

## CHAPTER 26:04 TRADE MARKS ACT

*Acts 2/1974, 44/1975 (s. 14), 15/1981, 29/1981, 11/1991 (s. 18), 20/1994 (s. 8), 22/2001 (s. 4), 10/2001, 3/2016.  
R.G.N. 1135/1975.*

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**AN ACT to consolidate and amend the law relating to the registration of trade marks and certification marks; to provide for the registration and control of the practice of trade mark agents; to protect registered trade marks against forgery; and to provide for matters incidental to or connected with the foregoing.**

[Date of commencement: 1st January, 1975.]

## PART I

### PRELIMINARY

#### 1 Short title

This Act may be cited as the Trade Marks Act [*Chapter 26:04*].

#### 2 Interpretation

(1) In this Act—

“appointed day” means the 1st January, 1975;

“assignment” means assignment by act of the parties concerned;

“certification mark” means a mark registered or deemed to have been registered under Part IX;

“Controller” means the Controller of Patents, Trade Marks and Industrial Designs appointed in terms of paragraph (a) of subsection (2) of section 3 of the Patents Act;

“Convention country” means a country or territory which the President has, in terms of section 79 of the Patents Act, declared to be a Convention country for the purposes of that Act;

“distinguishing guise”, in relation to any goods, means the shape or configuration of containers of the goods;

“examiner” means a person appointed in terms of paragraph (b) of subsection (3) of section *three* to be an examiner;

“legal representative” means—

(a) the liquidator or receiver of a company; or

(b) the representative recognized by law of any person who has died, become insolvent or bankrupt or assigned his estate, is an infant or a minor is of unsound mind or is otherwise under a disability;

“limitations” means any limitations of the exclusive right to the use of a trade mark given by the registration of a person as proprietor thereof, including limitations of that right as to—

(a) the mode of use thereof; or

(b) the use thereof in relation to goods to be sold or otherwise traded in or as to services to be performed in any place within Zimbabwe; or

(c) the use thereof in relation to goods to be exported to, or services to be performed in respect of, a market outside Zimbabwe;

“mark” means any sign which can be represented graphically and is capable of distinguishing the good or services of one undertaking from those of other undertakings;

[Definition amended by Act 10 of 2001]

“Minister” means the Minister of Justice, Legal or Parliamentary Affairs or any other Minister to whom the President may, from time to time, assign the administration of this Act;

“patent agent” means a person who is registered in terms of the Patents Act as a patent agent and is entitled to practise as such;

“Patents Act” means the Patents Act [*Chapter 26:03*];

“permitted use” means permitted use as defined in subsection (2) of section *thirty-three*;

“Register” means the Register of Trade Marks kept at the Trade Marks Office under section *five*;

“registered trade mark” means a trade mark that is entered in the Register in terms of this Act;

“registered user” means a person who is for the time being registered as such under section *thirty-three*;

“Registrar” means the Controller or the Registrar of Trade Marks or an assistant registrar of trade marks appointed under paragraph (a) of subsection (3) of section *three*;

“repealed legislation” means the Trade Marks Act 1957 (No. 14 of 1957) and any subsidiary legislation which, immediately before the appointed day, was in force thereunder;

“trade mark” means a mark which is used or proposed to be used in relation to goods or services for the purpose of—

- (a) indicating a connection in the course of trade between the goods or services and some person having the right, either as proprietor or as registered user, to use the mark, whether with or without any indication of the identity of that person; and
- (b) 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;

but does not include a certification mark;

“trade mark agent” means a person who is registered as such in the Register of Trade Mark Agents;

“Trade Marks Office” means the Trade Marks Office established under section *three*;

“transmission” means transfer by operation of law, devolution on the legal representative of a deceased person or any other mode of transfer not being assignment;

“Tribunal” means the Intellectual Property Tribunal established by section 3 of the Intellectual Property Tribunal Act [*Chapter 26:08*].

[Definition amended by Act 10 of 2001]

(2) Any reference in this Act to the use of a mark shall be construed—

- (a) as a reference to the use of a printed or other visual representation of the mark and, in the case of a distinguishing guise, to the use of such distinguishing guise; and
- (b) if the mark is capable of being audibly reproduced, as including a reference to the use of an audible reproduction of the mark.

(3) Any reference in this Act to the use of a mark—

- (a) in relation to goods, shall be construed as a reference to the use thereof upon, or in physical or other relation to, goods;
- (b) in relation to services, shall be construed as a reference to the use thereof in relation to the performance of such services.

## PART II

### ADMINISTRATION

#### **3 Trade Marks Office, Controller, Registrar of Trade Marks and other officers**

(1) There shall be established an office, to be called the Trade Marks Office, for the registration of trade marks and other matters in terms of this Act.

(2) The Controller shall exercise general supervision and direction of the Trade Marks Office.

(3) There shall be—

- (a) a Registrar of Trade Marks; and
- (b) such number of assistant registrars of trade marks, examiners and other officers as may be necessary for the purposes of this Act; and

who shall in the performance of their functions under this Act be subject to the control of the Controller, and whose offices shall be public offices and form part of the Public Service.

(4) The Registrar, assistant registrars, examiners and other officers shall perform such functions as are conferred upon them in terms of this Act.

#### **4 Seal**

The seal of the Patent Office kept in terms of the Patents Act shall also be the seal of the Trade Marks Office, and impressions thereof made for the purposes of this Act or the repealed legislation shall be judicially noticed.

#### **5 Register of Trade Marks**

(1) There shall be kept at the Trade Marks Office for the purposes of this Act a Register of Trade Marks in which shall be entered all trade marks or certification marks, as the case may be, registered in terms of this Act with—

- (a) the names, addresses and descriptions of their proprietors; and
- (b) particulars of assignments and transmissions; and
- (c) the names, addresses and descriptions of all registered users; and
- (d) disclaimers, conditions, limitations and such other matters relating to such trade marks or certification marks as may be prescribed.

(2) The Register shall be divided into the following Parts—

- (a) Part A, for the registration of distinctive marks that are registrable in terms of section *twelve*; and
- (b) Part B, for the registration of marks that are capable of distinguishing goods and services, as provided in section *thirteen*; and
- (c) Part C, for the registration of certification marks as provided in Part IX; and
- (d) Part D, for the registration of defensive trade marks as provided in section *thirty-two*; and
- (e) such other Parts as the Controller may from time to time determine, for the registration of such other classes of marks as may be provided for by or in terms of this Act.

[Subsection inserted by Act 10 of 2001]

(3) All registers of trade marks established and kept under the repealed legislation shall, under arrangements made by the Controller with the approval of the Minister, be incorporated with and form part of the Register of Trade Marks established under subsection (1) so, however, that such arrangements shall in no way be deemed to extend the term and effect of any trade mark or certification mark registered in such registers beyond the term and effect provided in respect of such mark by this Act, and the trade marks or certification marks so registered shall be deemed to have been registered in terms of this Act.

(4) The Register shall be prima facie evidence of any matter required or authorized by or under this Act to be entered therein or which was required or authorized by or under the repealed legislation to be entered in a register of trade marks referred to in subsection (3).

### PART III

#### EFFECT OF REGISTRATION AND ACTION FOR INFRINGEMENT

#### **6 No action for infringement of unregistered trade mark**

No person shall be entitled to institute any proceedings to prevent, or to recover damages for, the infringement of an unregistered trade mark:

Provided that nothing in this Act shall affect the right of any person, at common law, to bring an action against any other person for unlawful competition or for passing off goods or services as the goods or services of another person.

[Proviso amended by Act 10 of 2001]

#### **7 Registration to be in respect of particular goods or services**

(1) A trade mark shall be registered in respect of a particular class or particular classes of goods or services or in respect of goods or services falling in such class or classes in accordance with such classification as may be prescribed.

(2) Any question arising as to the class within which any goods or services fall shall be determined by the Registrar whose decision shall be final.

#### **8 Infringement of rights given by registration in Part A or Part B**

(1) Subject to this section and to sections *ten* and *eleven*, a registered trade mark shall be infringed by any unauthorised use in the course of trade, whether as a trade mark or otherwise, of a mark that is identical to the registered trade mark or so nearly resembling it as to be likely to deceive or cause confusion, where that mark is used in relation to the same or similar goods or services as those in respect of which the trade mark is registered.

[Subsection substituted by Act 10 of 2001]

(2) In the case of a trade mark registered in Part B of the Register, no interdict or other relief shall be granted in an action for infringement by virtue of paragraph (a) of subsection (1) if the defendant establishes to the satisfaction of the court that the use of which the plaintiff complains is not likely to be taken as indicating a connection in the course of trade between the goods or services concerned and some person having the right, either as proprietor or as registered user, to use the trade mark.

(3) The right to the use of a trade mark given by registration in Part A or Part B of the Register shall be subject to any conditions or limitations entered on the Register and shall not be deemed to be infringed by the use of that trade mark in any mode—

- (a) in relation to goods to be sold or otherwise traded in, or services to be performed, in any place; or
- (b) in relation to goods to be exported to, or services to be performed for, any market; or
- (c) in any other circumstances;

to which, having regard to any such conditions or limitations, the registration does not extend.

(4) The right to the use of a trade mark given by registration in Part A or Part B of the Register shall not be deemed to be infringed by the use of that trade mark by any person—

- (a) in relation to goods connected in the course of trade with the proprietor or registered user of that trade mark if, as to those goods or a bulk of which they form a part, the proprietor or the registered user conforming to the permitted use has—
  - (i) applied that trade mark and has not subsequently removed or obliterated it; or
  - (ii) at any time expressly or impliedly consented to the use of that trade mark; or
- (b) in relation to goods adapted to form part of, or to be accessory to, other goods in relation to which that trade mark has been used without infringement of the right given by paragraph (a) of subsection (1) or might for the time being be so used, if—
  - (i) the use of that trade mark is reasonably necessary in order to indicate that the goods are so adapted; and
  - (ii) neither the purpose nor the effect of the use of that trade mark is to indicate otherwise than in accordance with the fact a connection in the course of trade between any person and the goods.

(5) The use of a registered trade mark, being one of two or more registered trade marks that are identical or nearly resemble each other, in the exercise of the right to the use of that trade mark given by registration in Part A or Part B of the Register shall not be deemed to be an infringement of the right so given to the use of any other of those trade marks.

(6) Where a mark that is identical to a registered trade mark is used as a trade mark in respect of the same goods or services as those in respect of which the registered mark is registered, it shall be presumed for the purposes of this section, unless the contrary is proved, that such use is likely to deceive or cause confusion.

[Subsection inserted by Act 10 of 2001]

## **9 Infringement by breach of certain restrictions**

(1) Where, by a contract in writing made with the proprietor or a registered user of a registered trade mark, a purchaser or owner of goods or person performing services enters into an obligation to the effect that he will not do, in relation to the goods or services, an act specified in subsection (2), any person who, being the owner for the time being of the goods or person for the time being performing the services, as the case may be, and having notice of the obligation, does that act or authorizes it to be done, in relation to the goods or services, in the course of trade or with a view to any dealing therewith in the course of trade shall be deemed thereby to infringe the right to the use of the trade mark given by the registration thereof, unless that person became the owner of the goods or person performing the services as the case may be—

- (a) by purchase for money or money's worth in good faith before receiving notice of the obligation; or
- (b) by virtue of a title derived through another who became the owner as mentioned in paragraph (a).

(2) The acts specified for the purposes of subsection (1) are—

- (a) the application of the trade mark upon the goods after they have suffered alteration in any manner specified in the contract as respects their state or condition, get-up or packing;
- (b) the application of the trade mark in relation to services after they have suffered alteration in any manner specified in the contract as respects their performance;
- (c) in a case in which the trade mark is upon the goods or in relation to the services, the alteration, part removal or part obliteration thereof;
- (d) in a case in which the trade mark is upon the goods or in relation to the services and there is also thereon or in relation thereto other matter, being matter indicating a connection in the course of trade between the proprietor or registered user and the goods or services, the removal or obliteration, whether wholly or partly, of the trade mark unless that other matter is wholly removed or obliterated;
- (e) in a case in which the trade mark is upon the goods or in relation to the services, the application of any other trade mark to the goods or in relation to the services;
- (f) in a case in which the trade mark is upon the goods or in relation to the services, the addition to the goods or in relation to the services of any other matter in writing that is likely to cause injury or prejudice to the reputation of the trade mark.

(3) In this section—

- (a) any reference, in relation to goods or services, to—
  - (i) the proprietor shall be construed as a reference to the proprietor in whose name the trade mark is registered in respect of those goods or services;
  - (ii) a registered user shall be construed as a reference to the person who is the registered user of the trade mark in respect of those goods or services;
  - (iii) the registration of a trade mark shall be construed as a reference to the registration of the trade mark in respect of those goods or services;
- (b) the expression “upon”, when used in relation to any goods, includes a reference to physical relation thereto.



## 9A Entitlement to and nature of civil remedies for infringement

(1) Subject to this Act, an infringement of a registered trade mark shall be actionable at the suit of the proprietor and any registered user of the mark.

(2) Subject to this Act, in any proceedings for an infringement of a registered trade mark there shall be available to the plaintiff all such remedies by way of damages, interdict, attachment, the rendering of account, the delivery of improperly marked goods or of articles used or intended to be used for marking goods or otherwise, as are available in respect of the infringement of any other proprietary right.

[Section inserted by Act 10 of 2001]

## 9B Forum in which remedies for infringement may be sought

Proceedings in respect of an infringement of a registered trade mark may be instituted—

- (a) in the Tribunal; or
- (b) in the High Court; or
- (c) subject to the jurisdictional limits provided for in the Magistrates Court Act [*Chapter 7:10*], in a magistrates court:

Provided that the Tribunal shall not have jurisdiction to entertain criminal proceedings.

[Section inserted by Act 10 of 2001]

## 9C Damages in infringement proceedings

(1) Damages for an infringement of a registered trade mark may, at the option of the person seeking them, be calculated on the basis of the amount that a registered user would reasonably have been expected to pay under the circumstances for his use of the trade mark concerned:

Provided that, if the person seeking damages intends to exercise this option, he shall give notice of his intention, in writing, to any registered user of the trade mark concerned.

(2) In determining the amount of damages in proceedings for an infringement of a registered trade mark, the Tribunal or court shall take the following factors into account, in addition to all other material considerations—

- (a) the extent and nature of the infringement; and
- (b) the amount which could be payable to the proprietor in respect of the use of the trade mark by some other person.

(3) Where in proceedings for an infringement of a registered trade mark it is established that an infringement was committed and the Tribunal or court, having regard to—

- (a) the flagrancy of the infringement; and
- (b) any benefit shown to have accrued to the person responsible for the infringement as a result of it;

is satisfied that effective relief would not otherwise be available to the plaintiff or applicant, the Tribunal or court shall have power to award such additional damages as it thinks fit.

(4) Where in proceedings for an infringement of a registered trade mark it is established that an infringement was committed but that at the time of the infringement the person responsible for it was not aware and had no reasonable grounds for suspecting that he was not entitled to engage in the infringing activity, the plaintiff or applicant shall not be entitled under this section to any damages against that person in respect of the infringement.

[Section inserted by Act 10 of 2001]

## 9D Anton Piller orders

(1) If a person who has instituted or intends instituting proceedings for an infringement of a registered trade mark satisfies the Tribunal or a court that, *prima facie*—

- (a) he has a cause of action against another person which he intends to pursue; and
- (b) the other person has in his possession documents or other things of whatsoever nature which constitute evidence of great importance in substantiation of that cause of action; and
- (c) there is a real and well-founded apprehension that the documents or other things may be hidden, destroyed or rendered inaccessible before discovery can be made in the usual way;

the Tribunal or court, as the case may be, may make such order as it considers necessary or appropriate to secure the preservation of the documents or things as evidence.

(2) An order in terms of subsection (1) may be granted without notice to the person who is allegedly in possession of the documents or other things to which the order relates, and the Tribunal or court may sit *in camera* for the purpose of hearing an application for such an order:

Provided that the Tribunal or Court shall not grant an order without such notice unless it is satisfied that there is a real possibility that the documents or things will be hidden, destroyed or rendered inaccessible if notice is given.

(3) An order in terms of subsection (1) may be granted on such conditions, including the giving of security by the applicant, as the Tribunal or court may fix.



(4) This section shall not be taken to limit any power a court may have under its ordinary jurisdiction to grant orders such as are referred to in this section.

[Section inserted by Act 10 of 2001]

## 9E Protection of familiar foreign marks

(1) In this section—

“familiar foreign mark” means a mark which is well known in Zimbabwe as being the mark of a person who—

- (a) is a national of a Convention country; or
- (b) is domiciled in, or has a real and effective industrial or commercial establishment in, a Convention country;

whether or not that person carries on business or has any goodwill in Zimbabwe.

(2) On application by the proprietor of a familiar foreign mark, the Tribunal or a court of competent jurisdiction may prohibit the use in Zimbabwe of a trade mark which constitutes, or the essential part of which constitutes, a reproduction, imitation or translation of the familiar foreign mark, where the trade mark is being or will be used in relation to—

- (a) goods or services which are identical or similar to the goods or services in respect of which the familiar foreign mark is well known in Zimbabwe, where such use is likely to deceive or cause confusion; or
- (b) goods or services which are not similar to those in respect of which the familiar foreign mark is well known in Zimbabwe, if—
  - (i) the use of the trade mark in relation to those goods or services would indicate a connection between them and the proprietor of the familiar foreign mark; and
  - (ii) the interests of the proprietor of the familiar foreign mark are likely to be injured by such use; and
  - (iii) the familiar foreign mark is registered as a trade mark in the Convention country concerned.

(3) The proprietor of the familiar foreign marks, shall, within a month of instituting infringement procedures, apply for the registration of the said mark in Zimbabwe.

[Section inserted by Act 10 of 2001]

## 10 Saving of vested rights

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

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

whichever is the earlier, or, on such use being proved, to object to that person being registered in the Register for that identical or nearly resembling trade mark in respect of those goods or services under subsection (2) of section *fifteen*.

## 11 Saving of use of name, address or description of goods and of utilitarian features of distinguishing guise

(1) The registration of a trade mark shall not interfere with—

- (a) any bona fide use by a person of—
  - (i) his own name or the name of his place of business; or
  - (ii) the name of any of his predecessors in business or the name of any such predecessor’s place of business; or
- (b) the use by any person of any bona fide description of the character or quality of his goods or services.

(2) The registration of a distinguishing guise shall not prevent the bona fide use by any person of any utilitarian or functional feature embodied in that distinguishing guise.

## PART IV

### REGISTRABILITY AND VALIDITY OF REGISTRATION

## 12 Distinctiveness requisite for registration in

### Part A

(1) In order to be registrable in Part A of the Register, a trade mark shall contain or consist of at least one of the following essential particulars—

- (a) the name of a company, individual or firm, represented in a special or particular manner;
- (b) the signature of the applicant for registration or some predecessor in his business;

- (c) an invented word or invented words;
- (d) a word or words having no direct reference to the character or quality of the goods or services concerned and not being, according to its or their ordinary signification, a geographical name or a surname:

Provided that a word or words shall not be regarded as being, according to its or their ordinary signification, a geographical name or a surname if the trade mark contains an additional essential particular that makes the intended significance clear beyond doubt;

- (e) any other distinctive mark:

Provided that a name, signature or word which does not, or words which do not, fall within the descriptions in paragraphs (a), (b), (c) and (d) shall not be registrable under the provisions of this paragraph except upon evidence of its or their distinctiveness.

- (2) For the purposes of subsection (1)—

“distinctive” means apt, in relation to the goods or services in respect of which the trade mark is proposed to be registered, to distinguish goods or services with which the proprietor of the trade mark is or may be connected in the course of trade from goods or services in the case of which no such connection subsists, either generally or, where the trade mark is proposed to be registered subject to limitations, in relation to use within the extent of the registration.

- (3) In determining whether a trade mark is apt to distinguish as mentioned in subsection (2), the Registrar may have regard to the extent to which—

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

- (4) Where—

- (a) an application has been made for registration of a trade mark in Part A of the Register; and

- (b) before the date of the application—

- (i) the trade mark was, with the consent and authority of the applicant, used by a person other than the applicant and the applicant exercised control over the character or quality of the goods or services of that other person in respect of which the trade mark was used; and
- (ii) the use of the trade mark by that other person was in accordance with any conditions set out in the application referred to in paragraph (c); and
- (iii) the connection in the course of trade that existed between the applicant and that other person was made known; and

- (c) an application has been made by the applicant and that other person for the registration of that other person as a registered user of the trade mark; and

- (d) the Registrar is satisfied that that other person would be entitled to be registered as a registered user of the trade mark immediately after the registration of the trade mark;

the Registrar may, for the purpose of determining whether the trade mark is distinctive of the goods or services of the applicant, treat the use of the trade mark by that other person as equivalent to the use of the trade mark by the applicant.

- (5) Notwithstanding anything to the contrary contained in this section, a distinguishing guise shall only be registrable in Part A of the Register if—

- (a) it has been so used in Zimbabwe by the applicant or his predecessor in title as to have become distinctive at the date of the application; and
- (b) the registration of that distinguishing guise, in relation to the goods concerned, is not likely to limit unreasonably the development of any art or industry.

- (6) A trade mark may be registered in Part A of the Register notwithstanding any registration in Part B of the Register in the name of the same proprietor of the same trade mark or any part or parts thereof.

- (7) An appeal shall lie from any decision of the Registrar under this section.

### **13 Capability of distinguishing requisite for registration in Part B**

(1) In order to be registrable in Part B of the Register, a trade mark shall be capable, in relation to the goods or services in respect of which it is proposed to be registered, of distinguishing goods or services with which the proprietor of the trade mark is or may be connected in the course of trade from goods or services in the case of which no such connection subsists, either generally or, where the trade mark is proposed to be registered subject to limitations, in relation to use within the extent of the registration.

(2) In determining whether a trade mark is capable of distinguishing as mentioned in subsection (1), the Registrar may have regard to the extent to which, by reason of the use of the trade mark or of any other circumstances, the trade mark is in fact capable of so distinguishing or is capable of becoming distinctive as referred to in section *twelve*.

(3) Where—

- (a) an application has been made for the registration of a trade mark in Part B of the Register; and
- (b) before the date of the application the trade mark was used by a person other than the applicant in the circumstances referred to in paragraph (b) of subsection (4) of section *twelve*; and
- (c) an application has been made by the applicant and that other person for the registration of that other person as a registered user of the trade mark; and
- (d) the Registrar is satisfied that that other person would be entitled to be registered as a registered user of the trade mark immediately after the registration of the trade mark;

the Registrar may, for the purpose of determining whether the trade mark is capable of distinguishing as mentioned in subsection (1) the goods or services of the applicant, treat the use of the trade mark by that other person as equivalent to use of the trade mark by the applicant.

(4) A trade mark may be registered in Part B of the Register notwithstanding any registration in Part A of the Register in the name of the same proprietor of the same trade mark or any part or parts thereof.

(5) Notwithstanding anything to the contrary contained in this section, a distinguishing guise shall not be registrable in Part B of the Register.

(6) An appeal shall lie from any decision of the Registrar under this section.

#### **14 Prohibition of registration or maintenance of registration of deceptive, etc., matter**

(1) A mark—

- (a) the use of which would be likely to deceive or cause confusion; or
- (b) the use of which would be contrary to law; or
- (c) which comprises or contains scandalous matter; or
- (d) which is prescribed to be a prohibited mark; or
- (e) which, for any other reason, would not be entitled to protection in a court of law;

shall not be registered as a trade mark.

(2) It shall not be lawful to maintain the registration of a trade mark which, through fault or neglect on the part of the registered proprietor or his assignee, has become one which is likely to deceive or cause confusion or which, for any other reason, would not be entitled to protection in a court of law.

(2a) Without derogation from subsection (1) or (2), the Registrar shall, on his own initiative or at the request of an interested party, refuse or invalidate the registration of a trade mark which contains or consists of a geographical indication with respect to goods not originating in the territory indicated, if use of the indication in the trademark of such goods in Zimbabwe is of such a nature as to mislead the public as to the true nature of origin.

[Subsection inserted by Act 10 of 2001]

(3) Where, in the opinion of the Registrar, a trade mark will in use be likely to deceive or cause confusion as to the character or quality of some, but not all, of the goods or services included in the appropriate classification referred to in section *seven*, the Registrar may, notwithstanding subsection (1) of section *thirty-one*, upon receipt of an undertaking by the proprietor of the trade mark that he will limit the use of the trade mark to goods or services in relation to which such use will, in the opinion of the Registrar, not be likely to deceive or cause confusion, register the trade mark in respect of the goods or services concerned and of some or all of the other goods or services included in the appropriate classification referred to in section *seven*.

#### **15 Prohibition of registration of identical or resembling trade marks**

(1) Subject to subsection (2), no trade mark shall be registered in respect of any goods or services or description of goods or services that—

- (a) is identical with a trade mark belonging to a different proprietor and already on the Register in respect of the same goods or services or description of goods or services; or
- (b) so nearly resembles a trade mark belonging to a different proprietor and already on the Register in respect of the same goods or services or description of goods or services as to be likely to deceive or cause confusion; or
- (c) could, if it were registered, be the subject of an order under section *nine E* prohibiting its use on the ground that it is a reproduction, imitation or translation of a familiar foreign mark as defined in that section.

[Paragraph inserted by Act 10 of 2001]

(2) In the case of honest concurrent use or other special circumstances which, in the opinion of the Registrar, make it proper so to do, the Registrar may permit the registration of trade marks that are identical or nearly resemble

each other in respect of the same goods or services or description of goods or services by more than one proprietor, subject to such conditions or limitations, if any, as the Registrar may think it right to impose.

(3) Where separate applications are made by different persons to be registered as proprietors respectively of trade marks that are identical or nearly resemble each other in respect of the same goods or services or description of goods or services, the Registrar may refuse to register any of them until their applications have been referred in accordance with the prescribed procedure to the Tribunal and their rights determined or their rights have been settled by agreement in a manner approved by the Registrar.

(4) Where the Registrar, in carrying out his duties under this section, has to consider any matter involving deception or confusion, he shall have regard to the likelihood of deception or confusion arising between any trade mark as applied in relation to goods and any trade mark as applied in relation to services.

(5) An appeal shall lie from any decision of the Registrar under this section.

### **15A Prohibition of registration of State emblems, etc.**

A mark cannot be validly registered if it is identical with, or is an imitation of or contains as a element, an armorial bearing, flag and other emblem, a name or abbreviation or initials of the name of, or official sign or hallmark adopted by any State, intergovernmental organisation or organisation created by an international convention, unless authorised by the competent authority of that State or organisation.

[Section inserted by Act 10 of 2001]

### **16 Registration in Part A to be conclusive as to validity after five years**

In all legal proceedings relating to a trade mark registered in Part A of the Register, including applications under section *thirty-seven*, the original registration of the trade mark in Part A of the Register shall, after the expiration of five years from the date of that registration, be taken to be valid in all respects, unless—

- (a) that registration was obtained by fraud; or
- (b) the trade mark offends against section *fourteen*:

Provided that this section shall not preclude the expunging or variation in terms of subsection (2) of *section thirty-eight* of the registration of a distinguishing guise.

### **17 Registration subject to disclaimer**

(1) Subject to subsection (2), if a trade mark—

- (a) contains any part not separately registered by the proprietor as a trade mark; or
- (b) contains matter common to the trade or otherwise of a non-distinctive character;

the Registrar, in deciding whether the trade mark shall be entered or shall remain on the Register, may require, as a condition of its being on the Register, that—

- (i) the proprietor shall disclaim any right to the exclusive use of any part of the trade mark or to the exclusive use of all or any portion of such trade mark as aforesaid, to the exclusive use of which the Registrar holds him not to be entitled; or
- (ii) the proprietor shall make such other disclaimer as the Registrar may consider necessary for the purposes of defining his rights under the registration.

(2) A disclaimer on the Register shall not—

- (a) affect any rights of the proprietor of a trade mark except such as arise out of the registration of the trade mark in respect of which the disclaimer is made; or
- (b) prejudice or affect any right the proprietor may have in relation to another application for registration at a later date if the disclaimed matter is, at that later date, deemed to have become distinctive in connection with his goods or services.

### **18 Requirements in regard to blank spaces**

If—

- (a) a trade mark contains any blank space or spaces apparently intended for added matter; and
- (b) the Registrar is satisfied that there would be no likelihood of deception or confusion being caused by the use of that trade mark;

the Registrar, in deciding whether the trade mark shall be entered on the Register, may require, as a condition of its being entered on the Register, that the blank space or spaces shall, in use—

- (i) be left vacant; or
- (ii) be occupied only by either or both of the following—
  - A. matter which is wholly descriptive or does not have the character of a trade mark; or
  - B. an associated trade mark which is registered in respect of one or more of the goods or services in respect of which the trade mark containing the blank space or spaces is proposed to be registered and which is specified by the Registrar.

## 19 Words used as name or description of an article, substance or service

(1) The registration of a trade mark shall not be deemed to have become invalid by reason only of any use, after the date of the registration, of a word or words which the trade mark contains or of which it consists, as the name or description of an article, substance or service:

Provided that if it is proved—

- (a) that there is a well known and established use of the word or words as the name or description of the article, substance or service by a person or persons carrying on a trade therein, not being use in relation to goods or services connected in the course of trade with the proprietor or a registered user of the trade mark or, in the case of a certification mark, goods or services certified by the proprietor; or
- (b) that—
  - (i) the article or substance was formerly manufactured or the service was formerly performed under a patent; and
  - (ii) a period of two years or more after the cesser of the patent has elapsed; and
  - (iii) the word or words is or are the only practicable name or description of the article, substance or service, as the case may be;

the provisions of subsection (2) shall have effect.

(2) Where the facts mentioned in paragraph (a) or (b) of the proviso to subsection (1) are proved with respect to any word or words, then—

- (a) if the trade mark consists solely of that word or those words, the registration of the trade mark, so far as regards registration in respect of the article, substance or service in question or of any goods or services of the same description, shall be deemed, for the purposes of section *thirty-seven*, to be an entry wrongly remaining on the Register;
- (b) if the trade mark contains that word or those words and other matter, the Registrar, in deciding whether the trade mark shall remain on the Register, so far as regards registration in respect of the article, substance or service in question and of any goods or services of the same description, may, if there is a decision in favour of its remaining on the Register, require, as a condition thereof, that the proprietor shall disclaim any right to the exclusive use in relation to that article, substance or service and any goods or services of the same description of that word or those words:

Provided that no disclaimer on the Register shall affect any rights of the proprietor of a trade mark except such as arise out of the registration of the trade mark in respect of which the disclaimer is made;

- (c) for the purposes of any other legal proceedings relating to the trade mark—
  - (i) if the trade mark consists solely of that word or those words, all rights of the proprietor, whether under the common law or by registration, to the exclusive use of the trade mark in relation to the article, substance or service in question or to any goods or services of the same description; or
  - (ii) if the trade mark contains that word or those words and other matter, all such rights of the proprietor to the exclusive use of that word or those words in relation to the article, substance or service in question or to any goods or services of the same description;

shall be deemed to have ceased on the date at which the use mentioned in paragraph (a) of the proviso to subsection (1) first became well known and established or at the expiration of the period of two years mentioned in subparagraph (ii) of paragraph (b) of that proviso, as the case may be.

(3) No word which is the commonly used and accepted name of any single chemical element or single chemical compound, as distinguished from a mixture, shall be registered as a trade mark in respect of a chemical substance or preparation, and any such registration in force at the appointed day or thereafter shall, notwithstanding anything in section *sixteen*, be deemed, for the purposes of section *thirty-seven*, to be an entry made in the Register without sufficient cause or an entry wrongly remaining on the Register, as the circumstances may require:

Provided that this subsection shall not have effect in relation to a word which is used to denote only a brand or make of the element or compound as made by the proprietor or a registered user of the trade mark, as distinguished from the element or compound as made by others, and in association with a suitable name or description open to public use.

## 20 Effect of limitation as to colour and of absence thereof

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

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



## PART V

## PROCEDURE FOR, AND DURATION OF, REGISTRATION IN PART A OR PART B

**21 Application for registration in Part A or Part B**

- (1) Any person who—
- (a) claims to be the proprietor of a trade mark used or proposed to be used by him; and
  - (b) is desirous of registering that trade mark; shall apply in writing to the Registrar in the prescribed manner for registration in Part A or Part B, as the case may be, of the Register.
- (2) Subject to this Act, the Registrar, on receipt of an application in terms of subsection (1), may—
- (a) refuse the application; or
  - (b) accept the application absolutely or subject to such amendments, modifications, conditions or limitations, if any, as he may think fit.

(3) In the case of an application for registration of a trade mark in Part A of the Register, the Registrar may, if the applicant is willing, instead of refusing the application, treat it as an application for registration in Part B of the Register and deal with the application accordingly.

(4) In the case of a refusal or conditional acceptance of an application for registration, the Registrar shall, if required by the applicant, state in writing the grounds of his decision and the materials used by him in arriving thereat, and the decision of the Registrar shall be subject to appeal.

(5) An appeal under this section shall be made in the prescribed manner and on the appeal the Tribunal shall, if required, hear the applicant and the Registrar and shall otherwise deal with such appeal in accordance with Part XII.

(6) An appeal under this section shall be heard on the materials stated by the Registrar in terms of subsection (5) and no further grounds of objection to the acceptance of the application shall be allowed to be taken by the Registrar, other than those so stated by him, except by leave of the Tribunal, and where any further grounds of objection are taken, the applicant shall be entitled to withdraw his application without payment of costs on giving notice as prescribed.

- (7) The Registrar may, at any time before or after acceptance—
- (a) correct any error in or in connection with the application; or
  - (b) permit the applicant to amend his application upon such terms as the Registrar may think fit:

Provided that the Registrar shall not permit an amendment which substantially affects the identity of the trade mark.

(8) Where the Tribunal is considering an appeal from a decision of the Registrar in terms of subsection (4), the Tribunal may permit the applicant to amend his application in terms of subsection (7) without the application for such amendment being made to the Registrar, but in such case the views of the Registrar on the amendment shall be obtained.

**22 Opposition to registration and appeals**

(1) When an application for registration of a trade mark has been accepted, whether absolutely or subject to amendments, modifications, conditions or limitations, the applicant shall, as soon as may be after acceptance, advertise in the prescribed manner the application as accepted and the advertisement shall set forth all conditions and limitations subject to which the application has been accepted:

Provided that the Registrar may direct that an application shall be advertised before acceptance—

- (a) if it is made under paragraph (e) of subsection (1) of section *twelve*; or
- (b) in any other case where it appears to the Registrar that it is expedient by reason of any exceptional circumstances so to do;

and where an application has been so advertised, the Registrar may, if he thinks fit, direct that it shall be advertised again when it has been accepted.

(2) Any person may, within the prescribed time from the date of the advertisement of an application, give notice to the Registrar of opposition to the registration, which notice shall—

- (a) be given in writing in the prescribed manner; and
- (b) include a statement of the grounds of opposition.

(3) The Registrar shall send a copy of any notice in terms of subsection (2) to the applicant and, within the prescribed time after receipt thereof, the applicant shall send to the Registrar in the prescribed manner a counter-statement of the grounds on which he relies for his application and if he does not do so, he shall be deemed to have abandoned his application.

- (4) If the applicant sends a counter-statement in terms of subsection (3), the Registrar shall—
- (a) furnish a copy thereof to the persons giving notice of opposition; and



(b) after hearing the parties, if so required, and considering the evidence, decide whether, and subject to what amendments, modifications, conditions or limitations, if any, registration is to be permitted.

(5) An appeal shall lie from any decision of the Registrar under this section, other than a decision in terms of paragraph (a) of subsection (10).

(6) An appeal under this section shall be made in the prescribed form and manner and on the appeal the Tribunal shall—

(a) if required, hear the parties and the Registrar; and

(b) make an order determining whether, and subject to what amendments, modifications, conditions or limitations, if any, registration is to be permitted.

(7) On the hearing of an appeal under this section, any party may, either in the manner prescribed or by special leave of the Tribunal, bring forward further material for the consideration of the Tribunal.

(8) On an appeal under this section, no further grounds of objection to the registration of a trade mark shall be allowed to be taken by the opponent or the Registrar, other than those stated in terms of this section by the opponent, except by leave of the Tribunal, and where any further grounds of objection are taken, the applicant, on giving notice as prescribed, shall be entitled to withdraw his application without payment of the costs of the opponent.

(9) On an appeal under this section, the Tribunal may, after hearing the Registrar, permit the trade mark proposed to be registered to be modified in any manner not substantially affecting the identity thereof, and may direct that the trade mark as so modified shall be advertised in the prescribed manner before being registered.

(10) Notwithstanding anything to the contrary contained in this section, where—

(a) the Registrar considers that by reason of any point of law involved or of the unusual importance or complexity of the matter it is desirable to do so; or

(b) the applicant and all persons who have given notice of opposition so request;

the Registrar, instead of deciding the matter as required by paragraph (b) of subsection (4), shall refer the matter to the Tribunal for decision and shall thereafter, in relation to the matter, act in accordance with the decision of the Tribunal.

(11) Regulations made in terms of section *one hundred and four* may provide for the granting of an extension of the time prescribed for the doing of any thing in terms of this section.

## **23 Registration**

(1) When an application for registration of a trade mark has been accepted and the application—

(a) has not been opposed and the time for notice of opposition has expired; or

(b) has been opposed and the opposition has been decided in favour of the applicant;

the Registrar shall register the trade mark in Part A or Part B, as the case may be, of the Register and the trade mark, when registered, shall be registered as at the date of the application for registration, and that date shall be deemed, for the purposes of this Act, to be the date of registration:

Provided that—

(i) where the Registrar is satisfied that the trade mark has been accepted in error or that, in the special circumstances of the case, the trade mark should not be registered or should be registered subject to amendments, modifications, conditions or limitations or to additional or different amendments, modifications, conditions or limitations, he may withdraw the acceptance and proceed as if the application had not been accepted;

(ii) the provisions of this subsection, relating to the date as at which a trade mark shall be registered and to the date to be deemed to be the date of registration, shall, as respects a trade mark referred to in subsection (1) of section *ninety-seven*, have effect subject to the provisions of that section.

(2) On the registration of a trade mark, the Registrar shall issue to the applicant a certificate in the prescribed form of the registration thereof sealed with the seal of the Trade Marks Office.

(3) Where the registration of a trade mark is not completed within twelve months from the date of the application by reason of default on the part of the applicant, the Registrar may, after giving notice of the non-completion to the applicant in writing in the prescribed manner, treat the application as abandoned, unless it is completed within the time specified in the notice.

## **24 Duration and renewal of registration**

(1) Subject to subsection (6), the registration of a trade mark shall be for a period of ten years but may be renewed from time to time in accordance with the provisions of this section.

(2) Subject to this section, the registered proprietor of a trade mark may, in the prescribed manner and within the prescribed period, renew the registration of the trade mark for a period of ten years from the expiration of the last registration.

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

Provided that a period of grace of six months shall be allowed for the late payment of the renewal fee.

[Proviso inserted by Act 10 of 2001]

(4) Where a trade mark has been removed from the Register for non-payment of the fee for renewal, it shall nevertheless, for the purpose of any application for the registration of a trade mark during one year next after the date of the removal, be deemed to be a trade mark that is on the Register:

Provided that this subsection shall not have effect where the Registrar is satisfied that—

- (a) there has been no bona fide trade use in Zimbabwe of the trade mark that has been removed during the three years immediately preceding its removal; or
- (b) no deception or confusion would be likely to arise from the use of the trade mark that is the subject of the application for registration by reason of any previous use of the trade mark that has been removed from the Register.

(5) Where—

- (a) a trade mark has been removed from the Register for non-payment of the fee for renewal; and
- (b) the proprietor of the trade mark—
  - (i) applies in the prescribed manner within three years of such removal for the trade mark to be restored to the Register; and
  - (ii) furnishes with his application a declaration in the prescribed form that the trade mark has bona fide been used in trade in Zimbabwe during the period from the date of removal or reasons satisfactory to the Registrar as to why there has been no such bona fide trade use;

the Registrar may, subject to any conditions referred to in subsection (3), restore that trade mark to the Register with effect from the date on which it was removed, and thereupon that trade mark shall be regarded for all purposes as though it had not been removed from the Register.

(6) Where—

- (a) a trade mark was registered before the appointed day in a register of trade marks kept under the repealed legislation the period of such registration shall be seven years from the date of such registration;
- (b) the registration of a trade mark has been renewed under the repealed legislation the period of such renewal shall be fourteen years from the expiration of the last registration under the repealed legislation.

(7) An appeal shall lie from any decision of the Registrar under this section.

(8) In this section—

“expiration of the last registration”, in relation to a trade mark, means the expiration in terms of this Act or the repealed legislation, as the case may be, of the original registration of the trade mark or of the last renewal of registration, as the case may be.

## 25 Registration of parts of trade marks

(1) Where the proprietor of a trade mark claims to be entitled to the exclusive use of any part thereof separately, he may apply to register the whole and any such part as separate trade marks shall—

(2) Each separate trade mark referred to in subsection (1) shall—

- (a) satisfy all the conditions of an independent trade mark; and
- (b) subject to the provisions of subsection (3) of section *thirty* and of subsection (2) of section *thirty-five*, have all the incidents of an independent trade mark.

## 26 Registration of trade marks as a series

Where a person claiming to be the proprietor of several trade marks in respect of the same goods or services or description of goods or services which, while resembling each other in the material particulars thereof, yet differ in respect of—

- (a) statements of the goods or services in relation to which they are respectively used or proposed to be used; or
- (b) statements of number, price, quality or names of places; or
- (c) other matter of a non-distinctive character which does not substantially affect the identity of the trade mark; or
- (d) colour; seeks to register those trade marks, they may be registered as a series in one registration.

## PART VI

## ASSIGNMENT AND TRANSMISSION

**27 Powers of, and restriction on, assignment and transmission**

(1) Notwithstanding any law to the contrary, a registered trade mark shall be, and shall be deemed always to have been, assignable and transmissible, either in connection with or without the goodwill of the business concerned in the goods or services in respect of which the trade mark is registered.

(2) A registered trade mark shall be, and shall be deemed always to have been, assignable and transmissible in respect either of all the goods or services in respect of which it is registered or was registered, as the case may be, or of some, but not all, of those goods or services.

(3) Subsections (1) and (2) shall have effect in the case of an unregistered trade mark used in relation to any goods or services as they have effect in the case of a registered trade mark registered in respect of any goods or services, if—

- (a) at the time of the assignment or transmission of the unregistered trade mark, it is or was used in the same business as a registered trade mark; and
- (b) it is or was assigned or transmitted at the same time to the same person as that registered trade mark and in respect of goods or services, all of which are goods or services in relation to which the unregistered trade mark is or was used in that business and in respect of which that registered trade mark is or was assigned or transmitted.

(4) Notwithstanding anything in subsections (1) to (3), a trade mark shall not be, or be deemed to have been, assignable or transmissible in a case in which, as a result of an assignment or transmission, there would in the circumstances subsist, or have subsisted, whether under the common law or by registration, exclusive rights in more than one of the persons concerned to the use, in relation to the same goods or services or description of goods or services, of trade marks nearly resembling each other or of identical trade marks if, having regard to the similarity of the goods or services and of the trade marks, the use of the trade marks in exercise of those rights would be, or have been, likely to deceive or cause confusion:

Provided that where a trade mark is, or has been, assigned or transmitted in such a case as aforesaid, the assignment or transmission shall not be deemed to be, or to have been, invalid under this subsection if the exclusive rights subsisting as a result thereof in the persons concerned respectively are, or were, having regard to limitations imposed thereon, such as not to be exercisable by two or more of those persons in relation to—

- (a) goods to be sold or otherwise traded in within Zimbabwe, otherwise than for export therefrom; or
- (b) goods to be exported to the same market outside Zimbabwe; or
- (c) services to be performed within Zimbabwe.

(5) Where the proprietor of a registered trade mark who proposes to assign that trade mark in respect of any goods or services in respect of which it is registered submits to the Registrar in the prescribed manner a statement of case setting out the circumstances—

- (a) the Registrar may issue to him a certificate stating whether, having regard to the similarity of the goods or services and of the trade marks referred to in the case, the proposed assignment of the first-mentioned trade mark would or would not be invalid under subsection (4); and
- (b) a certificate issued in terms of paragraph (a) shall, subject to the provisions of this section as to appeal and unless it is shown that the certificate was obtained by fraud or misrepresentation, be conclusive as to the validity or invalidity under subsection (4) of the assignment in so far as such validity or invalidity depends upon the facts set out in the case:

Provided that a certificate in favour of validity shall be so conclusive only if application under section *twenty-nine* for the registration of the title of the person becoming entitled is made within six months from the date on which the certificate is issued.

(6) Notwithstanding anything in subsections (1) to (3), a trade mark shall not, on or after the appointed day, be assignable or transmissible in a case in which, as a result of an assignment or transmission thereof, there would in the circumstances subsist, whether under the common law or by registration—

- (a) an exclusive right in one of the persons concerned to the use of the trade mark limited to use in relation to goods to be sold or otherwise traded in or services to be performed in a place or places in Zimbabwe; and
- (b) an exclusive right in another of those persons to the use of a trade mark nearly resembling the first-mentioned trade mark or of an identical trade mark in relation to the same goods or services or description of goods or services limited to use in relation to goods to be sold or otherwise traded in or services to be performed in another place or other places in Zimbabwe:

Provided that on application in the prescribed manner by the proprietor of a trade mark who proposes to assign it or of a person who claims that a trade mark has been transmitted to him or to a predecessor in title of his on or after the appointed day, the Registrar, if he is satisfied that in all the circumstances the use of the trade marks in exercise of the said rights would not be contrary to the public interest, may approve the assignment or transmission, and an assignment or transmission so approved shall not be deemed to be, or to have been, invalid under this subsection or under subsection (4), so, however, that in the case of a registered trade mark this provision shall not have effect unless application under section *twenty-nine* for the registration of the title of the person becoming entitled is made within six months from the date on which the approval is given or, in the case of a transmission, was made before that date.

(7) Notwithstanding anything contained in subsections (1) and (2) and subject to subsections (4) and (6), where a trade mark which is the subject of an application for registration has, subsequent to the date of the application, been assigned or transmitted, the Registrar may, on application in the prescribed manner and subject to such conditions as he may deem necessary, allow, on payment of the prescribed fee, the person or persons entitled to such trade mark by reason of such assignment or transmission to be substituted as the applicant or applicants, as the case may be, for registration of the trade mark.

(8) An appeal shall lie from any decision of the Registrar under this section.

## **28 Power of registered proprietor to assign and give receipts**

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

## **29 Registration of assignments and transmissions**

(1) Where a person becomes entitled by assignment or transmission to a registered trade mark, he shall make application to the Registrar to register his title, and the Registrar shall, on receipt of the application and on proof of title to his satisfaction—

- (a) register him as the proprietor of the trade mark in respect of the goods or services in respect of which the assignment or transmission has effect; and
- (b) cause particulars of the assignment or transmission to be entered on the Register.

(2) An application in terms of subsection (1) to register the assignment or transmission of a registered trade mark shall specify the effective date of the assignment or transmission and if the application is made more than twelve months after that date the applicant shall pay such penalty as is prescribed.

(3) Where the Registrar, in examining an application in terms of subsection (1) in respect of the assignment or transmission of a registered trade mark made with goodwill, finds from the records available to him that the assignor is entered in the Register as the registered proprietor of another trade mark in respect of the same description of goods or services as the trade mark being assigned or transmitted, he shall notify both the assignor and assignee of the state of the Register relating to such other trade mark and inquire of them as to the reason why such other trade mark is not the subject of the same application.

(4) Where, after giving notice in terms of subsection (3), the Registrar is advised, in relation to the trade mark which is the subject of the inquiry—

- (a) by the registered proprietor that the trade mark is of no further value to him and may be removed from the Register; or
- (b) by the assignee that he has no interest in seeking the proprietorship of the trade mark or its registration, and the registered proprietor—
  - (i) fails to reply to the inquiry by the Registrar within the period specified by the Registrar; or
  - (ii) replies within the period specified by the Registrar but fails to satisfy the Registrar that there are valid reasons why he should remain registered as the proprietor of the trade mark;

the Registrar may remove the trade mark from the Register.

(5) An appeal shall lie from any decision of the Registrar under this section.

(6) Except for the purposes of an appeal under this section or of an application under section *thirty-seven*, a document or instrument in respect of which no entry has been made in the Register in accordance with subsection (1) or the corresponding provision of the repealed legislation shall not be admitted in evidence in any court in proof of the title to a trade mark unless the court otherwise directs.

## **30 Certain trade marks to be associated so as to be assignable and transmissible as a whole only**

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

(2) Where a trade mark that is registered or is the subject of an application for registration in respect of any goods or services—

- (a) is identical with another trade mark that is registered or is the subject of an application for registration in the name of the same proprietor in respect of the same goods or services or description of goods or services; or
- (b) so nearly resembles another trade mark such as is referred to in paragraph (a) as to be likely to deceive or cause confusion if used by a person other than the proprietor;

the Registrar may at any time require that the trade marks shall be entered on the Register as associated trade marks.

(3) Where a trade mark and any part or parts thereof are, by virtue of subsection (1) of section *twenty-five*, registered as separate trade marks in the name of the same proprietor, they shall be deemed to be, and shall be registered as, associated trade marks.

(4) All trade marks that are, by virtue of section *twenty-six*, registered as a series in one registration shall be deemed to be, and shall be registered as, associated trade marks.

(5) On application made in the prescribed manner by the registered proprietor of two or more trade marks registered as associated trade marks, the Registrar may dissolve the association as respects any of them if he is satisfied that there would be no likelihood of deception or confusion being caused if that trade mark were used by another person in relation to any of the goods or services in respect of which it is registered and may amend the Register accordingly.

(6) An appeal shall lie from any decision of the Registrar under this section.

## PART VII

### USE AND NON-USE

#### **31 Removal from Register and imposition of limitation**

(1) Subject to section *thirty-two*, a registered trade mark may be removed from the Register in respect of any of the goods or services in respect of which it is registered on application by any person aggrieved to the Tribunal or, at the option of the applicant and subject to section *seventy-seven*, to the Registrar on the ground that—

- (a) the trade mark was registered without any bona fide intention on the part of the applicant for registration that it should be used in relation to those goods or services by him and that there has in fact been no bona fide use of the trade mark in relation to those goods or services by any proprietor thereof for the time being up to the date one month before the date of the application; or
- (b) up to the date one month before the date of the application a continuous period of five years or longer elapsed during which—
  - (i) the trade mark was a registered trade mark; and
  - (ii) there was no bona fide use thereof in relation to those goods or services by any proprietor thereof for the time being;

Provided that, except where the applicant has been permitted under subsection (2) of section *fifteen* to register an identical or nearly resembling trade mark in respect of the goods or services in question or where the Tribunal or the Registrar, as the case may be, is of the opinion that he might properly be permitted so to register such a trade mark, the Tribunal or the Registrar may refuse an application made under paragraph (a) or (b) in relation to any goods or services, if it is shown that there has been, before the relevant date or during the relevant period, as the case may be, bona fide use of the trade mark by any proprietor thereof for the time being in relation to goods or services of the same description, being goods or services in respect of which the trade mark is registered.

(2) Where, in relation to any goods or services in respect of which a trade mark is registered—

- (a) the matters referred to in paragraph (b) of subsection (1) are shown so far as regards non-use of the trade mark in relation to—
  - (i) goods to be sold or otherwise traded in in a particular place in Zimbabwe, otherwise than for export from Zimbabwe; or
  - (ii) goods to be exported to a particular market outside Zimbabwe; or
  - (iii) services to be performed in Zimbabwe;
 and
- (b) a person has been permitted under subsection (2) of section *fifteen* to register an identical or nearly resembling trade mark in respect of those goods or services under a registration extending to use in relation to—
  - (i) goods to be sold or otherwise traded in in that place, otherwise than for export from Zimbabwe; or
  - (ii) goods to be exported to that market; or
  - (iii) services to be performed in that place;



or the Tribunal or the Registrar is of the opinion that he might properly be permitted so to register such a trade mark;

on application by that person to the Tribunal or, at the option of the applicant and subject to section *seventy-seven*, to the Registrar, the Tribunal or the Registrar may impose on the registration of the first-mentioned trade mark such limitations as the Tribunal or the Registrar thinks right for securing that that registration shall cease to extend to such use as last aforesaid.

(3) An applicant shall not be entitled to rely, for the purposes of paragraph (b) of subsection (1) or for the purposes of subsection (2), on any non-use of a trade mark that is shown to have been due to special circumstances in the trade or to other circumstances, such as Government action, that arise independently of the will of the proprietor of the trade mark, and not to any intention not to use or to abandon the trade mark in relation to the goods or services to which the application relates.

[Subsection amended by Act 10 of 2001]

### **32 Defensive registration of well known trade marks**

(1) Where a trade mark registered in Part A of the Register has become so well known as respects any goods or services in respect of which it has been used that the use thereof in relation to other goods or services would be likely to be taken as indicating a connection in the course of trade between those goods or services and a person entitled to use the trade mark in relation to the first-mentioned goods or services, then, notwithstanding that the proprietor registered in respect of the first-mentioned goods or services does not use or propose to use that trade mark in relation to those other goods or services and notwithstanding anything in section *thirty-one*, the trade mark may, on the application in writing in the prescribed manner of the proprietor registered in respect of the first-mentioned goods or services, be registered in Part D of the Register in his name in respect of those other goods or services as a defensive trade mark and, while so registered, shall not be liable to be taken off the Register in respect of those goods or services under section *thirty-one*.

(2) The registered proprietor of a trade mark may—

- (a) in terms of subsection (1) apply for the registration thereof in respect of any goods or services as a defensive trade mark notwithstanding that it is already registered in his name in respect of those goods or services otherwise than as a defensive trade mark; or
- (b) apply for the registration thereof in respect of any goods or services otherwise than as a defensive trade mark notwithstanding that it is already registered in his name in respect of those goods or services as a defensive trade mark;

in lieu in each case of the existing registration.

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

(4) On application by any person aggrieved to the Tribunal or, at the option of the applicant and subject to section *seventy-seven*, to the Registrar, the registration of a trade mark as a defensive trade mark may be cancelled—

- (a) on the ground that the requirements of subsection (1) are no longer satisfied in respect of any goods or services in respect of which the trade mark is registered in the name of the same proprietor otherwise than as a defensive trade mark; or
- (b) as respects any goods or services in respect of which it is registered as a defensive trade mark on the ground that there is no longer any likelihood that the use of the trade mark in relation to those goods or services would be taken as giving the indication mentioned in subsection (1).

(5) The Registrar may at any time cancel in the prescribed manner the registration of a defensive trade mark if the registration of a trade mark in Part A of the Register upon which the registration of the defensive trade mark is wholly based—

- (a) is assigned to a different proprietor without the goodwill of the business relating to the goods or services in respect of which that trade mark was registered; or
- (b) is removed from the Register:

Provided that where a defensive trade mark is removed in terms of this paragraph if the trade mark upon which its registration was wholly based is restored to Part A of the Register in terms of subsection (5) of section *twenty-four*, the defensive trade mark shall be restored to Part D of the Register.

(6) Except as otherwise expressly provided in this section, this Act shall apply in respect of the registration of trade marks as defensive trade marks and of trade marks so registered as they apply in other cases and section *eight* relating to the infringement of a trade mark registered in Part A of the Register shall apply to the infringement of any defensive trade mark registered in terms of this section if that registration is valid.



### 33 Registered users

(1) Subject to this section, a person other than the proprietor of a trade mark registered in Part A or Part B of the Register may be registered as a registered user thereof in respect of all or any of the goods or services in respect of which that trade mark is registered.

(2) The use of a trade mark by a registered user thereof in relation to goods or services—

(a) with which he is connected in the course of trade; and

(b) in respect of which for the time being the trade mark remains registered and he is registered as a registered user;

being use such as to comply with any conditions or restrictions to which his registration is subject, is in this Act referred to as the “permitted use” thereof.

(3) The permitted use of a trade mark shall be deemed to be use by the proprietor thereof and shall be deemed not to be use by a person other than the proprietor for the purposes of section *thirty-one* and for any other purpose for which such use is material under this Act or any other law.

(4) Subject to any agreement subsisting between the parties, a registered user of a trade mark shall be entitled to call upon the proprietor thereof to take proceedings to prevent infringement thereof and, if the proprietor refuses or neglects to do so within two months after being so called upon, the registered user may institute proceedings for infringement in his own name as if he were the proprietor, making the proprietor a defendant:

Provided that a proprietor added as defendant in terms of this subsection shall not be liable for any costs unless he enters an appearance and takes part in the proceedings.

(5) Where it is proposed that a person should be registered as a registered user of a trade mark, the proprietor and the proposed registered user shall apply in writing to the Registrar in the prescribed manner and shall furnish him with such documents, information or evidence as may be prescribed or required by the Registrar.

(6) When the requirements of subsection (5) have been complied with, if the Registrar, after considering the information furnished to him under that subsection, is satisfied that in all the circumstances the use of the trade mark in relation to the proposed goods or services or any of them by the proposed registered user, subject to any conditions or restrictions which the Registrar thinks right, would not be contrary to the public interest, the Registrar may register the proposed registered user, with effect from the date of the application or such later date as the Registrar thinks fit, as a registered user in respect of the goods or services as to which he is so satisfied.

(7) The Registrar shall refuse an application in terms of subsection (5) if it appears to him that the grant thereof would tend to facilitate trafficking in a trade mark.

(8) Without derogation from section *thirty-seven*, the registration of a person as a registered user—

(a) may be varied by the Registrar as regards the goods or services in respect of which, or any conditions or restrictions subject to which, it has effect, on application in writing in the prescribed manner by the registered proprietor of the trade mark to which the registration relates; or

(b) may be extended by the Registrar, on application in writing by the registered proprietor, for a further period; or

(c) may be cancelled by the Registrar, on application in writing in the prescribed manner by the registered proprietor or any registered user of the trade mark; or

(d) may be cancelled by the Registrar, on application in writing in the prescribed manner by any person on any of the following grounds, that is to say—

(i) that the registered user has used the trade mark otherwise than by way of the permitted use or in such a way as to cause or to be likely to cause deception or confusion;

(ii) that the proprietor or the registered user misrepresented or failed to disclose some fact material to the application for the registration or that the circumstances have materially changed since the date of the registration;

(iii) that the registration ought not to have been effected, having regard to rights vested in the applicant by virtue of a contract in the performance of which he is interested.

(9) Provision shall be made in regulations made in terms of section *one hundred and four* for—

(a) the notification of the registration of a person as a registered user to any other registered user of the trade mark; and

(b) the notification of an application under subsection (8) to the registered proprietor and each registered user, other than the applicant, of the trade mark; and

(c) giving to the person making an application in terms of subsection (8) and to all persons who intervene in the proceedings in accordance with the regulations an opportunity of being heard.

(10) The Registrar shall cancel the registration of a person as a registered user of a trade mark in respect of any goods or services in respect of which the trade mark is no longer registered:

Provided that where the trade mark has been removed from the Register for non-payment of the fee for renewal, if the trade mark is restored to the Register in terms of subsection (5) of section *twenty-four*, the Registrar shall restore the registration of the registered user unless the proprietor of the trade mark or the registered user concerned requests that such registration be not restored.

(11) An appeal shall lie from any decision of the Registrar under this section.

(12) Nothing in this section shall confer on a registered user of a trade mark any assignable or transmissible right to the use thereof.

### **34 Proposed use of trade mark by corporation to be constituted, etc.**

(1) An application for the registration of a trade mark in respect of any goods or services shall not be refused nor shall permission for such registration be withheld on the ground only that it appears that the applicant does not use or propose to use the trade mark—

- (a) if the Registrar is satisfied that a body corporate is about to be constituted and that the applicant intends to assign the trade mark to the body corporate with a view to the use thereof in relation to those goods or services by the body corporate; or
- (b) if the application is accompanied by an application for the registration of a person as a registered user of the trade mark and the Registrar is satisfied that—
  - (i) the proprietor intends it to be used by that person in relation to those goods or services; and
  - (ii) that person will be registered as a registered user thereof immediately after the registration of the trade mark.

(2) Section *thirty-one* shall have effect, in relation to a trade mark registered by virtue of subsection (1), as if for the reference, in paragraph (a) of subsection (1) of that section, to intention on the part of an applicant for registration that the trade mark should be used by him there were substituted a reference to intention on his part that it should be used by the body corporate or registered user concerned.

(3) Where a trade mark is registered in respect of any goods or services by virtue of subsection (1) in the name of an applicant who relies on intention to assign to a body corporate as mentioned in that subsection, then, unless within such period as may be prescribed or within such further period not exceeding six months as the Registrar may on application being made to him in the prescribed manner allow, the body corporate has been registered as the proprietor of the trade mark in respect of those goods or services, the registration shall cease to have effect in respect thereof at the expiration of that period, and the Registrar shall amend the Register accordingly.

(4) An appeal shall lie from any decision of the Registrar under this section.

### **35 Use of one of associated or substantially identical trade marks equivalent to use of another**

(1) Where, under this Act, use of a registered trade mark is required to be proved for any purpose, the Registrar may, if and so far as the Registrar thinks fit, accept—

- (a) use of an associated registered trade mark; or
- (b) use of the trade mark with additions or alterations not substantially affecting its identity;

as an equivalent for the use required to be proved.

(2) The use of the whole of a registered trade mark shall, for the purposes of this Act, be deemed to be also a use of any registered trade mark, being a part thereof, registered in the name of the same proprietor by virtue of section *twenty-five*.

### **36 Use of trade mark for export trade**

The application in Zimbabwe of a trade mark to goods to be exported from Zimbabwe and any other act done in Zimbabwe in relation to goods to be exported from Zimbabwe or services to be performed outside Zimbabwe which, if done in relation to goods to be sold or otherwise traded in Zimbabwe or services to be performed in Zimbabwe would constitute use of a trade mark therein, shall be deemed to constitute use of the trade mark in relation to those goods or services for any purpose for which such use is material under this Act or any other law.

## PART VIII

### RECTIFICATION AND CORRECTION OF REGISTER

### **37 General power to rectify entries in Register**

(1) Any person aggrieved by—

- (a) the non-insertion in or omission from the Register of any entry; or
- (b) any entry made in the Register without sufficient cause; or

- (c) any entry wrongly remaining on the Register; or
- (d) any error or defect in any entry in the Register; may apply in the prescribed manner to the Tribunal or, at the option of the applicant and subject to section *seventy-seven*, to the Registrar, and the Tribunal or the Registrar may make such order for making, expunging or varying the entry as the Tribunal or the Registrar may think fit.

(2) In any proceedings under this section, the Tribunal or the Registrar may decide any question that it may be necessary or expedient to decide in connection with the rectification of the Register.

(3) Where the Registrar is of the opinion that there may have been any fraud in the registration, assignment or transmission of a registered trade mark, he may himself apply to the Tribunal under this section.

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

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

### **38 Power to expunge or vary registration for breach of condition or registration of distinguishing guise**

(1) On application by—

- (a) any person aggrieved to the Tribunal or, at the option of the applicant and subject to section *seventy-seven*, to the Registrar; or
- (b) the Registrar to the Tribunal;

the Tribunal or the Registrar may make such order as the Tribunal or the Registrar may think fit for expunging or varying the registration of a trade mark on the ground of any contravention of or failure to observe a condition entered on the Register in relation thereto.

(2) On application by any person aggrieved to the Tribunal or, at the option of the applicant and subject to section *seventy-seven*, to the Registrar, the Tribunal or the Registrar may make such order as the Tribunal or the Registrar may think fit for expunging or varying the registration of a distinguishing guise on the ground that the registration of that distinguishing guise has become likely to limit unreasonably the development of any art or industry.

### **39 Correction of Register**

(1) On request made in the prescribed manner by the registered proprietor, the Registrar may—

- (a) correct any error in the name, address or description of the registered proprietor of a trade mark; or
- (b) enter any change in the name, address or description of the person who is registered as proprietor of a trade mark; or
- (c) cancel the entry of a trade mark on the Register; or
- (d) strike out any goods or services from those in respect of which a trade mark is registered; or
- (e) enter a disclaimer or memorandum relating to a trade mark which does not in any way extend the rights given by the existing registration of the trade mark.

(2) On request made in the prescribed manner by the registered user of a trade mark, the Registrar may correct any error or enter any change in the name, address or description of the registered user.

(3) On request made in the prescribed manner by the registered proprietor or the registered user, as the case may be, the Registrar may—

- (a) correct any error or enter any change in the name or address of the person appointed for the purposes of his address for service; or
- (b) enter the name and address of any person appointed for the purposes of his address for service and cancel any previous appointment.

(4) The Registrar, after giving such notice, if any, as he considers to be necessary, may correct any error in an entry in the Register which has been made by an officer in the Trade Marks Office.

(5) An appeal shall lie from any decision of the Registrar under this section.

### **40 Alteration of registered trade mark**

(1) The registered proprietor of a trade mark may apply in the prescribed manner to the Registrar for leave to add to or alter the trade mark in any manner not substantially affecting the identity thereof, and the Registrar may—

- (a) refuse leave; or
- (b) grant leave on such terms and subject to such limitations as he may think fit.

(2) The Registrar may direct that an application in terms of subsection (1) shall be advertised in the prescribed manner in any case where it appears to him that it is expedient so to do.

(3) If, within the prescribed period from the date of an advertisement in terms of subsection (2), any person gives notice to the Registrar in the prescribed manner of opposition to the application, the Registrar shall, after hearing the parties if so required, decide the matter.

(4) An appeal shall lie from any decision of the Registrar under this section.

(5) Where leave to add to or alter a trade mark has been granted, the proprietor shall advertise in the prescribed manner the trade mark as altered, unless it has already been advertised in the form to which it has been altered in an advertisement under subsection (2).

#### **41 Adaptation of entries in Register to amended or substituted classification of goods or services**

(1) Where the prescribed classification in accordance with which a trade mark was registered, whether it was registered before, on or after the appointed day, is revised or substituted by a new classification, the proprietor of the trade mark shall, together with any application in terms of section *twenty-four* for the renewal of the registration thereof or the restoration of that trade mark to the Register, apply in the prescribed manner for revision of the class or classes in which the trade mark is registered so as to bring it in accord with the revised or substituted classification.

(2) If, on an application in terms of subsection (1), as a result of the revised or substituted classification—

(a) two or more identical trade marks owned by the same proprietor, which were under the previous registration registered in separate classes, fall within a single class, such marks may be consolidated as one registration in the revised or substituted class; or

(b) a trade mark is required to be recorded in more than one class, such mark shall be separately registered in each class in which the mark is so recorded and shall be treated as separate trade marks for the purposes of this Act.

(3) Regulations made in terms of section *one hundred and four* may empower the Registrar to amend the Register, whether by making or expunging or varying entries therein, for the purpose of adapting the designation therein of the goods or services or classes of goods or services in respect of which trade marks are registered to any amended or substituted classification that may be prescribed.

(4) The Registrar shall not, in the exercise of any power conferred upon him by regulations referred to in subsection (3), make any amendment to the Register that would have the effect of—

(a) adding any goods or services or classes of goods or services to those in respect of which a trade mark is registered, whether in one or more classes, immediately before the amendment is to be made; or

(b) ante-dating the registration of a trade mark in respect of any goods or services:

Provided that the provisions of this subsection shall not have effect in relation to any goods or services as to which the Registrar is satisfied that compliance with such provisions in relation thereto would involve undue complexity and that the addition or ante-dating, as the case may be, would not affect any substantial quantity of goods or services and would not substantially prejudice the rights of any person.

(5) An appeal shall lie from any decision of the Registrar under this section.

### **PART IX**

#### **CERTIFICATION MARKS**

#### **42 Certification mark to be distinctive**

(1) A mark apt, in relation to any goods or services, to distinguish in the course of trade, goods or services certified by any person in respect of origin, material, mode of manufacture or performance, quality, accuracy or any other characteristic from goods or services not so certified shall be registrable as a certification mark in Part C of the Register in respect of those goods or services in the name, as proprietor thereof, of that person:

Provided that a mark shall not be so registrable in the name of a person who carries on a trade in goods or services of the kind certified.

(2) In determining whether a mark is apt to distinguish as mentioned in subsection (1), the Registrar may have regard to the extent to which—

(a) the mark is inherently apt to distinguish in relation to the goods or services in question; and

(b) by reason of the use of the mark or of any other circumstances, the mark is in fact apt to distinguish as mentioned in subsection (1) in relation to the goods or services in question.

#### **43 Right given by registration of certification mark**

The rights acquired by registration of a certification mark shall, subject to this Part, be the same as the rights acquired by registration of a trade mark in Part A of the Register and, for that purpose, sections *eight, ten* and *eleven* shall apply, mutatis mutandis, in relation to certification marks.

#### **44 Application for registration of certification mark**

(1) An application for the registration of a certification mark in Part C of the Register shall be made to the Registrar in writing in the prescribed manner by the person proposed to be registered as the proprietor thereof.

(2) An applicant for the registration of a certification mark shall transmit to the Registrar draft rules for governing the use thereof at such time before the decision of the Registrar on the application as the Registrar may require in order to enable him to consider the draft.

(3) Subject to this Act, the Registrar may—

(a) refuse the application; or

(b) accept the application and approve the rules, either without modification and unconditionally or subject to any conditions or limitations or to any amendments or modifications of the application or of the rules as he may think fit.

(4) Subsections (4) to (8) of section *twenty-one* shall apply, mutatis mutandis, in relation to an application in terms of this section as they apply in relation to an application under subsection (1) of section *twenty-one*.

(5) In dealing with an application under this section, the Registrar shall have regard to the like considerations, so far as relevant, as if the application were an application under section *twenty-one* and to any other considerations relevant to applications under this section, including the desirability of securing that a certification mark shall comprise some indication that it is such a mark, and including also the following matters—

(a) whether the applicant is competent to certify the goods or services in respect of which the mark is to be registered; and

(b) whether the draft rules are satisfactory; and

(c) whether in all the circumstances the registration applied for would be to the advantage of the public.

(6) An application in terms of this section may be made by a Minister on behalf of any Ministry or department of the State.

#### **45 Advertising of acceptance of application**

When an application has been accepted, the applicant shall, as soon as may be after such acceptance, advertise the application as accepted in the prescribed manner, and subsections (2) to (11) of section *twenty-two* shall apply, mutatis mutandis, in relation to the registration of the certification mark as if the application had been an application under section *twenty-one*.

#### **46 Rules governing use of certification mark**

(1) There shall be deposited at the Trade Marks Office in respect of every certification mark registered under this Part rules approved by the Registrar for governing the use thereof which—

(a) shall include provisions as to the cases in which the proprietor is to certify goods or services and to authorize the use of the certification mark; and

(b) may contain any other provisions that the Registrar may require or permit to be inserted therein, including provisions conferring a right of appeal to the Registrar against any refusal of the proprietor to certify goods or services or to authorize the use of the certification mark in accordance with the rules.

(2) Rules deposited in terms of subsection (1) shall be open to inspection in like manner as the Register.

(3) Rules deposited in terms of subsection (1) may, on the application in the prescribed manner by the registered proprietor, be altered by the Registrar.

(4) The Registrar may direct that an application for an alteration in terms of subsection (3) shall be advertised in any case where it appears to him that it is expedient so to do.

(5) Where an application has been advertised in terms of subsection (4), if, within the prescribed period from the date of the advertisement, any person gives notice to the Registrar of opposition to the application subsections (2) to (11) of section *twenty-two* shall apply, mutatis mutandis.

#### **47 Rectification of Part C of Register**

The power to order rectification of the Register conferred by section *thirty-seven* shall include, in relation to certification marks, rectification on the ground that—

(a) in the case of any goods or services in respect of which the mark is registered, the proprietor is no longer competent to certify these goods or services as is contemplated by section *forty-two*; or



- (b) the proprietor has failed to observe a provision of the rules deposited in terms of section *forty-six* which it was his duty to observe; or
- (c) it is no longer to the advantage of the public that the mark should be registered; or
- (d) the advantage of the public requires that if the mark remains registered, the rules deposited in terms of section *forty-six* should be varied.

#### **48 Assignment or transmission of certification mark**

A certification mark shall not be assignable or transmissible otherwise than with the consent of the Registrar who may grant his consent subject to such terms and conditions as he may think fit.

#### **49 Appeals against refusal by registered proprietor to certify goods or services**

(1) There shall be a right of appeal to the Registrar in the prescribed manner against the refusal by the registered proprietor of a certification mark to certify goods or services or to authorize the use of the certification mark in accordance with the rules deposited in terms of section *forty-six*.

(2) Notwithstanding section *fifty-five*, the Registrar shall not have jurisdiction to award costs to or against any party on an appeal to him in terms of subsection (1).

#### **50 Provisions of the Act not applicable to certification mark**

Save as otherwise provided in this Part, this Act other than—

- (a) subsections (4) to (8) of section *twenty-seven* and sections *thirty-one*, *thirty-two*, *thirty-three*, *thirty-four* and *ninety-nine*; and
- (b) any provision the operation of which is limited by the terms thereof to registration in Part B of the Register; shall apply, mutatis mutandis, in relation to a certification mark.

### **PART X**

#### **FUNCTIONS OF REGISTRAR IN RELATION TO CERTAIN EVIDENCE, DOCUMENTS AND POWERS**

#### **51 Preliminary advice by Registrar as to distinctiveness, deceptiveness, etc.**

(1) It shall be a function of the Registrar to give to a person who proposes to apply for the registration of a trade mark in Part A or Part B of the Register advice as to whether the trade mark appears to the Registrar prima facie—

- (a) to be inherently apt to distinguish or capable of distinguishing, as the case may be, for the purposes of section *twelve* or *thirteen*, as the case may be; or
- (b) not to be prohibited from registration by virtue of subsection (1) or (2a) of section *fourteen*.

[Paragraph amended by Act 10 of 2001]

(2) Any person referred to in subsection (1) who is desirous of obtaining advice mentioned in that subsection shall make application to the Registrar therefor in the prescribed manner.

(3) If, on the application for the registration of a trade mark as to which the Registrar has given advice in terms of subsection (1) in the affirmative, made within three months after the advice is given, the Registrar, after further investigation or consideration, gives notice to the applicant of objection on the ground that the trade mark is not apt to distinguish or capable of distinguishing, as the case may be, or is incapable of registration by virtue of subsection (1) of section *fourteen*, the applicant shall be entitled, on giving notice of withdrawal of the application within the prescribed period, to have repaid to him any fee paid on the lodging of the application.

#### **52 Hearing before exercise of Registrar's discretion**

Where any discretionary or other power is given by this Act to the Registrar, he shall not exercise that power adversely to the applicant or the registered proprietor of the trade mark in question, as the case may be, without giving to the applicant or registered proprietor an opportunity of being heard.

#### **53 Evidence of certain entries and documents**

(1) A certificate purporting to be signed by the Registrar and certifying that any entry which is authorized by or under this Act or the repealed legislation to be made has or has not been made or that any other thing which is so authorized to be done has or has not been done shall be prima facie evidence of the matters so certified.

(2) A copy of any entry in the Register or of any document kept in the Trade Marks Office or of any trade mark or an extract from the Register or any such document certified by the Registrar and sealed with the seal of the Trade Marks Office shall be admitted in evidence without further proof and without production of the original.

#### **54 Inspection of documents**

(1) The Register and any prescribed form which is lodged at the Trade Marks Office shall, at all convenient times, be open to inspection by the public and certified copies, either sealed with the seal of the Trade Marks Office or unsealed as may be required, of any entry in, or particulars from, the Register or of any such form, as the case may be, shall be given to any person requiring them on payment of the prescribed fee.



(2) Save as otherwise provided in this Act, any person who wishes to inspect any document submitted in connection with any application made in terms of this Act or the repealed legislation, not being a prescribed form, shall apply in writing to the Registrar stating the reason therefor and the grounds on which he claims an interest in the matter, and on receipt of such application the Registrar—

- (a) shall refer a copy of the application to the proprietor of, or applicant for, the trade mark concerned, as the case may be, who may, within such period as may be prescribed, object to disclosure of the document or any information contained therein on the grounds that the interest claimed is not genuine or that the document contains information disclosure of which would cause damage or prejudice; and
- (b) may, after considering any objection lodged in terms of paragraph (a), permit the applicant to inspect such document or portion thereof if he considers that inspection thereof is justified in the circumstances and a certified copy of such document or an extract therefrom may be given on payment of the prescribed fee:

Provided that the Registrar shall not permit any inspection in terms of this paragraph—

- (i) prior to the date that the acceptance of the application concerned is advertised in terms of subsection (1) of section *twenty-two*; or
- (ii) where an objection has been lodged in terms of paragraph (a), without first notifying the person lodging the objection that he intends to permit such inspection and affording that person an opportunity of appealing in terms of subsection (3).

(3) An appeal shall lie from any decision of the Registrar under this section.

(4) In this section—

“prescribed form” means any application, request, authorization, declaration or other notice made or given in a form which has been prescribed for the purpose, but does not include any document accompanying or annexed to such form.

### **55 Power of Registrar to award costs**

(1) Subject to subsection (2) of section *forty-nine*, in all proceedings before the Registrar under this Act, the Registrar shall have power to award to any party such costs as he may consider reasonable and to direct how and by what parties they are to be paid.

(2) Any costs awarded by the Registrar shall be taxed by a taxing officer of the Tribunal and payment thereof may be enforced in the same manner as if they were costs allowed by the Tribunal.

(3) An appeal shall lie from any decision of the Registrar under this section.

### **56 Proceedings before Registrar**

(1) Evidence in any proceedings before the Registrar under this Act shall be given by affidavit:

Provided that the Registrar may, if he thinks fit in any particular case, take oral evidence on oath in lieu of or in addition to such evidence.

(2) The Registrar may, in any proceedings before him under this Act, allow any witness to be cross-examined on his affidavit or oral evidence.

(3) The Registrar may, in any proceedings before him under this Act, decide the hours, times and places at which he will sit and he may adjourn such proceedings for such time and to such place as he may think fit.

(4) For the purposes of any proceedings before him under this Act, the Registrar shall have the same powers, rights and privileges as are conferred upon a commissioner by the Commissions of Inquiry Act [*Chapter 10:07*], other than the power to order a person to be detained in custody, and sections 9 to 13 and 15 to 19 of that Act shall apply, mutatis mutandis, in relation to the hearing and determination of any matter before the Registrar under this Act and to any person summoned to give evidence or giving evidence before him.

### **57 Advertisements to be approved by Registrar**

(1) Subject to subsection (2), no advertisement or notice shall be published by any person under this Act unless it is in the prescribed form or the Registrar has approved the contents of such advertisement or notice and an advertisement or notice which has not been so approved shall not have any force or effect for the purposes of this Act.

(2) Subsection (1) shall not apply to an advertisement or notice published by or under the authority of the President or the Minister.

## **PART X**

### **TRADE MARK AGENTS**

### **58 Trade mark agents and their functions**

(1) Subject to this Act, a trade mark agent may act as agent on behalf of any person in connection with any matter or proceeding before the Registrar under this Act and may draw and sign all documents and make all

communications between an applicant and the Trade Marks Office and may represent an applicant at all attendances before the Registrar.

(2) A trade mark agent shall not be guilty of an offence under any enactment prohibiting the preparation for reward of certain documents by persons not legally qualified by reason only of the preparation or signature by him of any document relating to trade marks for use in the Trade Marks Office or required in any proceedings under this Act before the Registrar or the Tribunal.

## **59 Qualifications and registration of trade mark agents**

(1) The Registrar shall—

- (a) keep a Register of Trade Mark Agents in which the name of every person, immediately upon his being accepted for registration, shall be registered, showing against his name such particulars as the Registrar shall from time to time deem necessary; and
- (b) enter in such Register of Trade Mark Agents all changes relating to registrations.

(2) Any person ordinarily resident in Zimbabwe who—

- (a) has served such period of articles as may be prescribed and has passed the prescribed qualifying examinations; or
- (b) has passed the prescribed qualifying examinations and produces proof that he is a member in good standing of The Institute of Trade Mark Agents of the United Kingdom; or
- (c) produces proof that he holds a qualification recognized by the Minister as being equivalent to the qualifications required for the purposes of paragraph (a) or (b);

may make application to the Registrar in the prescribed manner to be registered as a trade mark agent, and the Registrar shall arrange such registration if he is satisfied that there is no good reason why it should not be arranged and that the applicant is not a person whose name could be removed from the Register of Trade Mark Agents under paragraph (b), (c) or (f) of subsection (1) of section *sixty*:

Provided that an officer in the Public Service who has been employed in the Trade Marks Office shall not be registered as a trade mark agent or be permitted to practice as such until at least twelve months have expired since he ceased to be so employed.

(3) Any person who, immediately before the appointed day, was registered as a trade mark agent in terms of the repealed legislation or was a patent agent shall be registered in terms of subsection (1) as a trade mark agent.

(4) An appeal shall lie from any decision of the Registrar under subsection (2).

## **60 Removal of names from Register of Trade Mark Agents**

(1) The Registrar may remove from the Register of Trade Mark Agents the name of any trade mark agent upon proof to his satisfaction that that trade mark agent—

- (a) has died; or
- (b) has become of unsound mind; or
- (c) has been adjudged insolvent under any law in force in Zimbabwe or has made an assignment to, or composition with, his creditors; or
- (d) has ceased to reside in Zimbabwe or has ceased to maintain a place of business therein; or
- (e) has applied for his name to be so removed; or
- (f) has, after being convicted in Zimbabwe or elsewhere of the crime of theft, fraud, forgery or uttering a forged document or perjury, been sentenced to serve a term of imprisonment without the option of a fine, whether such sentence is suspended or not, and has not received a free pardon; or
- (g) having been entitled to practise as a legal practitioner or patent agent or to be registered as a trade mark agent, has ceased to be so entitled; or
- (h) having been entitled to practise as a legal practitioner, patent agent or trade mark agent, has ceased to practise as such.

(2) An appeal shall lie from any decision of the Registrar under subsection (1).

(3) Subject to this section and such procedure as may be prescribed, the Tribunal may order the Registrar to remove the name of any trade mark agent from the Register of Trade Mark Agents or may suspend any trade mark agent from practising as such for such time as it thinks fit if it is satisfied, after due inquiry, that such person has been guilty—

- (a) of conduct discreditable to a trade mark agent; or
- (b) of a breach of any regulations prescribing the conduct of trade mark agents.

(4) No order shall be made by the Tribunal in terms of subsection (3) unless the trade mark agent concerned has been given notice of any allegations made against him and has had an opportunity to adduce evidence and to be heard.

(5) Any institute or other organization recognized by the Minister as being representative of the trade mark agents in Zimbabwe shall be entitled to be represented before, to adduce evidence and to be heard by the Tribunal before it makes an order in terms of subsection (3).

(6) Where the name of any trade mark agent has been removed from the Register of Trade Mark Agents under subsection (1) or (2), his name shall not be restored to that register except by direction of the Tribunal, which may further direct that such restoration shall be made either without fee or on payment of such fee, not exceeding the registration fee, as it may fix, and the Registrar shall restore the name accordingly.

### **61 Privileges of legal practitioners and patent agents**

Every person entitled to practise as a legal practitioner or patent agent in Zimbabwe may practise as a trade mark agent and perform the functions set out in section *fifty-eight* without being registered as a trade mark agent, but no such person shall be entitled to be so registered except under section *fifty-nine*.

### **62 Entitlement to practise as trade mark agent and power of Controller to refuse to deal with certain agents**

(1) No person shall practise as a trade mark agent unless he is registered as such or is, by virtue of section *sixty-one*, entitled so to practise.

(2) A person shall be deemed to practise as a trade mark agent if—

(a) he performs any of the functions of a trade mark agent set out in section *fifty-eight*; or

(b) he carries on within Zimbabwe the business of applying for or obtaining for others the registration of trade marks in Zimbabwe or elsewhere.

(3) No person who is not a legal practitioner or patent agent or registered as a trade mark agent shall describe himself as, or hold himself out to be, a trade mark agent or use any term implying such a meaning, nor shall such a person permit himself to be so described or held out.

(4) The Controller may refuse to recognize as agent in respect of any business under this Act any person who, not being a trade mark agent or entitled by virtue of section *sixty-one* to practise as a trade mark agent, is, in the opinion of the Controller, having regard to any other activities of that person, including the number of persons by whom that person is employed in any capacity and the remuneration received by him, acting as a trade mark agent in applying for the registration of trade marks in Zimbabwe or elsewhere in the name, or for the benefit, of one or more persons by whom he is employed.

(5) Any person who contravenes this section shall be guilty of an offence and liable to a fine not exceeding level seven or to imprisonment for a period not exceeding two years or to both such fine and such imprisonment.

[Subsection amended by Act 22 of 2001]

### **63 Prohibition of certain acts of trade mark agents**

(1) No trade mark agent shall have an interest, either as a partner or manager or otherwise, in more than one firm of trade mark agents in Zimbabwe.

(2) No trade mark agent shall practise under a name or title which includes the name of any person who is not or was not—

(a) in his lifetime ordinarily resident in Zimbabwe; or

(b) registered as a trade mark agent under the provisions of this Act or the repealed legislation.

(3) No person shall practise as a trade mark agent if he is a party to—

(a) a contract of partnership; or

(b) an arrangement providing for the sharing or paying over of any professional fees;

relating to the business of a trade mark agent with any person who is prohibited from practising as a trade mark agent.

(4) Any person who contravenes this section shall be guilty of an offence and liable to a fine not exceeding level seven or to imprisonment for a period not exceeding two years or to both such fine and such imprisonment.

[Subsection amended by Act 22 of 2001]

## **PART XII**

### **APPEALS AND LEGAL PROCEEDINGS**

### **64 Appeals from Registrar**

Where this Act provides for an appeal against a decision of the Registrar, the appeal shall be made to the Tribunal in accordance with this Part and the Intellectual Property Tribunal Act [*Chapter 26:06*].

[Subsection substituted by Act 10 of 2001]

## **65 Time for appeals**

An appeal referred to in section *sixty-four* shall be lodged with the Tribunal within two months after the appellant was notified of the decision or order against which the appeal is brought or within such further time as the Tribunal may for good cause allow.

[Section substituted by Act 10 of 2001]

## **66 Powers of Tribunal on appeal**

Without derogation from section 8 of the Intellectual Property Tribunal Act [*Chapter 26:06*], in any appeal under this Act the Tribunal may—

- (a) confirm, set aside or vary the order or decision against which the appeal is brought;
- (b) exercise any of the powers which could have been exercised by the Registrar in the proceedings in connection with which the appeal is brought.

[Section substituted by Act 10 of 2001]

## **67 References to Tribunal by Registrar**

(1) If it appears to the Registrar that any matter to be decided by him under this Act involves a point of law or to be of unusual importance or complexity, he may, after giving notice to the parties, refer the matter to the Tribunal for decision, and thereafter in relation to that matter he shall act in accordance with the decision of the Tribunal or any decision substituted therefor on appeal to the Supreme Court.

(2) Where a matter has been referred to the Tribunal in terms of subsection (1), the Registrar and the parties shall be entitled to be heard by and appear before the Tribunal before any decision is made in the matter.

[Section substituted by Act 10 of 2001]

## **68 ....**

[Section repealed by Act 10 of 2001]

## **69 ....**

[Section repealed by Act 10 of 2001]

## **70 Registration to be prima facie evidence of validity**

In all legal proceedings relating to a registered trade mark, including applications under section *thirty-seven*, the fact that a person is registered as proprietor of the trade mark shall be prima facie evidence of the validity of the original registration of the trade mark and of all subsequent assignments and transmissions thereof.

## **71 Certification of validity**

In any legal proceedings in which the validity of the registration of a registered trade mark comes into question and is decided in favour of the proprietor of the trade mark, the court or the Tribunal, as the case may be, which gave the decision may certify to that effect and, if it is so certified, then, in any subsequent legal proceedings in which the validity of the registration comes into question, the proprietor of the trade mark, on obtaining a final order or judgment in his favour, shall have his full costs, charges and expenses as between legal practitioner and client, unless in the subsequent proceedings the court or Tribunal, as the case may be, certifies that he ought not to have them.

[Section amended by Act 10 of 2001]

## **72 Counterclaim for rectification of Register in proceedings for infringement**

In any proceedings for an infringement of a registered trade mark, the defendant or respondent may counterclaim for the rectification of the Register and, if he does so—

- (a) he shall, within the time-limit for the deliver of the counterclaim, serve it on the Registrar with a copy of any notice, summons or other document by which the proceedings were instituted; and
- (b) the Registrar shall be entitled to take part in the proceedings without delivering a defence, affidavit or other notice or pleading:

Provided that he shall appear in the proceedings if directed to do so by the court concerned or the Tribunal, as the case may be.

[Section substituted by Act 10 of 2001]

## **73 Trade usage, etc., to be considered**

In any legal proceedings relating to a trade mark the court, the Tribunal or the Registrar, as the case may be, shall admit evidence of the usages of the trade concerned and of any relevant trade mark legitimately used by other persons.

[Section amended by Act 10 of 2001]

## **74 Registrar's appearance in proceedings involving rectification**

(1) In any legal proceedings in which the relief sought includes alteration or rectification of the Register, the Registrar—

- (a) shall have the right to appear and be heard; and
- (b) shall appear if so directed by the Tribunal.

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

#### **75 Power of Tribunal to review decision of Registrar**

The Tribunal, in dealing with any question of the rectification of the Register, including any application under section *thirty-seven*, shall have power to review any decision of the Registrar relating to the entry in question or the correction sought to be made.

**76 ....**

[Section repealed by Act 10 of 2001]

#### **77 Procedure in cases of option to apply to Tribunal or Registrar**

Where under any of this Act an applicant has an option to make an application either to the Tribunal or to the Registrar and such application is made to the Registrar, the Registrar may—

- (a) at any stage of the proceedings, refer the application to the Tribunal; or
- (b) after hearing the parties, determine the question between them, subject to appeal to the Tribunal.

**78 ....**

[Section repealed by Act 10 of 2001]

#### **79 Costs of Registrar**

In all proceedings before the Tribunal under this Act, the costs of the Registrar shall be in the discretion of the Tribunal, but the Registrar shall not be ordered to pay the costs of any other party.

**80 ....**

[Section repealed by Act 10 of 2001]

### **PART XIII**

#### **PROTECTION OF REGISTERED TRADE MARKS**

#### **81 Interpretation in Part XIII**

In this Part—

“apply to”, in relation to goods, means—

- (a) to emboss, impress, engrave, etch or print upon; or
- (b) to weave or otherwise work into; or
- (c) to annex or affix to; such goods;

“covering” means any bottle, box, capsule, case, cask, frame, vessel, wrapper or other container or cover and includes a band, label, ticket or reel;

“customs officer” means an officer as defined in section 2 of the Customs and Excise Act [*Chapter 23:02*];

“Director of Customs and Excise” means the Director of Customs and Excise appointed in terms of the Customs and Excise Act [*Chapter 23:02*];

“forged”, in relation to a registered mark, means made or falsified as described in section *eighty-three*;

“inspector” means a person appointed as an inspector in terms of the Merchandise Marks Act [*Chapter 14:15*];

“sell” includes—

- (a) to expose for sale; and
- (b) to have in possession for the purpose of sale or for any purpose of trade or commerce.

#### **82 Application of trade mark**

(1) A trade mark or other mark shall be deemed to be applied to goods if—

- (a) it is applied to the goods themselves; or
- (b) it is applied to a covering on, in or attached to which the goods are sold; or
- (c) the goods are placed in or around, enclosed by or annexed to any covering to which the trade mark or other mark has been applied; or
- (d) it is used in any manner likely to lead to the belief that the goods in connection with which it is used are designated by that trade mark or other mark.

(2) Goods delivered in pursuance of an offer or request made by reference to a trade mark or other mark appearing in any sign, advertisement, invoice, winelist, catalogue, business letter, business paper, pricelist or other commercial document shall, for the purposes of paragraph (d) of subsection (1), be deemed to be goods in connection with which the trade mark or other mark is used.



(3) A trade mark or other mark shall be deemed to be applied in relation to services if it is used in any manner likely to lead to the belief that the services in connection with which it is used are designated by that trade mark or other mark.

(4) A registered trade mark shall be deemed to be falsely applied to goods or in relation to services if, without the consent of the proprietor or the authority of this Act, the registered trade mark or a mark so nearly resembling it as to be likely to deceive or cause confusion is applied to the goods or in relation to the services, as the case may be.

### **83 Forgery of registered trade mark**

A person shall be deemed, for the purposes of this Part, to forge a registered trade mark if—

- (a) without the consent of the proprietor of the registered trade mark or the authority of this Act, he makes that trade mark or a mark so nearly resembling that trade mark as to be likely to deceive or cause confusion; or
- (b) he falsifies a registered trade mark, whether by alteration, addition, effacement or otherwise.

### **84 Prohibition of forgery of registered trade marks and other acts**

(1) Subject to subsection (2), any person who—

- (a) forges a registered trade mark; or
- (b) falsely applies to goods or in relation to services a registered trade mark; or
- (c) makes a die, block, machine or other instrument for the purpose of forging, or of being used for forging, a registered trade mark; or
- (d) disposes of, or has in his possession, a die, block, machine or other instrument for the purpose of forging, or of being used for forging, a registered trade mark; or
- (e) without the consent of the proprietor of a registered trade mark—
  - (i) makes, imports or has in his possession any device for applying that registered trade mark to goods or in relation to services; or
  - (ii) makes any reproductions, replicas or representations of that trade mark; or
  - (iii) imports any reproductions, replicas or representations of that trade mark otherwise than on goods to which they have been applied;

or

- (f) makes, imports or has in his possession—
  - (i) any device for applying to any goods or in relation to any services a mark so nearly resembling a registered trade mark as to be likely to deceive or cause confusion; or
  - (ii) any reproductions, replicas or representations of a mark so nearly resembling a registered trade mark as to be likely to deceive or cause confusion, for the purpose of applying them to goods or in relation to services contrary to the provisions of this Part; or
  - (iii) any coverings bearing a mark so nearly resembling a registered trade mark as to be likely to deceive or cause confusion, for the purpose of using them to cover or contain, or in relation to, goods contrary to the provisions of this Part;

shall be guilty of an offence and liable to a fine not exceeding level seven or to imprisonment for a period not exceeding two years or to both such fine and such imprisonment.

[Subsection amended by Act 22 of 2001]

(2) It shall be a sufficient defence to any charge—

- (a) under subsection (1), if the person concerned proves that he acted without intent to defraud; or
- (b) under paragraph (b) or (c) of subsection (1) if the person concerned proves that—
  - (i) in the ordinary course of his business he was employed on behalf of other persons, either to make dies, blocks, machines or other instruments for making or being used in making trade marks or, as the case may be, to apply trade marks to goods or in relation to services and that, in the case which is the subject of the charge, he was so employed by some other person and was not interested in the goods or services by way of profit or commission dependent on the sale of such goods or performance of such services; and
  - (ii) he took reasonable precautions against committing the offence charged; and
  - (iii) he had, at the time of the commission of the alleged offence, no reason to suspect the genuineness of the trade mark; and
  - (iv) on request made by an inspector or police officer, he gave to that inspector or police officer all the information in his power with respect to the persons on whose behalf the trade mark was applied.

### **85 Prohibition of sale or importation of goods or performance of services with forged registered trade mark**

(1) Subject to subsection (2), any person who sells or imports any goods or performs any services to which—

- (a) a forged registered trade mark is applied; or
- (b) a registered trade mark is falsely applied; shall be guilty of an offence and liable to a fine not exceeding level seven or to imprisonment for a period not exceeding two years or to both such fine and such imprisonment.

[Subsection amended by Act 22 of 2001]

- (2) It shall be a defence to any charge under subsection (1) if the person concerned proves that—
  - (a) having taken all reasonable precautions against committing an offence under this Part—
    - (i) he had, at the time of the sale, no reason to suspect the genuineness of the trade mark; and
    - (ii) on request made by an inspector, police officer or customs officer, he gave to that inspector or officer all the information in his power with respect to the person from whom he obtained such goods;
  - or
  - (b) otherwise he had acted innocently.

## **86 Restriction on importation or exportation of counterfeit trade mark goods**

- (1) In this section—

“counterfeit trade mark goods” means any goods which bear without authorisation a trade mark which—

- (a) is identical to a registered trade mark; or
- (b) cannot be distinguished in its essential aspects from a registered trade mark;

and thereby infringes the rights of the proprietor of the registered trade mark;

“proprietor”, in relation to a registered trade mark, includes a registered user of the trade mark.

- (2) If the proprietor of a registered trade mark, by written notice to the Director of Customs and Excise—

- (a) informs the Director that he is the proprietor of the trade mark; and
- (b) satisfies the Director that there are reasonable grounds to suspect that counterfeit trade mark goods have been or may be imported into or exported from Zimbabwe; and
- (c) requests the Director to treat the counterfeit trade mark goods referred to in paragraph (b) as prohibited goods; and
- (d) describes the goods concerned with sufficient particularity to make them readily identifiable;

the Director shall forthwith comply with the request and ensure that no such goods are imported into or exported from Zimbabwe, and that any such goods that have been imported but not yet entered are not released to the importer:

Provided that the Director need not comply with such a request until the proprietor furnishes him with security in such form and for such amount as the Director may require to secure the fulfilment of any liability and the payment of any expense which he may incur as a result of the detention of any goods to which the request relates or as a result of anything done by him in relation to goods so detained.

(3) Where a request has been made under subsection (1) and has not been withdrawn, the importation into or exportation from Zimbabwe of any goods to which the request relates shall be prohibited for a period of ten working days from the date on which the Director of Customs and Excise complies with the request:

Provided that—

- (i) if within that period the proprietor has instituted proceedings for an order in terms of subsection (4), or proceedings for any other order leading to a decision on the merits of the matter, the importation or exportation of the goods concerned shall continue to be prohibited until the determination of those proceedings or until the court or tribunal concerned orders otherwise;
- (ii) this subsection shall not apply to the importation or exportation of a single article by a person for his personal and private use.

(4) If the proprietor of a registered trade mark satisfies the Tribunal or a court that—

- (a) he is the proprietor of the trade mark; and
- (b) there are reasonable grounds to suspect that counterfeit trade mark goods have been or may be imported into or exported from Zimbabwe;

the Tribunal or court may issue an order directing the Director of Customs and Excise to prevent the importation or exportation, as the case may be, of those goods.

- (5) An order under subsection (4)—

- (a) shall describe the goods concerned with sufficient particularity to make them readily identifiable; and
- (b) may be granted subject to conditions, including the giving of security by the applicant and the inspection of the goods concerned.

(6) For so long as an order under subsection (4) is in force, the Director of Customs and Excise shall treat the goods to which the order relates as if—

- (a) they were prohibited from importation in terms of section 47 of the Customs and Excise Act [*Chapter 23:02*]; or
- (b) their exportation was prohibited for the purpose of section 61 of the Customs and Excise Act [*Chapter 23:02*];

as the case may be.

(7) The Director of Customs and Excise shall take all necessary steps to inform an importer or exporter or intended importer or exporter of goods whose importation or exportation is prohibited by virtue of this section of the reasons for the prohibition.

(8) While any goods are detained pursuant to a request or an order under this section—

(a) the proprietor at whose instance the request or order was made; and

(b) the importer of the goods;

shall be given an adequate opportunity to inspect the goods in order to determine whether or not they are counterfeit trade mark goods.

(9) Notwithstanding anything in the Customs and Excise Act [*Chapter 23:02*], a person shall not be liable to any penalty under that Act, other than forfeiture of the goods, as a result of their importation or exportation being prohibited by virtue of this section.

[Section substituted by Act 10 of 2001]

### **87 Power to require information in respect of imported goods bearing fraudulent marks**

(1) Where goods the importation of which is prohibited by section *eighty-six* are imported into Zimbabwe and the Director of Customs and Excise is satisfied that the goods are counterfeit trade mark goods as defined in subsection (1) of that section, a customs officer may require the importer of the goods or his agent to produce any documents in his possession relating to the goods and to furnish information as to the name and address of the person by whom the goods were consigned to Zimbabwe and the name and address of the person to whom the goods were sent in Zimbabwe.

[Subsection amended by Act 10 of 2001]

(2) An importer or his agent who fails to comply with any requirement in terms of subsection (1) within fourteen days shall be guilty of an offence and liable to a fine not exceeding level five or to imprisonment for a period not exceeding six months or to both such fine and such imprisonment.

[Subsection amended by Act 22 of 2001]

(3) Notwithstanding section 210 of the Customs and Excise Act [*Chapter 23:02*], the Director of Customs and Excise may communicate to the proprietor or registered user of a registered trade mark which is alleged to have been used in contravention of this Act the name and address of the importer of the goods or his agent and such other information relating to that importer or his agent as the Director of Customs and Excise considers expedient in the circumstances.

### **88 Aiding and abetting offence under this Part**

Any person who within Zimbabwe procures, counsels, aids, abets or is accessory to the commission outside Zimbabwe of any act which, if committed within Zimbabwe, would be an offence under this Part, shall himself be guilty of that offence and liable to be punished accordingly.

[Subsection amended by Act 22 of 2001]

### **89 Limitation of period of prosecution**

No prosecution for an offence under this Part shall be commenced after the expiration of a period of—

(a) three years from the date on which the offence is alleged to have been committed; or

(b) one year after the first discovery thereof by a police officer or customs officer;

whichever is the earlier.

### **90 Evidence**

(1) Any invoice or other document submitted or used by an importer or any other person in connection with the importation of goods in respect of which a prosecution is brought under this Part may be produced as evidence in any criminal proceedings without calling the person who prepared or signed it.

(2) In any prosecution for an offence under this Part, evidence that any imported goods were shipped at any port of call shall be prima facie evidence that those goods were grown, manufactured or produced in the country within which that port is situated.

(3) Where, in any prosecution for an offence under this Part, the consent of the proprietor of a trade mark is a relevant issue the onus of proving the consent of such proprietor shall lie on the accused.

## 91 Forfeiture of goods

(1) On conviction of any person for an offence under this Part, the court may, in addition to any sentence passed, declare any goods in respect of or by means of which the offence was committed to be forfeited to the State, unless the owner of the goods or any person acting on his behalf or other person interested in the goods shows cause to the contrary.

(2) After any goods in respect of or by means of which it is suspected that an offence under this Part has been committed are seized by a police officer and no prosecution is instituted following that seizure—

- (a) the magistrate shall, on application by a police officer, cause a notice to be published in the Gazette and in a newspaper circulating in the area stating that unless cause is shown to the contrary at the time and place specified in the notice such goods shall be declared forfeited; and
- (b) at the time and place referred to in paragraph (a) the magistrate may, unless the owner of the goods or any person acting on his behalf or other person interested in the goods shows cause to the contrary declare such goods to be forfeited to the State.

## PART XIV

### OFFENCES AND PENALTIES

## 92 Falsification of entries in Register

Any person who—

- (a) makes or causes to be made a false entry in the Register; or
- (b) makes or causes to be made a writing falsely purporting to be a copy of an entry in the Register; or
- (c) produces or tenders or causes to be produced or tendered in evidence any writing referred to in paragraph (b), knowing the entry or writing to be false;

shall be guilty of an offence and liable to a fine not exceeding level seven or to imprisonment for a period not exceeding two years or to both such fine and such imprisonment.

[Section amended by Act 22 of 2001]

## 93 Penalty for falsely representing a trade mark as registered

(1) Any person who makes a representation—

- (a) with respect to a mark not being a registered trade mark, to the effect that it is a registered trade mark; or
- (b) with respect to a part of a registered trade mark not being a part separately registered as a trade mark, to the effect that it is so registered; or
- (c) to the effect that a registered trade mark is registered in respect of any goods or services in respect of which it is not registered; or
- (d) to the effect that the registration of a trade mark gives an exclusive right to the use thereof in any circumstances in which, having regard to limitations entered on the Register, the registration does not give that right;

shall be guilty of an offence and liable to a fine not exceeding level five.

[Subsection amended by Act 22 of 2001]

- (2) For the purposes of subsection (1), the use in Zimbabwe, in relation to a trade mark, of the word “registered” or of any other word or abbreviation referring, whether expressly or impliedly, to registration or of a prescribed symbol shall be deemed to import a reference to registration in the Register, except—
  - (a) where that word or symbol is used in physical association with other words delineated in characters at least as large as those in which that word is delineated and indicating that the reference is to registration as a trade mark under the law of a country outside Zimbabwe, being a country under the law of which the registration referred to is in fact in force; or
  - (b) where that word, being a word other than the word “registered”, is of itself such as to indicate that the reference is to such registration as mentioned in paragraph (a); or
  - (c) where that word or symbol is used in relation to a mark registered as a trade mark under the law of a country outside Zimbabwe and in relation to goods to be exported to that country or services to be performed in that country.

## 94 Deceiving or influencing the Registrar or an officer

(1) Any person who—

- (a) for the purpose of deceiving the Registrar or any other officer of the Trade Marks Office in the execution of the provisions of this Act; or
- (b) for the purpose of procuring or influencing the doing or omission of anything in relation to this Act or any matter thereunder;

makes or submits a false statement or representation, whether orally or in writing, knowing the same to be false, shall be guilty of an offence and liable to a fine not exceeding level seven or to imprisonment for a period not exceeding two years or to both such fine and such imprisonment.

[Subsection amended by Act 22 of 2001]

(2) Any person who, having innocently made a false statement or representation, whether orally or in writing, for the purpose of procuring or influencing the doing or omission of anything in relation to this Act or the repealed legislation or any matter thereunder and who, on becoming aware that such statement or representation was false, fails to advise the Registrar forthwith of such falsity shall be guilty of an offence and liable to a fine not exceeding level six or to imprisonment for a period not exceeding one year or to both such fine and such imprisonment.

[Subsection amended by Act 22 of 2001]

## 95 Witness giving false evidence

Any person who, after having been sworn, wilfully gives false evidence before the Registrar concerning the subject matter of the proceeding in question, knowing such evidence to be false or not knowing or believing it to be true, shall be guilty of an offence and liable to a fine not exceeding level seven or to imprisonment for a period not exceeding two years or to both such fine and such imprisonment.

[Subsection amended by Act 22 of 2001 and by Act 10 of 2001]

## 96 Penalties

Save where otherwise specially provided in this Act, any person who is guilty of an offence under this Act shall be liable to a fine not exceeding two thousand dollars or to imprisonment for a period not exceeding two years or to both such fine and such imprisonment.

## PART XV

### GENERAL

## 97 Convention arrangements

(1) Where any person who—

- (a) has applied for protection of a trade mark in a Convention country or is the legal representative or assignee of a person who has made such application; and
- (b) applies in terms of this Act, within six months from the date of the application for protection in the Convention country, for registration of the trade mark;

he shall be entitled, if his trade mark is otherwise registrable in terms of this Act, to registration of his trade mark in priority to other applicants and the registration shall have the same date as the date of the application in the Convention country:

Provided that nothing in this section shall entitle the proprietor of a trade mark to recover damages for infringements happening prior to the actual date on which his trade mark is registered in Zimbabwe.

(2) Where applications have been made for the registration of a trade mark in two or more Convention countries, the period of six months referred to in paragraph (b) of subsection (1) shall be reckoned from the date on which the earlier or earliest of those applications was made.

(3) Where a person has applied for protection for a trade mark by an application which in accordance with—

- (a) the terms of a treaty subsisting between any two or more Convention countries, is equivalent to an application duly made in any one of those Convention countries; or
- (b) the law of any Convention country is equivalent to an application duly made in that Convention country; he shall be deemed for the purposes of this section to have applied in that Convention country.

(4) The registration of a trade mark shall not be invalidated by reason only of the use of the trade mark in Zimbabwe during the period specified in this section as that within which application may be made.

(4a) An application in terms of this Act for the registration of a trade mark which is already registered in a Convention country—

- (a) of which the applicant is a national; or
- (b) in which the applicant is domiciled or in which he has a real and effective industrial or commercial establishment;

shall be accepted unless the trade mark concerned—

- (i) is of such a nature as to infringe rights lawfully acquired by any person in Zimbabwe; or
- (ii) is not distinctive as referred to in section *twelve* or capable of distinguishing goods or services as referred to in section *thirteen*; or
- (iii) consists exclusively of signs which—



- A. serve, in trade, to designate the kind, quality, quantity, intended purpose, value, place of origin or time of production of the goods or services to which the trade mark relates; or
  - B. have become customary in the established practices of the trade in Zimbabwe;
- or
- (iv) is contrary to morality or public order; or
  - (v) is likely to deceive.

[Subsection inserted by Act 10 of 2001]

(4b) Subsection (4a) shall apply notwithstanding that the mark sought to be registered in Zimbabwe may differ from the trade mark already registered in a Convention country in respect of elements that do not alter its distinctiveness and do not affect its identity in the form in which it was registered there.

[Subsection inserted by Act 10 of 2001]

(5) The application for the registration of a trade mark under this section shall be made in the same manner as is required in the case of any ordinary application under this Act, save that proof of application or registration in a Convention country shall be established in the manner prescribed.

[Subsection amended by Act 10 of 2001]

### **97A Banjul Protocol on Marks**

(1) In this section—

“Protocol” means the Banjul Protocol on Marks within the framework of the African Regional Industrial Property Organisation (ARIPO), adopted between the 15th to the 19th November, 1993.

(2) Words or expressions to which a meaning has been assigned in the Protocol shall bear the same meaning when used in this section.

(3) Subject to this section, the Protocol shall have the force of law within Zimbabwe.

(4) Any trade mark which has been registered by the ARIPO Office in accordance with the Protocol and in respect of which Zimbabwe has been designated—

(a) shall have the same effect, *mutatis mutandis*, as a trade mark registered under this Act; and

(b) shall be accorded the same protection, *mutatis mutandis*, as a trade mark registered in accordance with section *ninety-seven*.

(5) Subsection (4) shall apply to trade marks registered by the ARIPO Office before the date this Act comes into effect in accordance with the Protocol:

Provided that the proprietor of any such mark shall not be entitled to damages or any other remedy for infringement of copyright in the mark which took place before that date.

(6) The Minister shall cause a statutory instrument to be published in the *Gazette* setting out the provisions of the Protocol and any regulations made under the Protocol, and shall amend the statutory instrument whenever necessary to record any amendment of the Protocol or those regulations.

[Subsection inserted by Act 10 of 2001]

### **97B Madrid Protocol**

(1) In this section—

“Madrid Protocol” refers to the Madrid Protocol relating to the Madrid Agreement of 1989.

(2) Words or expressions to which a meaning has been assigned in the Madrid Protocol shall bear the same meaning when used in this section.

(3) Subject to this section, the Madrid Protocol shall have the force of law within Zimbabwe.

(4) Any trade mark which has been registered by the Trade Marks Office in accordance with the Madrid Protocol and in respect of which Zimbabwe has been designated, shall—

(a) have the same effect, with such changes as may be necessary, as a trade mark registered under this Act; and

(b) be accorded the same protection, with such modifications as may be necessary, as a trade mark registered in accordance with section *ninety-seven*.

(5) Subsection (4) shall apply to trade marks registered by the Trade Marks Office before the date this Act comes into effect in accordance with the Madrid Protocol:

Provided that the proprietor of any such mark shall not be entitled to damages or any other remedy for infringement of copyright in the mark which took place before that date.

(6) The Minister, by notice in a statutory instrument—

(a) shall set forth the provisions of the Madrid Protocol and any regulations made under the Madrid Protocol, and shall amend the statutory instrument whenever necessary to record any amendment of the Madrid Protocol or those regulations;

- (b) may directly or indirectly amend any provision of this Act (whether by addition, substitution or repeal) insofar as such amendment is strictly necessary for the purpose of—
- (i) implementing the provisions of the Madrid Protocol in Zimbabwe;
  - (ii) bringing this Act into conformity with the Madrid Protocol;
  - (iii) managing the interface between trade marks registered under this Act otherwise than in accordance with the Madrid Protocol and those registered under this Act in accordance with Madrid Protocol, including provisions to enable those holders of trade marks registered under this Act before the domestication of the Madrid Protocol and who wish to benefit from the provisions of the Madrid Protocol to expeditiously re-register their trade marks in accordance with the Madrid Protocol;

(7) The Minister shall lay the draft statutory instrument referred to in subsection (6) before the National Assembly, and if the National Assembly makes no resolution against the publication of the statutory instrument within the next seven sitting days after it is so laid before it, the Minister shall cause it to be published in the *Gazette*.

(8) In the event of inconsistency between this Act and the statutory instrument referred to in subsection (6) then—

- (a) the statutory instrument shall prevail over this Act to the extent of the inconsistency; and
- (b) this Act shall be construed with such modifications, qualifications, adaptations and exceptions as may be necessary to bring it into conformity with the statutory instrument.

[Section inserted by Part CXI of Act 3 of 2016]

## **98 Power of Minister to institute actions outside Zimbabwe**

It shall be lawful for the Minister to take, in any place outside Zimbabwe, such lawful steps, whether by way of action or prosecution at law or otherwise, as he thinks fit to prevent or restrain, or to secure punishment for, the registration, use or application in relation to, or in respect of, goods not grown, produced or manufactured in Zimbabwe or services not performed from Zimbabwe of any trade mark or other mark or description indicating or suggesting or likely to lead to the belief that the goods in respect of which, or to which, such trade mark or description is used or applied were grown, produced or manufactured in Zimbabwe or the services in respect of which such trade mark or description is used or applied were performed from Zimbabwe, as the case may be.

## **99 Change of form of trade connection not to be deemed to cause deception or confusion**

The use of a registered trade mark in relation to goods or services between which and the person using the trade mark any form of connection in the course of trade subsists shall not be deemed to be likely to cause deception or confusion on the ground only that the trade mark has been or is used in relation to goods or services between which and that person or a predecessor in title of his a different form of connection in the course of trade subsisted or subsists.

## **100 Jointly owned trade marks**

(1) Where the relations between two or more persons interested in a trade mark are such that no one of them is entitled as between himself and the other or others of them to use it except—

- (a) on behalf of both or all of them; or
- (b) in relation to an article with which both or all of them are connected in the course of trade or to services which are performed by both or all of them; those persons may be registered as joint proprietors of the trade mark, and this Act shall have effect in relation to any rights to the use of the trade mark vested in those persons as if those rights had been vested in a single person.

(2) Subject to subsection (1), nothing in this Act shall authorize the registration of two or more persons who use a trade mark independently or propose so to use it as joint proprietors thereof.

## **100A Collective marks**

(1) In this section—

“collective mark” means a mark that is capable of distinguishing, in the course of trade, goods or services of persons who are members of an association from goods or services of persons who are not members of the association.

(2) On application by the association concerned, a collective mark shall be registrable in such Part of the Register as the Controller may determine in terms of paragraph (e) of subsection (2) of section *five*.

(3) Subject to subsection (2) and to any regulations made in terms of section *one hundred and four*, Part V shall apply, *mutatis mutandis*, to applications for the registration of collective marks, to their registration and to the duration and renewal of their registration.

(4) Subject to this section, this Act shall apply, *mutatis mutandis*, to registered collective marks in the same way as it applies to registered trade marks.

[Section inserted by Act 10 of 2001]

### **101 Lodging and authentication of documents**

(1) Any application, notice or document authorized or required under this Act to be lodged, made or given at the Trade Marks Office or to the Registrar or any other person may be delivered by hand or sent by registered post.

(2) No authentication shall be required in respect of any document lodged in the Trade Marks Office under this Act or used in proceedings before the Tribunal.

### **102 Provisions as to fees**

(1) Where, under this Act, a fee is payable—

- (a) in respect of the performance of any act by the Registrar, the Registrar shall not perform that act until the fee has been paid; or
- (b) in respect of the doing of any act by any person other than the Registrar, the act shall be deemed not to have been done until the fee has been paid; or
- (c) in respect of the lodging of a document, the document shall be deemed not to have been lodged until the fee has been paid.

(2) All fees shall be paid at the Trade Marks Office in such manner as the Controller, with the approval of the Minister, may accept.

### **103 Patent and Trade Marks Journal**

Particulars of applications for the registration of trade marks and other proceedings or matters arising under this Act, together with such reports or cases and other relevant matters as the Controller may deem fit, shall be published in the Patent and Trade Marks Journal published in terms of section 95 of the Patents Act.

### **104 Power to make regulations**

(1) The Minister may make regulations prescribing anything which under this Act is to be prescribed and generally for the better carrying out of the objects and purposes of this Act or to give force or effect to its provisions or for its better administration.

(2) Regulations made in terms of subsection (1) may provide for—

- (a) regulating the practice under this Act, including the service of documents;
- (b) classifying goods and services for the purposes of registration of trade marks;
- (c) making or requiring duplicate representations of trade marks and other documents;
- (d) securing and regulating the publishing and selling or distributing, in such manner as he thinks fit, of copies and other documents;
- (e) regulating the conduct of the business of the Trade Marks Office;
- (e1) the provision of services by the Trade Marks Office, including the provision of information regarding marks, and the fees and charges payable for such services;  
[Paragraph inserted by Act 10 of 2001]
- (f) the qualifications for eligibility to enter into articles with a trade mark agent or patent agent and matters relating to such articles or service thereunder;
- (g) examinations for the qualifications of trade mark agents in terms of this Act, the recognition for such purpose of qualifications obtained, either in or outside Zimbabwe, and the fees to be paid in connection with the registration of trade mark agents;
- (h) the professional conduct of trade mark agents;
- (i) other fees payable under this Act and fees which may be charged in relation to the conduct of trade mark business by trade mark agents and by patent agents or legal practitioners performing the functions of trade mark agents;
- (j) giving effect to any international treaty or agreement which relates to trade marks and to which Zimbabwe is a party.

[Paragraph inserted by Act 10 of 2001]

(3) Regulations referred to in paragraph (b) of subsection (2)—

- (a) may themselves classify the goods and services concerned; or
- (b) may simply refer to a classification system prescribed by or set out in any treaty or international agreement, in which event a copy of the treaty or agreement shall be kept available for inspection, free of charge, at the Trade Marks Office.