LAWS OF SOUTH SUDAN

Trade Marks Bill, 2013

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Laws of South Sudan
Trade Marks Bill, 2013

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Laws of South Sudan

Trade Marks Bill, 2013

In accordance with the Provisions of Article 55 (3) (b), read together with Provisions of Article 85 (1) of the Transitional Constitution of the Republic of South Sudan 2011, the National Legislature, with the assent of the President of the Republic of South Sudan, hereby enacts the following:

Chapter I
Preliminary Provisions

1. Title and Commencement

This Bill may be cited as "Trade Marks Bill, 2013, and shall come into force on the date of its signature by the President

2. Repeal and Saving

(1) All provisions of any existing legislation that are governed by the provisions of this Bill shall be hereby repealed.

(2) Notwithstanding the provisions of subsection (1) of this section, all registrations, appointments, proceedings, orders, rules and regulations taken or made thereunder, except to the extend they are repealed by or are otherwise in consistent with provisions of this Bill, shall remain in force, until they are repealed or amended in accordance with provisions of this Bill.

3. Purpose

The purpose of this Bill, is to provide for the establishment of a regulatory framework to render the best practices for registration of Trade Marks and other relevant matters in South Sudan

4. Authority and Application

(1) This Bill is drafted in accordance with provisions of Articles 28, 37 (2), (c) and (d), and 52, read together with provisions of Schedule (A) paragraph (24) and Schedule (C) paragraphs (5) and (28) of Transitional Constitution of the Republic of South Sudan, 2011, that grant the National Government legislative authority over intellectual property rights, trade, commerce, industry and industrial development and matters relating to businesses, trade licenses and conditions of operation.

(2) The provisions of this Bill, shall apply throughout South Sudan, on all matters related to the organization of Trade Marks and other relevant Matters thereof.

5. Interpretation

In this Bill, unless the context otherwise requires:-

"Sign to Original Source"	means any expression or sign indicating the origin of goods or services in a particular Country or group of Countries, area or region.
"Trade Mark"	means any clear Mark connected or laid on any good and used or proposed to be used, with the objective of distinguishing goods of a person from goods of other persons. unless its usage is not be prohibited, the Trade Mark may consist of any distinguished Mark, including any word, name or borrowed name, pictured symbol or mark, implied description or financial or signboard address, ticket, parcel, sign, container or any group of things mentioned above;
"Service Mark"	means any usage of distinguished mark or its usage is proposed to distinguish services of a person from the service of others.
"Minister"	Means the National Minister of Justice
"President"	means the President of the Republic of South Sudan.
"Ministry"	means the National Ministry of Justice
"Assignments"	means assignment by acts of the parties concerned
"Limitation"	means any limitations of the exclusive right to the use of a trademark granted by the registration of a person as proprietor of trade mark, including limitations of that right or make of use as to use in relation to goods to be sold, or otherwise, traded in; in any place in South Sudan, or as to use in relation to goods to be exported to any market outside South Sudan.
"Mark"	includes, brand, heading, label, ticket, name, signature, word, letter, numeral or any combination of them.
"Prescription"	means in relation to proceedings before the court, prescribed by rules of court and in other cases, prescribed by this Bill or the rules.

"Register"	means the register of trademarks provided under this Bill;
"Registered User"	means a person who is for the time being registered as such under provisions of this Bill.
"Registrar"	means the registrar of trademarks appointed under the provisions of this Bill.
"Registered Trade Mark"	means a trade mark duly entered on the register, in relation to a certification trade mark, a mark used for or proposed to be used in relation to goods for the purpose of indicating, or to indicate, a connection in the course of trade between the goods and a person or group of persons 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 trade mark, a mark registered or deemed to have been registered under the provision of this Bill
"Court"	means the Competent High Court or any other Court or Tribunal, with jurisdiction to consider cases or suits arising under this Bill;
"Undersecretary"	means the Undersecretary of the National Ministry of Justice

Chapter II
Trade Marks Register

6. Establishment of Register

(1) There shall be established a register for trademarks in which all registered trademarks are recorded, with names and addresses of their owners and transfer notification related thereto, names and addresses of all registered users and transferees, with such conditions, restrictions, limitations, infringement or cancellation or any similar subject relevant with trademarks, as may be determined by the Registrar;

(2) The Register shall be kept in the Directorate of Registration of Companies and Businesses in the Ministry or in any other place that may be appointed by an order of the Minister to be published in the official Gazette;

7. Appointment of Registrar

The Minister shall, in consultation with the Undersecretary, appoint a Registrar to be responsible for register, who shall be responsible for the execution of duties conferred to him or her under the provisions of this Bill and shall be accountable in discharge of the assigned responsibilities to the Undersecretary and the Minister respectively.

8. Restrictions on Registration of Trademarks for Specific Goods

(1) Trademarks for any specific goods shall be registered for the purpose that the mark shall be used with indication of its special unit as it may be indicated on the goods, in accordance with the categorization of goods provided on schedule annexed with the trademarks rules, issued under this Bill, provided that the same registration shall not include all goods provided under one category.

(2) The Registrar shall decide in all issues related to determination of the unit and all other matters related to the goods

9. Public Access to Register

(1) Subject to any prescribed rule, the register established in accordance with provisions of this Bill, shall, all the time be subject for perusal and accession by the public;

(2) Any person may obtain an authenticated and certified copy of any record in the register, whenever required and after payment of the prescribed fee.

10. Registration and Prioritization of Trademarks

(1) The absolute right of trade mark ownership shall be acquired by a registration in accordance with provisions of this Bill,

(2) The right to register trade mark may be granted to the first person, who satisfies the application for registration conditions or to the first person who correctly alleges that his or her application was first submitted;

(3) Trademarks may be registered with such timeframe restriction on its usage.

11. Specific Restrictions on Registration

(1) The following Marks shall not be registered as trademarks:-

(a) Marks that consist of shapes or modules reflecting the nature of goods or its industrial purposes;

(b) Marks basically consist of symbol or indication, that may lead to the exposure of characteristics of the commodity such as its type, quantity, purpose, price and ingredients;

(c) Marks that become linguistically or commonly used for trade in that country, as a re-known description for specific goods.

(d) Marks that contradict with ethnical conduct or public order, that specifically deceive trade constituencies or public opinion, with respect to the nature and origin of such goods and manner of its manufacture, characteristics or conformity with the required purpose;

(e) Marks that imitate the military shooters or flags and different type of logos or first alphabets for names of any country or any International Government Organization or International Organization or any Organization established under International Treaty, unless the competent authorities approve in such a Country or International Organization;

(f) Marks that imitate the official marks or official Seal of any country, unless the competent authorities of that country approve its usage;

(g) Similar Marks or resembling logos related to religious, sectarian or tribal organizations;

(h) Marks that resemble or imitate the image of any religious, tribal leader or having any sectarian indication;

(2) The following Marks shall not be registered, except with the approval of the third party owner of the interest:-

(a) Marks that resemble, any image that may lead to deception of public opinion, mark that has been submitted or registered by other third person or submitted thereafter by other person, who alleges prioritized right in the registration with respect to such goods or other goods, and its usage may lead to deception or public opinion in that respect;
(b) Marks that are considered to be wholly or partly printed or imitated or translated or a copy of other marks that may lead to deception of public opinion in relation to the forged mark owned by a third person in that Country;
(c) Marks that violate rights of third person or contradict the prevention of prejudicial competition applicable laws.

12. Application for Registration

(1) The application for registration of mark shall be submitted to the Registrar in the prescribed form, after payment of prescribed fees and shall contain the following:-

(a) Application for registration of the mark.
(b) Applicant full name, address and where the applicant is outside the country, his or her application shall be submitted through an accredited agent, in accordance with provisions of Section 18 of this Bill;

(2) Where the application is submitted by an agent, who is not a member of the South Sudan Bar Association, the agent shall submit a power of attorney duly signed by the applicant;
(3) Where the application is incomplete or has not been completed within three months from the date of its submission, the Registrar shall after notifying the applicant in writing in the prescribed manner, with the incomplete information found on the application and the applicant shall be considered to have relinquished it, unless he or she completed the application within the specified period on the notification.

13. Registration Requirements

(1) Upon application for trademark registration, the applicant shall produce and prove, his or her Nationality, subject to provisions of subsection (3) of this section, the application for registration shall be acccompanied with certificate of incorporation of the company or certificate of registration of the company or summary from the official commercial register or any other document that the Registrar may approve.

(2) Where the application for registration of transfer of trademark is submitted, the transferor shall produce and prove his or her Nationality, subject to provisions of

subsection (3) of this Section, the application for registration of the transfer shall be accompanied with the certificate of incorporation of the company or certificate of registration of the company or summary from the official commercial register or any other document that the Registrar may approve;

(3) Where such a certificate, summary or document has been submitted before in the register, the Registrar may not allow its re-submission and he or she may require its re-submission for another time in a specific situation and where the certificate, summary or document is not written in English language, the applicant shall submit an authenticated, accredited and translated text in the English language;

(4) Prior to the issuance of registration certificate of the trademark, the applicant shall submit an affidavit duly authenticated to the effect that his or her Nationality has not been altered, since the date of the application for registration of trademark.

14. Competition of Applications With Respect to Resembling Marks

Where a person from among persons alleges that, he or she is the owner of the same mark or resembling trademark for specific goods or classification of goods and requested that it shall be registered in his or her name on the ground of its ownership, the Registrar shall refer the dispute to the competent high court to determine the disputed rights of parties and shall take into consideration the registration date in the country in which the mark originated and its priority usage in South Sudan.

Chapter III

General Provisions

15. International Agreements

(1) Where the Republic of South Sudan at any time becomes a member in an International Agreement, with the objective of protection of common trademarks, any person who applies with first application for registration of mark in any other country member to the agreement or otherwise, shall be considered to have applied for registration in the Republic of South Sudan on the same date on which he or she has first applied, provided that the application have been submitted in South Sudan within six months from the date of submission of first application and the owner of the registered mark shall not have the right for compensation of any damage that may occur before the date of registration of the mark in the Republic of South Sudan;

(2) The person who applies for trademark registration, may obtain the priority referred under subsection (1) of this section, where he or she desires in accordance with the prescribed methods;

16. Continuity and Reorganization of Previous Registrations

All previous registered Marks, in accordance with provisions of any repealed law, that has been published in the official Gazette, shall be considered to have been registered in accordance with provisions of this Bill, provided that the owner of the registered trademark or his or her agent, shall apply to the Registrar on the prescribed form for review of the previous registration, in accordance with annexed schedule with the trademarks rules, issued in accordance with provisions of this Bill and after payment of prescribed fees, within five years from the date of commencement of this Bill;

17. Delegation in Submission or Objection of Registration

(1) The application for registration or objection of registration and submission of all other deliberations between the applicant, objecting person and the Registrar and between the owner of the registered trademark and the Registrar or any other person, may be through an agent

(2) Any applicant, objecting person or owner, may appoint an agent on his or her behalf with respect to registration of trademark, by submitting the duly authenticated authorization to the Registrar and in this situation any correspondence or document related with the trademark issued by the agent, shall be considered to have been issued by his or her principal;

(3) Any person not residing in South Sudan, may submit his or her application for registration or objection of registration or any letter or other deliberations by an accredited agent, in accordance with provisions of section 18 of this Bill;

18. Qualifications of Agent

(1) The following persons may be qualified to perform as agents of trademarks:-

(a) South Sudan Advocates who work in South Sudan;
(b) South Sudan Certified Accountants who work in South Sudan;
(c) The Minister may approve or withdraw in writing his or her approval at any time, from any of the following to work as an agent for trademarks, in accordance with any condition that he or she may deem appropriate:-

(i) South Sudan Graduates of Universities and High Institutes who have studied Commercial Law

(ii) South Sudanese who are with practical experience of not less than five years in Government office or private office for trademarks;
(iii)Any other person that the Minister may permit to perform trademark activities;

(2) The Registrar may not be obliged to accept any agent convicted before any criminal court or his or her name has been canceled from the Advocates Roll or prohibited from practicing as certified accountant;

19. Power of Registrar on Registration of Trademark

(1) The Registrar may reject application for registration of any trademark or approve with or without conditions, amendments, correction or restrictions with respect to the manner and place of usage or in accordance with any other condition that he or she may deem appropriate in conformity with provisions of this Bill;

(2) Decision of the Registrar with respect to the registration, any condition for trademark, amendment, correction or restrictions on registration of trademark, shall be appealable before the Undersecretary and Minister respectively and the decision of the Minister shall be final and binding;

(3) Notwithstanding the provisions of subsection (2) of this section, the aggrieved person may institute an objection before the Competent High Court.

20. Declaration of Registration Application

Whenever the application for registration of trademark is approved without any condition or restriction, the Registrar shall forthwith declare the approved registration application in the prescribed manner and shall indicate in the declaration all conditions and restrictions the basis of which the approval was granted.

21. Objection of Registration

(1) Any person resides in South Sudan, who has an interest therein, may object to registration of any trademark within six months from the date of the declaration of its registration and any person resides outside South Sudan, may submit an objection application for the approval of registration, within eight months from the date of declaration referred above on ground of any of the following reasons:-

(a) That the mark is not admissible for registration in accordance with provisions of this Bill.
(b) That the applicant has fraudulently obtained the mark or
(c) That the applicant has no intention to use the mark at the time when he or she submitted the application and that the applicant has finally relinquished the mark;

(2) Any objection of registration of any trademark, shall be submitted in accordance with the prescribed manner;

(3) The Registrar shall send a copy of the objection notification to the applicant of registration application and he or she, within the prescribed period after receiving the notification, may submit to the Registrar a counter petition indicating reasons upon which he or she has relayed on the registration application and in failure to counter the objection he or she shall be considered to have relinquished the application for registration;

(4) Where the applicant of counter petition has sent in accordance with the forgoing subsection of this section, the Registrar shall submit a copy the counter petition to the objection applicant and he or she whenever deemed necessary, may hear different parties and consider the production evidence and to decide on the possibility of approving, amending or correcting the registration or imposing restrictions upon which the registration may be approved;

(5) Where the Registrar is hearing the different parties, as provided under subsection (4) of this section, the evidence shall be produced in a form of written affidavit and the Registrar may admit oral evidence in any situation, that he or she may deem or request additional to the produced evidence on the written affidavit;

(6) The decision of the Registrar with respect to the objection of registration and counter petition against the objection application, shall be appealable before the Undersecretary and to the Minister and the decision of the Minister shall be final and binding. However the aggrieved party may institute an administrative objection before Competent High Court;

(7) Where the objection is not submitted within the prescribed period or after issuance of the final decision of the Ministry or the decision of the Competent High Court that granted the registration right, the Registrar may, subject to such conditions, amendments, correction and restrictions if any, proceed with the registration of trademark procedures and shall issue thereafter the registration certificate under his or her signature in the prescribed manner and the registration of the mark shall be considered with effect from the date of the application, which shall be for the purposes of this Bill the date of registration;

22. Period for Registration and Renewal

(1) The period for registration of trademark shall be ten years with effect from the date of registration and it may be renewable at any time within six months before the expiration

of this period or any subsequent ten years, by an application in the prescribed manner and after the payment of the prescribed fees;

(2) Where the renewal of registered mark is undertaken, no alteration shall be made on the registered mark or on the list of goods on which the mark is registered in its name, however name of some goods may be deleted from the list;

(3) An additional period may be granted for six months for the renewal of registered trademark, after the expiration of its period, provided that an additional financial obligation shall be paid in respect of that delay as may be prescribed;

(4) For the purposes of section 27 of this Bill, the period for the usage of the mark by another person shall not exceed the original period of the registration of the mark.

23. Consequential Rights of Registration

The registration of trademark grants its registered owner, the right to prohibit any third party of the following:-

(1) Any usage of the trademark or resembling indication that may likely deceive the public opinion with respect to any registered trademark in its name or in respect of any other goods that the usage of the trademark or resembling indication may deceive public opinion;

(2) Any other usage of the trademark or resembling indication or resembling commercial name, without any right and such circumstances that may likely damage the interests of trademark owner.

24. Transfer and Division of Registration

(1) Trademark may be transferred or independent transfer of all businesses of the registered owner or part thereof, in respect of all registered goods in its name or part of the goods, provided that the usage of the mark by the person to whom goods are transferred and that it may not be a deception or duress or misrepresentation;

(2) The transfer shall be registered, upon the application of any of the parties within six months from its date and after payment of the prescribed fees and in the event of irregularity in its registration, the transfer shall be canceled and void and where the Registrar is satisfied with the transfer proceedings or referral, he or she shall register such a transfer, and the decision shall be subject to appeal before the Undersecretary and the Minister respectively, however any person not satisfied with the final decision of the Minister may institute an administrative objection before the Competent High Court;

25. Usage of Trademark with Approval of Registered Owner

(1) Where the trademark is used after the approval of registered owner, by any natural or juristic person, such usage shall be considered usage by the registered owner him or herself, provided that the existing relationships and arrangements between the registered owner and user, shall envisage a guarantee that may enable the actual owner to supervise the usage of trademark, with respect to the nature and characteristics of goods and that the usage of trademark shall not be in the manner that may result to deception of public opinion;

(2) Agreements between related persons in relation to the usage of registered trademark, shall be registered, upon the application of any of the parties within six months from date of agreement and the Registrar shall issue registration certificate under his or her signature on prescribed form, after payment of prescribed fees and the registration shall be considered with effect from date of application and the registration period shall not exceed the period of registration of the mark itself and any agreement not registered in accordance with forgoing, shall have no any effect and be considered void;

(3) (a) The Minister may by an order decide the necessity of obtaining his or her approval on agreements related with the usage of trademark by a related persons and in the amendment and renewal of such agreements, including payment of revenue percentages outside South Sudan, taking into consideration the needs of the Country and its economic development;

(b) The transfer of revenue percentages outside the Country shall be subject to such regulations applicable at the time of transfer;

26. Relinquish of Registration

The owner of registered trademark may wholly or partially relinquish registration of any trademark in respect of goods registered in the name of trademark, in the prescribed manner after payment of the prescribed publishing fees.

27. Cancellation of Registration

The court may order upon the application of any person of interest or the application of the Registrar where:-

(1) The trademark is not entitled for registration in accordance with provisions of this Bill, provided that the reasons which were not previously existing at the time of the decision of the registration shall not be considered;
(2) The trademark was obtained by fraudulent manner;

(3) The trademark after its registration in South Sudan, was not used without genuine reasons within consecutive five years, before alleging failure of usage and the court shall decide on the basis of circumstances of the case and on whom the burden of proof is laying, where failure of use of the trademark is alleged;

Chapter IV
Miscellaneous Provisions

28. Application on Service Marks

The provisions of this Bill, shall apply on service marks with respect to services provided in the registration.

29. Conclusiveness of Registration of Trademark

In all legal Proceedings related with registered trademark, the registration of a person and trademark shall be conclusive evidence of correctness of the original registration of the trademark and all subsequent transfers or transactions therewith.

30. Offences and Penalties

(1) Any person who forges the registration of trademark, without registering the trademark in accordance with provisions of this Bill, is guilty of an offence and upon conviction shall be punishable with the fine to be determined by the court on every contravention;

(2) No person shall obtain compensations for any trespass on unregistered trademark in South Sudan;

(3) In case of suit for trespass of any trademark, the court shall consider the trespass case and admit the evidence of branched origins in the trade, with respect to types of goods that the trademark have been registered in its name and any trademark used legally with respect to such goods or by other persons;

(4) The registration of any trademark in accordance with provisions of this Bill, shall not affect any correct usage by any person for his or her name, place of work , name or place of work of his or her predecessors or use of any person for any actual description of the nature, characteristics of his or her goods;

(5) The provisions of this Bill, shall not prejudice the right of any person in instituting suit against another person for prejudicial competition for his or her trade or the right to compensation of damages of that competition;

(6) Any person who, with the purpose of fraud, commits or attempts to commit or assists or abets any other person to commit any of the following acts:-

(a) Uses registered trademark pursuance to provisions of this Bill, by other person or imitates trademark in which goods were registered in its name;

(b) Sells or stores for purposes of sale or with the purpose of selling any goods that carry mark, that its usage is considered to be contravention with provisions of paragraph (a) of this subsection;

(c) Uses registered trademark that has been duly registered in accordance with provisions of this Bill, by any other person for the purpose of advertisement in the media or by any other manner of goods in whose name trademark was registered;

(d) Influences of or sculptures or prints any sign post or construction or sketch or any description for registered trademark duly registered by other person or any imitation that may cause any person other than registered owner of the trademark from benefited therefrom, by the manner that may be considered contravention in accordance with provisions of paragraphs (a), (b) and (c) of this subsection

(e) Binds, wraps, sells or stores with the purpose of sale any goods collected, bound, wrapped or prepared in any form with the intention of making the buyers to believe that they are goods for other producer or that it originated from other source other than its actual source, for the purposes of this paragraph it may not be important for the goods which have been bound, wrapped or collected, to carry or otherwise registered trademark duly registered;

(f) Benefits directly or indirectly from the reference to an unreal source or deceives or imitates to any reference to a source even if the real source is indicated or the reference was to a source accompanied with words such as (type), (quality), (manufacture), (imitation) or other similar words;

(g) Imports any goods that carry trademark which may constitute trespass to a register trademark duly registered or imports goods collected, wrapped, bound or prepared in a form that may be circulated as if the goods are of other producer;

(h) Any person who commits any of the acts, provided under paragraphs (a), (b), (c), (d), (e), (f) and (g) of this subsection, is guilty of an offence and upon conviction shall be punishable with imprisonment for a period not exceeding one year or with a fine to be determined by the court or both.

(7) The competent court that considers contraventions provided under subsection (6) of this section, may order expropriation and destruction of all goods, binding, wrapping circulating and other materials and all equipment for printing, binding, wrapping, circulating or other materials of the mark and other related materials thereof.

31. Competent Court

Any contravention of provisions of this Bill shall be considered before competent high court or any other lower court as may be prescribed under any applicable law.

32. Withhold of Trade Mark

Whenever the registered owner of any trademark became a citizen of a Country with which transactions are prohibited, he or she shall lose all rights in the trademark, and the mark shall be withheld and be submitted to the Minister, who shall be competent to make any proceeding that may be deemed appropriate with respect to such trademarks and in particular he or she may transfer such marks and all accredited rights therein to any other person in accordance with such conditions that may be deemed appropriate.

33. Applicant Resides Abroad

The application of any person, who resides outside South Sudan to the Registrar, with the purpose of transferring any registration or renewal of the trademark or for any other purpose provided under provisions of this Bill, may be submitted by his or her agent.

34. Regulations

(1) The Minister may issue such rules and regulations appropriate and necessary for the efficient and effective implementation of provisions of this Bill;
(2) Notwithstanding the provisions of subsection (1) of this section, the Minister may from time to time may issue such rules or determined their forms or undertake such proceedings that he or she may deem appropriate for:-

(a) Organizing procedures in accordance with provisions of this Bill;
(b) Classifying goods and services with the purpose of registration of trademarks
(c) Determining prescribed fees in accordance with provisions of this Bill
(d) Performing or requesting accredited copies for trademarks and other documents
(e) Guaranteeing, organizing, publishing and selling or distribution of copies of trademarks and other documents in the manner that the Registrar may deem appropriate
(f) Organizing generally registration process with respect to trademarks and matters provided in this Bill under the supervision and control of the Registrar