

International Comparative Legal Guides



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Trade Marks 2021

A practical cross-border insight into trade mark work

10th Edition

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Trade Marks 2021

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Misozi Hope Masengu

1 Relevant Authorities and Legislation

1.1 What is the relevant trade mark authority in your jurisdiction?

The Patents and Companies Registration Agency (“PACRA”) is the relevant trade mark authority in Zambia.

1.2 What is the relevant trade mark legislation in your jurisdiction?

The Trade Marks Act, Chapter 401 of the Laws of Zambia (“TMA”), the attendant Trade Marks Regulations; and the Merchandise Marks Act, Chapter 405 of the Laws of Zambia.

2 Application for a Trade Mark

2.1 What can be registered as a trade mark?

A trade mark is registrable under the TMA, if it contains or consists of at least one of the following essential particulars:

- A name of a company, individual or firm, represented in a special or particular manner.
- The signature of the applicant for registration or some predecessor in the applicant’s business.
- An invented word or words.
- A word or words having no direct reference to the character or quality of the goods.
- A word or words not being (according to its original signification), a geographical name or a surname.
- Any other distinctive mark, including a device, brand, heading, label, ticket, name, signature, word, letter, numeral or combination.

2.2 What cannot be registered as a trade mark?

Under the TMA, the following cannot be registered as trade marks:

- All marks which do not comply with the requirements listed in question 2.1 above.
- A mark which is either identical to or nearly resembles an already existing registered trade mark in respect of the same goods or description of goods, as to be likely to deceive or cause confusion (*NR Investments Limited vs. Tiger Foods Brands Intellectual Property Holdings Limited* [2015/ ZMHC 116]).

- A mark which would be disentitled to protection in a court of justice.
- A mark which would be contrary to law or morality.
- A scandalous design.
- Service marks.
- A mark with the words “Patent”, “Patented”, “Registered”, “Registered Design”, “Copyright”, “To counterfeit this is a forgery” or words to the like effect.
- Representations of the Armorial Ensigns of Zambia or similar devices.
- Representations of the national flag of Zambia.
- Representations of the President, or any colourable imitations thereof.

2.3 What information is needed to register a trade mark?

In order to register a trade mark, the following information is required:

- A representation of the trade mark to be affixed on the prescribed application form. If the trade mark is a device, logo or label, it may be displayed on a separate material and attached to the form.
- The specific class and description of the goods for which an applicant uses or intends to use the mark.
- Where priority of the trade mark is claimed by the applicant on the basis of an application having been made in a Convention country, the applicant is required to specify the date of such application and provide proof of registration in the Convention country.
- Where the proposed trade mark contains a word or words in characters other than Roman, or in a language other than English, a transliteration and/or translation should be provided.
- Full name, address, description and nationality of the individual, firm or body corporate making the application and details of the trade mark agent (if applicable).

2.4 What is the general procedure for trade mark registration?

The registration of a trade mark is made by an application in the prescribed form and filed with the PACRA for approval by the Registrar, together with the prescribed fees. Thereafter, applicants are issued a Lodgement Certificate to track the progress of their application(s). Upon examination of the application, the Registrar may either accept absolutely, refuse it or give conditional acceptance. In the case of refusal or conditional

acceptance, the Registrar is obliged (if required by the applicant) to state in writing, the grounds of the decision, and the applicant is at liberty to request for a hearing or respond to the refusal/conditional acceptance in writing within two months of the Registrar's decision. The decision is appealable to the High Court.

If the application is accepted, a Notice of Acceptance will be issued by the PACRA and the applicant will be required to immediately advertise the trade mark in the Industrial Property Journal for two months. If the application is unopposed within the prescribed period, the Registrar will register the trade mark and issue a certificate of registration. If the application is opposed, the Registrar will give the parties a hearing to hear the evidence of either party and to determine whether the opposition has merit. In the event that the opposition does not succeed, the Registrar will register the trade mark and issue the applicant with a certificate of registration. The registration process must be completed within a period of 12 months. If the opposition succeeds, the application may be refused.

2.5 How is a trade mark adequately represented?

A trade mark is adequately represented by the affixation of the mark to the prescribed application form or any other approved material. In every case, six additional representations of the mark must be filed together with the application. In the case of word marks represented in plain letters, the word should be printed or stencilled in letters of not less than 3/8 inch in size. The representations must be of durable nature and the mark must be distinctive.

2.6 How are goods and services described?

In accordance with the International (Nice) Classification of Goods and Services for the Purposes of Registration of Marks. The description of goods in the class in which protection is sought must be specific and limited to the goods in that particular class. A proprietor may claim all the goods in one class. The TMA, however, does not provide for the registration or protection of service marks. Parties, therefore, can only claim protection in relation to goods associated with a service (*Celitel Zambia Plc vs. Star Search Agency Ltd, Trademark Opposition No. 53-54/2007 STAR SEARCH*).

2.7 To the extent 'exotic' or unusual trade marks can be filed in your jurisdiction, are there any special measures required to file them with the relevant trade mark authority?

Generally, the TMA does not provide for the registration or protection of "exotic" or unusual marks. The registration of service marks in particular is not provided and a proprietor can only claim protection in relation to goods associated with a service. Where a trade mark claims colour limitations, the TMA provides that the colour(s) must be specifically stated or described.

2.8 Is proof of use required for trade mark registrations and/or renewal purposes?

Proof of prior or current use is not required, unless a proprietor is seeking the registration of a trade mark which is identical or nearly resembles another registered trade mark in respect of the same goods or description of goods.

Proof of prior use is not a requirement for renewal purposes.

However, the law provides that an aggrieved party may make an application to the High Court or to the Registrar for the removal of a trade mark from the Trade Mark's Register for lack of *bona fide* use of the trade mark in relation to the goods in respect of which registration was obtained.

2.9 What territories (including dependents, colonies, etc.) are or can be covered by a trade mark in your jurisdiction?

A trade mark registered in Zambia covers Zambia only.

2.10 Who can own a trade mark in your jurisdiction?

A trade mark can be owned by a natural or legal person.

2.11 Can a trade mark acquire distinctive character through use?

Yes, however, evidence of use must be adduced to the PACRA Registrar. The evidence required must be adduced by affidavit or otherwise and should point to actual commercial use of the trade mark. Evidence of use may also relate to market share held by the trade mark; and how intensive, geographically widespread and long-standing the use of the mark has been.

2.12 How long on average does registration take?

An average of six to eight months if there is no opposition to the registration of the trade mark.

2.13 What is the average cost of obtaining a trade mark in your jurisdiction?

The average cost of obtaining a trade mark for a local applicant is USD100, and USD240 for a foreign applicant.

2.14 Is there more than one route to obtaining a registration in your jurisdiction?

Yes, through the Madrid Protocol System designating Zambia. However, such applications are subject to the examination criteria established under the TMA (*Sigma – Tau Industrie Farmaceutiche Riunite vs. Amina Limited, Trade mark Opposition No.767/2015 Betasol*).

2.15 Is a Power of Attorney needed?

Yes, where the applicant acts through a trade mark agent.

2.16 If so, does a Power of Attorney require notarisation and/or legalisation?

No, a signature is sufficient.

2.17 How is priority claimed?

The TMA provides that any person can claim priority provided the application to register is made within six months from the

date of the application for protection in the Convention country. The applicant is required to specify on the application the date of such application in the Convention country, and to furnish the PACRA Registrar with a certificate verified by the registrar or registering authority of the Convention country. Alternatively, the applicant may verify the application made or deemed to have been made subject to the approval of the Registrar.

2.18 Does your jurisdiction recognise Collective or Certification marks?

The law recognises both certification marks and collective marks.

3 Absolute Grounds for Refusal

3.1 What are the absolute grounds for refusal of registration?

The main absolute grounds for refusal include:

- The mark is not distinct or is generic (*Phillip Morris Products SA vs. British American Tobacco, Trademark Opposition No. 152/2010 BULL'S EYE*).
- The mark is a word(s) having a direct reference to the character or quality of the goods.
- The mark is (according to its ordinary signification) a geographical name or surname (*Yoyo Foods Ltd vs. Eustace Spaita Bobo, Trademark Opposition No. 65/2009 BOBO Beef*).
- The mark is contrary to law or morality.
- The mark is a scandalous sign.

3.2 What are the ways to overcome an absolute grounds objection?

Absolute grounds of objection may be overcome as follows;

- amending or modifying the proposed trade mark in accordance with the TMA and/or directions of the Registrar;
- an application for registration of a trade mark in Part A of the register (other than certification marks) may be treated as an application under Part B of the register, if the applicant consents;
- the applicant may file a written response to the decision of the registrar, containing submissions, arguments and evidence demonstrating how the proposed trade mark is in line with the requirements of the TMA;
- the applicant may adduce evidence to the PACRA Registrar that the trade mark has acquired distinctiveness through use; and
- the applicant may appeal against the decision of the PACRA Registrar to the High Court.

3.3 What is the right of appeal from a decision of refusal of registration from the Intellectual Property Office?

The decision of the PACRA Registrar may be appealed to the High Court on a point of law or fact or mixed law and fact.

3.4 What is the route of appeal?

An appeal from the decision of the Registrar is made to the High Court. An appeal from the High Court lies with the Court of Appeal. An appeal can be made from the Court of Appeal to the Supreme Court with leave and on specific grounds.

4 Relative Grounds for Refusal

4.1 What are the relative grounds for refusal of registration?

That the trade mark is either identical to or nearly resembles an already existing registered trade mark in respect of the same goods or description of goods, as to be likely to deceive or cause confusion.

4.2 Are there ways to overcome a relative grounds objection?

Relative grounds of refusal may be overcome as follows:

- The applicant may file submissions, arguments and evidence demonstrating how the proposed trade mark is in line with the requirements of the TMA.
- The applicant may claim honest concurrent use of the trade mark alongside the registered proprietor's trade mark and adduce evidence to the PACRA Registrar to demonstrate such use.
- The applicant may agree with the registered proprietor to have the trade marks co-exist in the market subject to applicable conditions.
- Where the applicant's mark is opposed based on section 17(1) of the TMA and it is discovered by the applicant that the opponent's registered mark has in fact not been in use for five years preceding such discovery, the applicant may also choose to begin an expungement process of such trade mark.
- The applicant may appeal against the decision of the PACRA Registrar to the High Court.

4.3 What is the right of appeal from a decision of refusal of registration from the Intellectual Property Office?

The decision of the PACRA Registrar may be appealed to the High Court on a point of law or fact or mixed law and fact.

4.4 What is the route of appeal?

An appeal from the decision of the Registrar is made to the High Court. An appeal from the High Court lies with the Court of Appeal. An appeal can be made from the Court of Appeal to the Supreme Court with leave and on specific grounds.

5 Opposition

5.1 On what grounds can a trade mark be opposed?

The absolute grounds are listed in question 3.1 above and the relative ground(s) in question 4.1 above.

5.2 Who can oppose the registration of a trade mark in your jurisdiction?

A trade mark may be opposed by any person with an interest or who may be affected by the registration of the trade mark. An important point to note is that under Zambian law, protection is only afforded to registered marks regardless of how well known a mark is. Therefore, only a registered proprietor of a trade mark

can successfully oppose the registration of a trade mark which is identical or similar and is likely to cause confusion. (*DH Brothers Industries (PTY) Ltd vs. Olivine Industries (2012) ZR 34.*)

5.3 What is the procedure for opposition?

The procedure for opposition begins by filing a Notice of Opposition with the PACRA within two months from the date of the advertisement for registration of the trade mark, in the Trademarks Journal. The said Notice must be accompanied by a statement of the grounds of opposition. The Registrar thereafter makes the Notice available to the applicant, who will be required to file a counter-statement within two months from receipt of the Opposition. It is important to note that failure to file a counter-statement will result in the application for registration being declared abandoned. Once the said documents are filed, the parties are required to file evidence in the form of affidavits or solemn declarations and the Registrar will then set a date to hear the arguments of both parties. Upon considering the evidence, the Registrar will decide whether (and subject to what conditions if any) the registration of the trade mark is to be permitted. The decision of the Registrar may be subject to appeal to the High Court.

6 Registration

6.1 What happens when a trade mark is granted registration?

When a trade mark is registered, the Registrar issues the applicant with a certificate of registration and the trade mark is entered on the Register.

6.2 From which date following application do an applicant's trade mark rights commence?

An applicant's trade marks rights commence from the date of registration, which is the date of the application of the trade mark.

6.3 What is the term of a trade mark?

A trade mark is initially valid for a term of seven years and after renewal, for a term of 14 years from the date of expiration.

6.4 How is a trade mark renewed?

To renew a trade mark, the registered proprietor must file the prescribed renewal form and pay the prescribed fees, not more than six months before expiration of the last registration. However, the renewal process is Registrar-driven and the TMA requires the Registrar to issue notices before the expiration of the last registration of the trade mark, if the prescribed fees have not been paid by the proprietor. At the date of expiration, if the renewal fees still remain outstanding, the Registrar is obligated to advertise this fact in the Trademarks Journal. The trade mark may only be removed from the register after one month from the date of advertisement in the Trademarks Journal. It is worth noting that failure by the Registrar to take the steps under the TMA before the removal of a trade mark will be considered a dereliction of duty and ultravires the TMA, thereby rendering the removal null and void (*Societies Des Produits Nestle SA vs. Kingdom Investments Ltd [2011] ZMHC 10*).

7 Registrable Transactions

7.1 Can an individual register the assignment of a trade mark?

Yes, this is done by application to the Registrar in the prescribed form, accompanied by the assignment.

7.2 Are there different types of assignment?

Yes, an assignment can be in respect of all or merely some of the goods for which the trade mark is registered.

7.3 Can an individual register the licensing of a trade mark?

Yes, a licence may be registered with or without conditions or restrictions. The application is made by the registered proprietor and the proposed registered user, to the Registrar in the prescribed manner, accompanied by an affidavit or a solemn declaration made by the proprietor. The following information must be provided in the application:

- Particulars of the relationship existing between the proprietor and the proposed registered user.
- The goods in respect of which registration is proposed.
- Any conditions or restrictions.
- Whether the permitted use is to be for a specified period or without limit.

7.4 Are there different types of licence?

Yes, licences may be exclusive or non-exclusive. Licences may also be for a specified duration or without limit.

7.5 Can a trade mark licensee sue for infringement?

Yes, depending on the agreement between the parties. The TMA generally provides that a licensee/registered user may be entitled to sue after requesting the registered proprietor to sue for infringement and the proprietor refuses or neglects to do so within two months after being so called upon. In this case, the registered user may sue for infringement in his own name as if he were the proprietor, making the proprietor a defendant. The proprietor so added as a defendant shall not be liable for any costs unless he enters an appearance and takes part in the proceedings.

7.6 Are quality control clauses necessary in a licence?

Yes, the parties are at liberty to agree upon such clauses in the agreement.

7.7 Can an individual register a security interest under a trade mark?

The TMA does not provide for this. However, a security interest may be registered pursuant to the Movable Property (Security Interest) Act No. 3 of 2016, this is done by the creation and subsequent registration of a security agreement relating to the said trade mark at the collateral registry.

7.8 Are there different types of security interest?

Yes, a security interest may be fixed, floating or there may be other charges.

8 Revocation

8.1 What are the grounds for revocation of a trade mark?

The registration of a trade mark can be revoked on any of the following grounds:

- Failure to renew registration on the basis of non-compliance with the renewal conditions or requirements.
- Where the registered trade mark has not been in use for the period of five years.
- If the registered trade mark was registered fraudulently.
- Where there is failure to observe registration, conditions prescribed by the Registrar.

8.2 What is the procedure for revocation of a trade mark?

To revoke a trade mark, an application is filed with the PACRA in the prescribed form. Alternatively, an application may be made directly to the High Court. The application must be accompanied by a statement setting out the nature of the applicant's interest, the facts upon which the applicant bases their case and the relief sought. Where the application is made by a person who is not the registered proprietor of the trade mark in question, the application must be accompanied by a copy of the application and a copy of the statement. The application is thereafter, transmitted to the registered proprietor of the trade mark who will be required to file a counter-statement. The parties are then required to file evidence in the form of affidavits or solemn declarations and thereafter, the Registrar will set a date to hear the arguments of both parties. Upon considering the evidence, the Registrar will decide whether or not the trade mark should be revoked. The decision of the Registrar may be subject to appeal at the High Court.

8.3 Who can commence revocation proceedings?

Any legal or natural person who is aggrieved or has sufficient interest. The Registrar may also commence revocation proceedings to the High Court, in the case of fraud in the registration, assignment or transmission of a registered trade mark.

8.4 What grounds of defence can be raised to a revocation action?

The registered proprietor of the trade mark may demonstrate *bona fide* use of the trade mark, or that the non-use of the trade mark was due to special circumstances in the trade or in the market. The proprietor may also prove that there was no fraud in the registration of the trade mark.

8.5 What is the route of appeal from a decision of revocation?

See question 3.4 above.

9 Invalidity

9.1 What are the grounds for invalidity of a trade mark?

Where the trade mark was registered by fraud or in breach of the absolute grounds of refusal as set out in question 3.1 above.

9.2 What is the procedure for invalidation of a trade mark?

See question 8.2 above.

9.3 Who can commence invalidation proceedings?

See question 8.3 above.

9.4 What grounds of defence can be raised to an invalidation action?

The defences that may be raised will vary depending on the grounds for invalidation advanced by the applicant.

- Where an application is made on the basis that a registered trade mark be invalidated for lack of distinctiveness, a defence may be that the trade mark has acquired distinctiveness through use and adduce evidence of such use.
- Where an application is made on the ground that the registered trade mark is identical and resembles a trade mark registered earlier, a defence may be raised that there is no likelihood of confusion.
- The registered proprietor may file submissions to the Registrar of the PACRA, containing arguments and evidence demonstrating how the proposed trade mark complies with the requirements of the TMA.

9.5 What is the route of appeal from a decision of invalidity?

An appeal from the decision of the Registrar is made to the High Court. An appeal from the High Court lies with the Court of Appeal. An appeal can be made from the Court of Appeal to the Supreme Court with leave and on specific grounds.

10 Trade Mark Enforcement

10.1 How and before what tribunals can a trade mark be enforced against an infringer?

The registered owner of a trade mark may commence legal proceedings for infringement in the High Court, by way of a Writ of Summons and Statement of Claim.

10.2 What are the key pre-trial procedural stages and how long does it generally take for proceedings to reach trial from commencement?

The legal proceedings may be commenced before the principal or commercial registry of the High Court. Where the matter is commenced by Writ of Summons, parties will be required at the commencement of the matter to file a list and description of documents to be relied on at trial, list of Witnesses to be called at trial and in the case of the Plaintiff, an acknowledged

letter of demand or Affidavit of service. The parties will then be issued with orders for directions. A scheduling conference is also required in order for the court and the litigants to, *inter alia*, determine the real issues in dispute, settle or strike out admitted or frivolous claims or documents and set a date for trial of the matter. There is an additional requirement in the commercial registry to file skeleton arguments and List of Authorities in support of a claim and in opposition. The matter will then be set down for trial. Generally, it may take three to four months for proceedings to reach the trial stage, depending on the registry involved, the parties and the interim reliefs sought.

10.3 Are (i) preliminary, and (ii) final injunctions available and if so on what basis in each case?

Both preliminary and final injunctions are available and may be granted in cases where:

- There is a *prima facie* case, i.e. a serious question to be tried which has real prospects of success.
- The applicant is likely to suffer irreparable injury which cannot be atoned for in damages.
- The balance of convenience lies in favour of granting the injunction.

10.4 Can a party be compelled to provide disclosure of relevant documents or materials to its adversary and if so how?

Yes, by way of a Notice to Produce in accordance with the rules of court.

10.5 Are submissions or evidence presented in writing or orally and is there any potential for cross-examination of witnesses?

Submissions and evidence are generally presented in writing but may be augmented by oral arguments. Witnesses may be cross-examined.

10.6 Can infringement proceedings be stayed pending resolution of validity in another court or the Intellectual Property Office?

Yes. The proceedings may also be consolidated if they are both before the High Court.

10.7 After what period is a claim for trade mark infringement time-barred?

The TMA does not provide a time-bar for infringement claims.

10.8 Are there criminal liabilities for trade mark infringement?

The TMA provides for criminal liability for the following offences:

- Submission of false information to the Registrar for purposes of deceiving the Registrar.
- Making false entries in the register of trade marks.
- Falsely representing a trade mark as registered or registered in respect of certain goods (*Yoyo Foods* case, cited in question 3.1 above).
- Giving false evidence.

The TMA provides that any person found guilty of these offences may be liable to a fine or imprisonment not exceeding three years, or both.

10.9 If so, who can pursue a criminal prosecution?

The Zambia Police (Intellectual Property Unit) is responsible for prosecutions relating to trade mark infringement.

10.10 What, if any, are the provisions for unauthorised threats of trade mark infringement?

The TMA does not provide for unauthorised threats of trade mark infringement.

11 Defences to Infringement

11.1 What grounds of defence can be raised by way of non-infringement to a claim of trade mark infringement?

The following defences may be raised in a claim for trade mark infringement:

- The trade mark is not identical or similar to the registered trade mark in respect of the same goods or description of goods.
- The use of the trade mark is not likely to deceive or cause confusion.
- The claimant's trade mark was invalidly registered.
- The trade mark has been previously registered on the basis of honest concurrent use with the claimant's registered trade mark.
- The proprietor of the trade mark has consented to the use of the trade mark.

11.2 What grounds of defence can be raised in addition to non-infringement?

The proprietor of the trade mark has consented to the use of the trade mark, either expressly or impliedly.

12 Relief

12.1 What remedies are available for trade mark infringement?

The following remedies are available:

- Injunctions (interdict).
- Damages.
- An account of profits.
- Delivery up and/or destruction of the offending materials (*Trade Kings Limited vs. Unilever PLC Cheesebrough Ltd and Others SCZ/2/2000*).
- Removal of the offending trade mark from the trade mark register if it was invalidly registered.
- Criminal sanctions such as payment of a fine or imprisonment or both.

12.2 Are costs recoverable from the losing party and, if so, how are they determined and what proportion of the costs can usually be recovered?

Costs are awarded to the successful party at the court's discretion and taxed in default of agreement. All legal costs are recoverable, including expenses.

13 Appeal

13.1 What is the right of appeal from a first instance judgment and is it only on a point of law?

Any first instance judgment is appealable. The appeal may be on a point of law, fact or a combination of law and fact.

13.2 In what circumstances can new evidence be added at the appeal stage?

Leave to adduce new evidence may be granted at the appeal stage where a party successfully claims that the evidence came to its knowledge after passing of judgment. The court may also grant leave if it is in the furtherance of justice.

14 Border Control Measures

14.1 Is there a mechanism for seizing or preventing the importation of infringing goods or services and, if so, how quickly are such measures resolved?

The Merchandise Marks Act expressly prohibits the importation of any goods bearing a forged trade mark or false trade description or any goods bearing a trade mark or mark closely resembling a trade mark so as to likely be deceptive. The Zambia Police (Intellectual Property Unit), the Zambia Revenue Authority and the Zambia Bureau of Standards are all mandated by law to prevent importation of such goods, as well as to seize them and in some cases arrest and prosecute offenders.

15 Other Related Rights

15.1 To what extent are unregistered trade mark rights enforceable in your jurisdiction?

The TMA does not accord any protection to unregistered trade marks in relation to both infringement and opposition proceedings. Unregistered trade marks are protected only under the tort of passing off (*Trade Kings vs. Unilever* case cited in question 12.1 above).

15.2 To what extent does a company name offer protection from use by a third party?

The registration of a company name as a trade mark, in addition to registration as a company name, gives exclusive rights to its use as a trade mark. However, the mere registration of a company name does not give exclusive rights to use of the name as a trade mark. A third party will not be prevented from registering the company name as a trade mark, and the registered company would have no legal basis to prevent such registration (*Celtel vs. Star Search*, cited in question 2.6 above). There is no statutory protection in Zambia for all kinds of unregistered trade marks, including well known marks.

In relation to the use of a confusingly similar company name by a third party however, the Zambia Companies Act does offer some protection. The Registrar will not approve a proposed company name which he/she believes may cause confusion in respect of another name or trade mark of a registered company or a well-known name or trade mark.

15.3 Are there any other rights that confer IP protection, for instance book title and film title rights?

No, there are no other rights that confer IP protection.

16 Domain Names

16.1 Who can own a domain name?

A domain name can be owned by any natural or legal person.

16.2 How is a domain name registered?

A domain name is registered through an Internet Service Provider (“ISP”). ISPs are licensed to register domain names by the Zambia Information and Communications Technology Authority (“ZICTA”). The application is submitted to the ISP and depending on the availability of the domain name, it will be registered. Annual renewal fees are also payable.

16.3 What protection does a domain name afford *per se*?

Once a domain name has been registered, a similar domain name cannot be registered if there is a likelihood that it will cause confusion.

16.4 What types of country code top level domain names (ccTLDs) are available in your jurisdiction?

The primary top-level domain name in Zambia is “.zm”. There are, however, 11 second-level types of domain names, such as: “.gov.zm”; “.mil.zm”; “.sc.zm”; “.net.zm”; “.sch.zm”; “.blz.zm”; “.org.zm”; “.com.zm”; “.co.zm”; “.info.zm”; and “.edu.zm”.

16.5 Are there any dispute resolution procedures for ccTLDs in your jurisdiction and if so, who is responsible for these procedures?

Any dispute concerning a ccTLD is to be determined in accordance with the Zambia Arbitration Act, No. 19 of 2000. This is provided by the Electronic Communications and Transactions Act 2009 of the Laws of Zambia).

17 Current Developments

17.1 What have been the significant developments in relation to trade marks in the last year?

The trade marks registry at the PACRA has recorded an increase in the number of trade mark registrations and corresponding opposition proceedings.

17.2 Please list three important judgments in the trade marks and brands sphere that have been issued within the last 18 months.

1. *National Brands Limited vs. Yoyo Foods Limited (2020)*. In this matter, the PACRA Registrar held that to prove honest concurrent use, one must adduce evidence showing use of the trade mark within Zambia. Furthermore, the Registrar

held that the duration of use must be long enough to secure a commercial advantage. Leave to appeal was granted.

2. *Britania vs. Britannia (2020)* the PACRA Registrar held that section 16 of the Trade Marks Act is a general provision that can be relied upon by members of the public where there is likely to be confusion between trade marks and is not limited to the requirement that one of the marks must already be registered. Nonetheless, the applicant must provide evidence of the probable confusion amongst the members of the public. The Registrar further addressed the application of section 17 (1) and upheld the decision of the court in the *DH Brothers* case that an unregistered mark cannot be afforded protection under the TMA.
3. *Bidvest Food Zambia Limited and 5 Others v CAA Import and Export Limited (2020)* the Supreme Court held that a distributor retains goodwill in his or her own business, but not in the supplier's goods or business and therefore, a distributor has no entitlement to goodwill compensation upon termination of a distributorship agreement, whether at common law or under legislation, unless it is expressly provided for in the agreement. However, if the agreement is terminated in breach of its express or implied terms, or, in the absence of proper notice, the distributor may be entitled to damages for breach of contract.

17.3 Are there any significant developments expected in the next year?

A new TMA may be enacted which is expected to provide for service marks, non-traditional marks and geographical indications. The Act is expected to incorporate the offences provided under the Merchandise Marks Act and this will, therefore, see the repeal of that Act and the creation of an all-encompassing TMA.

17.4 Are there any general practice or enforcement trends that have become apparent in your jurisdiction over the last year or so?

There has been an increase in criminal enforcement, rather than private or civil enforcement for trade mark infringement. The bulk of the cases were commenced under the Merchandise Marks Act which provides criminal sanctions for the offences committed rather than civil sanctions.



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