unless the context otherwise requires—
  - (a) “assignment” means assignment by act of the parties concerned;
  - (b) “court” means the High Court;
  - (c) “limitations” means any limitations of the exclusive right to the use of a trademark given by the registration of a person as proprietor of the trademark, including limitations of that right as to mode of use, as to use in relation to goods to be sold, or otherwise traded in, in any place in Uganda, or as to use in relation to goods to be exported to any market outside Uganda;
  - (d) “mark” includes a device, brand, heading, label, ticket, name, signature, word, letter, numeral or any combination of them;
  - (e) “permitted use” has the meaning assigned to it by section 30(1);
  - (f) “prescribed” means, in relation to proceedings before the court, prescribed by rules of court, and, in other cases, prescribed by this Act or the rules;
  - (g) “register” means the register of trademarks kept under this Act;
  - (h) “registered trademark” means a trademark that is actually on the register; (i) “registered user” means a person who is for the time being registered as such under section 30; (j) “registrar” means the registrar of trademarks appointed under section 2; (k) “surname” means and includes a name by which a person is customarily known by members of the community to which he or she belongs; (l) “trademark” means, except in relation to a certification trademark, a mark used or proposed to be used in relation to goods for the purpose of indicating, or so as to indicate, a connection in the course of trade between the goods and some

person having the right either as proprietor or as registered user to use the mark, whether with or without any indication of the identity of that person, and means, in relation to a certification trademark, a mark registered or deemed to have been registered under section 39;

- (m) “transmission” means transmission by operation of law, devolution on the personal representative of a deceased person and any other mode of transfer not being assignment;
- (n) “tribunal” means the court or, subject to section 52, the registrar.

(2) References in this Act to the use of a mark shall be construed as references to the use of a printed or other visual representation of the mark, and references in this Act to the use of a mark in relation to goods shall be construed as references to the use of the mark upon, or in physical or other relation to, goods.

## **2. Designation of registrar.**

(1) Subject to any written law relating to the appointment of persons to the public service, the Minister shall designate a registrar of trademarks.

(2) The registrar shall have a seal of such device as may be approved by the Minister; but until the seal has been obtained a stamp in such form as the Minister may approve shall be used in lieu of it.

(3) Impressions of such seal or stamp shall be judicially noticed and admitted in evidence.

(4) Any act or thing directed to be done by or to the registrar may be done by or to any officer authorised by the Minister.

## **PART II—REGISTRATION AND INFRINGEMENT.**

### *The register.*

## **3. Register of trademarks.**

(1) There shall be kept at the office of the registrar for the purposes of this Act the record called the register of trademarks, in which shall be entered all registered trademarks with the names, addresses and descriptions of their proprietors, notifications of assignments and transmissions, the

names, addresses and descriptions of all registered users, disclaimers, conditions, limitations and such other matters relating to registered trademarks as may be prescribed.

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

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

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

*Effect of registration and the action for infringement.*

**4. No action for infringement of unregistered trademark.**

No person shall be entitled to institute any proceeding to prevent, or to recover damages for, the infringement of an unregistered trademark, but nothing in this Act shall be deemed to affect rights of action against any person for passing off goods as the goods of another person or the remedies in respect of those rights of action.

**5. Registration to be in respect of particular goods.**

A trademark must be registered in respect of particular goods or classes of goods, and any question arising as to the class within which any goods fall shall be determined by the registrar, whose decision shall be final.

**6. Right given by registration in Part A, and infringement of it.**

(1) Subject to this section and sections 9 and 10, the registration (whether before or after the commencement of this Act), of a person in Part A of the register as proprietor of a trademark (other than a certification trademark) in respect of any goods shall, if valid, give or be deemed to have given to that person the exclusive right to the use of the trademark in relation to those goods and, without prejudice to the generality of the foregoing provisions, that right shall be deemed to be infringed by any person, who, not being the proprietor of the trademark or a registered user of the trademark using by way of the permitted use, uses a mark identical with it or so nearly resembling it as to be likely to deceive or cause confusion in the course of

trade in relation to any goods in respect of which it is registered and in such manner as to render the use of the mark likely to be taken either—

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

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

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

- (a) in relation to goods connected in the course of trade with the proprietor or a registered user of the trademark if, as to those goods or a bulk of which they form part, the proprietor 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 as aforesaid or might for the time being be so used, if the use of the mark is reasonably necessary in order to indicate that the goods are so 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 any person and the goods.

(4) The use of a registered trademark, being one of two or more registered trademarks that 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 deemed to be an infringement of the right so



given to the use of any other of those trademarks.

**7. Right given by registration in Part B, and infringement of it.**

(1) Except as provided by subsection (2), the registration (whether before or after the commencement of this Act) of a person in Part B of the register as proprietor of a trademark in respect of any goods shall, if valid, give or be deemed to have given to that person the like right in relation to those goods as if the registration had been in Part A of the register, and section 6 shall have effect in like manner in relation to a trademark registered in Part B of the register as it has effect in relation to a trademark registered in Part A of the register.

(2) In any 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 deemed to be an infringement by virtue of section 8, no injunction or other relief shall be granted to the plaintiff if the defendant establishes to the satisfaction of the court that the use of which the plaintiff complains is not likely to deceive or cause confusion or to be taken as indicating a connection in the course of trade between the goods and some person having the right either as proprietor or as registered user to use the trademark.

**8. Infringement by breach of certain restrictions.**

(1) Where, by a contract in writing made with the proprietor or a registered user of a registered trademark, a purchaser or owner of goods enters into an obligation to the effect that he or she will not do, in relation to the goods, an act to which this section applies, any person who, being the owner for the time being of the goods and having notice of the obligation, does that act, or authorises it to be done, in relation to the goods, in the course of trade or with a view to any dealing with the goods in the course of trade, shall be deemed by that act or authorisation to infringe the right to the use of the trademark given by the registration of the trademark, unless that person 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 so became the owner of the goods.

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

- (a) the application of the trademark upon the goods after they have suffered alteration in any manner specified in the contract as

- respects their state or condition, getup or packing;
- (b) in a case in which the trademark is upon the goods, the alteration, part removal or part obliteration of the trademark;
  - (c) in a case in which the trademark is upon the goods, and there is also other matter upon the goods, being matter indicating a connection in the course of trade between the proprietor or registered user and the goods, the removal or obliteration, whether 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, the application of any other trademark to the goods;
  - (e) in a case in which the trademark is upon the goods, the addition to the goods of any other matter in writing that is likely to injure the reputation of the trademark.

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

## **9. Saving for vested rights.**

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

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

whichever is the earlier, or to object (on such use being proved) to that person being put on the register for that identical or nearly resembling trademark in respect of those goods under section 14(2).

## **10. Saving for use of name, address or description of goods.**

No registration of a trademark shall interfere with—

- (a) any bona fide use by a person of his or her own name or of the name of his or her place of business, or of the name, or of the name of the place of business, of any of his or her predecessors in business; or
- (b) the use by any person of any bona fide description of the character or quality of his or her goods, not being a description that would be likely to be taken as importing any such reference as is mentioned in section 6(1)(b) or 39(3)(b).

*Registrability and validity of registration.*

## **11. Distinctiveness requisite for registration in Part A.**

(1) In order for a trademark (other than a certification trademark) to be registrable in Part A of the register, it must 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 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, and not being according to its ordinary signification a geographical name or a surname;
- (e) any other distinctive mark, but a name, signature, or word or words, other than such as fall within the descriptions in paragraphs (a), (b), (c) and (d) of this subsection, shall not be registrable under this paragraph except upon evidence of its distinctiveness.

(2) For the purposes of this section, “distinctive” means adapted, in relation to the goods in respect of which a trademark is registered or proposed to be registered, to distinguish goods, with which the proprietor of the trademark is or may be connected in the course of trade, from goods in the case of which no such connection subsists, either 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 provided in subsection (2), the court or the registrar may have regard to the extent to which—

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

## **12. Capability of distinguishing requisite for registration in Part B.**

(1) In order for a trademark to be registrable in Part B of the register, it must 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 proprietor of the trademark is or may be connected in the course of trade, from goods in the case of which no such connection subsists, either 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.

(2) In determining whether a trademark is capable of distinguishing as provided in subsection (1), the court or the registrar may have regard to the extent to which—

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

(3) A trademark may be registered in Part B notwithstanding any registration in Part A in the name of the same proprietor of the same trademark or any part of the trademark.

## **13. Prohibition of registration of deceptive, etc. matter.**

It shall not be lawful to register as a trademark or part of a trademark any matter the use of which would, by reason of its being likely to deceive or cause confusion or otherwise, be disentitled to protection in a court of justice, or would be contrary to law or morality, or any scandalous design.

#### **14. Prohibition of registration of identical and resembling trademarks.**

(1) Subject to subsection (2), no trademark shall be registered in respect of any goods or description of goods that is identical with a trademark belonging to a different proprietor and already on the register in respect of the same goods or description of goods, or that so nearly resembles such a trademark as to be likely to deceive or cause confusion.

(2) In case of honest concurrent use, or of other special circumstances which in the opinion of the court or the registrar make it proper so to do, the court or the registrar may permit the registration of trademarks that are identical or nearly resemble each other in respect of the same goods or description of goods by more than one proprietor subject to such conditions and limitations, if any, as the court or the registrar, as the case may be, may think it right to impose.

(3) Where separate applications are made by different persons to be registered as proprietors respectively of trademarks that are identical or nearly resemble each other, in respect of the same goods or description of goods, the registrar may refuse to register any of them until their rights have been determined by the court, or have been settled by agreement in a manner approved by the registrar or on an appeal by the court, as the case may be.

#### **15. 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 34), 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 offends against section 13.

(2) Nothing in section 7(1) shall be construed as making applicable to a trademark, as being a trademark registered in Part B of the register, the provisions of subsection (1) relating to a trademark registered in Part A of the register.

**16. Registration subject to disclaimer.**

- (1) If a trademark—
  - (a) contains any part not separately registered by the proprietor as a trademark; or
  - (b) contains matter common to the trade or otherwise of a nondistinctive 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 that the proprietor 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 any such matter as aforesaid, to the exclusive use of which the tribunal holds the proprietor not to be entitled; or that the proprietor shall make such other disclaimer as the tribunal may consider necessary for the purpose of defining his or her rights under the registration.

- (2) No disclaimer on the register shall affect any rights of the proprietor of a trademark except such as arise out of the registration of the trademark in respect of which the disclaimer is made.

**17. Words used as name or description of an article or substance.**

- (1) The registration of a trademark shall not be deemed to have become invalid by reason only of any 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; but if it is proved either—

- (a) that 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 carrying on a trade in it, not being use in relation to goods connected in the course of trade with the proprietor or a registered user of the trademark or (in the case of a certification trademark) goods certified by the proprietor; or
  - (b) that the article or substance was formerly manufactured under a patent, that a period of two years or more after the cesser of the patent has elapsed and that the word or words is or are the only practicable name or description of the article or substance,

subsection (2) shall have effect.

- (2) Where the facts mentioned in subsection (1)(a) or (b) are proved with respect to any 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 of any goods of the same description, shall be deemed for the purposes of section 34 to be an entry wrongly remaining on the register;

- (b) if the trademark contains that word or those words and other matter, the court or the registrar, 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 any goods of the same description, may in case of a decision in favour of its remaining on the register require as a condition of remaining that the proprietor shall disclaim any right to the exclusive use in relation to that article or substance and any goods of the same description of that word or those words, so, however, that no disclaimer on the register shall affect any rights of the proprietor of a trademark except such as arise 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— (i) if the trademark consists solely of that word or those words,

all rights of the proprietor, whether under the common law or by registration, to the exclusive use of the trademark in relation to the article or substance in question or to any goods of the same description; or (ii) if the trademark contains that word or those words and other matter, all such rights of the proprietor to the exclusive use of that word or those words in such relation as aforesaid, shall be deemed to have ceased on the date at which the use mentioned in subsection (1)(a) first became well-known and established, or at the expiration of the period of two years mentioned in subsection(1)(b).

(3) No word which is the commonly used and accepted name of any single chemical element or single chemical compound, as distinguished from a mixture, shall be registered as a trademark in respect of a chemical substance or preparation; and any such registration in force at the commencement of this Act or thereafter shall, notwithstanding anything in section 15, be deemed for the purposes of section 34 to be an entry made in the register without sufficient cause, or an entry wrongly remaining on the register, as the circumstances may require; but the foregoing provisions of this subsection 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 proprietor 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.

#### **18. Effect of limitation as to colour and absence of such limitation.**

(1) A trademark may be limited in whole or in part to one or more specified colours, and in any such case, the fact that it is so limited shall be taken into consideration by the court or the registrar having to decide on the distinctive character of the trademark.

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

*Procedure for, and duration of, registration.*

#### **19. Application for registration.**

(1) Any person claiming to be the proprietor of a trademark he or she has used or proposes to use who is desirous of registering it must apply in writing to the registrar in the prescribed manner for registration either in Part A or in Part B of the register.

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

(3) In the case of an application for registration of a trademark (other than a certification trademark) in Part A of the register, the registrar may, if the applicant is willing, 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, if required by the applicant, state in writing the grounds of his or her decision and the materials he or she used in arriving at the decision, and the decision shall be subject to appeal to the court.

(5) An appeal under this section shall be made in the prescribed manner, and on the appeal the court shall, if required, hear the applicant and



the registrar, and shall make an order determining whether, and subject to what amendments, modifications, conditions or limitations, if any, the application is to be accepted.

(6) Appeals under this section shall be heard on the materials stated as aforesaid by the registrar, and no further grounds of objection to the acceptance of the application shall be allowed to be taken by the registrar, other than those he or she so stated as aforesaid except by leave of the court. Where any further grounds of objection are taken, the applicant shall be entitled to withdraw his or her application without payment of costs on giving notice as prescribed.

(7) The registrar or the court, as the case may be, 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 such terms as the registrar or the court, as the case may be, may think fit.

## **20. Opposition to registration.**

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

(2) The registrar may cause an application to be advertised before acceptance if it is made under section 11(1)(e), or in any other case where it appears to the registrar that it is expedient by reason of any exceptional circumstances so to do; and where an application has been so advertised, the registrar may, if he or she thinks fit, advertise it again when it has been accepted but shall not be bound so to do.

(3) Any person may, within the prescribed time from the date of the advertisement of an application, give notice to the registrar of opposition to the registration.

(4) The notice shall be given in writing in the prescribed manner, and shall include a statement of the grounds of opposition.

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

(6) If the applicant sends such a counterstatement as aforesaid, the registrar shall furnish a copy of it to the person giving notice of opposition, and shall, after hearing the parties, if so required, and considering the evidence decide whether, and subject to what conditions or limitations, if any, registration is to be permitted.

(7) The decision of the registrar shall be subject to appeal to the court.

(8) An appeal under this section shall be made in the prescribed manner, and on the 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, if any, registration is to be permitted.

(9) On the 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.

(10) 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 opponent or the registrar, other than those so stated as aforesaid by the opponent, except by leave of the court. Where any further grounds of objection are taken, the applicant shall be entitled to withdraw his or her application without payment of the costs of the opponent on giving notice as prescribed.

(11) On an appeal under this section, the court may, after hearing the registrar, permit the trademark proposed to be registered to be modified in any manner not substantially affecting its identity, but in any such case the trademark shall be advertised in the prescribed manner before being registered.

(12) If a person giving notice of opposition or an applicant sending a counterstatement after receipt of a copy of such a notice, or an appellant,

neither resides nor carries on business in Uganda, the court or the registrar may require the appellant to give security for costs of the proceedings before the court or the registrar relative to the opposition or to the appeal, and in default of the security being duly given may treat the opposition or application, or the appeal, as abandoned.

## **21. Registration.**

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

- (a) the application has not been opposed and the time for notice of opposition has expired; or
- (b) the application has been opposed and the opposition 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, as the case may be, and the trademark, when registered, shall be registered as of the date of the application for registration and that date shall be deemed for the purposes of this Act be the date of registration.

(2) The provisions of subsection (1) relating to the date as of which a trademark shall be registered and to the date to be deemed to be the date of registration shall, as respects 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 its registration under the hand and 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 noncompletion to the applicant in writing in the prescribed manner, treat the application as abandoned unless it is completed within the time specified in that behalf in the notice.

## **22. Duration and renewal of registration.**

(1) The registration of a trademark shall be for a period of seven years, but may be renewed from time to time in accordance with this section;

except that in relation to a registration as of a date before the 1st January, 1953, this subsection shall have effect with the substitution of a period of fourteen years for the period of seven years.

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

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

(4) Where a trademark has been removed from the register for nonpayment of the fee for renewal, it shall, nevertheless, for the purpose of any application for the registration of a trademark during one year next after the date of the removal, be deemed to be a trademark that is already on the register; but the foregoing provisions of this subsection shall not have effect where the court or the registrar 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 any previous use of the trademark that has been removed.

### **23. Registration of parts of trademarks and of trademarks as a series.**

(1) Where the proprietor of a trademark claims to be entitled to the exclusive use of any part of it separately, he or she may apply to register the whole and any such part as separate trademarks. Each such separate trademark must satisfy all the conditions of an independent trademark and shall, subject to sections 25(3) and 32(2), have all the incidents of an

independent trademark.

(2) Where a person claiming to be the proprietor of several trademarks, in respect of the same goods or description of goods, which, while resembling each other in their material particulars, yet differ in respect of—

- (a) statements of the goods 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 nondistinctive character which does not substantially affect the identity of the trademark; or
- (d) colour,

seeks to register those trademarks, they may be registered as a series in one registration.

### PART III—ASSIGNMENT AND TRANSMISSION.

#### **24. Powers of, and restrictions on, assignment and transmission.**

(1) Notwithstanding any rule of law or equity to the contrary, a registered trademark shall be, and shall be deemed always to have been, assignable and transmissible either in connection with the good will of a business or not.

(2) A registered trademark shall be, and shall be deemed always to have been, assignable and transmissible in respect either of all the goods in respect of which it is registered, or was registered, or of some, but not all, 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 it is or was used in the same business as a registered trademark, and if it is or 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 is or was used in that business and in respect of which that registered trademark is or was assigned or transmitted.

(4) Notwithstanding subsection (3), a trademark shall not be, or be

deemed to have been, assignable or transmissible in a case in which as a result of an assignment or transmission there would in the circumstances subsist, or have subsisted, whether under the common law or by registration, exclusive rights in more than one of the persons concerned to the use, in relation to the same goods or description of goods, of trademarks nearly resembling each other or of identical trademarks, if, having regard to the similarity of the goods and of the trademarks, the use of the trademarks in exercise of those rights would be, or have been, likely to deceive or cause confusion; but where a trademark is, or has been assigned or transmitted in such a case as aforesaid, the assignment or transmission shall not be deemed to be, or to have been, invalid under this subsection if the exclusive rights subsisting as a result thereof in the persons concerned respectively are, or were, having regard to limitations imposed thereon, such as not to be exercisable by two or more of those persons in relation to goods to be sold, or otherwise traded in, within Uganda (otherwise than for export from Uganda) or in relation to goods to be exported to the same market outside Uganda.

(5) The proprietor of a registered trademark who proposes to assign it in respect of any 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 to the proprietor a certificate stating whether, having regard to the similarity of the goods and of the trademarks referred to in the case, the proposed assignment of the first-mentioned trademark would or would not be invalid under subsection (4), and a certificate so issued shall, subject to the provisions of this section as to appeal and unless it is shown that the certificate was obtained by fraud or misrepresentation, be conclusive as to the validity or invalidity under subsection (4) of the assignment insofar as such validity or invalidity depends upon the facts set out in the case, but, as regards a certificate in favour of validity, only if application for the registration under section 27 of the title of the person becoming entitled is made within six months from the date on which the certificate is issued.

(6) Notwithstanding anything in subsections (1) to (3), a trademark shall not, on or after 1st January, 1953, be assignable or transmissible in a case in which as a result of an assignment or transmission of the trademark there would in the circumstances subsist, whether under the common law or by registration, an exclusive right in one of the persons concerned to the use of the trademark limited to use in relation to goods to be sold or otherwise traded in, in a place in Uganda, and an exclusive right in another of those

persons to the use of a trademark nearly resembling the first-mentioned trademark or of an identical trademark in relation to the same goods or description of goods limited to use in relation to goods to be sold, or otherwise traded in, in another place in Uganda.

(7) Notwithstanding subsection (6), on application in the prescribed manner by the proprietor of a trademark who proposes to assign it, or of a person who claims that a trademark has been transmitted to him or her or to a predecessor in title of his or hers on or after 1st January, 1953, the registrar, if he or she is satisfied that in all the circumstances the use of trademarks in exercise of those rights would not be contrary to the public interest, may approve the assignment or transmission; and an assignment or transmission so approved shall not be deemed to be, or to have been, invalid under subsection (4) or (6), so, however, that in the case of a registered trademark this provision shall not have effect unless application for the registration under section 27 of the title of the person becoming entitled is made within six months from the date on which the approval is given or, in the case of transmission, was made before that date.

(8) Where an assignment in respect of any goods of a trademark that is at the time of the assignment used in a business in those goods is made, on or after 1st January, 1953, otherwise than in connection with the good will of that business, the assignment shall not take effect until the following requirements have been satisfied, that is to say, the assignee must, not later than the expiration of six months from the date on which the assignment is made or within such extended period, if any, as the registrar may allow, apply for directions with respect to the advertisement of the assignment, and must advertise it in such form and manner and within such period as the registrar may direct.

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

## **25. Certain trademarks to be associated so as to be assignable and transmissible as a whole only.**

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

(2) Where a trademark that is registered, or is the subject of an application for registration, in respect of any goods is identical with another trademark that is registered, or is the subject of an application for registration, in the name of the same proprietor in respect of the same goods, or description of goods, or so nearly resembles it as to be likely to deceive or cause confusion if used by a person other than the proprietor, the registrar may at any time require that the trademarks shall be entered on the register as associated trademarks.

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

(4) Where a trademark and any part or parts of a trademark are, by virtue of section 23(1), registered as separate trademarks in the name, of the same proprietor, they shall be deemed to be, and shall be registered as, associated trademarks.

(5) All trademarks that are, by virtue of section 23(2), registered as a series in one registration shall be deemed to be, and shall be registered as, associated trademarks.

(6) On application made in the prescribed manner by the registered proprietor of two or more trademarks registered as associated trademarks, the registrar may dissolve the association as respects any of them 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 in respect of which it is registered, and may amend the register accordingly.

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

## **26. Power of registered proprietor to assign and give receipts.**

Subject to this Act, the person for the time being entered in the register as proprietor of a trademark shall, subject to any rights appearing from the register to be vested in any other person, have power to assign the trademark, and to give effectual receipts for any consideration for an assignment of it.



## **27. Registration of assignments and transmissions.**

(1) Where a person becomes entitled by assignment or transmission to a registered trademark, he or she shall make 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 the person as the proprietor of the trademark in respect of the goods in respect of which the assignment or transmission has effect, and shall cause particulars of the assignment or transmission to be entered on the register.

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

(3) Except for the purposes of an appeal under this section or of an application under section 34, a document or instrument in respect of which no entry has 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.

### **PART IV—USE AND NONUSE.**

## **28. Removal from register and imposition of limitations on ground of nonuse.**

(1) Subject to section 29, a registered trademark may be taken off the register in respect of any of the goods in respect of which it is registered on application by any person aggrieved to the court or, at the option of the applicant and subject to section 52, to the registrar, on the ground either—

- (a) that the trademark was registered without any bona fide intention on the part of the applicant for registration that he or she should use it in relation to those goods, and that there has in fact been no bona fide use of the trademark in relation to those goods by any proprietor of the trademark for the time being up to the date one month before the date of the application; or
- (b) that up to the date one month before the date of the application a continuous period of five years or longer elapsed during which the trademark was a registered trademark and during which there was no bona fide use of the trademark in relation to those goods by any proprietor of the trademark for the time being.

(2) Except where the applicant has been permitted under section

14(2) to register an identical or nearly resembling trademark in respect of the goods in question or where the tribunal is of opinion that he or she might properly be permitted so to register such a trademark, the tribunal may refuse an application made under subsection (1)(a) or (b) in relation to any goods if it is shown that there has been, before the relevant date or during the relevant period, as the case may be, bona fide use of the trademark by any proprietor of the trademark for the time being 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 subsection (1)(b) are shown so far as regards nonuse of the trademark in relation to goods to be sold, or otherwise traded in, in a particular place in Uganda (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 14(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 for export from Uganda), or in relation to goods to be exported to that market, or the court or the registrar is of opinion that he or she might properly be permitted so to register such a trademark, on application by that person to the court, or, at the option of the applicant and subject to section 52, to the registrar, the tribunal may impose on the registration of the first-mentioned trademark such limitations as the court or the registrar thinks proper for securing that that registration shall cease to extend to such use as last aforesaid.

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

## **29. Defensive registration of well-known trademarks.**

(1) Where a trademark consisting of an invented word or invented words has become so well-known as respects any goods in respect of which it is registered and in relation to which it has been used that its use in relation to other goods would be likely to be taken as indicating a connection in the

course of trade between those goods and a person entitled to use the trademark in relation to the first-mentioned goods, then, notwithstanding that the proprietor registered in respect of the first-mentioned goods does not use or propose to use the trademark in relation to those other goods and notwithstanding anything in section 28, the trademark may, on the application in the prescribed manner of the proprietor registered in respect of the first-mentioned goods, be registered in his or her name in respect of those other goods as a defensive trademark and, while so registered, shall not be liable to be taken off the register in respect of those goods under section 28.

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

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

(4) On application by any person aggrieved to the court or, at the option of the applicant and subject to section 52, to the registrar, the registration of a trademark as a defensive trademark may be cancelled on the ground that the requirements of subsection (1) are no longer satisfied in respect of any goods in respect of which the trademark is registered in the name of the same proprietor otherwise than as a defensive trademark, or may be cancelled as respects any 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 goods would be taken as giving the indication mentioned in subsection (1).

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

(6) Except as otherwise expressly provided in this section, the provisions of this Act shall apply in respect of the registration of trademarks as defensive trademarks and of trademarks so registered as they apply in other cases.

### **30. Registered users.**

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

(2) The use of a trademark by a registered user of the trademark in relation to goods 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 a registered user, being use such as to comply with any conditions or restrictions to which his or her registration is subject, is in this Act referred to as the “permitted use” of the trademark.

(3) The permitted use of a trademark shall be deemed to be use by the proprietor of the trademark, and shall be deemed not to be use by a person other than the proprietor, for the purposes of section 28 and for any other purpose for which such use is material under this Act or at common law.

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

(5) Where it is proposed that a person should be registered as a registered user of a trademark, the proprietor and the proposed registered user must apply in writing to the registrar in the prescribed manner and must furnish the registrar with a statutory declaration made by the proprietor, 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 proprietor and the proposed registered user, including particulars showing the degree of control by the proprietor over the permitted use which their relationship will confer and whether it is a term of their relationship that the proposed registered user shall be the sole registered user or that there shall be any other restriction as to persons for whose registration as registered users application may be made;
  - (b) stating the goods in respect of which registration is proposed;
  - (c) stating any conditions or restrictions proposed with respect to the characteristics of the goods, to the mode or place of permitted use or any other matter; and
  - (d) stating whether the permitted use is to be for a period or without limit of period, and, if for a period, the duration of the period,
- and with such further documents, information or evidence as may be required under the rules or by the registrar.

(6) When the requirements of subsection (5) 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 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 as to which the registrar is so satisfied subject as aforesaid.

(7) The registrar shall refuse an application under the foregoing provisions of this section if it appears to him or her that the grant of the application would tend to facilitate trafficking in a trademark.

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

(9) Without prejudice to section 34, the registration of a person as a registered user—

- (a) may be varied by the registrar as regards the goods in respect of which, or any conditions or restrictions subject to which, it has effect, on the application in writing in the prescribed manner of the registered proprietor of the trademark to which the

- registration relates;
- (b) may be cancelled by the registrar on the application in writing in the prescribed manner of the registered proprietor or of the registered user or of any other registered user of the trademark; or
  - (c) may be cancelled by the registrar on the application in writing in the prescribed manner of any person on any of the following grounds—
    - (i) that 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) that the proprietor 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;
    - (iii) that the registration ought not to have been effected having regard to rights vested in the applicant by virtue of a contract in the performance of which he or she is interested.

(10) Provision shall be made by the rules for the notification of the registration of a person as a registered user to any other registered user of the trademark, and for the notification of an application under subsection (9) to the registered proprietor and each registered user (not being the applicant) of the trademark, and for giving to the applicant on such an application, and to all persons to whom such an application is notified and who intervene in the proceedings in accordance with the rules, an opportunity of being heard.

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

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

(13) Nothing in this section shall confer on a registered user of a trademark any assignable or transmissible right to the use of the trademark.

### **31. Proposed use of trademark by corporation to be constituted, etc.**

(1) No application for the registration of a trademark proposed in respect of any goods shall be refused, nor shall permission for such

registration be withheld, on the ground only that it appears that the applicant does not use or propose to use the trademark—

- (a) if 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 corporation with a view to the use of the trademark in relation to those goods by the corporation; or
- (b) if the application is accompanied by an application for the registration of a person as a registered user of the trademark, and the court or the registrar is satisfied that the proprietor intends it to be used by that person in relation to those goods and the court or the registrar is also satisfied that that person will be registered as a registered user of the trademark immediately after the registration of the trademark.

(2) Section 28 shall have effect, in relation to a trademark registered under the power conferred by subsection (1), as if for the reference in section 28(1)(a) 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 corporation 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 corporation as aforesaid, require the applicant to give security for the costs of any proceedings before the court or the registrar relative to any opposition or appeal, and in default of such security being duly given may treat the application as abandoned.

(4) Where a trademark is registered in respect of any goods under the power conferred by subsection (1) in the name of an applicant who relies on intention to assign to a corporation as aforesaid, then, unless within such period as may be prescribed, 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 corporation has been registered as the proprietor of the trademark in respect of those goods, the registration shall cease to have effect in respect thereof at the expiration of that period, and the registrar shall amend the register accordingly.

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

(1) Where under this Act use of a registered trademark is required to be proved for any purpose, the court or the registrar may, if and so far as the court or the registrar thinks right, accept 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 deemed to be also a use of any registered trademark, being a part of it, registered in the name of the same proprietor by virtue of section 23(1).

**33. Use of trademark for export trade.**

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

PART V—GENERAL.

*Rectification and correction of the register.*

**34. General power to rectify entries in register.**

(1) Any person aggrieved by the noninsertion in or omission from the register of an entry, or by any entry made in the register without sufficient cause, or by any entry wrongly remaining on the register, or by any error or defect in any entry in the register, may apply in the prescribed manner to the court or, at the option of the applicant and subject to section 52, to the registrar, and the court or the registrar may make such 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 the provisions of this section.

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

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

### **35. Power to expunge or vary registration for breach of condition.**

On application by any person aggrieved to the court, or, at the option of the applicant and subject to section 52, 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 any contravention of, or failure to observe, a condition entered on the register in relation to the trademark.

### **36. Correction of register.**

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

- (a) correct any error in the name, address or description of the registered proprietor of a trademark;
- (b) enter any change in the name, address or description of the person who is registered as proprietor of a trademark;
- (c) cancel the entry of a trademark on the register;
- (d) strike out any goods or classes of goods 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 the name, address or description of the registered user.

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

### **37. Alteration of registered trademark.**

(1) The registered proprietor of a trademark may apply in the prescribed manner to the registrar for leave to add to or alter the trademark in any manner not substantially affecting its identity, and the registrar may refuse leave or may grant it on such terms and subject to such 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 in any case where it appears to him or her that it is expedient so to do, and where the registrar does so, if within the prescribed time from the date of the advertisement any person gives notice to the registrar in the prescribed manner of opposition to the application, the registrar shall, after hearing the parties if so required, decide the matter.

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

(4) Where leave as aforesaid 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).

### **38. Adaptation of entries in register to amended or substituted classification of goods.**

(1) The Minister may from time to time make such rules, prescribe such forms and generally do such things as he or she thinks expedient, for empowering the registrar to amend the register, whether by making or expunging or varying entries in it, so far as may be requisite for the purpose of adapting the designation in it of the goods or classes of goods in respect of which trademarks registered to any amended or substituted classification that may be prescribed.

(2) The registrar shall not in exercise of any power conferred on him or her for the purpose specified in subsection (1) make any amendment of the register that would have the effect of adding any goods or classes of goods 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 antedating registration of a trademark in respect of any goods; except that this subsection shall not have effect in relation to goods as to which the registrar is satisfied that compliance with this subsection in relation to them would involve undue complexity and that the addition or antedating would not affect any substantial quality of goods and would not substantially prejudice the rights of any person.

(3) A proposal for the amendment of the register for the purpose aforesaid shall be notified to the registered proprietor of the trademark affected, shall be subject to appeal by the registered proprietor to the court, shall be advertised with any modifications, and may be opposed before the registrar by any person aggrieved on the ground that the proposed amendment contravenes the provisions of subsection (2); and the decision of the registrar on any such opposition shall be subject to appeal to the court.

### *Certification trademarks.*

## **39. Certification trademarks.**

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

(2) In determining whether a mark is adapted to distinguish as aforesaid, the court or the registrar may have regard to the extent to which—

- (a) the mark is inherently adapted to distinguish as aforesaid in relation to the goods 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 as aforesaid in relation to the goods in question.

(3) Subject to subsections (4) to (6) and sections 9 and 10, the registration of a person as proprietor of a certification trademark in respect of any goods shall, if valid, give to that person the exclusive right to the use of the trademark in relation to those goods, and, without prejudice to the generality of the foregoing words, that right shall be deemed to be infringed

by any person who, not being the proprietor of the trademark or a person authorised by the proprietor under the regulations in that behalf using it in accordance therewith, uses a mark identical with it or so nearly resembling it as to be likely to deceive or cause confusion, in the course of trade, in relation to any goods in respect of which it is registered, and in such manner as to render the use of the mark likely to be taken either—

- (a) as being use as a trademark; or
- (b) in a case in which the use is use upon the goods or in physical relation to them or in an advertising circular or other advertisement issued to the public, as importing a reference to some person having the right either as proprietor or by his or her authorisation under the relevant regulations to use the trademark or to goods certified by the proprietor.

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

(5) The right to the use of a certification trademark given by registration as aforesaid shall not be deemed to be infringed by the use of any such mark as aforesaid by any person—

- (a) in relation to goods certified by the proprietor of the trademark if, as to those goods or a bulk of which they form part, the proprietor or another in accordance with the proprietor's authorisation under the relevant regulations has applied the trademark and has not subsequently removed or obliterated it, or the proprietor 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 as aforesaid or might for the time being be so used, if the use of the mark is reasonably necessary in order to indicate that the goods are so adapted and neither the purpose nor the effect of the use of the mark is to indicate otherwise than in accordance with the fact that the goods are certified by the proprietor,

but paragraph (a) of this subsection shall not have effect in the case of use

consisting of the application of any such mark as aforesaid to any goods, notwithstanding that they are such goods as are mentioned in that paragraph, if such application is contrary to the relevant regulations.

(6) Where a certification trademark is one of two or more registered trademarks that are identical or nearly resemble each other, the use of any of those trademarks in exercise of the right to the use of that trademark given by registration shall not be deemed to be an infringement of the right so given to the use of any other of those trademarks.

(7) There shall be deposited at the office of the registrar in respect of every trademark registered under this section regulations for governing the use of the trademark, which shall include provisions as to the cases in which the proprietor is to certify goods and to authorise the use of the trademark, and may contain any 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 proprietor to certify goods or to authorise the use of the trademark in accordance with the regulations.

(8) Regulations deposited in accordance with subsection (7) shall be open to inspection in like manner as the register.

(9) A certification trademark shall not be assignable or transmissible otherwise than with the consent of the court.

(10) The First Schedule to this Act shall have effect with respect to the registration of a mark under this section and to marks so registered.

#### *Rules and fees.*

#### **40. Power of Minister to make rules.**

The Minister may from time to time make such rules, prescribe such forms and generally do such things as he or she thinks expedient—

- (a) for regulating the practice under this Act, including the service of documents;
- (b) for classifying goods for the purposes of registration of trademarks;
- (c) for making or requiring duplicates of trademarks and other documents;
- (d) for securing and regulating the publishing and selling or

distributing, in such manner as the Minister thinks fit, of copies of trademarks and other documents; (e) generally, for regulating the business of the registrar in relation to trademarks and all things by this Act placed under the direction or control of the registrar.

#### **41. Fees.**

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

#### *Powers and duties of registrar.*

#### **42. Preliminary advice by registrar as to distinctiveness.**

(1) The power to give to a person who proposes to apply for the registration of a trademark in Part A or Part B of the register advice as to whether the trademark appears to the registrar *prima facie* to be inherently adapted to distinguish, or capable of distinguishing, shall be a function of the registrar under this Act.

(2) Any person who is desirous of obtaining such advice must make application to the registrar for it in the prescribed manner.

(3) If on an application for the registration of a trademark as to which the registrar has given advice as aforesaid in the affirmative, made 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 capable of distinguishing, the applicant shall be entitled, on giving notice of withdrawal of the application within the prescribed period, to have repaid to him or her any fee paid on the filing of the application.

#### **43. Hearing before exercise of registrar's discretion.**

Where any discretionary or other power is given to the registrar by this Act or any rules made under it, the registrar shall not exercise that power adversely to the applicant for registration or the registered proprietor of the trademark in question without (if duly required so to do within the prescribed time), giving to the applicant or registered proprietor an opportunity of being heard.

#### **44. Power of registrar to award costs.**

(1) In all proceedings before the registrar under this Act, the registrar shall have power to award to any party such costs as the registrar may consider reasonable, and to direct how and by what parties they are to be paid, and any such order may, by leave of the court or a judge of the court, be enforced in the same manner as a judgment or order of the court to the same effect.

(2) The Chief Justice may, from time to time, make rules in regard to the amount of and generally as to costs.

*Legal proceedings and appeals.*

#### **45. Registration to be prima facie evidence of validity.**

In all legal proceedings relating to a registered trademark (including applications under section 34), the fact that a person is registered as proprietor of the trademark shall be prima facie evidence of the validity of the original registration of the trademark and of all subsequent assignments and transmissions of the trademark.

#### **46. Certificate of validity.**

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 proprietor of the trademark, the court may certify to that effect, and if it so certifies, then in any subsequent legal proceeding in which the validity of the registration comes into question the proprietor 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 the proprietor ought not to have them.

#### **47. Costs of registrar in proceedings before court.**

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

**48. Trade usage, etc. to be considered.**

In any action or proceeding relating to a trademark or trade name, the court or the registrar shall admit evidence of the usages of the trade concerned and of any relevant trademark or trade name or getup legitimately used by other persons.

**49. 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 so directed by the court.

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

**50. Court's power to review registrar's decision.**

The court, in dealing with any question of the rectification of the register (including all applications under section 34), shall have power to review any decision of the registrar relating to the entry in question or the correction sought to be made.

**51. Discretion of court in appeals.**

In any appeal from a decision of the registrar to the court under this Act, the court shall have and exercise the same discretionary powers as under this Act are conferred upon the registrar.

**52. Procedure in cases of option to apply to court or registrar.**

Where under any of the foregoing provisions of this Act an applicant has an option to make an application either to the court or to the registrar—

- (a) if an action concerning the trademark in question is pending, the application must be made to the court;



- (b) if in any other case the application is made to the registrar, the registrar 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, subject to appeal to the court.

*Evidence.*

**53. 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 it right so to do, he or she may take evidence viva voce in lieu of or in addition to evidence by declaration. Any such statutory declaration may in the case of appeal be used before the court in lieu of evidence by affidavit, but if so used shall have all the incidents and consequences of evidence by affidavit.

(2) In case any part of the evidence is taken viva voce, the registrar shall, in respect of requiring the attendance of witnesses and taking evidence on oath, be in the same position in all respects as a magistrate.

**54. Evidence of entries in register.**

(1) A printed or written copy of any entry in the register purporting to be certified by the registrar and sealed within 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) Any person requiring such a certified copy as aforesaid shall be entitled to obtain it on payment of the prescribed fee.

**55. Evidence of things done by registrar.**

A certificate purporting to be under the hand of the registrar as to any entry, matter or thing that he or she is authorised by this Act or the rules to make or do shall be prima facie evidence of the entry having been made, and of its contents, and of the matter or thing having been done or not done.

*Offences and penalties.*

**56. Falsification of entries in register.**

If any person makes or causes to be made a false entry in the register, or a writing falsely purporting to be a copy of an entry in the register, or produces or tenders or causes to be produced or tendered in evidence any such 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 thousand shillings.

**57. Fine for falsely representing a trademark as registered.**

- (1) Any 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) with respect to a part of a registered trademark not being a part separately registered as a trademark, to the effect that it is so registered;
  - (c) to the effect that a registered trademark is registered in respect of any goods 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 use of the trademark in any 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 thousand shillings.

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

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

trademark under the law of a country outside Uganda and in relation to goods to be exported to that country.

*Miscellaneous.*

**58. Change of form of trade connection not to be deemed to cause deception.**

The use of a registered trademark in relation to goods between which and the person using it any form of connection in the course of trade subsists shall not be deemed 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 of his or her a different form of connection in the course of trade subsisted or subsists.

**59. Jointly owned trademarks.**

(1) Where the relations between two or more persons interested in a trademark are such that no one of them is entitled as between himself or herself and the other or others of them to use it 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 proprietors 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 as aforesaid, nothing in this Act shall authorise the registration of two or more persons who use a trademark independently, or propose so to use it, as joint proprietors of the trademark.

**60. Trusts and equities.**

(1) There shall not be entered in the register any notice of any trust, express, implied or constructive, nor shall any such notice be receivable by the registrar.

(2) Subject to this Act, equities in respect of a trademark may be enforced in like manner as in respect of any other personal property.

**61. Recognition of agents.**

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

**62. Address for service.**

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

**Certification trademarks.**

1. (1) An application for the registration of a mark under section 39 of this Act must be made to the registrar in writing in the prescribed manner by the person proposed to be registered as the proprietor of the mark.

(2) The provisions of section 19(2) and (4) to (7) of this Act shall have effect in relation to an application under section 39 of this Act as they have effect in relation to an application under section 19(1).

(3) In dealing under section 19(2) and (4) to (7) of this Act with an application under section 39 of this Act, the court or the registrar shall have regard to the like considerations, so far as relevant, as if the application were an application under section 19 of this Act and to any other considerations relevant to applications under section 39, including the desirability of securing that a certification trademark shall comprise some indication that it is such a trademark.

(4) An applicant for the registration of a mark under section 39 of this Act shall transmit to the registrar draft regulations for governing the use of the mark in accordance with section 39(7).

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

- (a) whether the applicant is competent to certify the goods 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 refuse to accept the application; or accept the application, and approve the regulations either without modification and unconditionally or subject to any conditions or limitations, or to any amendments or modifications of the application or of the regulations which the registrar thinks requisite having regard to any of the matters aforesaid; but, except in the case of a direction for acceptance and approval without modification and unconditionally, the registrar shall not decide the matter without giving to the applicant an opportunity of being heard.

2. (1) When an application has been accepted, the registrar shall as soon as may be after such acceptance, cause the application as accepted to be advertised in the prescribed manner, and the provisions of section 20(2) to (12) of this Act shall have effect in relation to the registration of the mark as if the application had been an application under section 19 of this Act; but in deciding under the said provisions, the registrar shall have regard only to the considerations referred to in paragraph 1(3), and a decision under the said provisions in favour of the applicant shall be conditional on the determination in his or her favour by the registrar under subparagraph (2) of this paragraph of any opposition relating to any of the matters referred to in paragraph 1(5).

(2) When notice of opposition is given relating to any of the matters referred to in paragraph 1(5), the registrar shall, after hearing the parties, if so required, and considering any evidence, decide whether, and subject to what conditions or limitations or amendments or modifications of the application or of the regulations, if any, registration is, having regard to those matters, to be permitted.

3. (1) The regulations deposited in respect of a certification trademark may, on the application of the registered proprietor, be altered by the registrar.

(2) The registrar may cause an application for his or her consent to be advertised in any case where it appears to the registrar that it is expedient so to do, and where the registrar causes an application to be advertised, if within the prescribed time from the date of the advertisement any person gives notice to the registrar of opposition to the application, the registrar shall not decide the matter without giving the parties an opportunity of being heard.

4. (1) The court may, on the application in the prescribed manner of any person aggrieved, or on the application of the registrar, make such order as it thinks fit for expunging or varying any entry in the register relating to a certification trademark, or for varying the deposited regulations, on the ground—

- (a) that the proprietor is no longer competent, in the case of any of the goods in respect of which the trademark is registered, to certify those goods;
- (b) that the proprietor has failed to observe a provision of the deposited regulations to be observed on his part;

- (c) that it is no longer to the public advantage that the trademark should be registered; or
- (d) that it is requisite for the public advantage that, if the trademark remains registered, the regulations should be varied, and the registrar shall have no jurisdiction to make an order under section 34 of this Act on any of those grounds.

(2) The registrar shall rectify the register and the deposited regulations in such manner as may be requisite for giving effect to an order made under subparagraph 1 of this paragraph.

5. Notwithstanding anything in section 44 of this Act, the registrar shall not have any jurisdiction to award costs to or against any party on an appeal to the registrar against a refusal of the proprietor of a certification trademark to certify goods or to authorise the use of the trademark.

6. Any decision of the registrar under the provisions of this Schedule shall be subject to appeal to the court.

7. The following provisions of this Act shall not have effect in relation to a certification trademark, that is to say, sections 6, 8, 11, 19 and 20 (except as expressly applied by this Schedule), and section 24(4) to (8), 28 to 31, and 58 and any provisions the operation of which is limited by the terms of the provisions to registration in Part B of the register.

**History:** Cap. 83; Act 3/1965; Decree 18/1976.