

# BILL

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SCHEDULE—Article 4 of Paris Convention.

No.



2014

Sierra Leone

**A BILL ENTITLED**

**THE TRADEMARKS 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 commencement.

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— Grounds for refusal of registration of mark.
- (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;

- (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 opposition to registration 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 <sup>Registration</sup> reference to the registration and issue the applicant with a certificate <sup>certificate</sup> 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 in relation to any goods or services for which the trade mark was registered without the permission of the owner.

(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*.

Invalidation of collective mark.

13. The Tribunal shall invalidate the registration of a collective mark if the person requesting the invalidation proves that—

- (a) only the registered owner uses the trade mark to the exclusion of other enterprises;
- (b) the registered owner permits the use of the trade mark in contravention of the regulations of the collective mark; or
- (c) the registered owner uses or permits the use of the trade mark in a manner likely to deceive trade circles or the public as to the origin or any other common characteristics of the goods or services concerned.

Removal of trade mark from register for non-use.

14. (1) A person interested in a trade mark may request the Registrar to remove a trade mark from the register because up to one month prior to filing for removal, the trade mark had not been used by the registered owner or a licensee for any of the goods or services in respect of which it was registered for a continuous period of five years or longer.

(2) The trade mark shall not be removed from the register if it is shown that special circumstances prevented the use of the trade mark and that there was no intention to abandon the trade mark in respect of those goods or services.

Change in ownership.

15. (1) A change in the ownership of a trade mark or a collective mark, or of an application for registration of a trade mark or collective mark shall be in writing and shall be filed with the Registrar.

(2) The change shall be recorded and published by the Registrar.

(3) A third party shall not be affected by a change of ownership of a trade mark or collective mark until the change of ownership has been filed with the Registrar.

(4) A change in the ownership of the registration of a trade mark or a collective mark shall not be valid if it is likely to deceive or cause confusion with regard to the nature, origin, manufacturing process, characteristics or suitability for the purpose of the goods or services to which the trade mark or collective mark is applied.

(5) A change in the ownership or a trade name shall be in writing addressed to the Registrar, when an enterprise is being transferred or when part of the enterprise identified by that name is being transferred.

16. (1) A licence contract concerning the registration of a trade mark or an application for registration shall be submitted to the Registrar who shall keep its contents confidential but shall record it and publish a reference to it. Licence contract.

(2) A licence contract shall not be valid against third parties until it has been filed with the Registrar.

17. If the ordinary residence or principal place of business of an applicant under this Act is outside Sierra Leone, the applicant shall be represented by a legal practitioner resident and practising in Sierra Leone. Representation of applicants.

### PART III—TRADE NAMES AND UNFAIR COMPETITION

18. (1) A name or designation may not be used as a trade name if - Trade names.

- (a) by its nature or the use to which it may be put, it is contrary to public order or morality; and
- (b) in particular, it is liable to deceive trade circles or the public as to the nature of the enterprise identified by that name.

(2) Where, under any law, it is an obligation to register trade names, such names shall be protected, even prior to or without registration, against any unlawful act committed by third parties.

19. (1) Any act of competition contrary to honest practices in industrial or commercial matters shall be unlawful. Acts of unfair competition.

(2) The following acts, in particular, shall be deemed to constitute acts of unfair competition:-

- (a) all acts of such a nature as to create confusion by any means whatever with the establishment, the goods, or the industrial or commercial activities of a competitor;
- (b) false allegations in the course of trade, of such a nature as to discredit the establishment, the goods, or the industrial or commercial activities of a competitor;
- (c) indications or allegations, the use of which, in the course of trade, is liable to mislead the public as to the nature, manufacturing process, characteristics, suitability for their purpose, or the quantity of the goods.

**PART IV – TRADE MARK REGISTRY**

Trade Marks Registry 20. (1) There is hereby established a Trade Marks Registry which shall be located at the Agency.

(2) The Registry shall be headed by the Registrar who shall be assisted by such number of Assistant Registrars as may be required.

(3) The Registrar shall be responsible for the registration of trade marks and for the administration of registered trade marks.

(4) The Registrar may delegate any functions of the office of the Registrar to an Assistant Registrar.

Register of trade marks. 21. (1) There shall continue to be a register of trade marks.

(2) Collective marks shall be registered in a special section of the register of trade marks.

(3) There shall be recorded in the register entries required under this Act.

(4) The register of trade marks shall be open to the public and any person may obtain an extract from the register in accordance with this Act.

22. (1) A person aggrieved by the non-insertion, omission, an error or defect in respect of an entry in the register or by an entry that wrongly remains on the register may apply to the Registrar to make, expunge or vary the entry but an application for rectification may not be made for any matter that affects the validity of the registration of the trade mark. Rectification or correction of register.

(2) Where proceedings have commenced before the Tribunal concerning a trade mark, the application for rectification of the register shall be made to the Tribunal.

(3) Where an application for rectification is made to the Registrar, the Registrar may refer the application to the Tribunal at any stage during the proceedings before the Registrar.

(4) Where there is fraud in the registration, assignment or transmission of a registered trade mark, the Registrar may apply to the Tribunal for rectification.

(5) A rectification order from the Tribunal shall direct that notice of the rectification be served in the prescribed manner on the Registrar who shall comply with the notice.

(6) A registered owner or any person authorised by the owner may apply to the Registrar–

(a) to correct an error or enter a change in the name, address or description of the registered owner of a trademark in the register;

(b) to cancel the entry of a trade mark in the register;

(c) to strike out any goods or classes of goods from those in respect of which a mark is registered; or

(d) to enter a disclaimer or memorandum relating to a trade mark which does not extend to the rights given by the existing registration of the trade mark.

(7) A licensee of a trade mark may correct in the register an error or enter a change in the name, address or description of the registered owner with the written consent of the owner.



Publication. 23. The Registrar shall cause to be published in the *Gazette*, and where available, an official Bulletin, any publication required under this Act.

Correction of errors and extension of time. 24. (1) The Registrar may correct any error or mistake in -

- (a) an application or document filed with the Registry; and
- (b) an entry made under this Act.

(2) The Registrar may extend the time for doing any act or taking any proceeding under this Act upon notice to the parties concerned and on such terms as the Registrar may direct.

PART V—TRADE DESCRIPTION AND FRAUDULENT MARKS

Trade description and fraudulent marks. 25. (1) A trade description is a description, statement or any other indication direct or indirect -

- (a) as to the number, quantity, measure, gauge, or weight of any goods; or
- (b) as to the standard of quality of any goods, according to a classification commonly used or recognised in the trade; or
- (c) as to the fitness for purposes, strength, performance or behaviour of any goods; or
- (d) as to the place or country in which any goods were made or produced; or
- (e) as to the mode of manufacturing or producing any goods; or
- (f) as to the material of which any goods are composed; or
- (g) as to any goods the subject of an existing patent, privilege, or copyright.

(2) The use of a figure, word, or mark which, according to the custom of the trade, is commonly taken to be an indication of any of the matters referred to in paragraphs (a) to (g) of subsection (1) shall be deemed to be a trade description within the meaning of this Act.

(3) A description is false if -

- (a) it is likely to be misunderstood as, or mistaken for, an indication as to the same or some other matter which would be false or misleading in a material respect with respect to the goods to which the description is applied; and
- (b) anything likely to be misunderstood as, or mistaken for, an indication as to any of those matters is for those purposes a trade description and includes an alteration of a trade description whether by addition, effacement or otherwise where that alteration makes the description false or misleading in a material respect; and
- (c) the fact that a trade description is a trade mark or part of a trade mark shall not prevent the trade description from being a false trade description.

(4) The provisions of this Act with respect to the application of a false trade description to goods shall extend to the application of goods of any figures, words or marks or arrangement or a combination of any of them, whether including a trade mark or not, as are reasonably likely to lead persons to believe that the goods are the manufacture or merchandise of a person other than the person whose manufacture or merchandise they really are.

(5) The provisions of this Act with respect to the application of a false trade description to goods, or with respect to goods to which a false trade description is applied, shall extend to the application to goods of any false name or initials of a person, and to goods with the false name or initials of a person applied, in the same way as if the name or initials were a trade description.



(6) In subsection (5) the expression false name or initials means, as applied to goods -

- (a) any name which is or initials which are not a trade mark or part of a mark but is or are identical with or a colourable imitation of the name or initials of a person carrying on business in connection with goods of the same description, and not having authorised the use of the name or initials; and
- (b) any name which is or initials which are either those of a fictitious person or of a person not in good faith carrying on business in connection with those goods.

Application  
of marks and  
descriptions.

26. (1) A person applies a trade mark or trade description to goods who-

- (a) applies the trade mark, mark or trade description to goods directly or causes the trade mark, or trade description to be applied to goods;
- (b) applies it to a covering, label, reel, or any other thing in which the goods are sold or exposed or had in possession for the purpose of sale, trade, or manufacture; or
- (c) places, encloses, or annexes any goods which are sold or exposed or had in possession for the purpose of sale, trade, or manufacture, in, with, or to a covering, label, reel, or any other thing to which a trade mark or trade description has been applied; or
- (d) uses a trade mark or mark or trade description in a manner likely to lead to the belief that the goods in connection with which it is used are designed or described by that trade mark or mark or trade description.

(2) A trade mark or mark or trade description is applied whether it is woven, impressed or otherwise worked into, or annexed or affixed to the goods or to a covering, label, reel or any other thing.

(3) Goods delivered in pursuance of a request made by reference to a trade mark or trade description appearing in an advertisement, invoice, sign, list, business letter, business paper or any other commercial communication, are, for the purposes of paragraph (d) of subsection (1), goods in connection with which the trade mark or trade description is used.

(4) The particulars on the customs entry relating to any imported goods are, for the purposes of this Act, a trade description applying to the goods.

(5) A person falsely applies a trade mark to goods if, without the consent of the owner of a trade mark, the trade mark or mark applied resembles the original as to be likely to deceive; but in a prosecution for falsely applying a trade mark or mark to goods the burden of proving the consent of the owner is on the defendant.

(6) In this section -

"covering" includes a stopper, cork, bottle, vessel, box, cover, capsule, case, frame or wrapper;

"label" includes a band or ticket.

27. (1) A person forges a trade mark who-

Forging of  
trade mark.

- (a) without the consent of the owner of the trade mark makes a trade mark so nearly resembling that trade mark as to be likely to deceive; or
- (b) falsifies a genuine trade mark, whether by alteration, addition, effacement, or otherwise; and a trade mark so made or falsified is in this Act referred to as a "forged trade mark".

(2) In a prosecution for forging a trade mark, the burden of proving the consent of the owner lies on the defendant.

Offences relating to trade marks and trade descriptions.

28. (1) No person shall -
- (a) apply a false trade description to goods;
  - (b) falsely apply to goods a mark so nearly resembling a trade mark as to be likely to deceive;
  - (c) forge a trade mark;
  - (d) use an article or instrument to forge a trade mark;
  - (e) possess an article to forge a trade mark; or
  - (f) cause the infringement of a trade mark under this subsection.

(2) No person shall sell or expose for or possess for sale or for any purpose of trade or manufacture any goods or things -

- (a) to which a forged trade mark or false trade description is applied, or
- (b) to which a trade mark so nearly resembling a trade mark as to be likely to deceive is applied.

(3) Any person who contravenes subsection (1) or (2) commits an offence and is liable on conviction to a fine not exceeding sixty million leones or to a term of imprisonment not exceeding five years or to both.

(4) Where a person is convicted of an offence under this section the goods and things of any kind by means of or in relation to which the offence is committed are liable, at the discretion of the Tribunal, to be forfeited to the State.

Defences.

29. (1) Where a person is charged with an offence under subsection (1) of section 28, it is a good defence if that person proves that the act was done without the intent to defraud.

(2) Where a person is charged with an offence under paragraph (a), (b) or (d) of subsection (1) of section 28 or under paragraph (f) of that subsection, it is a good defence if that person proves that -

- (a) being in the business of making articles or other instruments to make trade marks, the person applied marks or descriptions to goods and was not interested in the goods for profit or commission dependent on the sale of the goods;
- (b) reasonable precautions were taken against committing the offence charged;
- (c) at the time of the commission of the alleged offence, there was no reason, as an employee, to doubt the genuineness of the trade mark, mark or trade description; and
- (d) the police officer was given the relevant information with respect to the persons on whose behalf the trade mark, mark, or description was applied.

(3) Where a person is charged with an offence under subsection (2) of section 28, it is good defence for that person to prove—

- (a) that having taken reasonable precautions against committing an offence against this Act, that person did not, at the time of the commission of the alleged offence have a reason to doubt the genuineness of the trade mark, mark or trade description and that on demand made by or on behalf of the police officer, gave the information that was required with respect to the persons from whom the goods or things were obtained; or
- (b) that otherwise that person had acted innocently.

Informant to give notice to Commissioner-General.

30. (1) An informant shall—
- (a) give the Commissioner-General notice in writing which shall stipulate—
    - (i) the number of packages expected;
    - (ii) a description of the goods by marks or other particulars sufficient for identification;
    - (iii) details of the means of conveyance and expected date of arrival of the goods in the country;
    - (iv) the reasons for which the detention is requested; and
    - (v) any other information the Commissioner-General may require;
  - (b) deposit with the Commissioner-General such sum of money as the Commissioner-General may require to cover expenses which may be incurred in the examination of goods under this Part.

(2) The Commissioner-General may require security from the informant to recover expenses, charges, costs and damages incurred in respect of the detention and subsequent proceedings.

(3) Upon failure to provide the security, the Commissioner-General may refuse to detain the goods.

(4) This section also applies to transhipped goods and goods in transit.

(5) The notice shall be in such a form as may be prescribed under this Act.

(6) An informant is a person other than a customs officer who has information about an offence committed under this Part.

31. In a prosecution for an offence under this Act, where goods are imported, evidence of the port of shipment shall be *prima facie* evidence of the place of origin of the goods. Proof of place of origin.

32. A prosecution for an offence under this Act shall not be commenced after the expiration of three years from the commission of the offence or of one year after the first discovery of the commission by the prosecutor, whichever occurs first. Limitation of prosecutions.

33. On the sale or in the contract for the sale of any goods to which a trade mark or mark or trade description has been applied, the seller warrants that the mark is a genuine trade mark and not forged or falsely applied and that the trade description is not a false trade description within the meaning of this Act, unless the contrary is expressed in some writing signed by or on behalf of the seller and delivered at the time of the sale or contract to and accepted by the purchaser. Implied warranty on sale of marked goods.

34. The Customs Act, applies to this Part with respect to the procedure for processing of unclaimed goods and the power of the Commissioner-General in relation to imported goods not properly marked. Forfeiture of unclaimed goods. Act No. 9 of 2011.

35. In this Part, unless the context otherwise requires, "Commissioner-General" means Commissioner-General of the National Revenue Authority. Definition.

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

36. (1) The Registrar may, subject to approval of the Tribunal, award costs and direct how and by which parties they are to be paid in proceedings under this Act. Power of Registrar to award costs etc.

(2) The order for costs may, by leave of the Tribunal, be enforced in the same manner as a judgment or order of the Tribunal.

37. In legal proceedings relating to a registered trade mark, including applications under section 22, the fact that a person is registered as owner of the trade mark shall be *prima facie* evidence of the validity of the original registration of the trade mark and of subsequent assignments and transmission of the trade mark. Registration to be *prima facie* evidence of validity.

Certificate of validity. 38. (1) Where there is an issue about the validity of the registration of a registered trade mark in legal proceedings, the Tribunal may certify validity in favour of the owner.

(2) In subsequent legal proceedings where validity is an issue, the owner of the trade mark is entitled to costs, charges and expenses between legal practitioner and client on obtaining a final order or judgment, unless the Tribunal certifies otherwise.

Costs of Registrar in Tribunal proceedings. 39. In any proceedings before the Tribunal under this Act, the Registrar shall not be awarded costs or ordered to pay the costs of any other party.

Registrar's appearance in proceedings. 40. (1) The Registrar shall be a party to proceedings by the plaintiff, appellant or applicant in which the relief sought would affect the register and the Registrar shall appear and be heard.

(2) The Tribunal may direct the Registrar to appear in any legal proceedings before it.

(3) The Registrar instead of appearing in the Tribunal may submit a signed statement giving particulars of the proceedings in relation to the matter in issue and any decision given affecting the matter and the statement shall form part of the evidence in the proceeding.

Appeal to Tribunal. 41. An order or decision of the Registrar is subject to appeal to the Tribunal.

Procedure in cases of option to apply to Tribunal or Registrar. 42. (1) Where an applicant has an option to make an application either to the Tribunal or to the Registrar -

- (a) the application shall be made to the Tribunal if an action concerning the trade mark in question is before the Tribunal; or
- (b) where the application is made to the Registrar, the Registrar may refer the application to the Tribunal at any stage of the proceedings or may determine the question.

43. (1) Evidence shall be given by statutory declaration in any proceeding before the Registrar. Mode of taking evidence for proceedings before Registrar.

(2) Notwithstanding subsection (1) the Registrar may take evidence on oath instead of or in addition to a statutory declaration.

(3) The Registrar shall have the same powers to require the attendance of a witness, the production of a document and the taking of evidence on oath as a court.

(4) A witness before the Registrar is entitled to the same immunities and privileges as if appearing as a witness before court and may be awarded the same allowances as a witness.

(5) A summons under this section for the attendance of a witness to give evidence or for the production of a document shall be signed by the Registrar.

(6) If any person -

- (a) defaults to attend as a witness when summoned by the Registrar; or
- (b) refuses to take an oath, fails to produce a document or to answer any question required by the Registrar; or .
- (c) does any other thing which would amount to contempt of court,

the Registrar may certify the offence of that person under official seal to the Tribunal and the tribunal may take such measure as may be necessary as if the person is in contempt of court.

44. (1) A copy of any entry in the register, purporting to be certified and sealed with the official seal of the Registrar shall be admissible in evidence in the Tribunal without further proof or production of the original. Evidence of entries in register.

(2) A person may obtain a certified copy of an entry in the register from the Registrar on payment of the prescribed fee.

Evidence of things done by Registrar.

45. A certificate purporting to be under the official seal of the Registrar shall be evidence of the action taken by the Registrar.

#### PART VII—MISCELLANEOUS PROVISIONS

Conservatory provisions and measures.

46. (1) The Tribunal shall have jurisdiction to hear cases under this Act and shall have the authority, subject to the relevant provisions of rules of civil and criminal procedure and on such terms as it may think reasonable to -

- (a) grant injunctions to prevent the infringement or prohibit the continuation of the infringement;
- (b) order the impounding of -
  - (i) copies of works or sound recording suspected of being made or imported without the authorization of the owner of any right protected under this Act where the making or importation of copies is subject to such authorization, or
  - (ii) the packaging of the implements that could be used for the making of, and the documents, accounts or business papers referring to such copies.

(2) The provisions of the applicable civil and criminal procedure laws dealing with search and seizure shall apply to infringement of rights under this Act.

Act No. 9 of 2011.

(3) The provisions of the Customs Act dealing with suspension or the release of suspected illegal goods shall apply to articles and implements protected under this Act.

Civil remedies.

47. (1) The owner of a right protected under this Act whose right has been infringed is entitled to payment, by the defendant, of -

- (a) damages suffered as a consequence of the act of infringement; and

- (b) expenses caused by the infringement, including legal costs.

(2) The amount of damages shall be fixed in accordance with the relevant provisions of the rules of civil proceedings, taking into account the importance of-

- (a) the material and moral prejudice suffered by the owner of the right; and
- (b) the defendant's profits attributable to the infringement.

(3) Where infringing copies exist, the Tribunal shall have the authority to order the destruction or other reasonable disposal of those copies and their packaging outside the channels of commerce in such a manner as to avoid harm to the owner of the right unless the owner of the right requests otherwise.

(4) Where there is a danger that implements may be used to commit or continue to commit an act of infringement, the Tribunal shall, whenever and to the extent that it is reasonable, order their destruction or other reasonable disposal outside the channels of commerce in such a manner as to minimize the risks of further infringements, including surrender to the owner of the right.

(5) Where there is a danger that an act of infringement may be continued, the Tribunal shall -

- (a) expressly order that the act shall not be committed; and
- (b) fix a fine which is twice the original fine, which shall be paid if the order is not respected.

(6) The Tribunal shall have exclusive original jurisdiction for all civil claims arising from this Act.

48. (1) A person who infringes a right protected under this Act willfully or by gross negligence and for profit-making purposes commits an offence and is liable on conviction to a fine not exceeding sixty million leones or to imprisonment for a term not exceeding five years or to both the fine and imprisonment. Criminal sanctions

(2) The Tribunal shall fix the amount of the fine, taking into particular account, the defendant's profits attributable to the infringement.

(3) The Tribunal may increase up to double the upper limit of the penalties specified in subsection (1), where the defendant has been convicted for a new act of infringement within five years of a previous conviction for an infringement.

Act No.32 of 1965.

(4) The Tribunal shall also apply in criminal proceedings the measures and remedies referred to in sections 74 and 75 of the Criminal Procedure Act, or the corresponding sections provided in any Criminal Procedure Act in force.

(5) The Tribunal shall have exclusive original jurisdiction for the trial of all offences under this Act.

Compensation to victim of offence.

49. In addition to any punishment imposed by the Tribunal in respect of an offence under this Act, the Tribunal may order -

- (a) that the sums of money arising out of the offence be paid to the person entitled under this Act to those sums; and
- (b) that the reproductions, duplications, extracts, imitations and other materials involved in the infringement, and the implements or devices used in the infringement be forfeited and disposed of as the Tribunal may direct, having regard to the circumstances relating to the infringement.

Settlement of disputes.

50. (1) Where any dispute arises between any parties under this Act or in relation to any copyright or claim under this Act, the parties involved in the dispute shall first seek to negotiate a settlement of the dispute among themselves.

(2) Where negotiation under subsection (1) fails, a report shall be made by either or both parties to the Commissioner-General who shall mediate for a settlement.

(3) Where no settlement is arrived at upon mediation, the matter shall be referred by the Commissioner-General to the Tribunal.

51. (1) The provision of any international or regional treaty or agreement in respect of trade marks to which Sierra Leone is a party shall apply to this Act or any regulation made under it.

Application of international and regional treaties and agreements.

(2) Any trade mark registered overseas by virtue of an international or regional treaty or agreement shall also be published in Sierra Leone in addition to the international and regional publication.

52. A person who knowingly makes or causes a false entry to be made in the register commits an offence and is liable on conviction to a fine not exceeding thirty million leones or to imprisonment for a term not exceeding one year or to both.

Falsification of entries in register.

53. (1) Any person who makes a false representation-

- (a) that a trade mark is a registered trade mark; or
- (b) that a part of a registered trade mark is separately registered as a trade mark; or
- (c) that a registered trade mark is registered in respect of specific goods; or
- (d) that the registration of a trade mark gives an exclusive right to its use taking into account the limitations entered on the register;

Offence of false representation of registration.

commits an offence and is liable on conviction to a fine not exceeding sixty million leones or to a term of imprisonment not exceeding five years or to both and, in the case of a continuing offence, a further fine not exceeding five million leones for each day on which the offence continues.

(2) For the purposes of this section, the use in Sierra Leone in relation to a trade mark of the word "registered", or of any other word or of a symbol referring whether expressly or impliedly to registration, shall be deemed to import a reference to registration in the register, except -



- (a) where that word or that symbol is used in physical association with words delineated in characters at least as large as those in which that word or that symbol is delineated and indicating that the reference is to registration as a mark under the law of a place outside Sierra Leone, where the registration referred to is in force; or
- (b) where that word is a word other than the word "registered" or that symbol itself indicates that the reference is to the registration as described in paragraph (a); or
- (c) where that word or that symbol is used in relation to a trade mark registered as a trade mark under the law of a place outside Sierra Leone and in relation to goods to be exported to that place.

Penalty for unlawful use of official badges

54. (1) A person shall not without lawful authority use any badge, seal, device, emblem or flag reserved by law for the use of the Republic, the President, a Minister of State, the Armed Forces, any Ministry, Department or Agency of the Government, any public officer or any member of the Armed Forces in such a manner as to lead to the belief that the person is authorised to use that badge, seal, device, emblem or flag.

(2) Subsection (1) applies to the use of any badge, seal, device, emblem or flag closely resembling the badge, seal, device, emblem or flag referred to in that subsection which is likely to deceive.

(3) A person who contravenes subsection (1) commits an offence and is liable on conviction to a fine not exceeding thirty million leones or to a term of imprisonment not exceeding one year or to both and, the case of a continuing offence, to a further fine not exceeding five million leones for each day on which the offence continues or to imprisonment not exceeding three months instead of a fine.

Possible cause of deception.

55. (1) Where, in the course of trade, a form of connection subsists between goods and the person who has registered a trade mark in respect of the goods, the trade mark shall not be deemed to be likely to cause deception or confusion.

(2) Subsection (1) operates on the ground that the trade mark has been or is used between the goods and the person using the trade mark or a predecessor of that person whether or not a different form of connection in the cause of trade subsisted or subsists.

56. (1) Where the relations between two or more persons jointly interested in a trade mark do not permit the use of the trade mark by one of them except—

Jointly owned trade marks.

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

those persons may be registered as joint owners of the trade mark and this Act shall apply as if those rights had been vested in a single person; but the rights of any person registered as a joint owner shall be deemed to be infringed by any of the other owners who use the trade mark in physical or other relation to goods in respect of which the trade mark is registered under this section where both or all of the joint owners are not and have not been connected in the course of trade.

(2) Subject to subsection (1), this Act does not authorise the registration of two or more persons who use a trade mark independently or propose to use it independently to be registered as joint owners.

57. (1) No notice shall be entered in the register of any trust express, implied or constructive and the Registrar shall not receive notice of a trust.

Trusts and equities.

(2) Equities in respect of a trade mark may be enforced in the same manner as any other movable property.

58. (1) Where an offence under this Act is committed by a body of persons, then—

Offences by bodies of persons.

- (a) in the case of a body corporate, any person who, at the time of the commission of the act constituting the offence, was a director or officer of that body, shall be deemed to be guilty of that offence; and



- (b) in the case of a firm, every person who at the time of the commission of the act constituting the offence was a partner or officer of that firm, shall be guilty of that offence.

(2) No person shall be liable for an offence by virtue of this section if he proves that the act in respect of which he is charged was committed by some other person without his knowledge or connivance and that he exercised all due care to prevent the commission of the offence, having regard to all the circumstances.

Regulations. 59. The Minister may by statutory instrument make regulations for—

- (a) providing the payment of fees for the registration of marks and collective matters;
- (b) generally carrying into effect the provisions of this Act.

Repeal of  
Cap. 244 and  
Cap. 245 and  
savings.

60. (1) The Trade Marks Act and the Merchandise Marks Act are hereby repealed.

(2) The repeal of the Acts referred to in subsection (1) (repealed Acts) shall not affect the validity of any mark or other right that was vested in any person by virtue of those Acts and those rights shall continue to be enforceable as if they were conferred under this Act.

(3) Notwithstanding the repeal of the repealed Acts –

- (a) any regulation made under the repealed Acts and in force immediately before the commencement of this Act shall continue in force until amended or revoked under this Act;
- (b) any appointment made under the repealed Acts and valid at the commencement of this Act shall remain valid as if made under the corresponding provision of this Act until terminated or otherwise dealt with under this Act.

(4) Notwithstanding the repeal of the repealed Acts, until such time that the Agency becomes operational under the enactment establishing it, the existing administrative arrangement for trade marks management and administration, shall remain valid, and subsisting and all powers to be vested in the Agency shall be duly exercised in accordance with the corresponding provisions of this Act, by the existing administrative structures for trade marks administration.

(5) Until such time that the Tribunal is duly established and operational under the Agency Act, the High Court shall exercise the jurisdiction and powers conferred on the Tribunal under this Act.

#### SCHEDULE (Section 4)

#### ARTICLE 4 OF PARIS CONVENTION

A. (1) Any person who has duly filed an application for a patent, or for the registration of a utility model, or of an industrial design, or of a trademark, in one of the countries of the European Union, or his successor in title, shall enjoy, for the purpose of filing in the other countries, a right of priority during the periods hereinafter fixed.

(2) Any filing that is equivalent to a regular filing under the domestic legislation of any country of the Union or under bilateral or multilateral treaties concluded between countries of the Union shall be authorised as giving rise to the right of priority.

(3) By a regular national filing is meant any filing that is adequate to establish the date on which the application was filed in the country concerned, whatever may be the subsequent fate of the application.

B. Consequently, any subsequent filing in any of the other countries of the Union before the expiration of the periods referred to above shall not be invalidated by reason of any acts accomplished in the interval, in particular, another filing, the publication or exploration of the invention, the putting on sale copies of the design,

or the use of the mark, and such acts cannot give rise to any third-party right or any right of personal possession. Rights acquired by third parties before the date of the first application that serves as the basis of the right of priority are reserved in accordance with the domestic legislation of each country of the Union.

C. (1) The periods of priority referred to above shall be twelve months for patents and utility models, and six months for industrial designs and trademarks.

(2) These periods shall start from the date of filing of the first application; the day of filing shall not be included in the period.

(3) If the last day of the period is an official holiday, or a day when the office is not open for the filing of applications in the country where protection is claimed, the period shall be extended until the first following working day.

(4) A subsequent application concerning the same object as previous first application within the meaning of paragraph (2) above, filed in the same country of the Union, shall be considered as the first application, of which filing date shall be the starting point of the period of priority, if, at the time of filing the subsequent application, the said previous application has been withdrawn, abandoned, or refused, without having been laid open to public inspection and without leaving any rights outstanding, and if it has not yet served as a basis for claiming a right of priority.

D. (1) Any person desiring to take advantage of the priority of a previous filing shall be required to make a declaration indicating the date of such filing and country in which it was made. Each country shall determine the latest date on which such declaration must be made.

(2) These Particulars shall be mentioned in the publications issued by the competent authority, and in particular in the patents and specifications relating thereto.

(3) The countries of the Union may require any person making a declaration of priority to produce a copy of the application (description, drawings, etc.) previously filed. The copy, certified as correct by the authority that received such application, shall not require any authentication, and may in any case be filed, without fee, at any time within three months of the filing of the subsequent application. They may require it to be accompanied by a certificate from the same authority showing the date of filing, and by a translation.

(4) No other formalities may be required for the declaration of priority at the time of filing the application. Each country of the Union shall determine the consequences of failure to comply with the formalities prescribed by this Article, but such consequences shall in no case go beyond the loss of the right of priority.

(5) Subsequently, further proof may be required.

Any person who avails himself of the priority of a previous application shall be required to specify the number of that application; this number shall be published as provided for by paragraph (2), above.

E. (1) Where an industrial design is filed in a country by virtue of a right of priority based on the filing of a utility model, the period of priority shall be the same as that fixed for industrial designs.

(2) Furthermore, it is permissible to file a utility model in a country by virtue of a right of priority based on the filing of a patent application, and vice versa.

F. No country of the Union may refuse a priority or a patent application on the ground that the applicant claims multiple priorities, even if they originate in different countries, or on the ground that an application claiming one or more priorities contains one or more elements that were not included in the application or applications whose priority is claimed, provided that, in both cases, there is unity within the meaning of the law of the country. With respect to the elements not included in the application or applications whose priority is claimed, the filing of subsequent application shall give rise to a right of priority under ordinary conditions.

G (1) If the examination reveals that an application for a patent contains more than one invention, the applicant may divide the application into certain number of divisional applications and preserve as the date of each the date of the initial application and the benefit of the right of priority, if any.

(2) The applicant may also, on his own initiative, divide a patent application and preserve as the date of each divisional application the date of the initial application and the benefit of the right of priority, if any. Each country of the Union shall have the right to determine the conditions under which such division shall be authorised.

H Priority may not be refused on the ground that certain elements of the invention for which priority is claimed do not appear among the claims formulated in the application in the country of origin, provided that the application documents as a whole specifically disclose such elements.

I (1) Application for inventors' certificate filed in a country in which applicants have the right to apply at their own option either for a patent or for an inventors' certificate shall give rise to the right of priority provided for by this Article, under the same conditions and with the same effects as applications for patents.

(2) In a country in which applicants have a right to apply at their own option either for a patent or for an inventors' certificate.