

**AN ANALYSIS OF THE PROPOSED AMENDMENTS OF THE  
TRADEMARKS REGIME IN ZAMBIA**

**BY**

**SUNDUZWAYO ZIMBA**

**UNZA**

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**AN ANALYSIS OF THE PROPOSED AMENDMENTS OF THE  
TRADEMARKS REGIME IN ZAMBIA**

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**SUNDUZWAYO ZIMBA**

**A DISSERTATION SUBMITTED TO THE UNIVERSITY OF  
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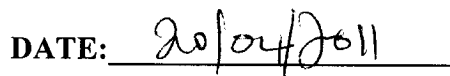
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## ABSTRACT

The absence of substantial review since it was inherited from the colonial government at independence in 1964, the Zambian Intellectual Property regime is largely outdated and falls far short of the minimum standards stipulated in the World Trade Organizations (WTO)' Agreement on Trade Related Aspects of Intellectual Property Rights (hereinafter called 'the TRIPS Agreement'). Apparently, Zambia and other Least Developed Countries (LDC5) have until 2013 to domesticate general provisions of the TRIPS Agreement and those relating to pharmaceuticals by 2016.

Trademarks are currently registered in connection with goods only. Under the current law, the Trade Marks Act Cap 401 protects trademarks only for goods and is administered by the Patents and Companies Registration Agency (PACRA) formerly Patents and Companies Registration Office (PACRO). The Act does not provide for the protection of service marks and other types of traditional and acceptable non-traditional marks. In terms of international obligations in the field of trademarks, Zambia acceded to the Madrid Protocol on the International Registration of Marks (hereinafter referred to as 'the Madrid Protocol') but has not amended its municipal law to recognize and provide for such marks. The Trade Marks Act, which provides for protection only for goods will require amendments in order to comply with the Madrid Protocol and the TRIPS Agreement.

The Trade Marks Act in its current form contains a number of provisions which are incompatible with the TRIPS Agreement and therefore needs to be revised to ensure compliance with the TRIPS Agreement. The relevant legislation dates back several decades and therefore neither reflects recent development in the field of industrial property nor ensure compliance with TRIPS obligations. Trademarks play a very important role in helping consumers distinguish a product or service from one source from those produced by another source. These products or services affect the public at large. It is therefore important that there is in place a trademark regime that will take into

account the Madrid Protocol and TRIPS Agreement as well as encompass the new trends in the field of intellectual property.

It is my sincere hope that this paper will significantly contribute to addressing some of the current problems inherent in the field of trademarks.

## **ACKNOWLEDGEMENTS**

My sincere heartfelt appreciation to my wife Nancy and my children for the role they played in inspiring me to accomplish this worthwhile work.

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Lastly but of course not the least, am indebted to my friends and relatives who gave me support in one way or the other, including standing in the gap for me the times I could not be around for my family.



## **DEDICATION**

This work is dedicated to my late parents Mr and Mrs Laison Ephraim Zimba, whom I shall always thank for bringing me to mother earth. To my wife Nancy and my children Thandiwe, Sunduzwayo Jr., Sibongile, Henry, Mwiza and Zikhalo, for their unwavering support, unconditional love and understanding through this academic journey.

**ACRONYMS**

|              |  |
|--------------|--|
| <b>ARIPO</b> | African Regional Intellectual Property Organisation                          |
| <b>ACP</b>   | African, Caribbean and Pacific Group of States                               |
| <b>EDF</b>   | European Development Fund  |
| <b>IIAS</b>  | International Institute for Advanced Studies                                 |
| <b>IP</b>    | Intellectual Property or Industrial Property                                 |
| <b>IPO</b>   | Industrial Property Office   |
| <b>IPRs</b>  | Intellectual Property Rights   |
| <b>LDCs</b>  | Least Developed Countries  |
| <b>MCTI</b>  | Ministry of Commerce, Trade and Industry                                     |
| <b>OCTs</b>  | Overseas Countries and Territories   |
| <b>OHIM</b>  | Office for the Harmonisation of the Internal Market of the<br>European Union |
| <b>PACRA</b> | Patents and Companies Registration Agency                                    |
| <b>PACRO</b> | Patents and Companies Registration Office                                    |
| <b>TRIPS</b> | Agreement on Trade Related Aspects of Intellectual Property<br>Rights        |
| <b>UNZA</b>  | University of Zambia   |
| <b>WIPO</b>  | World Intellectual Property Organisation                                     |
| <b>WTO</b>   | World Trade Organisation   |

## **LIST OF STATUTES**

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 The Patents and Companies Registration Agency Act No. 15 of 2010  
 The Australian Trade Marks Act 1995 (Consolidated as of 14<sup>th</sup> January, 2011)  
 The British Trade Marks Act, Chapter 26, 1994  
 The English Law (Extent of Application) Act, Cap 11  
 The Kenyan Trade Marks Act (Cap 506) (As amended by the Trade Marks Amendment Act, 2002)  
 The South African Trade Marks Act No. 194 of 1993  
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The Banjul Protocol on Marks  
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 The Trade Related Aspects of Intellectual Property Rights (TRIPS Agreement)

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## **CHAPTER ONE**

### **BACKGROUND AND RATIONALE OF TRADEMARKS**

#### **1.0 INTRODUCTION**

The purpose of this study is to analyze the proposed amendments to the current trademark regime in order to determine whether they will be more effective than the current piece of legislation. It is hoped that the analysis will provide an overview of the effectiveness of the proposed amendment taking into account the Madrid Protocol<sup>1</sup>, TRIPS Agreement<sup>2</sup> and recent developments in the field of trademarks.

#### **1.1 BACKGROUND AND RATIONALE OF TRADEMARKS**

Trademarks existed in the ancient world. Even at times when people either prepared what they needed themselves or, more usually, acquired it from local craftsmen, there were already creative entrepreneurs who marketed their goods beyond their localities and sometimes over considerable distances. As long as 3,000 years ago, Indian craftsmen used to engrave their signatures on their artistic creations before sending them to Iran. Manufacturers from China sold goods bearing their marks in the Mediterranean area over 2,000 years ago and at one time about a thousand different Roman pottery marks were in use, including the FORTIS brand, which became so famous that it was copied and counterfeited<sup>3</sup>. With the flourishing trade of the Middle Ages, the use of signs to distinguish the goods of merchants and manufacturers likewise expanded several hundred years ago. Their economic importance was still limited, however<sup>4</sup>.

Trademarks started to play an important role with industrialization, and they have since become a key factor in the modern world of international trade and market-oriented economies. Industrialization and the growth of the system of the market-oriented economy allow competing manufacturers and traders to offer consumers a variety of goods in the same category. Often

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<sup>1</sup> The Madrid Protocol on the International Registration of Marks, adopted in 1989

<sup>2</sup> The TRIPS Agreement, annex 1C of the Marrakesh Agreement Establishing the World Trade Organization, signed in Marrakesh, Morocco on 15 April 1994.

<sup>3</sup> WIPO Intellectual Property Handbook: Policy, Law and Use; WIPO Publication 2004 No. 489 (E) 2<sup>nd</sup> Edition, reprinted 2008, p. 67

<sup>4</sup> WIPO Intellectual Property Handbook: Policy, Law and Use. P.67



without any apparent differences for the consumer, they do generally differ in quality, price and characteristics. Clearly consumers need to be given the guidance that will allow them to consider the alternatives and make their choice between the competing goods. Consequently, the goods must be named. The medium for naming goods on the market is precisely the trademark.<sup>5</sup>

By enabling consumers to make their choice between the various goods available on the market, trademarks encourage their owners to maintain and improve the quality of the products sold under the trademark, in order to meet consumer expectations. Thus trademarks reward the manufacturer who constantly produces high-quality goods, and as a result they stimulate economic progress.<sup>6</sup>

A trademark is any sign that is capable of distinguishing the goods or services produced or provided by one enterprise from those of other enterprises<sup>7</sup>. For instance, various companies in Zambia produce bottled mineral water. What enables the consumer to distinguish water bottled for example, by company A, from that bottled by company B, is the sign, marking, symbol or label attached or fixed on the bottles in which the water is packed.

In general, it may be said that a trademark performs four main functions. These functions relate to the distinguishing of marked goods or services, their origin, their quality and their promotion in the marketing place<sup>8</sup>.

The first function of trademarks is to distinguish the products or services of an enterprise from products or services of other enterprises. Trademarks facilitate the choice to be made by the consumer when buying certain products or making use of certain services. The trademark helps the consumer to identify a product or service which was already known to him or which was advertised. In view of the fact that a trademark has the function of distinguishing, only distinctive signs are capable of serving as trademarks, and the main purpose of protecting

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<sup>5</sup> WIPO Intellectual Property Handbook: Policy, Law and Use. p. 68

<sup>6</sup> WIPO Intellectual Property Handbook: Policy, Law and Use. p. 68

<sup>7</sup> G M Kanja, Intellectual Property Law: UNZA Press, Lusaka, 2006. p. 327

<sup>8</sup> WIPO World wide Academy: Collection of Documents on Intellectual Property, 2001. p.10

trademarks is to ensure that only distinctive signs are used and that confusion among trademarks is prevented.<sup>9</sup>

The second function of a trademark is to refer to a particular enterprise which offers the products or services on the market, i.e., give an indication as to the origin of the goods or services for which the mark is used. Trademarks do not only or not always distinguish products or services as such. They distinguish them in their relationship to a particular enterprise, namely, the enterprise from which the products or services originate. Thus trademarks distinguish products or services from one source, from identical or similar products or services from other sources, namely, the various enterprises which offer such products or services. This function is important in the definition of the scope of protection of trademarks. The decisive test for that protection is whether the average consumer, in view of identical or similar trademarks relating to products or services of the same kind or of similar kinds, may believe that those products or services originate from one and the same enterprise.<sup>10</sup>

The third function of trademarks is to refer to a particular quality of the products or services for which the trademark is used. This function is not always recognized. In fact, the quality function of trademarks is one of the most controversial issues of trademark law. The reasons for maintaining that trademarks have the function of referring to a particular quality of the products or services for which they are used may be summarized as follows: a trademark frequently is not used by only one enterprise since the trademark owner may grant licenses to use the trademark to other enterprises; it is accordingly essential that licensees respect the quality standards of the trademark owner. Moreover, trading enterprises often use trademarks for products which they acquire from various sources. Thus, products, although not originating from one and the same enterprise, nevertheless have to correspond to certain common characteristics and quality standards which are applied by the trademark owner. A trademark owner therefore guarantees that only products that correspond to those standards and quality requirements will be offered under the trademark. In such cases, the trademark owner is not responsible for producing the products but rather—and this may be equally important—for selecting those that meet these

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<sup>9</sup> G M Kanja, *Intellectual Property Law*: p. 328

<sup>10</sup> G M Kanja, *Intellectual Property Law*: p. 328

standards and requirements. This argument is supported by the fact that even where the trademark owner is the manufacturer of a particular product, in the manufacturing process parts are frequently used which have not been produced by the trademark owner but which have been selected by him.<sup>11</sup>

The question whether a quality-guarantee function for trademarks is to be recognized has practical significance in connection with trademark licensing. In this connection, it is generally agreed that the licensee must respect certain quality standards set by the trademark owner. A controversial issue arises in respect of the question whether the trademark owner himself may change the quality and, if he does so, what are the consequences with respect to the trademark. Various approaches to solve this question are at present under discussion but there does not yet exist a generally accepted solution.<sup>12</sup>

The fourth and last function of trademarks is to promote the marketing and sale of products and the marketing and rendering of services. This function recently has become more and more important. Trademarks are not only used to distinguish or to refer to a particular enterprise or a particular quality but also to stimulate sales. A trademark which is to fulfill that function must be carefully selected. It must appeal to the consumer, create interest and inspire a feeling of confidence. This is why this function sometimes is called the "appeal function." Trademarks which overemphasize the appeal function may run the risk of being misleading. This is to be kept in mind in the selection of trademarks, for misleading trademarks are excluded from protection.<sup>13</sup>

In modern trade, consumers are confronted not only with a vast choice of goods of all kinds, but also with an increasing variety of services which tend more and more to be offered on a national and even international scale. There is therefore also a need for signs that enable the consumers to distinguish between the different services such as insurance companies, car rental firms,

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<sup>11</sup> G M Kanja, Intellectual Property Law: p. 329

<sup>12</sup> G M Kanja, Intellectual Property Law: p. 329

<sup>13</sup> G M Kanja, Intellectual Property Law: p. 329

airlines, etc. These signs are called service marks, and fulfill essentially the same origin-indicating and distinguishing function for services as trademarks do for goods.<sup>14</sup>

Since service marks are signs that are very similar in nature to trademarks, basically the same criteria can be applied, so service mark protection has sometimes been introduced by a very short amendment to the existing trademark law, simply providing for the application to service marks, *mutatis mutandis*, of the provisions on the protection of trademarks.<sup>15</sup>

Apart from trademarks and service marks, some countries provide for the registration of collective and certification marks which are used to indicate the affiliation of enterprises using the mark or which refer to identification standards met by the products for which the mark is used.<sup>16</sup>

A collective mark may be owned by an association which itself does not use the collective mark but whose members may use the collective mark; the members may use the collective mark if they comply with the requirements fixed in the regulations concerning the use of the collective mark. An enterprise entitled to use the collective mark may in addition also use its own trademark. The Paris Convention contains provision on collective marks in its Article 7*bis*. Those provisions, in particular, ensure that collective marks are to be admitted for registration and protection in countries other than the country where the association owning the collective mark has been established. This means that the fact that the said association has not been established in accordance with the law of the country where protection is sought is no reason for refusing such protection.<sup>17</sup>

A certification mark on the other hand may be defined as a mark used to distinguish goods and services in accordance with defined standards. An important requirement for the registration of a certification mark is the entity which applies for registration is "competent to certify" the products concerned. Thus, the owner of a certification mark must be representative for the products to which the certification mark applies. This is an important safeguard for the protection of the public against misleading practices.<sup>18</sup> The main difference between collective marks and certification marks is that the former may be used only particular enterprises, for

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<sup>14</sup> WIPO Intellectual Property Handbook: Policy, Law and Use. p. 68

<sup>15</sup> WIPO Intellectual Property Handbook: Policy, Law and Use. p. 68

<sup>16</sup> WIPO Intellectual Property Handbook: Policy, Law and Use. p. 69

<sup>17</sup> WIPO Intellectual Property Handbook: Policy, Law and Use. p. 69

<sup>18</sup> WIPO Intellectual Property Handbook: Policy, Law and Use. p. 69

example, members of the association which own the collective mark, while the latter may be used by anybody who complies with the defined standards.

Another category of trademarks are well-known trademarks. This category of protection of marks is provided for under Article *6bis* of the Paris Convention. The effect of Article *6bis* is to extend protection to a trademark that is well-known in a member country even though it is not registered or used in that country. The protection of the well-known trademark results not from its registration, which prevents the registration or use of a conflicting trademark, but from the mere fact that it is well known. Whether a trademark is well known in a member country will be determined by its competent administrative or judicial authorities. A trademark may not have been used in a country, in the sense that goods bearing that trademark have not been sold there, yet that trademark may be well-known in the country because of publicity there or the repercussions in that country of advertising in other countries. The main purpose of this stronger protection is to prevent companies from free-riding on the reputation of a well-known trademark and/or causing damage to its reputation or goodwill.<sup>19</sup>

Enterprises may own and use one, several or many different trademarks to distinguish their goods and services from those of their competitors. However, they also need to distinguish themselves from other enterprises. For that purpose they will adopt a trade name. A commercial name or designation or trade name means the same thing and is the name or designation which identifies the enterprise. Trade names or commercial names have in common with trademarks and service marks that they exercise a distinguishing function. Unlike trademarks and service marks, however, trade names distinguish one enterprise from others, quite independently of the goods or services that the enterprise markets or renders.<sup>20</sup> However, under Article 8 of the Paris Convention, a trade name must be protected without the obligation of filing or registration, whether or not it forms part of a trademark.

Finally, among the commercial designations there is what is known as geographical indications. The TRIPS Agreement in Articles 22 to 24 establishes certain obligations as regards protection

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<sup>19</sup> WIPO World wide Academy: Collection of Documents on Intellectual Property. p.34

<sup>20</sup> WIPO World wide Academy: Collection of Documents on Intellectual Property. p.96

of geographical indications, which are defined therein, for the purpose thereof, as “indications which identify a good as originating in the territory of Member, or a region or locality, where a given quality, reputation or other characteristic of the goods is essentially attributable to its geographical origin.” The notions of “indication of source” and of “appellations of origin” which are used in the Paris Convention, encompass geographical indications as defined in the TRIPS Agreement.<sup>21</sup>

In terms of international obligations in the field of trademarks, Zambia is a member of the Paris Convention<sup>22</sup> which it acceded on April 6, 1965. In relation to trademarks, there are various provisions ranging from Articles 5C to 7*bis* as well as Article 11. These Articles are relevant to trademarks and will be referenced to during the course of the discussion.

Another important treaty concerning trademarks that Zambia is party to is the Madrid Protocol on the International Registration of Marks which it acceded to on November 15, 2001 but has not amended its municipal law to recognize and provide for such marks. The Madrid system, as it is commonly referred, is governed by two treaties: the Madrid Agreement Concerning the International Registration of Marks, which dates from 1891, and the Protocol relating to the Madrid Agreement, which was adopted in 1989, entered into force on December 1, 1995, and came into operation on April 1, 1989. Common Regulations under the Agreement and Protocol also came into force on that last date. The system is administered by the International Bureau of WIPO<sup>23</sup>, which maintains the international register and publishes the gazette on international marks. Any state party to the Paris Convention for the Protection of Industrial Property may become party to the Agreement or the Protocol or both. The objectives of the system are two-fold. Firstly, it facilitates the obtaining of protection for marks (trademarks and service marks). Secondly, since an international registration is equivalent to a bundle of national registrations, the subsequent management of that register is made much easier.<sup>24</sup> In summary, the main advantages for trademark owners consists of simplicity of the international registration system

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<sup>21</sup> WIPO World wide Academy: Collection of Documents on Intellectual Property. p.13

<sup>22</sup> Paris Convention for the Protection of Industrial Property, of 1883 as revised

<sup>23</sup> World Intellectual Property Organization, of 1977

<sup>24</sup> WIPO World wide Academy: Collection of Documents on Intellectual Property. p.71

and financial savings made when obtaining and maintaining the protection of their marks abroad.<sup>25</sup>

International registration is also to the advantage of Trademark Offices. For example, they do not need to examine for compliance with formal requirements, or classify the goods or services, or publish the marks. The individual and other designation fees collected by the International Bureau are transferred to the Contracting Parties in which protection is sought. Furthermore, if the International Registration Service closes its biennial accounts with a profit, the proceeds are divided among the Contracting Parties.

The TRIPS Agreement is another important international instrument which concerns trademarks. Countries that are members of the World Trade Organization (WTO)<sup>26</sup> are parties to the Trade-Related Aspects of Intellectual Property Rights, also known as TRIPS. TRIPS requires of members of WTO to have laws in place that provide for different kinds of IP protection. TRIPS sets minimum standards and members countries are free to impose greater standard as provided for in Article 1.1 of the Agreement. In terms of trademarks, the TRIPS Agreement requires that members of WTO must have legislation in place that provides for trademark protection. Another important aspect of the TRIPS Agreement is that it requires member states to comply with certain provisions of the Paris Convention. This obligation exists irrespective of whether or not the particular state is a member of the Paris Convention. Article 2.1 of TRIPS reads:

“In respect of Parts II, III and IV of this Agreement, Members shall comply with Articles 1 through 12, and Articles 19, of the Paris Convention (1967).”

In addition the Agreement provides for certain basic principles, such as national and most-favoured-nation treatment, and some general rules to ensure that procedural difficulties in acquiring or maintaining IPRs do not nullify the substantive benefits that should flow from the Agreement. The obligations under the Agreement will apply equally to all Member countries, but developing countries will have a longer period to phase them in. Special transition arrangements operate in the situation where a developing country does not presently provide product patent protection in the area of pharmaceuticals.

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<sup>25</sup> Guide to the International Registration of Marks, WIPO Publication No. 455(E), WIPO, 2009, P. A.4

<sup>26</sup> World Trade Organization (WTO), established on 1<sup>st</sup> January, 1995

It is against this background and in line with the maxim *pacta sunt servanda* that Zambia needs to amend its legislation in order to make it more effective and in tandem with the rest of the world. The Trade Marks Act, which provides for protection only for goods will require amendments in order to comply with the Madrid Protocol and the TRIPS Agreement. As can be noted from the above, Zambia is bound by the obligations of the TRIPS Agreement by virtue of it being a member of the World Trade Organization (WTO) and has until 2013 to domesticate general provisions of the TRIPS Agreement.

## **1.2 STATEMENT OF THE PROBLEM**

The Trade Marks Act in its current form contains a number of provisions which are incompatible with the Madrid Protocol and the TRIPS Agreement and therefore needs to be revised to ensure compliance. The relevant legislation dates back several decades and therefore neither reflects recent development in the field of industrial property nor ensure compliance with the Madrid Protocol and the general provisions of the TRIPS obligations which have to be complied with by 2013.

## **1.3 PURPOSE OF STUDY**

The purpose of this study is to analyze the proposed amendments to the Trade Marks Act in order to determine whether they will be more effective than the current piece of legislation. It is hoped that the analysis will provide an overview of the effectiveness of the proposed amendment taking into account the Madrid Protocol, TRIPS Agreement and recent developments in the field of trademarks.

## **1.4 OBJECTIVES**

The Specific objectives of the study are as follows:

1. To highlight the rationale and history of the current trademark regime in Zambia
2. To analyze the proposed amendments to the current Trade Marks Act
3. To examine whether the proposed amendments adequately cover the weaknesses inherent in the current Trade Marks Act
4. Compare the proposed Trade Marks law with the current Trade Marks laws of Britain, Australia, Kenya and South Africa.



5. Attempt to spell out the probable problems that may be raised by the proposed amendments and;
6. To look at the possible remedies and effects of the amendments and to offer some recommendations.

### **1.5 SIGNIFICANCE OF STUDY**

Trademarks play a very important role in helping consumers distinguish a products (whether goods or services) of a person or an enterprise from products of other persons or enterprises. Trademarks also facilitates the choice to be made by the consumer when buying certain products or making use of certain services. These products and services affect the public at large. It is therefore very important that there is in place a trademark regime that will encompass the Madrid Protocol, TRIPS Agreement and new trends in the field of trademarks noting that the current Trade Marks law which was enacted on 1 April, 1958 has never undergone any major amendments.

### **1.6 RESEARCH METHODOLOGY**

This research will employ a non-empirical method of study which will involve largely desktop study that will review scholarly literature such as books, journals, articles, law reports and legal instruments. The internet will also be used where appropriate and necessary. Field study with relevant stakeholders will also be undertaken.

### **1.7 OUTLINE OF THE STUDY**

The research is arranged as follows:

Chapter one contains the introduction, statement of the problem, purpose of study, objectives, significance of the study and methodology.

Chapter two discusses the history and current status of the current Trade Marks regime in Zambia

Chapter three analyses the proposed Trade Marks law.

Chapter four makes a comparison of the proposed Trade Marks law with four selected jurisdictions and also discusses the challenges and possible remedies raised by the proposed law.

Chapter five consists of the conclusion and recommendations.

## **CHAPTER TWO**

### **HISTORY AND STATUS OF CURRENT TRADEMARK REGIME IN ZAMBIA**

#### **2.0 INTRODUCTION**

This Chapter will look at the status of the current trademark regime in Zambia with a focus on some of the pertinent provisions of the relevant legislation that governs trademarks.

#### **2.1 HISTORY OF CURRENT TRADEMARK REGIME IN ZAMBIA**

As discussed in chapter one, Trademark law in Zambia traces its origins from the trademark laws of the United Kingdom. This is because laws that were passed in the United Kingdom were extended or applied to Zambia like any other former colony of the United Kingdom. The trademark law is no exception and Section 2 of the English Law (Extent of Application) Act attests to this. The first legislation to govern trademark registration and protection was enacted on 1 April 1958, styled the Trade Marks Act (Chapter 693). The current trademark legislation is Chapter 401 which was last amended in 1994. It is important to note that the Trade Marks Act is administered by the Patents and Companies Registration Agency (PACRA)<sup>28</sup> formerly Patents and Companies Registration Office (PACRO).

The Trade Marks Act is the main law which regulates the registration and protection of trademarks in Zambia as well as the nation's trade mark system but does not provide for the protection of service marks and other types of traditional and acceptable non-traditional marks. The Merchandise Marks Act, on the other hand, governs largely prohibition of trading acts in the use of application of trademarks (as well as trade descriptions and origin of goods) on the market. The thrust of this chapter will be to discuss the pertinent provisions of the Trade Marks Act as it is the main piece of legislation that regulates the registration and protection of trademarks in Zambia.

#### **2.2 SALIENT PROVISIONS OF THE TRADE MARKS ACT.**

The general purpose of trademark regulation is for protection of consumers, business community and members of the public at large. In order to prosecute this mandate, the Trade

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<sup>28</sup> Patents and Companies Registration Agency (PACRA), created by Act No. 15 of 2010

Marks Act Cap 401 of the Laws of Zambia is divided into Fifteen Parts and Regulations. Parts I to XV contain substantive provisions of the law whereas the Regulations part contains the rules, schedule of fees, forms and procedures. Due to the nature of the discussion and its limitations, the focus will be on the provisions relating to subject matter, conditions of protection, registration, rights conferred, infringements, offences and remedies.

### **2.3 SUBJECT MATTER AND CONDITIONS OF PROTECTION**

As discussed in chapter one, a trademark is any sign that is capable of distinguishing the goods or services produced or provided by one enterprise from those of other enterprises. The Trade Marks Act defines a 'trade marks' as a mark used or proposed to be used in relation to goods for the purpose of indicating, or so as to indicate, a connection in the course of trade between the goods of some person having the right as proprietor or as registered user to use the mark<sup>29</sup>. In addition, the Trade Mark Act defines a 'mark' as including a device, brand, heading, label, ticket, name, signature, word, letter, numeral or any combination of the same<sup>30</sup>. It should be stated that this definition allows registration to a wide range of potential marks but only if they satisfy conditions that are prescribed by the Trade Marks Act which will be discussed below.

It is not any sign or symbol that is capable of serving as a trademark. According to section 14 of the Trade Marks Act, a trademark must be distinctive or distinguishable among different goods or products. A sign or symbol that is not distinctive cannot help the consumer to identify the goods of his choice. This goes to the root of the basic condition for a sign or symbol to serve as a trademark namely, to distinguish the goods or services of one enterprise from the goods or services of another enterprise. The Trade Marks Act defines 'distinctive' to mean adapted to distinguish, in relation to the goods in respect of which a trademark is registered or proposed to be registered, to distinguish goods with which the proprietor of the trademark is or may be connected in the course of trade from the goods in case of which no such connection subsists, either generally or, where the trademark is registered or proposed to be registered.<sup>31</sup> Another

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<sup>29</sup> Section 2 (1), Trade Marks Act

<sup>30</sup> Section 2 (1), Trade Marks Act

<sup>31</sup> Section 14 (2), Trade Marks Act

condition for a sign or symbol to serve as a trademark is that it must not be misleading, deceptive or contrary to public order or morality<sup>32</sup>.

The above stated conditions are compatible with the Paris Convention<sup>33</sup> which provides under Article 6 *quinquies* B that the trademarks enjoying protection may be denied registration or invalidated only if they are devoid of any distinctive character, or if they are contrary to morality or public order and, in particular, of such nature as to deceive the public.

## 2.4 TRADEMARK REGISTRATION

The conditions for the filing and registration of trademarks shall be determined in each country of the Union<sup>34</sup> by its domestic legislation<sup>35</sup>. In Zambia trademark registration may be obtained through registration or use. Even though trademarks may be protected through use, the protection through registration is preferred. This is because registering a trademark provides stronger protection, particularly in the case of conflict with an identical or confusingly similar mark as provided by sections 16 and 17 of the Trade Marks Act which prohibits registration of deceptive, identical or resembling trademarks. Furthermore, a registered trademark grants to the proprietor the exclusive right to use the trademark and exclude others from using the trademark as well as entitling the proprietor to enforce his rights against third parties who infringe his trademark rights<sup>36</sup>. If a third party attempts to exercise one of the exclusive rights provided under the Trade Marks Act without the consent of the trademark proprietor, this will constitute an infringement. However, under the Trade Marks Act, a person is disentitled to institute any proceedings to prevent or to recover damages for the infringement of an unregistered trademark<sup>37</sup>. In the case of **D.H. Brothers Industries (PTY) Limited v Olivine Industries (PTY) Limited**<sup>38</sup>, Justice Chibomba upheld the decision of Registrar of Trade Marks when she held *inter alia*, that the appellant's trademark could not be accorded protection on account of non-registration even though the appellant had shown sufficient prior use of the mark in Zambia.

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<sup>32</sup> Section 16, Trade Marks Act

<sup>33</sup> Paris Convention for the Protection of Industrial Property, of 1883 as revised

<sup>34</sup> Article 1 of the Paris Convention states that countries to which the Convention applies constitute a Union

<sup>35</sup> Article 6 (1), Paris Convention.

<sup>36</sup> Sections 9 (1) and 10, Trade Marks Act

<sup>37</sup> Section 7, Trade Marks Act

<sup>38</sup> **D.H.Brothers Industries (PTY) Limited v Olivine Industries (PTY) Limited** (2009/HPC/0239) unreported

There are three methods available for registration of trademarks, namely, the national, regional and international procedures. In Zambia the route commonly used is the national route while the international route, though in use has not been domesticated. The regional route has never been used as we shall see below.

The national procedure requires the proprietor of the mark to apply for a trademark under the Trade Marks Act, Cap 401. If the proprietor desires to register and protect the trade mark outside Zambia, he has to apply to the trade mark office of each country in which protection is sought by filing the corresponding and paying the prescribed fees. The Paris Convention provides that a mark duly registered in a country of the Union shall be regarded as independent of marks registered in other countries of the Union, including the country of origin<sup>39</sup>. The basis of this is that trade marks are territorial, meaning that a trade mark is only protected in the country where it is registered. Therefore, if a trade mark has to be protected in another country, it must be registered in that respective country.

The second method, the regional procedure requires the proprietor who desires to protect his trade mark in countries which are members of a regional trade mark system to apply for registration, with effect in the territories of all member countries, by filing an application for a trademark at the regional office. The regional trademark offices include ARIPO<sup>40</sup> under the Banjul Protocol<sup>41</sup> on Registration of Trade Marks. This process is available to Zambia who is a member of ARIPO but has not yet been ratified the Banjul Protocol. Another example of a regional procedure is the Office for the Harmonisation of the Internal Market of the European Union (OHIM)<sup>42</sup>.

The third method is the international procedure. Under the international procedure, the trademark proprietor makes an application to either to the International Bureau of WIPO or the

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<sup>39</sup> Article 6 (3), Paris Convention

<sup>40</sup> African Regional Intellectual Property Organisation (ARIPO), adopted on 9<sup>th</sup> December, 1976 at Lusaka, Zambia, as revised

<sup>41</sup> Banjul Protocol on Marks, adopted on 19<sup>th</sup> November, 1993 at Banjul, The Gambia

<sup>42</sup> Office for the Harmonisation of the Internal Market (OHIM), established by Regulation (EC) No. 40/94 of December 20, 1993

national trademark office, select some or all the contracting parties of the Madrid Protocol or Agreement in which he wishes to have the trademark protected. The principal advantages of using the Madrid system is that the trademark owner can register his trademark in all countries party to the system by filing a single international application, in one language, and subject to one set of fees and deadlines. Thereafter, the international registration can be maintained and renewed through a single procedure. As earlier mentioned, though the system is in use in Zambia, the appropriate legislation has not been domesticated since ratification on 15<sup>th</sup> November, 2001.

## **2.5 PROCEDURE AND DURATON OF REGISTRATION**

### **(a) Application**

The process of registering a trademark begins when any person claiming to be the proprietor of a trademark used or proposed to be used by him who is desirous of registering it applying in writing to the Registrar of PACRA in a prescribed manner for registration either in Part A or in Part B of the register of trademarks<sup>43</sup>. The division of the register into Parts A and B is due to the requirement of distinctiveness set out in section 14 of the Trade Marks Act. This demarcation means that the owners of distinctive marks can seek registration under Part A, while owners of marks with some distinctive character can pursue registration under Part B. An application to the Registrar for the Registration of a trademark shall be signed by the applicant or his agent. For a trademark other than a certification or defensive trademark the application shall be made of Form T.M. No.2 whereas for a certification or a defensive trademark the application shall be made on Form T.M. No. 5 or Form T.M. No. 33 respectively. Each application shall be for registration in respect of goods in one class of the Fourth Schedule only<sup>44</sup>. The Fourth Schedule referred to is the International Classification of Goods and Services for the purpose of Registrations of Marks<sup>45</sup> ("Nice Agreement") which is mandatory not only for the national registration of marks in countries party to the Nice Agreement, but also for the international registration of marks effected by the International Bureau of WIPO, under the Madrid Agreement, regional offices and a number of countries not party to the Nice Agreement including Zambia.

<sup>43</sup> Sections 22 or 26 and Regulation 21, Trade Marks Act

<sup>44</sup> Sections 22 or 26 and Regulation 21, Trade Marks Act

<sup>45</sup> The Nice Agreement concerning the International Classification of Goods and Services for the purposes Of Registration of Marks, signed at Nice, France on 15<sup>th</sup> June, 1957

Upon receipt of an application for the registration of the trademark in respect of any goods, the Registrar shall cause a search to be conducted amongst the registered trademarks and pending applications for the purpose of ascertaining whether there are on record any trademarks identical with the trademark applied for, or so nearly resembling it so as to render the trademark applied for likely to deceive or cause confusion<sup>46</sup>.

### **(b) Examination**

After such search and consideration of the application, and of any evidence of use or distinctiveness or any other matter which the applicant may furnish or may be required to furnish, the Registrar may accept the application absolutely, or he may object to it, or he may express his willingness to accept to such conditions, amendments, disclaimer, modifications or limitations as he may think fit<sup>47</sup>. This process is what is known as the substantive examination stage of a trademark application. This process ensures that the Trade Mark Office examines the application for a trademark to verify whether it complies with all substantive requirements, namely absolute and relative grounds for refusal of registration<sup>48</sup>. The Registrar may refuse absolutely in the following cases:

- (a) signs or marks which are not trademarks;
- (b) trademarks devoid of distinctive character;
- (c) descriptive signs;
- (d) generic terms;
- (e) deceptive marks;
- (f) trademarks contrary to public morality; and,
- (g) applications made in bad faith.

Furthermore, the Trade Marks Act prohibits the registration of words such 'Patent', 'Patented', representation of the President, or any colorable imitation thereof, or the word 'Red Cross' or 'Geneva Cross' etc.<sup>49</sup> Also, the following features may not appear on a trademark application, national flags, armorial bearings, official emblems of states<sup>50</sup>. The Paris Convention provides

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<sup>46</sup> Regulation 31, Trade Marks Act

<sup>47</sup> Section 22 (3), Trade Marks Act

<sup>48</sup> Regulation 32, Trade Marks Act

<sup>49</sup> Regulation 15, Trade Marks Act

<sup>50</sup> Regulation 16, Trade Marks Act

for the prohibition of state emblems, official hallmarks and emblems of intergovernmental organizations<sup>51</sup>.

The Trade Marks Act prohibits the registration of trademark on relative grounds if it is identical and resembles an earlier trademark. Therefore no trademark must be registered in respect of any goods or description of goods that is identical to a trademark belonging to another proprietor so as to be likely to deceive or cause confusion<sup>52</sup>. In the case of **Trade Kings Limited v The Attorney- General**<sup>53</sup> it was held that the test to be used in deciding the similarities or dissimilarities between two words or marks is whether ordinary sensible members of the public would be confused by the use of the two words.

### **(c) Advertisement of the trademark**

The Trade Mark Act requires the applicant of a trademark to advertise the trademark that has been accepted whether absolutely or with conditions and limitations, so as to enable those who may be affected by the registration of the trademark in question to raise an objection in the Trade Marks Journal<sup>54</sup>. If no objection is lodged within two months from the date of the advertisement, the trademark will be registered unless, the application has been accepted in error or unless the High Court otherwise directs<sup>55</sup>. The trademark when registered must be registered as of the date of the application for registration, and that date will be deemed the registration date<sup>56</sup>.

### **(d) Opposition**

Any person may oppose the application for registration of a trademark by giving written notice in a prescribed manner including the grounds of opposition, to the Registrar within two months from the date of advertisement of an application for registration<sup>57</sup>. The Registrar must send a copy of the notice of opposition to the applicant and, within two months of receipt of the opposition, the applicant must sent to the Registrar a counter-statement on the grounds which he relies on application, and if he does not do so, he will be deemed to have abandoned his

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<sup>51</sup> Article 6ter, Paris Convention

<sup>52</sup> Section 17 (1), Trade Marks Act

<sup>53</sup> (1999) Z.R. 53

<sup>54</sup> Section 23 (1) and Regulation 42 (1), Trade Marks Act

<sup>55</sup> Section 23 (1), Trade Marks Act

<sup>56</sup> Section 24 (1), Trade Marks Act

<sup>57</sup> Section 23 (2) and (3) and Regulations 42 and 43, Trade Marks Act



application<sup>58</sup> If the applicant sends such a counter-statement, the Registrar shall forthwith send a copy to the opponent within two months and must after hearing the parties, if so required, and considering the evidence, determine the matter subject to what conditions or limitations, if any, registration is to be permitted<sup>59</sup>. Upon completion of the evidence, the Registrar shall give notice to hear the parties of a date when he will hear the arguments in the case<sup>60</sup>. The Registrar's decision is subject to appeal<sup>61</sup>.

On the registration of a trademark, the Registrar shall issue to the applicant a certificate of registration sealed with the seal of the Patent Office<sup>62</sup>. Effect of registration is that the trademark is protected only in Zambia. Registration in another country must be obtained if protection is desired there. Where a registration is not completed within twelve months from the date of the application by reason of default on the part on the applicant, the Registrar may, after giving notice in writing of the non-completion, treat the application as abandoned, unless it is completed within the time specified in that behalf in the notice<sup>63</sup>.

The Trade Marks Act provides that a trade mark registration is valid for seven years but may be renewed from time to time<sup>64</sup>. The proprietor of a registered trademark must renew the registration after payment of a prescribed renewal fee, for a period of fourteen years from the date expiration of the original registration or of the last renewal of the registration<sup>65</sup>. It must be noted that the Registrar shall remove a trademark from the register for if it is not renewed within the time limit<sup>66</sup> but he may restore the trademark to the register if satisfied that it is just to do so<sup>67</sup>.

## **2.6 RIGHTS CONFERRED BY TRADEMARKS**

The proprietor of a registered trademark acquires exclusive right to use the trademark and the right to exclude other from using it. This is so because a trademark like any other personal

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<sup>58</sup> Section 23 (4) and Regulation 48, Trade Marks Act

<sup>59</sup> Section 23 (5) and Regulations 49-54, Trade Marks Act

<sup>60</sup> Regulation 54, Trade Marks Act

<sup>61</sup> Section 23 (6) to (10), Trade Marks Act

<sup>62</sup> Section 24 (2), Trade Marks Act

<sup>63</sup> Section 24 (3), Trade Marks Act

<sup>64</sup> Section 25 (1), Trade Marks Act

<sup>65</sup> Section 25 (2) and Regulation 64, Trade Marks Act

<sup>66</sup> Section 25 (4), Trade Marks Act

<sup>67</sup> Regulation 68, Trade Marks Act

property may be, for example be assigned, licensed or transmitted under the operation of the law. The Trade Marks Act provides that the registration of a person in Part A or Part B of the register of trademarks as proprietor of a trademark in respect of goods must, if valid, give or deemed to have given that person the exclusive right to use the trademark in relation to those goods<sup>68</sup>.

It is important to note that the exclusive right granted to the proprietor of a trademark is not absolute. The exclusive right must not prejudice any existing rights. Therefore according to section 12 of the Trade Marks Act, the proprietor or a registered user of a registered trademark is not allowed to interfere with or restrain the use by any person a trademark identical with or nearly resembling it, in relation to goods to which that person or a predecessor in title of his has continuously used the trademark from a date anterior. Furthermore, the exclusive right shall not apply to circumstances where:

- (a) the trademark owner permits or expressly or impliedly consent to use the trademark<sup>69</sup>;
- (b) the use of the trademark is reasonably necessary to indicate the intended purpose of products<sup>70</sup>;
- (c) any bona fide use by a person of his own name or of the name of his place of business, or of the name or place of business of his predecessor in business<sup>71</sup>; or
- (d) the use by any person of any bona fide description of the character or quality of his goods<sup>72</sup>; and
- (e) the trademarks rights have been exhausted.

The Trade Marks Act also provides for the assignment and transmission of registered trademark either in connection with the goodwill or not<sup>73</sup> and in respect of either of all the goods in respect of which it is or was registered, or some, but not all of the goods<sup>74</sup>. The Paris convention provides for assignment of a mark under Article 6*quater*.

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<sup>68</sup> Sections 9 and 10, Trade Marks Act

<sup>69</sup> Section 9 (3)(a), Trade Marks Act

<sup>70</sup> Section 9 (3)(b), Trade Marks Act

<sup>71</sup> Section 13(a), Trade Mark Act

<sup>72</sup> Section 13(b), Trade Marks Act

<sup>73</sup> Section 27 (1), Trade Marks Act

<sup>74</sup> Section 27(2), Trade Marks Act

## 2.7 INFRINGEMENT, REMEDIES AND OFFENCES

A registered trademark grants to the proprietor the exclusive right to use the trademark and to exclude others from using the trademark. If a third party attempts to exercise one of the exclusive rights provided under the Trade Marks Act without the consent of the trademark proprietor, this will constitute an infringement<sup>75</sup>. According to Section 9 of the Trade Marks Act, a claim for trademark infringement will arise where a person who uses a registered trademark on the same goods in relation to which the trademark is registered. Where the trademark is owned by more than one person each co-owner must consent to the use of the trademark by a third party and each co-owner must be joined to an action against the alleged infringer<sup>76</sup>. Any Infringement or legal proceeding relating to infringement or passing off of a trademark shall be brought in the High Court<sup>77</sup>.

Both civil and criminal remedies are available for trademark infringement. The Trade Marks Act provides for civil remedies include damages, injunctions, delivery up, account for profits, interdict including other remedies or relief which as noted from above are brought to the High Court. Damages are payable even if infringement is innocent. The provisions of sections 9, 10 and 11 of the Trade Marks Act stipulate that once a trademark is registered it confers the exclusive right or monopoly on the registered proprietor and the use of the registered trademark by any other person, other than those authorised by the registered proprietor, constitute an infringement whether the infringement was done knowingly or unknowingly.

The Trade Mark Act provides a number of offences relating to registration of trademarks as well as unauthorized use of a trademark. The Trade Marks Act makes it an offence for any person to falsify the entries in the register knowing the entries to be false<sup>78</sup> as well as any person who falsely represents a trademark as registered<sup>79</sup>. In addition to the offences under the Trade Marks Act, section 377 of the Penal Code<sup>80</sup> provides a number of offences relating to counterfeiting of trademarks. Thus any person is guilty of misdemeanour, with intent to defraud or enable another to defraud, if they commit any of the acts set out in section 377 of the Penal Code.

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<sup>75</sup> Sections, 9, 10 & 11, Trade Marks Act

<sup>76</sup> Section 74, Trade Marks Act

<sup>77</sup> Section 59, Trade Marks Act

<sup>78</sup> Section 68, Trade Marks Act

<sup>79</sup> Section 69, Trade Mark Act

<sup>80</sup> Chapter 87 of the Laws of Zambia

## **CHAPTER THREE**

### **ANALYSIS OF THE PROPOSED TRADEMARKS LAW**

#### **3.0 INTRODUCTION**

This Chapter will analyze the proposed amendment to the Trade Marks Act, and examine whether they cover the weaknesses inherent in the current Act and compliance with Zambia's international obligations in the field of trademarks.

#### **3.1 REVIEW PROCESS**

It is evident from the preceding chapters that the current Trade Marks Act which was imported from the United Kingdom is out of touch with reality and outdated. The process for the review of the Zambian Intellectual Property (IP) legislation was undertaken by the International Institute for Advanced Studies (IIAS)<sup>81</sup> which is a project under the auspices of TradeCom programme. The TradeCom programme, also referred to as the TradeCom Facility, is an African, Caribbean and Pacific Group of States (ACP) Programme financed by the European Development Fund (EDF)<sup>82</sup>. The EDF is the main instrument for providing community development aid in the African, Caribbean and Pacific (ACP) countries and the Overseas Countries and Territories (OCTs). This project was intended to offer technical assistance to the Zambia Ministry of Commerce, Trade and Industry (MCTI) in intellectual Property. The inception of the IIAS mission was in August 2009 and the key goal was the examination and reform of the Zambian IP regulatory framework. This was to be undertaken in cooperation with key stakeholders, most notably the Ministry of Commerce, Trade and Industry (MCTI) and PACRO. Following the results of IIAS legislative and policy review, it was discovered that Zambia's effective IP legislation most of which predates the establishment of the World Trade Organisation (WTO) in 1994 falls significantly short of meeting Trade-Related Aspects of Intellectual Property Rights (TRIPS) requirements both as regards the scope of subject matter covered and the strength/design of substantive standards as well as with respect to the

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<sup>81</sup> The International Institute for the Advanced Study of Cultures, Institutions and Economic Enterprise (IIAS), founded in 200 and established in Accra, Ghana.

<sup>82</sup> The European development Fund (EDF), created in 1957 by the Treaty of Rome, and first launched in 1959.

availability and efficacy of legal mechanisms enabling IP right holders to enforce their entitlements. Furthermore, Zambia's IP laws do not take adequate regard for domestic development interests in a number of critical areas, most notably education, public health and domestic innovation. Overall, the expert team's analysis exposed a clear need for substantial revision of existing Zambian IP laws and for the drafting of a new legislation in IP areas where Zambia currently has no legislation in place<sup>83</sup>.

The draft Trade Mark law which is the focus of this research study is also premised on the analysis and considerations made by IIAS. Due to the purpose of the study and its limitation, the focus of this chapter will be to look at some novel and salient provisions that take in to account the Madrid Protocol, TRIPS Agreement, recent developments in the field of trademarks as well as the analysis done by IIAS.

### 3.2 THE DRAFT TRADEMARKS LAW

The first novel aspect of the draft Trade Mark law is the title of the proposed Act itself. It is proposed that the law should be styled the **"Trade Marks and Geographical Indications Act"**. The draft law begins with the objectives of the proposed law which also form the preamble of the draft law. The objectives are:

- (a) Repeal and replace the Trademarks Act, Cap 401 of the Laws of Zambia;
- (b) Provide for the registration and protection of trade marks, service marks, defensive marks, collective marks, certification marks, well-known marks, geographical indications, trade names and other distinctive signs;
- (c) Encourage producers and operators to maintain the reputation of their trademarks and guarantee the quality of goods and services;
- (d) Give effect to the provisions of the Madrid Protocol Relating to the International Registration of Marks, the Paris Convention for the Protection of Industrial Property, the

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<sup>83</sup> TradeCom Facility, IIAS, Technical Assistance to the Zambia Ministry of Commerce, Trade & Industry in Intellectual Property, Progress Report, 2009, at page 2

World Trade Organisation Agreement on Trade Related Aspects of Intellectual Property Rights and any other international Treaty or Convention to which Zambia is or may be party to with the ultimate objective of benefiting consumers; and

(e) Provide for matters connected with or incidental to the foregoing.

The draft law contains Twenty six parts namely Parts I to XXVII which are substantive provisions of the proposed law. As already noted above, the preamble is comprised of precisely what is contained in the objectives of the draft law. The preamble truly reflect the intention of the proposed law which is broad and takes on board the pertinent issues such as the Madrid Protocol, TRIPS Agreement, recent developments in the field of trademarks as well as the analysis done by IIAS. This is a complete departure from the current Trade Marks Act which in its preamble simply provides that it is 'an Act to make provision relating to registration of trademarks and for other purposes incidental thereto'.

It will be recalled from chapter one that the obligations under TRIPS exist irrespective of whether or not the particular state is a member of the Paris Convention. Article 2.1 of TRIPS reads: "In respect of Parts II, III and IV of this Agreement, Members shall comply with Articles 1 through 12, and Articles 19, of the Paris Convention (1967)."

Part I of the draft Trade Marks law is one of the areas where a number of additions have been made especially to the interpretation section. There has been an inclusion of several words due to the expansion of the scope of application of the proposed Trade Marks law. Perhaps one of the most important is the definition "trademark" whose meaning has been expanded to include services marks. The definition in the draft Trade Marks law provides that a trademark 'other than a certification trademark or a collective trademark, means a mark used or proposed to be used by a person in relation to goods or services for the purpose of distinguishing the goods or services in relation to which the mark is used or proposed to be used from the same kind of goods or services connected in the course of trade with any other person'<sup>84</sup>. Another significant novel inclusion is the word "applicant" which is not defined in the Trade Marks Act Cap. 401.

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<sup>84</sup> Section 2, Draft Trade Marks law

The term “applicant” in the draft Trade Mark law means in relation to registration means a natural person or legal person applying for a trademark or geographical indication, including a legal representative; or a person in whose name such an application is for the time being proceeding<sup>85</sup>. Other words that have been defined in the draft Trade Marks law that are not defined in the current Trade Marks Act include *inter alia* “application”, “goods”, “label”, “opponent”, “person”, “use”<sup>86</sup> etc.

Part II of the draft Trade Mark law consists of the administration of the draft Trade Mark law. Under this Part novel provisions include single register of trademarks pursuant with section 9 (1) of the draft Trade Marks law. The current Trade Marks Act makes provision for the register to be divided into four parts<sup>87</sup>. Another new provision in the draft Trade Marks law is a provision relating to the immunity of Officers as regards official acts<sup>88</sup>.

Part III of the draft Trade Mark law deals with trademarks that may or may not be registrable and is one of the Parts that contain various provisions that are compatible to the Paris Convention and TRIPS Agreement. This Part is the equivalent of Parts IV and V of the current Trade Marks Act which deals with registration and validity. However, some of the novel aspects of the draft Trade Mark law under Part III include absolute and relative grounds of refusal of registration of a trademark<sup>89</sup>. Section 18 of the draft Trade Marks law provides for registrability of trademarks that contains representation of flag, etc, generally. The registrability of trademarks that contains flag state emblems, etc, of convention country, armorial bearings of certain international organizations are provided for under sections 19, 20 and 21 of the draft Trade Marks law. These sections are in line with the provisions Article 6ter of the Paris Convention.

Part IV of the draft Trade Mark law deals with application for registration of trademarks. This Part has various provisions that are absent in the present Trade Marks Act. One such provision

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<sup>85</sup> Section 2, Draft Trade Marks law

<sup>86</sup> Section 2, Draft Trade Marks law

<sup>87</sup> Section 6 (2), Trade Marks Act

<sup>88</sup> Section 13, Draft Trade Marks law

<sup>89</sup> Sections 16 and 17, Draft Trade Marks law

is filing of a single application for different classes of goods and services<sup>90</sup>. This provision takes care of trademarks under the Madrid Protocol which deals with both trademarks and service marks. Other provision under this part include those of joint applications<sup>91</sup>, filing date<sup>92</sup>, priority claim<sup>93</sup>, exhibition claim<sup>94</sup> and divisional application<sup>95</sup> all of which are provided for under Article 4 of the Paris Convention and Article 62 (3) of the TRIPS Agreement.

Part VIII of the draft Trade Marks law exclusively deals with infringement. This Part in line with Part III of the TRIPS Agreement which deals with enforcement of Intellectual Property under Article 41. This Article contains principles that pertain to all enforcement procedures. Some of the provisions include *inter alia*, what constitutes infringement of registered trademarks<sup>96</sup>, acts not constituting infringement<sup>97</sup>, exhaustion of rights conferred by registered trademark<sup>98</sup>, time for and person(s) entitled to bring action for infringement<sup>99</sup>. The draft Trade Mark law further provide for remedies for infringement<sup>100</sup> and various other remedies such as orders for erasure of offending sign<sup>101</sup>, order for delivery up of infringing goods, material or object<sup>102</sup> and order for disposal of infringing goods, material or object<sup>103</sup>. Part VIII ends with section 85 which deals with meaning of “infringing goods, material or articles”. The Paris Convention has no corresponding provisions on enforcement of Intellectual Property rights.

Part IX of the draft Trade Marks law deals with duration and renewal of registration. The duration of registration of a trademark shall be for a period of ten years from the date of filing or registration<sup>104</sup> and may be renewed from time to time in accordance with provision of section

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<sup>90</sup> Section 33 (3), Draft Trade Marks law

<sup>91</sup> Section 36, Draft Trade Marks law

<sup>92</sup> Section 45, Draft Trade Marks law

<sup>93</sup> Section 46, Draft Trade Marks law

<sup>94</sup> Section 47, Draft Trade Marks law

<sup>95</sup> Section 48, Draft Trade Marks law

<sup>96</sup> Section 69, Draft Trade Marks law

<sup>97</sup> Section 71, Draft Trade Marks law

<sup>98</sup> Section 74, Draft Trade Marks law

<sup>99</sup> Sections 75 & 76, Draft Trade Marks law

<sup>100</sup> Section 80, Draft Trade Marks law

<sup>101</sup> Section 81, Draft Trade Marks law

<sup>102</sup> Section 82, Draft Trade Marks law

<sup>103</sup> Section 83, Draft Trade Marks law

<sup>104</sup> Section 86, Draft Trade Marks law



86<sup>105</sup>. The registration may be renewed for a period of ten years from the date of expiration of the original registration or last renewal of the registration<sup>106</sup>. Article 18 of the TRIPS provides that initial registration, and each renewal of a trademark shall be for a term of no less than seven years'. The Paris Convention has no corresponding rule. Article 18 further provides that the registration of a trademark shall be renewable indefinitely. The current Trade Marks Act provides for initial renewal for a period of seven years and further indefinite periods of fourteen years<sup>107</sup>.

Part XIV of the draft Trade Marks law deals with collective trademarks. The requirement to undertake to file and protect collective trademarks is provided under Article 7*bis* of the Paris Convention. The draft Trade Marks law provides the definition of a collective trademark<sup>108</sup> and sets out the mode of its application<sup>109</sup>. It further sets out regulations governing use of a collective trademark<sup>110</sup> and the requirements for application and regulations by the Registrar<sup>111</sup> and concludes with the assignment of collective trademarks<sup>112</sup>. The current Act does not contain an express provision for collective trademarks though they may be applied for under Part C of the register.

Part XV of the draft Trade Marks law deals with certification trademarks. Certification trademarks are not provided for either under the Paris Convention or TRIPS. The current Trade Marks Act however, provides for certification trademarks<sup>113</sup>. The draft Trade Marks law unlike the current Trade Marks Act defines a certification trademark and sets out a number of provisions that are to apply to certification trademarks which are similar to collective trademarks.

Part XVI of the draft Trade Marks Act deals with defensive trademark. Defensive trademark like certification trademark are not explicitly provide for under the Paris Convention or TRIPS.

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<sup>105</sup> Section 86 (2), Draft Trade Marks law

<sup>106</sup> Section 87, Draft Trade Marks law

<sup>107</sup> Section 25 (1) and (2), Trade Marks Act

<sup>108</sup> Section 127, Draft Trade Marks law

<sup>109</sup> Section 128, Draft Trade Marks law

<sup>110</sup> Section 131, Draft Trade Marks law

<sup>111</sup> Section 136, Draft Trade Marks law

<sup>112</sup> Section 138, Draft Trade Marks law

<sup>113</sup> Section 42, Trade Marks Act

The current Trade Marks Act provides for the registration of defensive trademark under Part D of the register as well-known marks<sup>114</sup>. The draft Trade Marks law however, provides a stand alone part for defensive trademarks which are quiet distinct from well-known trademarks. One striking distinction between defensive trademarks and well-known trademarks is that the latter need not be registered but may be protected while the former needs to be registered. Well-known trademarks will be discussed in the next paragraph. An important element essential for a trademark to qualify as a defensive trademark is that it must have acquired reputation in Zambia in relation to all or any of the goods or services in respect of which it is registered and that it is likely that its use in relation to other goods or services will be taken to indicate that there is a connection between those other goods or services<sup>115</sup>. Another important aspect of a defensive trademark is that it may be registered in respect of particular goods or services even if the registered owner does not intend to use it in relation to those goods or services<sup>116</sup>. The provisions relating to trademarks are to shall apply to defensive trademarks and so apply as if in reference to a trademark<sup>117</sup>.

Part XVII deals with the protection of well-known trademarks. As discussed above well-known trademarks need not be registered<sup>118</sup>. The protection available to registered trademarks shall *mutatis mutandis* extend trademarks that will qualify as well-known trademarks<sup>119</sup>. Section 163(2) lists factors that are to taken into account in determining whether a trademark is well-known in Zambia. The Part concludes with a further provision on the protection of well-known trademark as provided by TRIPS especially Article 16 (3) of which extends protection of well-known trademarks in respect also of non-similar goods or service whereas the Paris Convention protects well-known trademarks in respect of identical or similar goods.

Part XVIII deals with geographical indications, one of the novel introductions in the Zambian Industrial property statute books. The title of the draft Trade Marks law is also testimony that geographical indications will now be protectable in Zambia. The part begins with the definition

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<sup>114</sup> Section 32, Trade Marks Act

<sup>115</sup> Section 159 (1), Draft Trade Marks law

<sup>116</sup> Section 159 (2), Draft Trade Marks law

<sup>117</sup> Section 160, Draft Trade Marks law

<sup>118</sup> Article 6bis, Paris Convention

<sup>119</sup> Section 163, Draft Trade Marks law

of geographical indications as defined by the TRIPS<sup>120</sup>. It should be noted that the Paris Convention contains no definition of ‘geographical indication’ and instead uses different terms, “indication of source” and “appellation of origin”<sup>121</sup> which it does not define. The draft Trade Marks law then sets out the scope of the proposed law in relation to geographical indication<sup>122</sup> pursuant to Article 22 of TRIPS. Like trademarks which has a proviso for trademarks which may be refused registration, section 167 of the draft Trade Marks law sets out what shall not be registered or protected as geographical indication. The part also has provisions for additional protection for geographical indications for wine and spirits as required by Article 23 of the TRIPS. One such provisions deal with homonymous geographical indication for wines and spirits<sup>123</sup>. Section 169 of the draft Trade Mark law sets person(s) entitled to apply for registration of geographical indication. Sections 170 to 173 lays down the procedures for application, examination and publication, objection and registration of a geographical indication respectively. The registration of a geographical indication shall be for a period of ten years, but may be renewed from time to time in accordance with the provisions and regulations prescribed by the law<sup>124</sup>. The part further makes provisions for the prohibition against improper use of geographical indications<sup>125</sup>, civil proceedings for improper use of geographical indications<sup>126</sup>, remedies<sup>127</sup> and seizure in the case of unlawful marking with indication of geographical origin<sup>128</sup>. These provisions are in line with Articles 9, 10 and 10*bis* as well as Article 22 of TRIPS.

There are provisions that take care of Article 23 of TRIPS entitled “International negotiations; Exceptions”. These are matter proper to WTO, for which the Paris Convention contains no corresponding provisions. These include provision regarding non-diminution of rights and prior use and registration<sup>129</sup>. This part concludes with provisions relating to registration of a foreign

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<sup>120</sup> Article 22 (1), TRIPS Agreement

<sup>121</sup> Article 1 (2), Paris Convention

<sup>122</sup> Section 166, Draft Trade Marks law

<sup>123</sup> Section 168, Draft Trade Marks law

<sup>124</sup> Section 175, Draft Trade Mark law

<sup>125</sup> Section 176 , Draft Trade Marks law

<sup>126</sup> Section 177, Draft Trade Marks law

<sup>127</sup> Section 178, Draft Trade Marks law

<sup>128</sup> Section 179, Draft Trade Marks law

<sup>129</sup> Section 183, Draft Trade Marks law.

geographical indication<sup>130</sup>, rectification and cancellation of registration<sup>131</sup>, grounds for invalidating registration of a geographical indication<sup>132</sup> and regulations that the Minister may make that are necessary for giving effect to the law<sup>133</sup>.

Part XIX deals with trade names and acts of unfair competition. This is one of the areas that are not adequately dealt with in the current Trade Marks Act. Article 8 of the Paris Convention requires countries of the Union to protect trade names without the obligation of filing or registration, whether or not it forms part of a trademark. The draft Trade Marks law makes provision for the definition of trade names and prohibited trade name<sup>134</sup>, method of protection of trade names<sup>135</sup> and assignment and transfer of trade names<sup>136</sup>. Article 10*bis* of the Paris Convention binds members of the Union to assure nationals of such countries effective protection against unfair competition. The draft Trade Marks Act makes provisions for acts of unfair competition and other acts of unfair competition under section 191 and 192 respectively. In terms of legal proceedings the remedies provided under Part VIII under sections 80, 81 and 82 shall be applicable to trade names, acts of unfair competition and other acts of unfair competition<sup>137</sup>.

Part XX of the draft Trade Marks law deals with international protection of marks. It is clear from the previous chapter that the current Trade Mark regime has no provisions for protection of international trademarks. The draft Trade Marks law begins with various definitions that are applicable in dealing with international registrations under the Madrid Protocol<sup>138</sup>. There is also a proviso empowering the Minister to make provision giving effect to the Madrid Protocol and any other treaty or protocol<sup>139</sup>. The part concludes with the provision which states that

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<sup>130</sup> Section 184, Draft Trade Marks law

<sup>131</sup> Section 185, Draft Trade Marks law

<sup>132</sup> Section 186, Draft Trade Marks law

<sup>133</sup> Section 187, Draft Trade Marks law

<sup>134</sup> Section 188, Draft Trade Marks law

<sup>135</sup> Section 189, Draft Trade Marks law

<sup>136</sup> Section 190, Draft Trade Marks law

<sup>137</sup> Section 193, Draft Trade Marks law

<sup>138</sup> Section 194, Draft Trade Marks law

<sup>139</sup> Section 195, Draft Trade Marks law

registration procedure of trademarks under this law shall apply *mutatis mutandis* to international trademark applications<sup>140</sup>.

Part XXI of the draft Trade Marks law deals with border measures. This is one of the requirements of Part III TRIPS under the heading enforcement of intellectual property rights. This is particularly pursuant to Article 51 of the TRIPS under provisional measures which makes provisions for special requirements related to border measures. Under the Paris Convention, the countries of the Union undertake to assure to nationals of the other countries of the Union appropriate legal remedies effectively to repress certain acts which are prohibited by the Convention under Articles 9, 10 and 10*ter*. The draft Trade Mark under this part begins with the provision dealing with the interpretation of various terms<sup>141</sup>. The rest of the provisions provide for the procedures and remedies that are available under this part<sup>142</sup>.

Part XXIV of the draft Trade Marks Act deals with offences and penalties. The draft Trade Mark law has some additions to this part which include counterfeiting<sup>143</sup>, altering of documents<sup>144</sup>, manufacturing and possession of die etc. for use in commission of offence<sup>145</sup>, selling etc. goods with false marks<sup>146</sup>(this is in conformity with Articles 9 and 10 of the Paris Convention), aiding and abetting offences<sup>147</sup>, false representation about Trade Marks Office<sup>148</sup> and forfeiture orders under the proceeds of crime legislation<sup>149</sup>.

Part XXV of the draft Trade Marks law deals with Trade Mark agents. There have been some additions to this part in the draft Trade Marks law such as qualifications to practice as a trademark agent<sup>150</sup> and the consequences of unregistered trademark attorneys and/or agent<sup>151</sup>.

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<sup>140</sup> Section 196, Draft Trade Marks law

<sup>141</sup> Section 197, Draft Trade Marks law

<sup>142</sup> Sections 198-210, Draft Trade Marks law

<sup>143</sup> Section 234, Draft Trade Marks law

<sup>144</sup> Section 237, Draft Trade Marks law

<sup>145</sup> Section 240, Draft Trade Marks law

<sup>146</sup> Section 241, Draft Trade Marks law

<sup>147</sup> Section 242, Draft Trade Marks law

<sup>148</sup> Section 243, Draft Trade Marks law

<sup>149</sup> Section 244, Draft Trade Marks law

<sup>150</sup> Section 247, Draft Trade Marks law

<sup>151</sup> Section 250, Draft Trade Marks law

It should be pointed out that what has been discussed in this chapter are some of the salient provisions that have been proposed in the draft Trade Marks law which are aimed at bringing the Trade Marks regime in conformity with the Madrid Protocol, TRIPS Agreement, recent developments in the field of trademarks. The next chapter will deal with challenges raised by the proposed amendments and look at possible remedies and also make a comparison with selected jurisdiction.

## **CHAPTER FOUR**

### **COMPARISON WITH SELECTED JURISDICTIONS, CHALLENGES RAISED BY THE PROPOSED AMENDMENTS AND POSSIBLE REMEDIES.**

#### **4.0 INTRODUCTION**

This Chapter will spell out challenges raised by the proposed amendments and look at possible remedies and also make a comparison with selected jurisdiction. In the previous chapter, the study was centered on the salient provisions of the proposed Trade Marks Act which have been introduced in order for Zambia to comply with its international obligations in the field of trademarks. Most of the novel provisions have been those relating to the Madrid Protocol and perhaps the most important, the TRIPS Agreement.

The TRIPS Agreement is a minimum standards agreement, which allows Members to provide more extensive protection of intellectual property if they so wish. Members are left free to determine the appropriate method of implementing the provisions of the Agreement within their own legal system and practice. The three main features of the Agreement are standards, enforcement and dispute resolution<sup>152</sup>.

#### **4.1 COMPARISON WITH SELECTED JURISDICTIONS**

The chapter will begin by making a comparison with Trade Marks laws from three Commonwealth Countries, namely, Britain (Zambia's former colonial masters), Australia and Kenya, and also South Africa, which is not a wholly common law jurisdiction as it also practices Roman-Dutch law in order to determine how their laws have been crafted especially in relation to international obligations. The comparison will mainly focus on some salient provisions of the proposed Zambian Trade Marks Act with the four selected jurisdiction bearing

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<sup>152</sup> <http://www.wto.org>. searched on 4<sup>th</sup> February, 2011

in the Madrid Protocol and the three main features of the TRIPS Agreement namely, standards, enforcement and dispute resolution. The latter part of the will look at the probable challenges posed by the proposed Trade Marks law and possible remedies.

#### **4.2 THE BRITISH TRADE MARKS ACT<sup>153</sup>**

The British Trade Marks Act entered into force on 29<sup>th</sup> September, 1994. It is an Act that makes provisions for geographical indication, trade names, trademarks and undisclosed information (trade secrets). It further provides for registered trade marks and the European Community trade mark and gives effect to the Madrid Protocol relating to the International Registration of Marks of 27 June 1989 and to certain provisions of the Paris Convention. It also proscribes the registering of a trade mark if it is of such a nature as to deceive the public about the geographical origin of the goods or services and prohibits in certain circumstances the disclosure of information without the consent of the applicant for the trade mark.

The Act is arranged into Parts I to VI. Part I which is titled “Registered Trade Marks” contains sections 1 to 50. This part is further divided into eleven sub-heading arranged as follows; Introductory, Grounds of refusal of registration, Effects of registered trademark, Infringement proceedings, Registered trademark as object of property, Licensing, Application for registered trademark, Priority, Registration procedure, Surrender, revocation & invalidity, Collective marks and Certification marks. This Part has various sections which are compatible with various provisions of the Paris Convention and TRIPS Agreement. In contrast to the proposed Trade Marks Act the relevant headings under Part I of the British Trade Marks Act may be summarised as follows:

- (i) Grounds for refusal of registration and effects of registered trademark under sections 3 to 13 are covered under Part III of the proposed Trade Marks Act under the heading “Registrable Trademark” and consists of section 14 to 32. However, the propose Trade Marks Act has more grounds for refusal compared to the British Trade Marks Act such as prohibition of trademarks containing commonly used chemicals under section 24 and use of name of another

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<sup>153</sup> Trade Marks Act Chapter 26, 1994



person under section 32. These are some of the provisions that are classified under the standard criteria under Article 15 to 21 of the TRIPS Agreement.

- (ii) Infringement proceedings under sections 14 to 21 of the British Trade Marks Act the equivalent of Part VIII of the proposed Trade Marks Act. This part which consists of sections 68 to 85 exclusively deals with infringement. These particular provisions are in line with Part III of the TRIPS Agreement which deals with enforcement of Intellectual Property under Article 41.
- (iii) Collective marks and certification under the British Trade Marks Act are covered by sections 49 and 50. Furthermore, collective marks are regulated by Schedule 1 whereas certification marks are regulated by Schedule 2. Under the proposed Trade Marks Act collective trademarks and certification trademarks are dealt with under Parts XIV and XV respectively. The parts consist of section 127 to 158. The requirement to undertake to file and protect collective trademarks is provided under Article 7*bis* of the Paris Convention. Certification trademarks are not provided for either under the Paris Convention or the TRIPS Agreement. The aspect of defensive trademarks is conspicuously absent in the British Trade Marks Act.

Part II is titled “Community Trade Marks and International Matters” and contains sections 51 to 61. The part is divided into four sub-headings arranged as follows; Community trademarks, The Madrid Protocol: International registration, The Paris Convention: Supplementary provisions and Miscellaneous. This part deals with provisions that relate to the Community trademark under the European Council, Madrid Protocol and the Paris Convention. This part in comparison with the Trade Marks Act may be summarized as follows:

- (i) The proposed Trade Marks Act does not contain provisions dealing with Community trademarks because Zambia is not a member of the European Union.
- (ii) The proposed Trade Marks Act under Part XX deals with International Protection of trademarks. This is the part that gives effect to the Madrid Protocol and consists of sections 194 to 196.
- (iii) The proposed Trade Marks Act contains a proviso which states that registration procedures of trademarks under this law shall apply *mutatis mutandis* to international

trademark applications whereas the British Trade Marks Act does not have such a provision.

Part III is titled “Administrative and Other Supplementary Provisions”. It contains sections 62 to 98. This part is divided into eight sub-headings. This part also contains some salient provisions such Legal proceedings and appeals, Importation of infringing goods, material or articles, Offences and forfeiture of counterfeit goods. The proposed Trade Marks Act on the other hand deals with these matters under various parts namely Part VIII dealing with infringement, Part XXI dealing with border measures, Part XXIII dealing with appeals and proceedings and Part XXIV dealing with offences and penalties. Both British Trade Marks Act and the proposed Trade Marks Act have seemingly similar provisions dealing with enforcement which is one of the features the TRIPS Agreement.

#### **4.3 THE AUSTRALIAN TRADE MARKS ACT<sup>154</sup>**

The Australian Trade Marks Act entered into force on 1<sup>st</sup> January, 1996. It is an Act for the enforcement of IP and related Laws and trademarks. It is a detailed piece of legislation which comprises 24 Parts. The focus will be to compare the salient provisions of the Australian Trade Marks Act to the proposed Zambian Trade Marks Act.

Part 3 & Part 4 titled “Trademarks and trademark rights and” “Application for registration” deal with matters relevant to registration and grounds for refusal. The parts consist of sections 17 to 51A. Under the proposed Trade Marks Act, these matter are dealt with under Part III of the under the heading “Registrable Trademark” and consists of section 14 to 32. Most of the provisions are similar to those found in the British Trade Marks Acts Act discussed above.

Parts 12, 13 & 14 deal with matters related to infringement and offences. These parts consist of sections 120 to 160. The proposed Trade Marks Act deals with these matters as earlier alluded to under Part VIII dealing with infringement, Part XXI dealing with border measures, Part XXIII dealing with appeals and proceedings and Part XXIV dealing with offences and penalties

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<sup>154</sup> Trade Marks Act 1995 ( consolidated as of 14<sup>th</sup> January, 2011)

These particular provisions go to the heart of the enforcement provisions under the Paris Convention and TRIPS Agreement.

Parts 15, 16 and 17 deal with matters pertaining to collective, certification and defensive trademarks respectively. These parts contain sections 161 to 189. The proposed Zambian Trade Mark law also makes provision for collective trademarks, certification trademarks and defensive trademarks under Parts XIV, XV & XVI. It should be noted that the British Trade Marks Act has no provision for defensive trademarks.

Part 17A titled “Protected International trademarks under the Madrid Protocol” contains section 18A which gives effect to the provisions of the Madrid Protocol. The proposed Trade Marks law contains Part XX which deals with International Protection of trademarks. This is the part that gives effect to the Madrid Protocol and consists of sections 194 to 196. The Australian Trade Marks Act like the British Trade Marks Act make regulations for implementing the Madrid Protocol but do not have a proviso that require registration procedures of trademarks under their laws to apply *mutatis mutandis* to international trademark applications as is the case with the proposed Trade Mark law.

#### **4.4 THE KENYAN TRADE MARKS ACT<sup>155</sup>**

The Kenyan Trade Marks Act original text entered into force on 1<sup>st</sup> January, 1957. It is an Act that makes provisions for the protection of trademarks. The Act consists of Parts I to XII as well as three schedules. Part I is the preliminary and consists of sections 1, 2 & 3 which deal with short title, interpretation and appointment of Registrar and other officers.

Part II which is titled “Registration, infringement and other Substantive provisions” has three sub-headings. The sub-headings include the register, effect of registration and action for infringement and registrability and validity of registration. This part contains sections 5 to 19. Section 15A is worth mention because it is the section that deals with protection of well-known trademarks as evinced by the Paris Convention and TRIPS Agreement. This part is cross cutting

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<sup>155</sup>Trade Marks Act (Chapter 506) (As last amended by the Trade Marks (Amendment) Act, 2002)

in terms of the three main features of the TRIPS Agreement. In contrast, the proposed Zambian Trade Marks legislation deals with matters of infringement and registrability under separate parts namely Parts III and VIII. The aspect of well-known trademarks on the other hand is dealt with in Part XVII of the proposed Trade Marks law.

Parts VII and VIIA deal with certification trademarks and collective trademarks respectively. This part consists of sections 40 and 40A. The proposed Zambian Trade Mark law makes provision for collective trademarks, certification trademarks and defensive trademarks under Parts XIV, XV & XVI. It should be noted that the Kenyan Trade Marks Act has no provision for defensive trademarks.

Part VIIB deals with international applications. The international applications involved are under the Banjul Protocol<sup>156</sup> and the Madrid Convention and Protocol. This part contains sections 40B, 40C and 40D respectively. In contrast, the proposed Zambian Trade Marks law under Part XX deals with international protection of trademarks under the Madrid Protocol. Kenya and Zambia are both members of ARIPO which administers the Banjul Protocol. Kenya is a signatory to the Banjul Protocol while Zambia is not.

Parts X and XI deal with matters relating to legal proceedings, appeals and offences. These parts comprise sections 46 to 59. These provisions form part of the enforcement requirements under the Paris Convention and TRIPS Agreement. The proposed Zambian Trade Marks law deals with these matters under Part VIII dealing with infringement, Part XXI dealing with border measures, Part XXIII dealing with appeals and proceedings and Part XXIV dealing with offences and penalties.

#### **4.5 THE SOUTH AFRICAN TRADE MARKS ACT<sup>157</sup>**

The South African Trade Marks Act was assented to on 22<sup>nd</sup> December, 1993, and the date of its commencement was 1<sup>st</sup> May, 1995. It is an Act that makes provisions for the protection of

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<sup>156</sup> Banjul Protocol on Marks, adopted on 19<sup>th</sup> November, 1993 at Banjul, The Gambia

<sup>157</sup> Trade Marks Act No. 194 of 1993

trademarks and geographical indications. It is in the process of amendment to make ensure compliance with the provision of the TRIPS Agreement and Article 6ter of the Paris Convention. The Act is divided into 18 parts.

As earlier noted South Africa is not a wholly common law jurisdiction as it also practices Roman-Dutch law and is also in the process of amending its Trade Mark legislation. The fact that the South African Trade Marks Act is not compliant with the Paris Convention and the TRIPS Agreement will be vivid as will be seen below in comparison with the proposed Zambian Trade Marks Act.

Parts III and IV relate to registrable trademarks and application for registration. These parts *inter alia*, spells out registrable and unregistrable trademarks, registration to be in respect of particular goods or services, name or representation of person, honest concurrent use, registration subject to disclaimer, application for registration, advertisement, registration of parts of trademark, proposed use of trademark by a body corporate to be established and non-completion of registration. The relevant section under these parts is 9 to 20. Under the proposed Zambian trademarks law, these matters are dealt with under Part III of the proposed Trade Marks law under the heading "Registrable Trademark" and consists of section 14 to 32. The proposed Zambian Trade Marks law is much wider as in sync with the Paris Convention and TRIPS Agreement.

Part VIII deals with infringement. This part covers matters such as registration being a condition precedent to an action for infringement, infringement of registered trademark, protection of well-known under the Paris Convention and vested rights. The relevant sections here are 33 to 36. The proposed Trade Marks law deals with these matters as earlier alluded to under Part VIII dealing with infringement, Part XXI dealing with border measures, Part XXIII dealing with appeals and proceedings and Part XXIV dealing with offences and penalties. The proposed Trade Marks Act is wider due to the inclusion of several enforcement provisions ranging from Articles 41 to 61 of the TRIPS Agreement.

Parts XII has sections 42 and 43 which deal exclusively with certification and collective trademarks. The proposed Zambian Trade Mark law makes provision for collective trademarks, certification trademarks and defensive trademarks under Parts XIV, XV & XVI.

Part XVI deals with appeal to and powers of the court as well as offences. The subject here include recourse and appeals to court, notice to Registrar of application to court, courts powers to review Registrar's decision, discretion of court in appeals and procedure in cases of option to apply to court or Registrar. Offences include penalties for fraud in relation to registers, making false statements for purpose of deceiving or influencing Registrar or other officer, falsely representing trademark as registered. This part consists of sections 53 to 62. As noted above the proposed Zambian Trade Marks law is wider due to the inclusion of various TRIPS Agreement enforcement provisions.

Part XVII deals exclusively with international arrangements under section 63. This section contemplates *inter alia*, the obligation of South Africa through the State President, the fulfillment of a treaty, convention, arrangement or engagement by proclamation in the Gazette to declare that any country or group of countries is a convention country or are convention countries for the purpose of all or any of the provisions of the Act. It further explains the application of this particular proviso. The proposed Zambian Trade Marks Act and indeed other common laws jurisdictions that have been referred in this chapter clearly mention the international treaties on trademarks that they are party to and spell out the modalities of protecting international trademarks.

It is evident that Britain, Australia and Kenya, all wholly common law jurisdictions, have their Trade Mark laws crafted in a somewhat similar fashion and seem to be in conformity with the various international obligations most notably the TRIPS Agreement. South Africa on the other hand is in the process of amending its Trade Marks law to ensure compliance with the TRIPS Agreement and Article 6ter of the Paris Convention. The proposed Zambian Trade Marks Act which is also crafted in a similar manner with the three common law countries referred to above, seems to have taken care of the deficiencies that are apparent in the current law most notably the TRIPS Agreement and Madrid Protocol.

An important distinction that needs to be mentioned, however, is that the proposed Zambian Trade Marks Act will include geographical indications while the other four jurisdictions referred to save for Kenya, have their geographical indications legislation crafted in different fashions. The British have a *sui generis* legislation for geographical indication encapsulated in the Trade Descriptions Act<sup>158</sup>. Australia on the other hand has various pieces of legislation<sup>159</sup> that deal with the protection of geographical indications. Kenya does not have any geographical indication legislation whereas South Africa, like Australia also has different pieces of legislation<sup>160</sup> dealing with geographical indications. This proposed Trade Marks legislation is going to be purely a Zambian Act passed by the Zambian Parliament. This development is a departure from the colonial legacy which most of our laws are derived. However, the proposed law is likely to pose some challenges based on the various novel aspects of industrial property matters that will be introduced. The latter part of this chapter will attempt to explore some of the challenges likely to be encountered and offer some possible remedies.

#### **4.6 CHALLENGES AND POSSIBLE REMEDIES POSED BY THE PROPOSED TRADE MARKS ACT**

The first key challenge likely to confront the Industrial Property Office (IPO) is human resource constraint. This will be created by the introduction of new industrial property rights such as servicemarks, geographical indications, trade names which will entail added administrative responsibilities. This challenge will require human resource training and possibly recruitment of new staff in the IPO.

The aspect of enforcement which will *inter alia*, fight against counterfeiting and piracy will probably pose one of the greatest challenges especially now that it will attract both civil and criminal sanctions. This is so because the effectiveness of enforcement will be attributed to the human resources, funding and practical experience in IP enforcement of relevant stakeholders, including relevant ministries and agencies, customs, police and judiciary. There will therefore

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<sup>158</sup> The Trade Descriptions Act, Chapter 29. <http://www.wipo.int/wipolex/en/details.visited> on 14/03/2011

<sup>159</sup> <http://www.wipo.int/wipolex/en/details.visited> on 14/03/2011

<sup>160</sup> <http://www.wipo.int/wipolex/en/details.visited> on 14/03/2011

be need to generate synergies in order to ensure effective enforcement actions against counterfeiting and piracy. A survey conducted by WIPO in 2002 indicated that the principal barrier to eliminating counterfeiting and piracy did not subsist in the substantive law, but rather in the remedies and penalties available (or not available) to stop and deter counterfeiting and piracy.<sup>161</sup> This is perhaps one of the biggest challenges that will be face by all stakeholders in the fight against counterfeiting and piracy. There will be need for cooperation and coordination among all the stakeholders concerning their right and remedies as rights have no real value unless they can be enforced. Counterfeiting relates to trademarks imitation while pirating concerns illicit copies of copyright materials was the finding in the case of **R v Johnstone**<sup>162</sup> The criminalization of counterfeiting and piracy did not originate from the TRIPS Agreement. Counterfeiting is a species of fraud. This was the ruling in the case of **R v Priestly**<sup>163</sup>. The reason for criminalizing IPRs was that 'civil remedies are not effective because counterfeiters are criminals. They do not respect the law, and they strategically and tactically carry out their criminal activities in ways explicitly designed to avoid the justice system, both civil and criminal',<sup>164</sup>

Another likely challenge is the introduction of the protection of trade names. Though this requirement is provided for by Article 8 of the Paris Convention, there are no clear guidelines on how to implement this. It should be noted that trade names or commercial designations are currently regulated a host of legislation namely, the Registration of Business Names Act<sup>165</sup> Companies Act<sup>166</sup> and the Trade Licensing Act<sup>167</sup> and remains to be seen how these statutes will operate in light of this development. This notion of protection of trade names whether registered or not and irrespective of the business undertaking is vague and may be subject to abuse. There is need to clearly state the guidelines that will regulate the protection of trade names or commercial designations bearing in mind the above mentioned statutes including any other

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<sup>161</sup> WIPO Doc., WIPO/E/EIM/3

<sup>162</sup> (2003) UKHL 28

<sup>163</sup> (1996) 2 Cr. App Rep 9 (S) 144

<sup>164</sup> LTC Harms, The enforcement of Intellectual Property: A case Study, 2<sup>nd</sup> Edition, 2008 (WIPO), Page 383

<sup>165</sup> Chapter 389 of the Laws of Zambia

<sup>166</sup> Chapter 388 of the Laws of Zambia

<sup>167</sup> Chapter, 393 of the Laws of Zambia



pieces of legislation available which deal with the subject matter of trade names or commercial designations.

The protection of well-known trademarks is another area which looks likely to pose some challenges. The criteria or factors to be taken into account in determining whether a trademark is well-known in Zambia as listed in section 163 (2) (a) to (e) of the proposed Trade Marks Act remains to be seen how it will be applied by the competent authority who in this case is the IPO. A practical problem that is likely to ensue in this context is whether the trademark must be well-known to all sectors of the public or whether it will be sufficient if it is well-known to the relevant sector of the public that has an interest in the trademark.<sup>168</sup> A classic example where the matter involving well-known trade marks was discussed is the case of **McDonald's Corp v Jorburgers Drive Inn Restaurant (Pty) Ltd**<sup>169</sup>. McDonald's, one of the largest franchisers of fast food restaurants in the world, if not the largest, had not traded nor had it used any of its trademarks in South Africa. A local company decided to establish fast food outlets using trademarks identical to McDonald's and applied for their registration. McDonald's relied on the statutory protection based on Article 6*bis* of the Paris Convention. The question discussed here is what level of awareness in the public mind is required for a mark to qualify as "well known". The court found that the marks were well known in South Africa. In China, the Supreme People's Court of China's interpretation on issues regarding the application of the law in civil trials of unfair competition cases of 1 February 2007 provides that a commodity will be recognized as 'well-known' if it has a certain market reputation in China and is well-known among the relevant members of the public. In determining whether something is well-known, the court will consider factors such as sales period, sales region, sales amount and sales target, and duration, extent and geographical region of promotional activity undertaken, as well as any evidence that the commodity has been recognized as a well-known commodity by the relevant authorities. The burden of proof lies with the plaintiff to establish that the commodity has the necessary market reputation<sup>170</sup>. The US Federal Trademark Dilution Act has a non-exclusive list of factors that should be taken into considered. These include the degree of inherent or acquired distinctiveness of the mark; the duration and extent of use of the mark in connection with the

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<sup>168</sup> LTC Harms, The enforcement of Intellectual Property: Page. 124

<sup>169</sup> (1997) (1) SA 1 (A) (South Africa)

<sup>170</sup> LTC Harms, The enforcement of Intellectual Property. Page 127

goods or services with which the mark is used; the duration and extent of advertising and publicity of the mark; the geographical extent of the trading area in which the mark is used; the channels of trade for the goods or services with which the mark is used; the degree of recognition of the mark in the trading areas and channels of trade used by the marks' owner and the person against whom the injunction is sought and the nature and extent of use of the same or similar marks by third parties<sup>171</sup>.

Another challenge that is likely to unfold is the introduction of a single register for trademarks under section 9 of the proposed Trade Marks Act. It should be noted that well-known trademarks under the current law are registered as defensive trademarks under Part D of the register pursuant to section 32 of the Trade Marks Act. On the other hand, the proposed Trade Marks Act states that there is no need for registration of well-known trademarks. The question that arises is that what will be the effect of well-known defensive trademarks under Part D of the current Trade Marks Act. Likewise, geographical indications (GIs) under the current trademarks regime are registered under Part C of the register of trademarks. The proposed Trade Marks legislation has provided for a separate register for GIs. What will then be the effect of the current GIs protected under Part C of the register of trademarks?

These are very important questions that need redress and the last chapter attempts to offer some very important recommendations that might overcome some of these challenges.

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<sup>171</sup> LTC Harms, *The enforcement of Intellectual Property*. Page 128

## **CHAPTER FIVE**

### **CONCLUSION AND RECOMMENDATIONS**

#### **5.0.0 INTRODUCTION**

This Chapter will focus on the conclusion and recommendations based on the research findings.

#### **5.0.1. CONCLUSION**

It may be recalled that the purpose of the study was analyze the proposed amendments to the current trademark regime in order to determine whether they will be more effective than the current piece of legislation taking into account the Madrid Protocol, TRIPS Agreement and recent developments in the field of trademarks.

#### **5.0.2 The Madrid Protocol**

The Madrid protocol seems to have been adequately covered under Part XX of the draft Trade Marks law dealing with international protection of marks discussed in chapter three. As was discussed in chapter one, the system is administered by the International Bureau of WIPO, which maintains the international register and publishes the gazette on international marks. Any state party to the Paris Convention for the Protection of Industrial Property may become party to the Agreement or the Protocol or both. The objectives of the system are two-fold. Firstly, it facilitates the obtaining of protection for marks (trademarks and service marks). Secondly, since an international registration is equivalent to a bundle of national registrations, the subsequent management of that register is made much easier. In summary, the main advantages for trademark owners consists of simplicity of the international registration system and financial savings made when obtaining and maintaining the protection of their marks abroad. This is vividly absent in the current Trade Marks Act. Additionally, this part is forward looking in that it does not only cater for the Madrid Protocol, but also empowers the Minister to make provisions giving effect to any other treaty or protocol. This proviso ensures that any treaties or instruments related to trademarks that Zambia signs in future are taken care of.

### 5.0.3 The TRIPS Agreement

The implementation of the TRIPS Agreement is a significant challenge to most LDCs including Zambia. This is because its implementation requires the preparation or updating of full range of industrial and intellectual property policies laws and regulations, as prescribed under the Agreement. At the same time, many countries are finding themselves increasingly involved in negotiations that are occurring in parallel at the international, regional and bilateral levels, negotiations that are constantly reshaping the global regime. LDCs are increasingly concerned about TRIPS-plus agreements at the regional and bilateral level, as these tend to require commitments that go beyond the minimum standards set out in the TRIPS Agreement<sup>172</sup>.

The TRIPS Agreement substantially changed the international intellectual property regime by introducing the principle of minimum intellectual property standards. In effect, this principle means that any intellectual property agreement negotiated subsequent to TRIPS among and/or involving WTO members can only create higher standards-commonly known as 'TRIPS-plus'. The TRIPS-plus concept covers both those activities aimed at increasing the level of protection for right holders beyond that which is given in the TRIPS Agreement and aimed at reducing the scope of effectiveness on rights and exceptions<sup>173</sup>.

The TRIPS Agreement is a minimum standards agreement, which allows members to provide more extensive protection of intellectual property if they so wish. The three main features of the TRIPS Agreement are standards, enforcement and dispute resolution. The draft Trade Marks law has taken on board standards and enforcement provisions of the TRIPS Agreement that are absent in the current Trade Mark legislation. Standards in the TRIPS Agreement consists of six Articles, namely, Articles 15 to 21. Some standards that have been included are, *inter alia*, definition of trademarks to include services, expansion of protectable subject matter such as well-known trademarks, collective trademarks, defensive trademarks and geographical indications. The enforcement measures on the other hand consist of Articles 41 to 61 of the TRIPS Agreement. The draft Trade Marks law has provided for these salient provisions which

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<sup>172</sup> M. Leesti & T. Pengelly, 'Assessing Technical Assistant Needs for Implementing TRIPS in LDCs' *A Diagnostic Tool Kit* (August, 2007) 9

<sup>173</sup> S.F. Musungu & G. Dutfield, 'Multilateral Agreements and a TRIPS-plus world' *The World Intellectual Property Organisation (WIPO) (QUNO and QIAP, 2003)* 2

include among others, border measures and criminal procedures which are not present in the current Trade Marks Act.

#### **5.0.4 RECOMMENDATIONS**

The recommendations discussed below by no means exhaust the list of recommendations.

These include:

##### **5.0.5 Accommodate all Stakeholders' views**

Ensure that all key stakeholders coordinate and participate effectively in the reform process towards the development of the legislation and regulation process. This will be essential to the success having wholly Zambian Trade Mark legislation that will ensure that all relevant interests are duly reflected in the final legislative draft. The opportunity should be fully utilized as the final draft is currently with the Ministry of Commerce, Trade and Industry after input from PACRA and the consultants. From MCTI the draft law will be expected to be circulated to other stakeholders for their comments after all, the deadline for the implementation of the TRIPS Agreement is July, 2013, which provide Zambia with enough time to carefully consider all available options<sup>174</sup>.

##### **5.0.6 Build domestic capacity**

There will be need to increase domestic capacity in human resource especially at the IPO. This as has been discussed in the previous chapter, will be necessitated by the introduction of new industrial property rights namely; servicemarks, geographical indications and trade names which will entail added administrative responsibilities. As a result of domestic capacity, many countries rely on foreign technical assistance<sup>175</sup>. Organisations such as WIPO, the WTO, and regional organizations such as ARIPO may be approached for technical assistant and capacity building,

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<sup>174</sup> Based on an interview with the Assistant Registrar (IP) at PACRA conducted on 11<sup>th</sup> March, 2011

<sup>175</sup> C.M. Correa, Designing Intellectual Property Policies in Developing Countries. (Third World Network, 2010)

### **5.0.7 Effective Enforcement of Intellectual Property Rights**

Intellectual Property Rights of all forms are useful and valuable to their holders only if they are capable of being enforced. The enforcement of trademarks will have much greater chance for success if they are well coordinated involving the relevant stakeholders. For Zambia the concept of enforcement and regulation which are new therefore present a challenge to enforcement authorities and regulators who may possess little, if any, specialized knowledge in the field. A key element that will be required to strengthen enforcement of trademark rights is to increase public awareness and understanding. It is therefore incumbent that a policy objective going forward is to ensure that enforcement system that has been formulated addresses serious and significant infringement such as counterfeit and piracy effectively. As was discussed in the previous chapter a survey conducted by WIPO in 2002, found out that the principle barriers to eliminating counterfeiting and piracy did not subsist in the substantive law, but rather the remedies and penalties (or not available) to stop and deter counterfeiting and piracy.

### **5.0.8 Need for Harmonisation of Laws**

The introduction of protection of trade names is fertile ground for potential conflict between the proposed Trade Mark law and existing legislation dealing trade names or commercial designations. The current legislations dealing with this subject matter as discussed in chapter four are the Registration of Business names Act, the Companies Act and the Trade Licensing. There will be need for the harmonization of these laws in order to ensure that they operate in tandem with each other.

### **5.0.9 Effective Protection of Well-known Trademarks**

The protection of well-known trademarks looks set to pose some challenges as noted under chapter four of the research paper. There are two types of protection for well-known trademarks. The first is based on a convention obligation created by Article 6*bis* of the Paris Convention. This protection is available for a peregrine trademark owner whose trademark, even though not registered within the local jurisdiction is well known locally. The second is for well-known registered within the jurisdiction. They may be protected against dilution without confusion. This kind of protection, which is recognized by the TRIPS Agreement, is optional and not obligatory. There will be need to learn from the experiences of other countries that already have

these laws in place. Further the Joint Recommendations Concerning Provision of Well-Known Marks<sup>176</sup> could be utilized. These guidelines are intended to clarify, consolidate and supplement existing international protection of well-known marks as established by Article 6*bis* of the Paris Convention and by Article 16.2 and 16.3 of the TRIPS Agreement.

### 5.1.0 Avoid TRIPS-plus standards

Zambia as a country should be mindful that the space left to make our own choices in IPR policies has been dramatically narrowed down by international agreements. This is precisely what developed countries have historically done without the limitations now imposed by such agreements<sup>177</sup>. The TRIPS Agreement as we now know is a minimum standard agreement and any other agreements negotiated subsequent to TRIPS among and/or involving WTO members can only create higher standards-commonly known as 'TRIPS-plus'. Such intellectual property rules and practices have the effect of reducing the ability of developing countries to protect the public interest and may be adopted at the multilateral, plurilateral, regional and/or national level<sup>178</sup>.

### 5.1.1 Conclusion of recommendations

Professor Correa in his book has raised a number of very pertinent issues which developing countries have to look at when designing Intellectual Property (IP) policies. He argues that the space available for developing countries for shaping their social and economic policies has been significantly eroded since the Second World War, as a result of the operation of a growing set of international rules and institutions<sup>179</sup>.

He further states that a basic premise for the design of an IP policy that addresses development needs is an *instrumental* nature of IP. IPRs are not natural rights but means established by societies to attain objectives that have changed over time and that vary according to the level of development and the policies applied in different countries. An IP policy cannot therefore be reduced to a set of measures that may be adopted to protect innovations and creations. It should be elaborated with the aim of integrating such protection into broader national policies in a

<sup>176</sup> Adopted by WIPO General Assembly, 1999

<sup>177</sup> C.M. Correa, *Designing Intellectual Property Policies in Developing Countries*. Page. 44

<sup>178</sup> S.F. Musungu & G. Dufield, *Multilateral Agreements and a TRIPS-plus world*. Page. 2

<sup>179</sup> C.M. Correa, *Designing Intellectual Property Policies in Developing Countries*. Page.1

manner that promotes *inter alia*, industrial and agricultural development and enhances the realization of people's fundamental rights to health, education and a sound environment<sup>180</sup>.

He concludes by stating that it seems time for developing countries to move from what has been so far an essentially defensive strategy in the area of IP to an offensive stand<sup>181</sup>.

It would be in the best interest of the country to seriously consider some of the issue brought to the fore by Professor Correa to help strengthen not only the Trade marks law but other IP laws namely, the Copyright and Performance Rights Act<sup>182</sup>, Patents Act<sup>183</sup>, the Registered Deigns Act<sup>184</sup> and the Merchandise Marks Act<sup>185</sup>.

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<sup>180</sup> C.M. Correa, Designing Intellectual Property Policies in Developing Countries. Page. 44

<sup>181</sup> C.M. Correa, Designing Intellectual Property Policies in Developing Countries. Page. 45

<sup>182</sup> Chapter 406 of the Laws of Zambia

<sup>183</sup> Chapter 400 of the Laws of Zambia

<sup>184</sup> Chapter 402 of the Laws of Zambia

<sup>185</sup> Chapter 405 of the Laws of Zambia



## BIBLIOGRAPHY

### BOOKS

Correa, C.M. Designing Intellectual Property Policies in Developing Countries. TWN  
Third Word Network, 2010

Harms L.T.C. The Enforcement of Intellectual Property Rights: A Case Book. Geneva  
WIPO Publication 2<sup>nd</sup> Edition, 2008

Kanja, G.M. Intellectual Property Law. Lusaka: UNZA Press, 2006

WIPO Guide to the International Registration of Marks. WIPO Publication, 2009

WIPO Intellectual Property Handbook: Policy, Law and Use. WIPO Publication, 2004

WIPO Worldwide Academy Collection of Documents on Intellectual Property. WIPO  
Publication, 2001

### PUBLICATIONS

Leesti M and Pegelly T. 'Assessing Technical Assistance Needs for Implementing TRIPS  
in LDCs', A Diagnostic Tool Kit 9 (August, 2007)

Musungu S.F. and Dutfield G. 'Multilateral Agreements and a TRIPS-plus world' WIPO  
2 (QUNO and QIAB, 2003)

TradeCom Facility. 'Technical Assistance to the Zambia Ministry of Commerce, Trade  
and Industry in Intellectual Property', Progress Report 3 (August, 2007)

### WEBSITES

<http://www.wto.org>. visited on 4<sup>th</sup> February, 2011

<http://www.wipo.int/wipolex/en/details>. visited on 14<sup>th</sup> March, 2011