

Namibia

## Industrial Property Act, 2012

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Republic of Namibia  
**Annotated Statutes**

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## **Industrial Property Act, 2012**

### **Act 1 of 2012**

Published in [Government Gazette no. 4907](#) on 23 March 2012  
**Assented to on 28 February 2012**

**Commenced on 1 August 2018 by [Government Notice 113 of 2018](#)**

*[Up to date as at 10 September 2021]*

*[Amended by [Business and Intellectual Property Authority Act, 2016 \(Act 8 of 2016\)](#) on 16 January 2017]*

ACT

**To provide for the establishment of an Industrial Property Registration Office and the appointment of a Registrar of industrial property; to provide for the grant, protection and administration of patents and utility model certificates; to provide for the registration, protection and administration of industrial designs; to provide for the registration, protection and administration of trade marks, collective marks, certification marks and trade names; to provide for the registration of industrial property agents; to provide for the establishment of an Industrial Property Tribunal; and to provide for incidental matters.**

BE IT ENACTED by the Parliament of the Republic of Namibia, as follows:

*[Act 8 of 2016 substitutes “Board” for “Minister” throughout the Act, except in sections 1, 85, 212, 215, 218, 219, 227, 234, 236 and 241. It also substitutes “Registration Office” for “Office” and “staff member” for “official” throughout the Act.]*

### **Chapter 1** **Preliminary and administrative provisions**

#### **Part 1 – Preliminary provisions**

##### **1. General definitions**

In this Act, unless the context indicates otherwise -

“agent” means a legal practitioner practising in Namibia in accordance with the Legal Practitioners’ Act, 1995 or an agent entitled to practice as provided in Part 2 of Chapter 5;



*[The correct name of the Act cited above is the “Legal Practitioners Act” (without an apostrophe); it is Act 15 of 1995.]*

“ARIPO” means the African Regional Intellectual Property Organisation established in Lusaka on December 9, 1976;

“BIPA” means the Business and Intellectual Property Authority established by section 3 of BIPA Act;

“BIPA Act” means the Business and Intellectual Property Authority Act, 2016 (Act No. 8 of 2016);

“Board” means the Board of BIPA constituted under section 8 of BIPA Act;

*[definitions of “BIPA”, “BIPA Act” and “Board” inserted by Act 8 of 2016]*

“bulletin” means the official bulletin of industrial property established in terms of section 9;

*[Act 8 of 2016 makes a global substitution of “staff member” for “official”, but that substitution has not been applied here as the result would be nonsensical.]*

“convention application” means an application in respect of which priority is claimed as provided for in the Paris Convention, and as contemplated in respect of patents in section 29, in respect of designs in section 102 and in respect of trade marks in section 141;

“convention country” means a state or territory which is a party to the Paris Convention;

“court” means the High Court of Namibia as defined in section 1 of the High Court Act, 1990 (Act No. 16 of 1990);

“Harare Protocol” means the Protocol on Patents and Industrial Designs within the Framework of ARIPO adopted in Harare on December 10, 1982 and the Regulations issued thereunder, as amended from time to time;

“industrial property” means patents, utility model certificates, industrial designs, and trade marks including certification trade marks and collective trade marks;

“Minister” means the Minister responsible for trade and industry;

*[definitions of “Office” and “official” deleted by Act 8 of 2016]*

“Paris Convention” means the Paris Convention for the Protection of Industrial Property concluded in Paris on March 20, 1883 as revised from time to time;

“patent” means the title granted under this Act to protect an invention;

“person” means a natural person or a legal person and includes an enterprise or other business entity;

“prescribe” means prescribe by regulation made under section 236;

“priority date” means the date of the earlier application or applications that serves or serve as the basis for the right of priority provided for in the Paris Convention and claimed in a convention application;

“record” means the entering or recordal of information in the appropriate register as contemplated in section 7(3);

“register” or “registers” means the registers referred to in section 7(1);

“Registrar” means the Registrar of business and industrial property as defined in section 1 of BIPA Act;

*[definition of “Registrar” substituted by Act 8 of 2016]*

“Registration Office” means the Registration Office as defined in section 1 of BIPA Act;

*[definition of “Registration Office” inserted by Act 8 of 2016]*

“staff member” means a staff member of BIPA as defined in section 1 of PIBA Act;

*[The definition of “staff member” is substituted by Act 8 of 2016. The reference to “BIPA Act” which was obviously intended erroneously appears as “PIBA Act” in the substituted definition.]*

“this Act” includes the regulations made under section 236;

“Tribunal” means the Industrial Property Tribunal established by section 215;

“TRIPS” means the Agreement on Trade Related Aspects of Intellectual Property which is annexed to the Agreement Establishing the WTO; and

“WTO” means the World Trade Organisation established by the Agreement Establishing the WTO signed at Marrakesh on 15 April 1994.

## **Part 2 – Industrial property Registration Office**

### **2. Registration of industrial property**

For the purposes of this Act, the Registration Office is responsible for all functions relevant to the registration, recordal, maintenance and administration of industrial property rights as provided for in this Act.

*[section 2 substituted by Act 8 of 2016]*

### **3. Functions of Registration Office**

- (1) The Registration Office is responsible for all functions relating to the registration, recordal, maintenance and administration of industrial property rights as provided for in this Act, including all functions as prescribed.
- (2) The Registration Office is also responsible for providing such information services to the public as are provided for under this Act, including such services as may be prescribed.

### **4. \*\*\***

*[section 4 deleted by Act 8 of 2016]*

### **5. Functions and powers of Registrar**

- (1) Without derogating from the generality of the provisions of section 4, the Registrar must exercise the following powers, and perform the following duties and functions, namely to -
  - (a) process all applications made in terms of this Act;
  - (b) grant or, where appropriate, refuse patents and utility model certificates;
  - (c) register or, where appropriate, refuse to register industrial designs, trade marks, certification trade marks and collective trade marks;
  - (d) administer granted patents and utility model certificates and registered industrial designs, trade marks, certification trade marks and collective trade marks;
  - (e) register licence contracts entered into in terms of this Act;
  - (f) carry out studies, programmes or exchanges of information or services regarding domestic and international industrial property law;
  - (g) extend periods during which things may be done as contemplated in section 206;
  - (h) issue administrative instructions as contemplated in section 237; and
  - (i) exercise such powers and perform such functions as are necessary to achieve the objects of this Act.
- (2) Despite anything to the contrary in this Act, the Registrar may, where no specific provision is made for the levying or charging of any fee or additional fee under this Act, charge the applicant any fees or additional fees as may be prescribed for the doing of any act or provision of any service as required under this Act.

## 6. Seal of Registration Office

The Registrar must keep a seal of the Registration Office and the impression of that seal must be judicially noticed.

## 7. Register of industrial property

- (1) The Registration Office must, in the prescribed form and manner, maintain appropriate registers for industrial property, including separate registers for patents, utility models, industrial designs, trade marks and any licence contracts or changes in ownership made in respect industrial property rights.

*[The word “of” is missing after the word “respect”: “changes in ownership made in respect of industrial property rights”.]*

- (2) Certification trade marks and collective trade marks must be registered in a special section of the register of trade marks.
- (3) All the records provided for in this Act must be made in the appropriate registers.
- (4) The registers maintained in terms of this section must be open to the public at such times as maybe determined by the Registrar and any person may, on payment of the prescribed fee and in the manner prescribed, consult the registers or obtain extracts from the registers.

*[The word “maybe” should be “may be”.]*

## 8. Inspection of records

- (1) Any person may, on payment of the prescribed fee and in the manner prescribed, inspect the official file containing all documents lodged in support of an application but -

*[Act 8 of 2016 makes a global substitution of “staff member” for “official”, but that substitution has not been applied here as the result would be nonsensical.]*

- (a) in the case of patents, utility models, and industrial designs, the file is open for inspection from the date on which the grant of the application is published as contemplated in section 39, 86 and 105(2); and

*[The word “section” should be plural to be grammatically correct.]*

- (b) in the case of trade marks, the file is open for inspection from the date on which the acceptance is published as contemplated in section 146(6).

- (2) The file relating to an application for a patent, utility model, industrial design or trade mark may be inspected before the grant of the patent or utility model or the registration of the industrial design or trade mark only with written consent of the applicant.
- (3) Any person may, on request in the prescribed manner and on payment of the prescribed fee, obtain copies or extracts from any document or entry open to public inspection.
- (4) Even before the grant of a patent or a utility model or the registration of an industrial design or a trade mark, the Registration Office may, on request, communicate the following bibliographic data:
  - (a) the name and address of the applicant and the name and address of the applicant’s agent, if any;
  - (b) the number of the application;
  - (c) the filing date of the application and, if priority is claimed, the date and number of the earlier application; and
  - (d) in the case of a patent, the title of the invention.

## 9. Bulletin of industrial property

The Registrar must establish and publish a bulletin of industrial property in respect of patents, utility models, industrial designs and trade marks, including certification trade marks and collective trade marks, in which must be published all matters that are required to be published under this Act.

## 10. Restrictions regarding staff members

- (1) An staff member of the Registration Office may not file an application for an industrial property right, be granted industrial property rights or hold any rights relating to industrial property while employed in the Registration Office and for a period of two years after termination of employment with the Registration Office.

*[As a result of the global substitution of “staff member” for “official” by Act 8 of 2016, the word “An” at the beginning of subsection (1) should now be “A”.]*

- (2) Nothing in this section contained applies to any acquisition of any industrial property rights by bequest or devolution by operation of law.

- (3) An staff member of the Registration Office may not, while employed by the Registration Office or after termination of such employment -

*[As a result of the global substitution of “staff member” for “official” by Act 8 of 2016, the word “An” at the beginning of subsection (3) should now be “A”.]*

- (a) disclose to any other person any information acquired by that staff member in the exercise of his or her powers or the performance of his or her functions under this Act and relating to the business or affairs of any person; or
- (b) use any information acquired under the circumstances referred to in paragraph (a) for self-gain or for the benefit of any third party.
- (4) Subsection (3)(a) does not apply if the information is disclosed -
- (a) for the purpose of the exercise of that staff member’s powers or the performance of his or her functions under this Act;
- (b) for the purpose of legal proceedings under this Act;
- (c) when the staff member is required to do so by any competent court or under any law; or
- (d) with the written authority of the Board.
- (5) A person who contravenes or fails to comply with subsection (1) or (3) commits an offence and on conviction is liable to a fine not exceeding N\$5 000 or to imprisonment for a period of 12 months or to both such fine and imprisonment.

## 11. Limitation of liability

The Registrar or staff member is not personally liable for damage or loss arising out of an act or omission committed in good faith, while exercising or performing the powers or functions under or in terms of this Act, except if such damage or loss was caused as a result of the gross negligence, dishonesty or unlawful conduct by the Registrar or staff member.

*[section 11 substituted by Act 8 of 2016]*

## Chapter 2 Patents

### Part 1 – Patents for inventions

## 12. Definitions and interpretation

(1) For the purposes of this Chapter -

“**anticipated**” means forming part of or disclosed by prior art;

“**art**” means -

- (a) all matter disclosed to the public, anywhere in the world, by publication in any form, or by oral disclosure, by use or in any other way;
- (b) matter contained in a pending application for a patent as contemplated in section 14(3);
- (c) knowledge developed by or in possession of a local or indigenous community and which originated at a date prior to the priority date of the relevant invention;

“**exploit**”, in relation to a patented invention, means doing any of the following acts:

- (a) when the patent has been granted in respect of a product -
  - (i) making, importing, disposing of, offering to dispose of or using the product;
  - (ii) stocking such product for the purposes of disposing of, offering to dispose of or using;
- (b) when the patent has been granted in respect of a process -
  - (i) using the process;
  - (ii) doing any of the acts referred to in paragraph (a) in respect of a product obtained directly by means of the process;

“**invention**” means an idea of an inventor in the form of new knowledge of a technical nature;

“**Patent Co-operation Treaty**” means the Patent Co-operation Treaty concluded at Washington on June 19, 1970 and the Regulations issued thereunder, as amended from time to time; and

“**prior art**” means the art at a date immediately prior to the filing date or, where appropriate, the priority date of an application claiming the invention.

(2) An invention -

- (a) may be, or may relate to, a product or a process applicable in any field of technology; and
- (b) may comprise a micro-organism or a microbiological process and the product of such process.

### 13. Patentable inventions

Patents are available for any inventions, whether products or processes, in all fields of technology, provided the invention is new, involves an inventive step and is industrially applicable.

### 14. Novelty, inventive step and industrial application

- (1) An invention is new if it is not anticipated by prior art.
- (2) For the purposes of subsection (1) disclosure to the public of the invention may not be taken into consideration if it occurred within six months preceeding the filing date or, where applicable, the priority date of the application, and if it was by reason or in consequence of -

*[The word “preceeding” is misspelt in the Government Gazette, as reproduced above.]*

- (a) acts committed by the applicant or his or her predecessor in title, or of an unauthorised disclosure; or
  - (b) an abuse committed by a third party with regard to the applicant or his or her predecessor in title.
- (3) For the purposes of subsection (1), prior art also includes matter contained in an application, open to public inspection, for a patent, despite that the application was lodged at the Registration Office and

became open to public inspection on or after the priority date of the relevant invention, if -

- (a) that matter was contained in that application both as lodged and as open to public inspection; and
- (b) the priority date of that matter is earlier than that of the invention.

### 15. Inventive step

- (1) An invention must be considered as involving an inventive step if, having regard to the prior art relevant to the invention claimed in the application and as defined in sections 12(1) and 14 but excluding section 14(3), it is not obvious to a person skilled in the art.
- (2) For purposes of subsection (1), an invention is deemed obvious when the prior art provides motivation to try the invention, or when the method of making a claimed product is disclosed in or rendered obvious by a single piece or combination of pieces of prior art.

### 16. Industrial application

An invention may be considered to be industrially applicable if it can be made or used in any kind of industry.

### 17. Matter excluded from patentability

- (1) The following are excluded from patentability:
  - (a) discoveries, scientific theories and mathematical methods;
  - (b) a literary, dramatic, musical or artistic work or any other aesthetic creation;
  - (c) schemes, rules or methods for doing business, performing purely mental acts or playing games;
  - (d) programmes for computers;
  - (e) presentations of information;
  - (f) diagnostic, therapeutical and surgical methods for the treatment of humans or animals;
  - (g) plants and animals other than micro-organisms and any essentially biological processes for the production of plants and animals other than non-biological and microbiological processes;
  - (h) the human body and all its elements in whole or in part;
  - (i) the whole or part of natural living beings and biological materials found in nature, even if isolated from it or purified, including the genome or germplasm;  
*[The word "germplasm" is misspelt in the Government Gazette, as reproduced above.]*
  - (j) new uses, methods of use, forms, properties of a known product or substance and already used for specific purposes and changes of shape, dimensions, proportions or materials in the subject matter applied for, except where the qualities of the subject matter are essentially altered or where its use solves a technical problem that did not previously have an equivalent solution; and
  - (k) new use of a known process, machine or apparatus unless such known process results in a new product or employs at least one new reactant.
- (2) For the purposes of subsection (1)(j), salts, esters, ethers, polymorphs, metabolites, pure form, particle size, isomers, mixtures of isomers, enantiomers, complexes, combinations, compositions, formulations, dosage forms, admixtures and other derivatives of known substances must be considered to be substances.

### 18. Exclusion from patentability on grounds of morality or public order

- (1) Inventions the commercial exploitation of which would be contrary to public order or morality are excluded from patentability, except that an invention will not be so excluded merely because the

exploitation thereof is prohibited by law.

- (2) For the purposes of subsection (1), public order or morality includes considerations relating to -
  - (a) the patentability and protection of human, animal or plant life or health; or
  - (b) the avoidance of serious harm to the environment.

## **Part 2 – Right to patent**

### **19. Right to a patent**

- (1) The right to a patent belongs to the inventor.
- (2) If two or more persons have jointly made an invention, the right to apply for the patent belongs to them jointly.
- (3) If and to the extent to which two or more persons have made the same invention independently of each other, the person whose application has the earliest filing date or, if priority is claimed, the earliest validly claimed priority date, and which application leads to the grant of a patent has the right to the patent for the duration of the patent.
- (4) The right to a patent may be assigned, or may be transferred by succession or otherwise by operation of law.

### **20. Naming of inventor**

- (1) The inventor must be named as such in the application for a patent and in the patent, unless in a written declaration addressed to the Registrar and lodged with the Registrar prior to the grant of the patent the inventor declares that he or she wishes not to be named.
- (2) Any promise or undertaking by the inventor made to any person to the effect that he or she will make a declaration as contemplated in subsection (1) has no legal effect.
- (3) When a declaration as contemplated in subsection (1) is lodged, the Registrar must record the declaration in the register and must retain such declaration for the duration of the patent.

### **21. Invention by employee or person commissioned**

- (1) Where an invention is made in the execution of a commission contract or in the course of an employment contract, the right to the patent for that invention passes to and belongs, in the absence of written contractual provisions to the contrary, to the person who commissioned the work or to the employer, as the case may be.
- (2) Where the right to a patent has passed to another as contemplated in subsection (1) and it later transpires that the invention has an economic value much greater than what the parties could have reasonably foreseen at the time of concluding the commission or employment contract, the inventor has a right to equitable remuneration, which must be determined by the Tribunal in the absence of agreement between the parties.
- (3) Despite subsections (1) and (2), when an employee, whose employment contract does not require him or her to engage in inventive activity, makes an invention in the field of activities of his or her employer by using data or means available to him or her through his or her employment, the right to the patent for that invention belongs, in the absence of written contractual provisions to the contrary, to the employer.
- (4) Where the right to a patent passes to employer in terms of subsection (3), the employee has a right to equitable remuneration as may in writing be agreed upon by him or her and the employer, taking into account his or her salary, the economic value of the invention and any benefit derived from the invention by the employer.

*[There should be a word such as “an” or “the” before the first use of the word “employer”.]*

- (5) In the absence of a written agreement between the parties, the remuneration as contemplated in subsection (4) must be determined by the Tribunal.
- (6) Any written contractual provision which is less favourable to the inventor than the provisions of this section, or which purports to exclude the application of this section, is void.
- (7) The provisions of section 20 regarding the naming of the inventor apply to a person entitled to a patent under this section.

## **22. Judicial assignment of right to a patent application or patent**

- (1) Where a dispute arises between persons as to their rights to obtain a patent for or to make, use, exercise or dispose of an invention, or as to the right to or title in a patent, any party to the dispute may apply to the Tribunal to decide the matter in dispute.
- (2) If the Tribunal is satisfied that a person is unable or unwilling to exercise his or her right to file or to participate in an application for a patent, the Tribunal may order that person to execute an assignment, in order that the application may be made without such participation, but where it appears to the Tribunal to be just and equitable, the Tribunal may order the payment of compensation to the non-participating person.
- (3) In any order declaring that a person has a right to the exclusion of any other person to apply for or to be the owner of a patent, the Tribunal may direct that such other person executes any deed of assignment that may be required and that such deed of assignment may extend to countries outside Namibia.

## **Part 3 – Application procedure**

### **23. Who may apply for a patent**

An application for a patent may be filed -

- (a) by the inventor or inventors;
- (b) by a person who has acquired the right to apply from the inventor by operation of law;
- (c) by both the inventor and the person referred to in paragraph (b); or
- (d) by an agent duly authorised to act on behalf of any of the persons referred to in paragraphs (a) to (c).

### **24. Application for a patent**

- (1) The application for a patent must be filed with the Registrar in the manner prescribed and must contain -
  - (a) a written request;
  - (b) a specification comprising of -
    - (i) a description;
    - (ii) one or more claims;
    - (iii) one or more drawings, where required; and
  - (c) an abstract.
- (2) Where the subject matter of a patent application is derived from or developed with biological resources or associated indigenous or traditional knowledge, the applicant must disclose in the application for a patent the country providing the resources or associated indigenous or traditional knowledge, from whom in the providing country they were obtained, and, as known after reasonable inquiry, the country of origin and any other information regarding the source or nature of the resources as may be prescribed.
- (3) The request must contain -



- (a) a petition to the effect that a patent be granted;
  - (b) the name of and other prescribed information concerning the applicant, the inventor, and agent, if any; and
  - (c) the title of the invention.
- (4) Where the applicant is not the inventor, the applicant must, within the prescribed period, provide a written statement establishing the applicant's right to the patent.
- (5) The description must -
- (a) disclose the invention and the manner in which it is to be performed in a manner sufficiently clear and complete for the invention to be carried out by a person skilled in the art;
  - (b) indicate the best mode for carrying out the invention known to the applicant at the filing date or, where priority is claimed, at the priority date of the application; and
  - (c) where necessary illustrate or exemplify the invention and the manner in which it is to be performed, or contain such further information or particulars regarding the invention as may be prescribed.
- (6) The claim or claims must -
- (a) define the matter for which protection is sought;
  - (b) be clear and concise; and
  - (c) be supported by the description.
- (7) Drawings are required when they are necessary for the understanding of the invention.
- (8) The description and the drawings may be used to interpret the claim or claims.
- (9) The purpose of the abstract is to provide technical information and may not be taken into account for the purpose of interpreting the scope of the protection.

## 25. Application fee

The application for a patent must be accompanied by the prescribed application fee which must be paid in the manner prescribed.

## 26. Unity of Invention

- (1) An application for a patent must relate to one invention only or to a group of inventions so linked as to be part of a single general inventive concept.
- (2) The claim or claims must relate to one invention or one inventive concept as contemplated in subsection (1) and must define the matter for which protection is sought.
- (3) The fact that a patent has been granted on an application that did not comply with the requirement of unity of invention under subsection (1) or (2) is not a ground for the invalidation of the patent.

## 27. Division of application

- (1) The applicant may at any time before a patent is granted, apply to the Registrar in the prescribed manner to divide the application into two or more applications, (referred to in this section as "divisional applications") provided that each application does not introduce matter not in substance disclosed in the disclosure in the initial application or incorporate a claim not fairly based on matter disclosed in the disclosure in the initial application.
- (2) If the Registrar is satisfied that the requirements of subsection (1) have been complied with, he or she

must allow the division.

- (3) Each divisional application must accorded the filing date and, where applicable, the priority date of the initial application.

*[The word "be" is missing after the word "must": "Each divisional application must be accorded...".]*

## 28. Amendment of application

- (1) The applicant may, at any time before a patent is granted, apply in the prescribed manner to the Registrar to amend the application, but the amendment may not be allowed if it introduces matter not in substance disclosed in the initial disclosure in the application, or introduces a claim not based on matter disclosed in the initial disclosure in the application.
- (2) If the Registrar is satisfied that the requirements of subsection (1) have been complied with, he or she must allow the amendment and must make the requested changes in the application.

## 29. Right of priority

- (1) An application for a patent may contain a declaration claiming the priority, as provided for in the Paris Convention, of one or more earlier national, regional or international applications filed by the applicant or his or her predecessor in title in or for any State party to the said convention or in any member of the WTO.
- (2) Where the application contains a declaration under subsection (1), the Registrar may require that the applicant furnish, within the prescribed time, a copy of each such earlier application certified as correct by the office with which it was filed.
- (3) The effect of the said declaration is as provided in the Paris Convention, including that -
  - (a) if the invention claimed in the application is fairly based on matter disclosed in one or more of such earlier applications, the priority date of the invention is the date on which the earliest of such earlier applications was filed; and
  - (b) the invention claimed in the application may have one or more priority dates.
- (4) If the Registrar finds that the requirements under this section have not been fulfilled, the said declaration is deemed not to have been made, and the date of the application will be the filing date accorded to the application as provided for in section 34.

## 30. Information concerning corresponding foreign applications

- (1) The applicant must, within the prescribed period, furnish the Registrar with date and number of any application for a patent or other title of protection filed by the applicant abroad (herein referred to as a foreign application) relating to the same or essentially the same invention as that claimed in the application filed with the Registration Office.
- (2) The applicant must furnish the Registrar with the following documents relating to any one of the foreign applications referred to in subsection (1) -
  - (a) a copy of any communication received by the applicant from any search or examination authority concerning the results of any search or examination carried out in respect of the foreign application;
  - (b) a copy of the patent or other title of protection granted on the basis of the foreign application;
  - (c) a copy of any final decision rejecting the foreign application or refusing the grant requested in the foreign application.
- (3) Where the document mentioned in subsection (2) is not available at the time of application for a patent, the document must be provided to the Registrar within the prescribed period after the applicant receives

the relevant document.

- (4) The applicant must, within the prescribed period, furnish the Registrar with -
  - (a) information relating to the withdrawal or surrender of a foreign patent application referred to in subsection (1);
  - (b) information relating to the surrender of a patent or other title of protection granted on a foreign application referred to in subsection (1); or
  - (c) a copy of any final decision invalidating or revoking the patent or other title of protection granted on a foreign application referred to in subsection (1).
- (5) Subsection (2)(a) does not apply in respect of information relating to the examination of the same international application in another elected office where the Registration Office is an elected office in the meaning of section 81 and has received or will receive an international preliminary report on patentability.

### **31. Post-dating of application**

The applicant may, at any time before a patent is granted, in the prescribed manner request the Registrar to direct that the application be post-dated to such date as may be specified in the request, except that -

- (a) no application may be post-dated under this section to a date later than six months from the date on which it was actually lodged;
- (b) an application claiming priority in terms of section 29 may not be post-dated under this section to a date later than the last date on which, under the provisions of this Act, the application could have been lodged; and
- (c) no application may be post-dated if priority has been claimed on the basis of that application by the applicant or his or her successors or predecessors in title in a subsequent application for a patent which leaves any rights outstanding.

### **32. Withdrawal of application**

The applicant may, at any time before a patent is granted, withdraw the application.

### **33. Conversion of patent application**

- (1) The applicant may at any time before a patent is granted or refused, in the prescribed manner, apply to the Registrar for the patent application to be converted to an application for a utility model as contemplated in section 90(1).
- (2) Such application for a utility model must be accorded as its filing date, the filing date of the patent application as provided for in section 34.

### **34. Filing date**

- (1) The Registrar must accord as the filing date of the application, the date of receipt of the application, provided that at the time of its receipt, the application contains -
  - (a) an express or implicit indication that the granting of a patent is sought;
  - (b) information allowing the identity of the applicant to be established; and
  - (c) a description which, on the face of it, appears to be a specification in respect of an invention.
- (2) If the Registrar finds that the application did not, at the time of receipt, comply with the requirements of subsection (1), the Registrar must invite the applicant to file the required correction within the prescribed time.

- (3) The Registrar must accord as the filing date of the application the date of receipt of the required correction referred to in subsection (2).
- (4) Where the applicant fails to make the required correction within the prescribed time, the application must be treated as if it had not been filed.
- (5) Where the application refers to drawings which in fact were not included in the application, the Registrar must invite the applicant to furnish the missing drawings within the prescribed time.
- (6) If the applicant complies with the invitation referred to in subsection (5), the Registrar must accord as the filing date of the application, the date of receipt of the missing drawings.
- (7) If the applicant fails to comply with the invitation referred to in subsection (5), the Registrar must accord as the filing date of the application, the date of receipt of the application and must treat any reference to the said drawings as non-existent.

## **Part 4 – Examination of application and grant of patent**

### **35. Examination as to form and unity of invention**

After according a filing date, the Registrar must examine whether -

- (a) the application complies with the requirements of sections 24, 25 and 26 or any formal requirements prescribed under this Act; and
- (b) information requested under section 30, if any, has been provided,

and must proceed to have the application examined as contemplated in section 36 or in such manner and by such persons or institutions as may be prescribed.

### **36. Examination as to substance**

- (1) Where the Registrar is satisfied that the application complies with the requirements indicated in section 35, the Registrar must examine the application or cause the application to be examined to determine whether -
  - (a) the claimed invention is patentable within the meaning of sections 13 to 16; and
  - (b) the claimed invention is not excluded from protection under sections 17 or 18.
- (2) An examination contemplated in subsection (1) must be conducted in the manner prescribed and the Registrar must take into account any search report established in terms of section 37.
- (3) If the Registrar finds, after the application has been examined as envisaged in subsection (1) and taking into account section 37, that the application does not comply with the requirements referred to in subsection (1), or cannot be granted in the light of the results of a search or examination report referred to in section 37, he or she must notify the applicant in the manner prescribed, setting out the reasons for the finding.
- (4) The applicant may, on receipt of the notification referred to in subsection (3) and within the prescribed period, submit arguments as to why the application, despite the finding of the Registrar, should be granted, or submit changes to the description, claims or drawings to address the finding of the Registrar as contemplated in subsection (5).
- (5) The Registrar must, on the request of the applicant within the prescribed period, make such changes in the description, claims or drawings of the specification as requested by the applicant in order to remove the reasons for non-compliance as referred to in subsection (3), except that no such change will be allowed if it would result in the introduction into the specification of matter not in substance disclosed in the initial disclosure, or result in a claim not fairly based on matter disclosed in the initial disclosure.

### **37. International-type search**

- (1) For the purposes of section 36, the Registrar must take into account -
  - (a) the results of any international search report and any international preliminary examination report established under the Patent Cooperation Treaty in relation to the application;
  - (b) a search and examination report submitted under section 30(2)(a) relating to a corresponding foreign application, if any, or a final decision submitted under section 30(2)(c) on the refusal to grant a patent on a corresponding foreign application, if any, or a final decision submitted under section 30(3) relating to the withdrawal, surrender, revocation or invalidation of a foreign patent application or a patent or other title of protection granted on a foreign patent application as the case maybe, if any; and  
*[The word "maybe" should be "may be".]*
  - (c) a search and examination report which was carried out upon his or her request by an external search and examination authority as contemplated in subsection (2).
- (2) The Registrar may, instead of or in addition to conducting the examination of an application as contemplated in section 36, refer the application to an external search and examination authority as approved by the Board.

### **38. Grant or refusal of patent**

- (1) If the Registrar is satisfied that the application as originally filed or as amended complies with the requirements of sections 35 and 36 the Registrar must grant the patent.
- (2) If the Registrar is satisfied that the requirements of sections 35 and 36 have not been complied with despite arguments submitted in terms of section 36(4) or changes made to the description, claims or drawings in accordance with section 27 or section 36, the Registrar must refuse the application and notify the applicant accordingly.
- (3) The Registrar must, whenever possible, make a final decision on the application not later than two years after the commencement of the examination referred to in section 35.

### **39. Registration and publication of patent**

- (1) Where the Registrar grants a patent, he or she must -
  - (a) publish a reference to the grant of the patent in the bulletin;
  - (b) issue to the applicant a certificate of the grant of the patent; and
  - (c) record the patent in the relevant register.
- (2) The Registrar must, on payment of the prescribed fee, make available a copy or copies of any patent granted under this section to any person who requests for such a copy.

*[The word "for" before the phrase "such a copy" is superfluous.]*

### **40. Amendment of patent**

- (1) The owner of the patent may, at any time after the grant of the patent, request the Registrar to amend the patent in order to limit the extent of the protection conferred by the patent or by making changes in the description, claims or drawings of the patent provided that the amendment would not -
  - (a) result in the introduction into the specification of matter not in substance disclosed in the initial disclosure contained in the application on the basis of which the patent was granted; or
  - (b) result in a claim which is not wholly within the scope of a claim contained in the specification before the amendment.
- (2) The request for the amendment of a patent must, in the prescribed manner, be published in the bulletin.

- (3) Any person may, within the prescribed time and in the prescribed manner, oppose a request for amendment and any opposition to an amendment must be dealt with by the Registrar in the prescribed manner, and the Registrar must determine whether and on what conditions, if any, the amendment ought to be allowed.
- (4) If the Registrar is satisfied that the requirements of subsection (1) have been complied with, and if there is no opposition as provided for in subsection (3) or, if there is opposition, and the Registrar is satisfied that such opposition is without merit, he or she must make the requested changes in the description, claim or drawings of the patent.
- (5) If the Registrar is not satisfied that the requirements of subsection (1) have been complied with, or if there is opposition as provided for in subsection (3) and the Registrar is satisfied that the opposition has merit, he or she must refuse the amendment and refuse to make the requested changes in the description, claims or drawings of the patent.

## **Part 5 – Rights and obligations of applicant or owner of patent**

### **41. Rights of applicant or owner of patent**

Subject to sections 43 and 47(6) and to the provisions of Part 9, the applicant or the owner of a patent in Namibia has the following rights:

- (a) the applicant has the right to be granted the patent, where the relevant provisions of this Act have been satisfied;
- (b) the owner has the right to exploit the patent;  
*[The word “to” before “the patent” is superfluous.]*
- (c) the owner has the right, within the limits specified in section 43, to exclude all other persons from exploiting in Namibia the patented invention without his or her authority (such unauthorised exploitation herein referred to as “infringement”), so that he or she has and enjoys the whole profit and advantage accruing by reason of the invention; and
- (d) the applicant or the owner has the right to assign, or transfer by succession the patent application or the patent and to conclude licence contracts for the exploitation of the patented invention in Namibia by other persons as provided for in Part 8.

### **42. Obligations of applicant or owner of patent**

The applicant or the owner of a patent has the following obligations:

- (a) the applicant must disclose the invention in a clear and complete manner and in particular to indicate the best mode for carrying out the invention, in accordance with the requirements of this Act;
- (b) the applicant must give information concerning corresponding foreign applications and grants, as required by section 30;
- (c) the owner must exploit or work the patented invention in Namibia within the prescribed time limits;
- (d) the applicant or the owner must pay any prescribed fees;
- (e) the owner must comply with the requirements of section 70(4) before instituting any infringement proceedings; and
- (f) the applicant or owner must comply with any other requirements provided for under this Act.

### **43. Limitation of rights**

- (1) The following acts do not constitute an infringement of the rights under a patent, namely -

- (a) acts of importation of patented inventions which have been put on the market in any territory or country by the owner of the patent or with his or her authorisation;
  - (b) the use of patented inventions on aircraft, land vehicles, or vessels of other countries which temporarily or accidentally enter the airspace, territory or waters of Namibia;
  - (c) acts related to experimental use of the patented invention or acts done on a non-commercial scale for scientific research;
  - (d) use of a patented invention for teaching purposes;
  - (e) the use of a patented invention in a pharmacy or by a medical doctor for the preparation of a medicine in accordance with a medical prescription for individual cases; or
  - (f) acts performed by any person who in good faith, before the filing or, where priority is claimed, the priority date of the application on which the patent is granted, was using the invention or was making effective and serious preparations for such use in Namibia (the “prior user”).
- (2) It is not an infringement of a patent for any person to carry out acts, including testing, making, constructing, importing or using the patented invention solely for uses reasonably related to the development and submission of information required under any law of Namibia or any other country other than Namibia that regulates the manufacture, construction, distribution, use, import or sale of any product; except that it is not permitted to stock any products of the patented invention in any substantial quantities for any purpose other than for the development or submission of the information required.

#### 44. ARIPO patents

- (1) Where an application for the grant of a patent in ARIPO is filed with the Registration Office as the receiving office as contemplated in Article 2 of the Harare Protocol, the Registrar must without delay transmit the application to the office of ARIPO and perform such acts as are required of him or her, after which the application must be processed in accordance with the provisions of the Harare Protocol.
- (2) If the office of ARIPO decides to grant a patent on an application and notifies the Registrar, the Registrar must -
  - (a) accord as the filing date of the application, the filing date accorded to the application by the office of ARIPO;
  - (b) determine whether the application complies with sections 35 and 36;
  - (c) if the Registrar finds that the requirements referred to in sections 35 and 36 are not complied with, communicate in writing to the office of ARIPO within six months from the date on which the Registrar was notified, that if a patent is granted by that office that patent has no effect in Namibia;
  - (d) if the Registrar finds that the requirements referred to in sections 35 and 36 are complied with, deal with the application in accordance with sections 38 and 39.
- (3) A patent granted by ARIPO by virtue of the Harare Protocol and in respect of which Namibia is a designated State, has the same effect in Namibia as a patent granted under this Act unless the Registrar has communicated to ARIPO in respect of the application therefor, a decision as contemplated in subsection (2)(c).

### Part 6 – Duration of patent and annual fees

#### 45. Duration of patent and extension

Subject to section 46, a patent expires 20 years after the filing date of the application for the patent in terms of section 34(1), 44(2)(a) or 83(2)(c), as the case may be.

#### 46. Annual fees

- (1) In order to maintain the patent or patent application, the owner of the patent or the applicant for a patent must, in the manner prescribed, pay to the Registrar the prescribed annual fee for each year starting one year after the filing date of the application for the grant of the patent.
- (2) If the owner of a patent or the applicant for a patent fails to pay the prescribed fee within the prescribed period, the Registrar may on request by the owner or applicant, grant a grace period not exceeding six months within which the annual fee and any prescribed surcharge must be paid by the owner or applicant.
- (3) If an annual fee is not paid in accordance with the provisions of subsection (1) or before the expiration of six months referred to in subsection (2), the patent application is deemed to have been withdrawn or the patent lapses.

#### **47. Restoration**

- (1) Where a patent application or a patent has lapsed owing to the non-payment of any prescribed annual fee within the prescribed period or the grace period referred to in section 46, the owner of the application or the patent may in the prescribed manner and on payment of the prescribed fee, apply to the Registrar for the restoration of the application or the patent.
- (2) If the Registrar is satisfied that the omission was unintentional and that no undue delay has occurred in the making of the application, he or she must publish the application for restoration in the bulletin in the prescribed manner, and thereupon any person may within such period as prescribed, give notice in the prescribed manner of opposition to the restoration of the application or the patent.
- (3) If there is no opposition as provided for in subsection (2), or if there is opposition and the Registrar is satisfied that such opposition is without merit, he or she must restore the application or the patent.
- (4) Any such restoration of the application or the patent is subject to the payment of such annual fees as contemplated in section 46 as remain unpaid at the date of the restoration and any additional administrative charges incurred by the Registrar or penalty fees as may be prescribed.
- (5) If there is opposition as provided for in subsection (2) and the Registrar is satisfied that the opposition has merit, he or she must refuse to restore the application or the patent.
- (6) The owner of a patent restored in accordance with subsections (1) to (4) is not entitled, in terms of the provisions of section 41, to institute any proceedings against or recover damages from any person who exploited the patented invention after the lapse of a period of six months from the date on which the annual fee was due and before the date on which the request for restoration was advertised, or who commenced exploitation of the patented invention during the aforesaid period and thereafter continues to exploit the patented invention.
- (7) Where a patent application or a patent has been restored in accordance with subsections (1) to (4), any person who during the period referred to in subsection (6) expended any money, time or labour with a view to exploiting the patented invention and who is prevented from such exploitation by the restoration of the patent, may apply to the Tribunal for compensation to be paid by the owner of the patent in respect of the money, time and labour so expended.
- (8) If the owner fails to pay the compensation, if any, found to be payable by the Tribunal, the patent application or the patent lapses.

### **Part 7 – Change in ownership and joint ownership of patent applications and patents**

#### **48. Change in ownership of applications or patents**

- (1) Any change in the ownership of a patent or in the ownership of a patent application, must be in writing and signed by the transferor, unless the transferor is deceased or has ceased to exist.
- (2) The owner of a patent or patent application or any interested party may in the prescribed manner request the Registrar to change ownership of the patent or patent application.



- (3) On receipt of an application made under subsection (2) -
  - (a) the Registrar must record the change in the appropriate register; and
  - (b) except in the case of the transfer of an application, the Registrar must publish any such change in the bulletin.
- (4) A change in the ownership of any title mentioned in this section has no effect against third parties unless it has been recorded by the Registrar in the appropriate register.

#### **49. Joint ownership of patent applications**

- (1) Where two or more persons have jointly filed an application for a patent, the joint applicants have, in the absence of an agreement to the contrary, equal undivided shares in the application, and none of them may without the consent of the other joint applicant or applicants deal in any way with the application, but if any proceedings are required to save the application from becoming abandoned, any applicant may institute such proceedings on behalf of himself or herself and any other joint applicant.
- (2) If any dispute arises between joint applicants as to their respective rights in and to an application for a patent or as to the manner in which the application is to be proceeded with or the manner in which they may deal with the application or exploit the invention, any such joint applicant may apply to the Tribunal to decide the matter in dispute.
- (3) Unless the Tribunal otherwise directs, the person who makes an application in terms of subsection (2) is liable for all costs and expenses incurred in respect of proceedings in terms of that subsection.
- (4) If the Tribunal is satisfied that a joint applicant is unable or unwilling to proceed as joint applicant, the Tribunal may in the manner contemplated in section 22, order that he or she assign his or her rights to any joint applicant able and willing so to proceed, provided that where it appears to the Tribunal to be just and equitable, the Tribunal may order the payment of compensation to the assignor.
- (5) In any proceedings in terms of subsection (2) the Tribunal must, unless it appears that there are good reasons to the contrary, resolve the dispute in a manner which will lead to the preservation of the application and the grant of a patent.

#### **50. Joint ownership of patents**

- (1) Where a patent is granted to two or more persons jointly, each of the joint patent owners is, in the absence of an agreement to the contrary, entitled to an equal undivided share in the patent.
- (2) Subject to the provisions of subsection (4), a joint patent owner is, in the absence of an agreement to the contrary and in the absence of consent of the other joint patent owner, not entitled to -
  - (a) make, import, dispose of, offer for disposal or use the patented invention;
  - (b) grant a licence or to assign the whole or any part of his or her interest in the patent; or
  - (c) take any steps or institute any proceedings relating to the patent.
- (3) Despite subsection (2), a joint patent owner may pay any renewal fee that is payable without recourse to any other patent owner, unless the Tribunal directs otherwise in proceedings in terms of subsection (7).
- (4) Where a patented invention is disposed of by a joint patent owner, the acquirer or any person claiming through him or her is entitled to deal with it in the same manner as if the article had been disposed of by the patent owners jointly.
- (5) Any joint patent owner may institute proceedings for infringement and must give notice thereof to every other joint patent owner, and any such other patent owner may intervene as co-plaintiff and recover any damages in respect of any damage he or she may have suffered as a result of the infringement.
- (6) If in any proceedings under subsection (5) damages are awarded to a plaintiff, damages must be awarded as if he or she were the sole patent owner, and the defendant is not obliged to compensate any other joint

patent owner in respect of the infringement in question.

- (7) Where any dispute arises between joint patent owners as to their respective rights in or to a patent, the institution of proceedings relating to the patent or the manner in which they should deal with the patent or the patented invention, any joint patent owner may apply to the Tribunal to decide the matter in dispute.
- (8) If in considering any application under subsection (7) the Tribunal is satisfied that a joint patent owner is unable or unwilling to remain a patent owner, the Tribunal may order him or her to assign his or her rights to any other joint patent owner able and willing so to remain but, where it appears to the Tribunal to be just and equitable, it may order the payment of compensation to such joint patent owner who is so ordered to assign his or her rights.
- (9) In considering any application under subsection (7) the Tribunal must, unless it appears that there are good reasons to the contrary, resolve the dispute in a manner which will lead to the preservation and exploitation of the patent.

## Part 8 – Voluntary licences

### 51. Form and recordal of licence

- (1) The owner of a patent application or a patent may enter into a contract with one or more other persons to authorise such person or persons to exploit the invention covered by the patent application or the patent in Namibia (herein referred to as a “voluntary licence”).
- (2) A voluntary licence contract concerning an application for a patent or a patent must be submitted to the Registrar in the prescribed manner and within the prescribed period.
- (3) The Registrar must -
  - (a) record the grant of the licence in the appropriate register;
  - (b) keep contents of the licence confidential; and  
*[The word “the” is missing before the word “contents”.]*
  - (c) publish a reference to the grant of the licence in the bulletin.
- (4) A licence contract has no effect against third parties until such recordal is effected.
- (5) The recordal of a licence under subsection (2) may be cancelled on request to the Registrar in the prescribed manner, accompanied by proof that the licence has expired or has been terminated.

### 52. Prohibited terms in licences

- (1) Any condition in a contract relating to the sale of a patented invention or to a licence under a patent of which the effect will be -
  - (a) to prohibit or restrict the purchaser or licensee from purchasing or using any product or process or class of products or processes, whether patented or not, supplied or owned by any person other than the seller or licensor or his or her nominee;
  - (b) to prohibit or restrict the purchaser or licensee from using any product or process not protected by the patent;
  - (c) to require the purchaser or licensee to acquire from the seller, licensor or his or her nominee any product or process or class of products or processes not protected by the patent;
  - (d) to require or induce the purchaser or licensee to observe a specified minimum resale price in respect of any article or class of articles protected by the patent; or
  - (e) to prohibit or restrict the making, using, exercising or disposing of the invention concerned in any

country in which the invention is not patented,  
is invalid.

- (2) Nothing in this section affects any condition in a contract -
- (a) whereby a person is prohibited from selling any goods other than those of a particular person; or
  - (b) for the lease of or a licence to use a patented article, whereby the lessor or licensor reserves to himself or herself or his or her nominee the right to supply such new parts of the patented article, other than ordinary articles of commerce, as may be required to put or keep it in repair.
- (3) The Board may, after consultation with the Registrar, by notice in the Gazette declare any other condition in a licence to be a condition to which subsection (1) applies and that condition if contained in a licence is invalid for the purposes of subsection (1).

### 53. Rights of licensee

In the absence of an agreement to the contrary -

- (a) a voluntary licence to make a patented product carries with it the right to exploit the patented product, including the right to use or offer to dispose of or dispose of the patented product;
- (b) a voluntary licence to use or exercise a patented process carries with it the right to exploit the patented process, including the right to make, use or offer to dispose of or dispose of the product of the process; and
- (c) an exclusive voluntary licence carries with it the right for the licensee to exploit the patent to the exclusion of all others, including the owner of the patent,

but such licensee has no right to institute proceedings against third parties for the infringement of the patent unless the licence contract provides for such right or section 70(2) applies.

### 54. Effect of non-grant or invalidation of patent

- (1) Any contract, in so far as it relates to a licence under a patent application or a patent to make, use, exercise, offer to dispose of, dispose of or import a patented invention, terminates on the date on which a patent is refused on the application under which the licence was granted, or on which the patent, under which the licence was granted, expires, is revoked or otherwise ceases to protect such invention.
- (2) Where a contract relates to licences under more than one application or patent, such part of the contract as relates to any particular licence terminates when the application or the patent under which it was granted is refused or expires, is revoked or otherwise ceases to protect the invention concerned, and the contract as a whole must terminate when all the patents under which all such licences were granted and which were in force at the time when the contract became operative, expire, are revoked or otherwise cease to protect the relevant inventions.
- (3) Nothing in this section affects any right to terminate a contract or a condition in a contract independently of this section.

## Part 9 – Compulsory licences

### 55. Compulsory licence for non-working or insufficient-working

*[The term “insufficient-working” should be “insufficiently-working” to be grammatically correct. Also, there appears to be a word or words missing in the heading, which should perhaps refer to “non-working or insufficiently-working inventions”, “non-working or insufficiently-working patents” or “non-working or insufficiently-working patented inventions”.]*

- (1) Any person may, after the expiration of a period of four years from the date of filing of the patent application or three years from the date of the grant of the patent, whichever period expires last, in the

prescribed form and manner make an application to the Tribunal to exploit a patented invention in Namibia.

- (2) On receipt of an application made under subsection (1), the Tribunal may grant such person a compulsory licence to exploit the patent on such terms and conditions as determined by the Tribunal, if the patented invention was not adequately exploited in Namibia by the owner of the patent or his or her licensee by working the invention locally.

*[The second use of the word "made" is superfluous: "made under made subsection (1)".]*

- (3) Despite subsection (2), a compulsory licence may not be granted if the owner of the patent satisfies the Tribunal that circumstances exist which justify the lack of adequate exploitation of the invention.
- (4) On request made to the Tribunal of any person who proves that the rights in a patent are being abused, the Tribunal may grant such a person a compulsory licence to exploit the patent on such terms and conditions as determined by the Tribunal.
- (5) The person to whom a compulsory licence is granted under subsection (2) or (4) has the right to exploit the patented invention in Namibia, otherwise than by importing the patented invention, according to the terms and conditions set out in the determination by the Tribunal, and must commence the exploitation of the patented invention within the time limit fixed in that determination and, thereafter, must exploit the patented invention to an adequate extent.
- (6) A compulsory licence granted under this section is non-exclusive and in particular does not exclude -
- (a) the exploitation by the owner of the patent of his or her rights under section 41;
  - (b) the granting of voluntary licences to third parties by the owner of the patent under section 51; or
  - (c) the granting of other compulsory licences under this section or section 56 or 57.
- (7) The decision by the Tribunal granting the compulsory licence must determine -
- (a) the scope and function of the licence;
  - (b) the time limit within which the licensee must begin to exploit the patented invention; and
  - (c) the amount of the adequate compensation to be paid to the owner of the patent and the conditions of payment.
- (8) When making a decision under subsection (7) the Tribunal must take the following considerations into account:
- (a) that the scope of the exploitation of the patented invention by the licensee must be limited to the purpose for which the licence was authorised;
  - (b) that, after hearing both parties, the terms and conditions of the licence may be varied to the extent that changed circumstances justify such variation; and
  - (c) that the compensation to be paid to the owner of the patent must be reasonable in the circumstances, taking into account the economic value of the licence.
- (9) A party who is aggrieved by the decision of the Tribunal made under this section, may appeal against the decision to the court.

## 56. Compulsory licence based on interdependence of patents

- (1) If the invention claimed in a patent (herein referred to as the "later patent") cannot be exploited in Namibia without infringing a patent granted on the basis of an application having an earlier filing date or, where appropriate, priority date (herein referred to as the "earlier patent"), and provided that the invention claimed in the later patent involves an important technical advance of considerable economic significance in relation to the invention claimed in the earlier patent, the Tribunal may, on application made in the prescribed manner by the owner of the later patent, grant to the owner of the later patent a

compulsory licence under the earlier patent to the extent necessary to avoid infringement of the earlier patent.

- (2) Where a compulsory licence is issued under subsection (1), the Tribunal must, on application in the prescribed manner by the owner of the earlier patent, grant to the owner of the earlier patent a compulsory licence on reasonable terms in respect of the later patent.
- (3) In the case of an application for the issuance of a compulsory licence under subsections (1) and (2), the provisions of sections 55(6), (7) and (8) relating to the conditions for the grant of a compulsory licence do, with the necessary changes, apply, except that no time limit needs to be determined for the exploitation to commence.
- (4) In the case of a compulsory licence issued under subsection (1), any transfer of the licence may be made only with the transfer of the later patent, or, in the case of a compulsory licence issued under subsection (2), only with the transfer of the earlier patent.
- (5) A party who is aggrieved by the decision of the Tribunal made under this section, may appeal against the decision to the court.

## 57. Compulsory licence in public interest

- (1) Where -
  - (a) the public interest, in particular national security, nutrition, health or the development of other vital sectors of the national economy, so requires;
  - (b) a national emergency or circumstances of extreme urgency have arisen, including a public health crisis, which requires the use of the patented invention;
  - (c) the Namibian Competition Commission (hereafter “the Commission”) established in terms of the Competition Act, 2003 (Act No. 2 of 2003) (hereafter “the Competition Act”) has determined that the manner of exploitation, of the patent by the owner of the patent or his or her licensee, constitutes a restrictive business practice prohibited under Part I or Part II of Chapter 3 of the Competition Act, and the Board is satisfied that the exploitation of the invention in accordance with this section would remedy such practice;
  - (d) an interested party has unsuccessfully endeavoured at least for a period of six months to obtain the patent owner’s licence for the use of the patented invention on reasonable terms and conditions, and the refusal of the patent owner to grant a licence has the effect that the trade or industry or agriculture of Namibia, or the trade of a class of persons in Namibia, or the establishment of any new trade or industry in Namibia is being prejudiced and it is in the public interest that a licence should be granted; or
  - (e) a patented product relates to a pharmaceutical product in respect of which Namibia has insufficient or no manufacturing capacity as contemplated in the Decision of the General Council of the WTO of August 30, 2003 or in Article 31bis of TRIPS, and a licence for the importation of the patented product is required as contemplated in the said decision or article,

the Board may, on submission to him or her of an application as contemplated in subsection (3), decide that, even without the consent of the owner of the patent, a third person designated by the Board may be authorised by way of a compulsory licence to exploit a patented invention, including by the importation of the patented invention, on such terms and conditions as determined by the Board.

- (2) The exploitation of the patented invention under a licence granted under this section is limited to the purpose for which it was authorised and is subject to the payment to the owner of the patent of an adequate compensation therefor, taking into account the economic value of the Board’s authorisation, as determined in the said decision, and, where a decision has been taken under subsection (1)(c), the need to correct the restrictive business practices.
- (3) An application may be submitted by any interested party for the Board’s authorisation under subsection (1), which application must be accompanied by evidence that the owner of the patent has received, from

the person seeking the authorisation, a written request for a voluntary licence, but that that person has been unable to obtain such a licence on reasonable terms and conditions and, in the case of an application under subsection (1)(d), within a period of six months from the written request.

- (4) Where importation takes place pursuant to the Decision of the General Council of the WTO of August 30, 2003 or Article 31 bis of TRIPS whichever is applicable as contemplated in subsection (1)(e), and the exporting country issues a compulsory licence for the same patented invention, no compensation is payable to the owner of the patent as contemplated in subsection (2).
- (5) The provisions of subsection (3) with regard to a prior request for a voluntary licence do not apply in cases of -
  - (a) national emergency or other circumstances of extreme urgency as contemplated in subsection (1)(b);
  - (b) public non-commercial use; and
  - (c) restrictive business practices determined as such by the Commission in accordance with subsection (1)(c),

except that, in such cases the owner of the patent must be notified of the Board's decision as soon as is reasonably practicable.

- (6) The exploitation of a patented invention in the field of semi-conductor technology may only be authorised under this section either for public non-commercial use or where the Commission has determined that the manner of exploitation of the patented invention, by the owner of the patent or his or her licensee, is a restrictive business practice prohibited under the Competition Act and if the Board is satisfied that the issuance of the non-voluntary licence would remedy such practice.
- (7) Any authorisation under this section is non-exclusive and in particular does not exclude -
  - (a) the exploitation by the owner of the patent of his or her rights under section 41; or
  - (b) the granting of voluntary licence contracts to third parties by the owner of the patent under section 51; or
  - (c) the grant of a compulsory licence under section 55 or 56.
- (8) Where a third person has been designated and authorised by the Board as contemplated in subsection (1), the authorisation may only be transferred to another party together with the enterprise or business of that third person or with the part of the enterprise or business within which the patented invention is being exploited.
- (9) Except where the compulsory license is issued under subsection 1(c), the compulsory license will be predominantly for the supply of the domestic market.
- (10) On written application made to him or her by the owner of the patent, or by the third person authorised to exploit the patented invention, the Board may, after hearing the parties, vary the terms and conditions of the decision authorising the exploitation of the patented invention to the extent that changed circumstances justify such variation.
- (11) On written application made to him or her by the owner of the patent, the Board must terminate the authorisation if he or she is satisfied, after hearing the parties, that the circumstances which led to the decision have ceased to exist and are unlikely to recur, or that the third person designated by the Board has failed to comply with the terms and conditions of the decision.
- (12) Despite subsection (11), the Board may not terminate the authorisation if he or she is satisfied that the need for adequate protection of the legitimate interests of the third person designated by the Board justifies the maintenance of the decision.
- (13) A party who is aggrieved by the decision of the Board which is made under this section, may appeal against the decision to the Tribunal.

- (14) An appeal against the grant of a compulsory licence does not stay or suspend the use of the patented invention during the appeal process and the patent holder's sole remedy is limited to an action for the recovery of adequate compensation.

### **58. Procedure for grant of compulsory licences**

- (1) An application for a compulsory licence under sections 55, 56 or 57 may be submitted by any interested party in the manner prescribed.
- (2) An application must be accompanied by -
  - (a) where required, evidence that the owner of the patent has received, from the person seeking the compulsory licence, a written request for a voluntary contractual licence, but that that person has been unable to obtain such a licence on reasonable commercial terms and conditions within the prescribed period, except in cases mentioned in section 57(6); and
  - (b) evidence of the payment of the prescribed fee.
- (3) The patent owner or any other person appearing from the register to be interested in the patent may in the prescribed manner oppose the application.
- (4) The Tribunal, or the Board, as the case may be, must consider the application on its merits and may -
  - (a) order the grant to the applicant of a licence on such conditions as it, he or she may deem fit, including a condition in the circumstances contemplated in section 55(5) precluding the licensee from importing into Namibia any product made from or out of the patented invention; or
  - (b) if it or he or she considers that the grant of the licence is not justified, refuse the application and give reasons for such refusal to the person who made the request.

### **59. Grant and terms of compulsory licences**

- (1) Any compulsory licence granted under section 55 or 56 is non-exclusive and is not transferable except to a person to whom the business or the part of the business in connection with which the rights under the licence were exercised has been transferred.
- (2) The Tribunal or the Board may order that a licence granted in terms of section 55 or 56 or 57, as the case may be, be deemed to have been granted on the date on which the application for a licence has been received.
- (3) A licence granted under section 55 or 56 must include a provision that, subject to adequate protection of the legitimate interests of the licensee, the licence must, on application by the patentee, be terminated if the circumstances which led to its grant cease to exist and, in the opinion of the Tribunal are unlikely to recur.
- (4) Any licence granted under section 55 or 56 or 57 may be amended or revoked by the Tribunal or the Board as the case may be.

### **60. Rights and obligations of licensee under a compulsory licence**

Subject to the conditions that may be attached to a compulsory licence, a licensee under this Part has the same rights and obligations as any other licensee under a patent.

### **61. Recordal of compulsory licences**

- (1) A compulsory licence granted under section 55 or 56 or 57 must be submitted to and retained by the Registrar who must keep its contents confidential but must record the grant thereof in the appropriate register and must publish a reference to such grant in the bulletin.
- (2) A compulsory licence has no effect against third parties until the recordal under subsection (1) has been



effected.

- (3) The recordal of the grant of a compulsory licence effected under subsection (1) may be cancelled on request to the Registrar in the prescribed manner, accompanied by proof that such licence has expired or has been terminated.

## 62. Licences of right

- (1) At any time after the date of the grant and sealing of a patent, the owner of a patent may apply to the Registrar for the patent to be endorsed with the words "licences of right" and where such an application is made the Registrar must, if satisfied that the patent owner is not precluded by contract from granting licences under the patent, cause the patent to be endorsed accordingly.
- (2) Where a patent has been endorsed under this section -
- (a) any person is at any time thereafter entitled as of right to a licence under the patent upon such conditions as may, in the absence of agreement, be decided by the Tribunal on the application of the patent owner or the person requiring the licence;
  - (b) the Tribunal may, on the application of the holder of any licence granted under the patent before the endorsement, order such licence to be replaced by a licence to be granted by virtue of the endorsement on conditions to be decided by the Tribunal;
  - (c) no interdict may, in proceedings for infringement of the patent (other than by the importation of goods), be granted against the defendant if he or she undertakes to take a licence upon conditions to be decided by the Tribunal, and the amount, if any, recoverable from the defendant by way of damages must in such case not exceed double the amount which would have been payable by him or her as licensee if such a licence had been granted before the earliest infringement; and
  - (d) the renewal fee payable in respect of the patent after the date of the endorsement is one half of the renewal fee which would have been payable if the patent had not been so endorsed.
- (3) The licensee under a licence granted by virtue of the endorsement of a patent in terms of this section may, (unless in the case of a licence where the conditions are determined by agreement, the licence otherwise expressly provides), call on the patent owner to institute proceedings in respect of any infringement of the patent, and if the patent owner fails to do so within two months after being so called upon, the licensee may institute proceedings for the infringement in his or her own name as if he or she were the owner of the patent, joining the patent owner as a defendant.
- (4) A patent owner so joined as a defendant under subsection (3) is not liable for any costs unless he or she enters an appearance and takes part in the proceedings.
- (5) An application for the endorsement of a patent in terms of this section must contain a statement, to be verified in such manner as may be prescribed, that the patent owner is not precluded by contract from granting licences under the patent, and the Registrar may require from the applicant such further evidence as he or she may think necessary.
- (6) An application under this section for the endorsement of a patent of addition must be dealt with as an application for the endorsement of the patent for the main invention also, and an application made under this section for the endorsement of a patent in respect of which a patent of addition is in force, must be dealt with as an application for the endorsement of the patent of addition also, and where a patent of addition is granted in respect of a patent already endorsed under this section, the patent of addition must also be so endorsed.
- (7) Every endorsement of a patent in terms of this section must be recorded in the register and must be advertised in the bulletin and in such other manner as the Registrar may direct, to bring the endorsement to the notice of interested persons.

## Part 10 – Exploitation by government



### **63. Exploitation of patented invention by Government or person authorised by Government**

- (1) For purposes of this section “public interest” includes, but is not limited to, public health, nutrition, agriculture, national emergency, relief, social service, socio-economic development and national security purposes.
- (2) Despite anything to the contrary in this Act, where a vital public interest requires that one or more acts of exploitation, including stocking, be performed with respect to a patented invention, the Board may decide that the patented invention be, even in the absence of the consent of the owner of the patent, exploited by a government ministry, office or agency as defined in the Public Service Act, 1995 (Act No. of 1995) (hereafter “government entity”) or by a third person, including a contractor, subcontractor, or any other person, firm or corporation undertaking any activity for a non-commercial purpose for or on behalf of a government entity, designated by the Board.

*[The Act number has been omitted in the bracketed text above; the Public Service Act is Act 13 of 1995.]*

- (3) Authorisation in relation to the use of an invention under this section may be given either before or after the use of the invention.
- (4) Where the Board knows, without conducting a patent search, that it is using or will use or has used or will have used a valid patent, the Board must promptly notify the patent holder.
- (5) Any government entity or third person authorised to use an invention pursuant to subsection (2) must pay adequate compensation, as determined by the Board, to the owner of the patent for the use of the invention.
- (6) Where exploitation of a patented invention pursuant to subsection (2) involves importation of a product and such importation takes place pursuant to the Decision of the General Council of the WTO of August 30, 2003 or Article 31 bis of TRIPS whichever is applicable, and the exporting country issues a compulsory licence for the same patented invention, no compensation is payable to the owner of the patent as contemplated in subsection (5).
- (7) The owner of the patent may appeal to the Tribunal against any decision of the Board made in terms of subsection (2) or of the Board made in terms of subsection (5).
- (8) An appeal against the decision of the Board does not stay or suspend the use of the patented invention during the appeal process, the patent holder’s sole remedy being limited to a claim against the government entity or the third person authorised to use the invention for the recovery of adequate compensation.

## **Part 11 – Surrender, invalidation and revocation**

### **64. Surrender of patent**

- (1) A patent owner may at any time, by giving notice in the prescribed manner to the Registrar, offer to surrender his or her patent, and the Registrar must, on receipt of the notice, give notice of the offer to any person shown in the register to have an interest in the patent.
- (2) Any person may within the prescribed time lodge in writing with the Registrar an objection to the surrender of the patent.
- (3) If no objection is so lodged or if any such objection is overruled by the Registrar or the Tribunal after having given the patent owner and the objector an opportunity to be heard, the patent is deemed to have been revoked as from the date of receipt by the Registrar of the offer of surrender, and the Registrar must advertise the revocation of the patent in the bulletin and make the necessary entries in the register.
- (4) An offer to surrender a patent may not be considered as long as any proceedings for infringement or invalidation of that patent are pending before the Tribunal, except by consent of the parties to such proceedings.

## 65. Invalidation of patent

- (1) Any person may, in the prescribed form and manner, apply to the Tribunal to invalidate a patent.
- (2) An application for invalidation must be served on the owner of the patent and must be notified to the Registrar in the prescribed manner.
- (3) Subject to section 67, the Tribunal must invalidate the patent if the person requesting the invalidation proves that any one of the following grounds for invalidation applies to the patent, namely -
  - (a) that the owner of the patent is not the inventor or the successor in title of the inventor;
  - (b) that the grant of the patent is in fraud of the rights of the person requesting the invalidation or the rights of any other person through whom such person claims;
  - (c) that the grant of the patent was obtained on the strength of a false representation by the applicant which is material and which the applicant knew to be false at the time when the representation was made;
  - (d) that the invention cannot be performed or does not lead to the results and advantages set out in the specification;
  - (e) that any of the requirements of sections 12 to 18, 24, 25, 26, 27, 28(1) or 30 has not been complied with; or
  - (f) that a corresponding patent granted in another country has been invalidated or revoked in that country on a ground which would also apply as a ground of invalidity against the patent in Namibia.
- (4) The final decision of the Tribunal must be notified to the Registrar who must record it and publish as soon as possible in the bulletin a reference thereto.

## 66. Effects of invalidation

An invalidated patent, and any claim of an invalidated patent, must be regarded as non-existent from the date of the grant of the patent.

*[The word "non-existent" is misspelt in the Government Gazette, as reproduced above.]*

## 67. Amendment of patent in invalidation proceedings

If the Tribunal, in the case of an application for the invalidation of a patent as contemplated in section 65, is satisfied that an amendment of the patent will remove the ground of invalidity, it may uphold the patent subject to such amendment and subject to such terms or conditions as it deems fit.

## 68. Revocation of patent in public interest

- (1) Where the Board is of opinion that a patent or the mode in which it is exercised is inimical to the interests of the State or generally prejudicial to the public, and the Board is satisfied that the prejudice cannot be remedied by way of a compulsory licence, the Board may, after giving the patentee an opportunity to be heard, make a declaration to that effect in the Gazette and thereupon the patent is deemed to be revoked.
- (2) A party who is aggrieved by the decision of the Board which is made under this section, may appeal against the decision to the Tribunal.

## Part 12 – Infringement

### 69. Acts of infringement

- (1) Subject to sections 43, 47(6), 55, 56, 57, 62 and 63, the owner of a patent in Namibia has, as provided for in section 41, the right to exclude all other persons from exploiting in Namibia the patented invention

without his or her authority.

- (2) Subject to sections 43, 47(6), 55, 56, 57, 62 and 63, exploitation of a patented invention by any person without the authority of the owner of the patent constitutes an infringement.
- (3) The owner of the patent has, in addition to the right granted under subsection (1), the right to prevent any person from procuring or inciting third parties to perform acts which would result in the infringement of the patent.

## 70. Infringement proceedings

- (1) Subject to section 62(3) concerning the right of a licensee of right to institute infringement proceedings after unsuccessfully requesting the owner of a patent to do so, proceedings for infringement of a patent may be instituted in the Tribunal by the owner of the patent.

*[The phrase "of right" is superfluous.]*

- (2) A licensee under a voluntary licence may call upon the owner of the patent to institute proceedings in respect of an infringement of the patent, and if the patent owner refuses to do so, the licensee may institute such proceedings in his or her own name.
- (3) Proceedings for infringement must be instituted and prosecuted in the manner prescribed.
- (4) Before the owner institutes proceedings in terms of this section he or she must give notice in writing of his or her intention to do so to every licensee whose name is recorded in the register, and any such licensee is entitled to intervene in such proceedings and to recover any damages he or she may have suffered as a result of the infringement.
- (5) In any proceedings for infringement the defendant may counterclaim for the revocation of the patent and, by way of defence, rely upon any ground on which a patent may be revoked.

## 71. Remedies

- (1) Where a patent granted and recorded in terms of this Act has been infringed and the owner or a licensee has instituted proceedings as contemplated in section 62(3) or 70, the Tribunal may grant the owner or the licensee the following relief, namely -
  - (a) an interdict;
  - (b) an order for any infringing product or process or any article or product of which the infringing product or process forms an inseparable part to be delivered up to the owner ;
  - (c) damages;
  - (d) in lieu of damages, at the option of the owner or licensee, a reasonable royalty which would have been payable by a licensee for the use of the patented invention concerned.
- (2) For the purposes of determining the amount of any damages or reasonable royalty to be awarded under this section, the Tribunal may direct an enquiry to be held and may prescribe such procedures for conducting such enquiry as it may deem fit.
- (3) Despite subsection (1), the patent holder or licensee's sole remedy in situations mentioned in section 55, 56, 57 and 63, is the recovery of adequate remuneration.

## 72. Declaration of non-infringement

- (1) In proceedings between any person and the patent owner the Tribunal may, despite that no assertion to the contrary has been made by the patent owner, make a declaration that the use by that person of any process or the making or use or offer to dispose or disposal or importation of any product by that person, does not or would not constitute an infringement of a patent, if it is proved -

- (a) that such person has applied in writing to the patent owner for a written acknowledgement to the effect of the declaration claimed, and has furnished the patent owner with full particulars of the process or article in question; and
  - (b) that the patent owner has failed to give such an acknowledgement.
- (2) The costs of all parties to proceedings for a declaration instituted by virtue of this section may be awarded in such manner as the Tribunal may deem fit.

### **73. Threat of infringement proceedings**

- (1) Any person threatened with infringement proceedings who can prove that the acts performed or to be performed by him or her do not constitute infringement of the patent may request the Tribunal to grant an interdict to prohibit such threats and award damages for financial loss resulting from the threats.
- (2) Proceedings under subsection (1) may not be instituted after five years from the date of the threats.
- (3) The mere notification of the existence of a patent does not constitute a threat within the meaning of subsection (1).
- (4) The defendant in proceedings under subsection (1) may apply by way of a counterclaim for any relief to which he or she would be entitled in separate proceedings in respect of any infringement by the plaintiff of the patent to which the threat relates.

### **74. Relief for partial infringement**

- (1) If the validity of a patent is put in issue in proceedings for infringement of the patent and it is found that the patent is only partially valid, the Tribunal may, subject to subsection (2), grant relief in respect of that part of the patent found to be valid and infringed.
- (2) Where in any such proceedings it is found that a patent is only partially valid, the Tribunal may not grant relief in the form of damages, costs or expenses, except where the party relying on the patent proves that the specification was framed in good faith and with reasonable skill and knowledge and, in that event, the Tribunal may grant relief in respect of the patent which is valid and infringed, subject to the discretion of the Tribunal as to costs or expenses and as to the date from which damages should be reckoned.
- (3) As a condition of relief under this section, the Tribunal may direct that the specification be amended to its satisfaction upon an application made for that purpose under this section and an application may be so made accordingly, whether or not all other issues in the proceedings have been determined.
- (4) Where in any proceedings for infringement of a patent, the Tribunal finds that any claim in the complete specification in respect of which infringement is alleged, is valid, but that any other claim therein is invalid, the following provisions apply, namely:
  - (a) if a counterclaim for the revocation of the patent has been made in the proceedings on the ground of the invalidity of any claim in the specification, the Tribunal may postpone the operation of any order issued thereon for such time as may be required to enable the patent owner to effect any amendment of the specification pursuant to the conditions imposed by the Tribunal, and the Tribunal may attach such other condition to any order to be issued on the counterclaim as it may deem fit; and
  - (b) when the specification has been amended in terms of paragraph (a), the Tribunal may, subject to such order as to costs as it may issue and as to the date from which damages must be calculated, grant relief in respect of any claim which had, before the amendment, been found to be valid and infringed, and in exercising this discretion the Tribunal may take into consideration the conduct of the patent owner in inserting in the specification those claims which had been found, before amendment, to be invalid or permitting such claims to remain there.

### **75. Presumption of use of patented process**

- (1) Without derogating from the provisions of section 41(2) or section 69(1) a claim in respect of a patent for a process or an apparatus for producing any product must be construed as extending to such product when produced by the process or apparatus claimed.
- (2) If the invention for which a patent is granted is a process for obtaining a new product and if there is substantial likelihood that the identical product was made by the process and the owner of the patent has been unable through reasonable efforts to determine the process actually used, the identical product produced by a person other than the patent owner or a licensee under that patent is, unless the contrary is proved, deemed, in any proceedings, to have been obtained by that process.
- (3) In the adduction of proof to the contrary pursuant to subsection (2), the legitimate interests of the person other than the patent owner or a licensee in protecting their manufacturing and business secrets must be taken into account.
- (4) In considering whether any person has discharged the onus imposed upon him or her by this section, the Tribunal may not require such person to disclose any secret process used by him or her in producing the product concerned, if it appears to the Tribunal that it would be unreasonable to do so.

## **Part 13 – International applications under the patent co-operation treaty and other international arrangements**

### **76. Application of Patent Co-operation Treaty and definitions**

- (1) The Patent Co-operation Treaty (hereafter “the Treaty”), the Regulations made thereunder and the Administrative Instructions made under those Regulations must be given the force of law in Namibia.
- (2) Any reference in this Part to the Treaty includes reference to the Regulations and Administrative Instructions made under those Regulations.
- (3) The Registration Office must process international applications in accordance with the provisions of this Act, the Treaty, and the Regulations made thereunder.
- (4) Where the provisions of this Act conflict with those of the Treaty, the provisions of the Treaty prevail.
- (5) For the purposes of this Part, “designate”, “designated office”, “elect”, “elected office”, “international application”, “international filing date”, “international preliminary examination” and “receiving office” and any other term or expression defined or used in this Part has the same meanings as in Article 2 of the Treaty.

### **77. Filing date and effect of international application designating Namibia**

- (1) An international application designating Namibia for the purposes of a national patent has as its filing date, the international filing date accorded under Article 11 of the Treaty.
- (2) An international application designating Namibia for the purposes of a national patent has, subject to this Part, the same effect as and must be treated as an application for a patent filed under this Act.

### **78. The Registration Office as receiving office**

- (1) The Registration Office must, unless an agreement is in force under subsection (2), act as a receiving office in respect of any international application filed with it by a resident or national of Namibia.
- (2) The Registration Office may, with the consent of the Board, make an agreement referred to in rule 19(1)(b) of the Regulations under the Treaty whereby an intergovernmental organisation or the national office of another contracting state of the Treaty may act instead of and on behalf of the Registration Office as receiving office for applicants who are residents or nationals of Namibia.

### **79. Filing of international applications with the Registration Office**

- (1) Subject to section 78(2), an international application filed with the Registration Office as receiving office must be filed in English and -
  - (a) the prescribed transmittal fee must be paid to the Registration Office within one month from the date of receipt of the international application; and
  - (b) the international fee and the search fee specified in rules 15 and 16 of the Regulations under the Treaty must be paid to the Registration Office within the time limits specified in the said rules.
- (2) If the applicant fails to comply with any of the requirements of subsection (1) within the time limits referred to in that subsection, the international application must be considered withdrawn for the purposes of this Act.

### **80. The Registration Office as designated office**

The Registration Office must act as the designated office in respect of an international application in which Namibia is designated for the purposes of obtaining a national patent under this Act.

### **81. The Registration Office as elected office**

The Registration Office must act as the elected office in respect of an international application in which Namibia is designated as referred to in section 80 if the applicant elects Namibia for the purposes of an international preliminary examination under Chapter II of the Treaty.

### **82. National processing**

The Registration Office as designated office or elected office may not commence processing of the national phase of an international application designating or electing Namibia for the purposes of a national patent before the expiration of the time limit referred to in section 79 except if the applicant complies with the requirements of that section and files with the Registration Office an express written request for early commencement of such processing.

### **83. Entering national phase**

- (1) The applicant in respect of an international application designating Namibia for the purposes of a national patent must, regardless of the provisions of Articles 22 and 39 of the Treaty, before the expiration of 31 months from the priority date or of such later time limit as may be prescribed -
  - (a) pay the prescribed national fee to the Registration Office; and
  - (b) if the international application was not filed in, or has not been published under the Treaty as a translation into English, file with the Registration Office, within the prescribed period, a translation of the international application, containing the prescribed contents, into English.
- (2) When processing the national phase of an international application, the Registration Office must apply the provisions of this Act applicable to patent applications as well as the Treaty, the Regulations made thereunder, and the Administrative Instructions issued thereunder, subject to the following provisions -
  - (a) the applicant must be represented by an agent as contemplated in Chapter 5, which agent must be appointed within the prescribed time;
  - (b) if the international application is a convention application and the applicant has complied with rule 17.1 of the Regulations made under the Treaty, the applicant is deemed to have complied with section 29(2);
  - (c) the filing date accorded to the international application in terms of the Treaty is the filing date of the national phase application for purposes of sections 45 and 46;
  - (d) any amendment or correction of any document forming part of an international application in accordance with the Treaty or the Regulations made thereunder is deemed to be an amendment or

correction under section 28, section 36(4) or section 40, as the case may be, and may be set aside as provided for in section 220(3)(b) or 222(1)(c).

- (3) The Registrar may upon application made either before or after the expiry of the time limit or the further time limit contemplated in subsection (1), extend the time limit for a further period not exceeding three months.

#### **84. Failure to enter national phase**

If the applicant fails to comply with the requirements of section 83 within the time limit or extended time limit referred to in that section, the designation of Namibia in the international application is considered withdrawn for the purposes of this Act.

#### **85. Processing international applications in accordance with Patent Co-operation Treaty**

- (1) The Minister may subject to subsection (2), prescribe provisions concerning the processing of international applications by, and other functions, of the Registration Office under the Treaty, including fees payable, time limits and other requirements relating to international applications.
- (2) The provisions of section 234 apply to provisions prescribed in terms of this section and concerning the processing of an international application by the Registration Office.

### **Part 14 – Utility model certificates**

#### **86. Application of provisions relating to patents**

- (1) For the purposes of this Part -  
“utility model” means an invention with the exclusion of a process, a microbiological process and the products of a microbiological process;  
“utility model certificate” means the title granted to protect a utility model.
- (2) Subject to section 87, the provisions of this Chapter do apply, with the necessary changes, as if a utility model is an invention and a utility model certificate or an application therefore is a patent or an application therefor, as the case may be.

#### **87. Special provisions relating to utility model certificates**

- (1) A utility model qualifies for a utility model certificate if it is new and is industrially applicable.
- (2) Sections 13 and 15, insofar as they refer to an inventive step, do not apply in the case of a utility model for which a utility model certificate is requested.
- (3) Sections 36, 38 and 39 apply in the case of applications for utility model certificates except insofar as section 36 refers to sections 13 and 15, and insofar as section 38 refers to section 37.
- (4) Section 45 does not apply in the case of utility model certificates.
- (5) In the case of proceedings under section 65 in respect of a utility model certificate, the Tribunal may invalidate the utility model certificate on any of the following grounds -
  - (a) that the claimed utility model does not qualify for a utility model certificate, having regard to subsection (1) and sections 14(1) and (2), 16, 18, 86(1) and 88(1);
  - (b) that the description and the claims do not comply with the requirements under section 24(4) or (5) and any prescribed requirements;
  - (c) that any drawing which is necessary for the understanding of the utility model has not been



furnished;

- (d) that the owner of the utility model certificate is not the inventor or his or her successor in title.
- (6) Section 65(3) does not apply in the case of a utility model certificate.

### **88. Duration of utility model certificate**

- (1) A utility model certificate expires at the end of the seventh year after the date of the filing of the application.
- (2) No annual fee is payable during the term referred to in subsection (1).

### **89. Surrender, invalidation and revocation of utility model certificate**

Subject to section 87, the provisions of sections 64 to 68 do apply, with the necessary changes, in regard to the surrender or invalidation of a utility model certificate as if a utility model is an invention and a utility model certificate or an application therefore is a patent or an application therefore, as the case may be.

### **90. Conversion of application for utility model certificate or applications for patent**

- (1) At any time before the grant or rejection of a patent, an applicant for a patent may, upon payment of the prescribed fee, convert his or her application into an application for a utility model certificate, which latter application must be accorded the filing date of the initial application.
- (2) At any time before the grant or rejection of a utility model certificate, an applicant for a utility model certificate may, upon payment of the prescribed fee, convert his or her application into an application for a patent, which latter application must be accorded the filing date of the initial application.
- (3) No person may convert an application under subsection (1) or (2) more than once.

## **Part 15 – General**

### **91. Appeals**

- (1) The Tribunal has jurisdiction in all cases of dispute relating to the matters provided for in this Chapter, and in all matters which under this Chapter may be referred to the Tribunal.
- (2) Any decision taken by the Registrar under this Chapter, including in regard to the grant of a patent or utility model certificate, or in regard to the rejection of an application for such a grant, may be the subject of an appeal to the Tribunal by an interested party in the matter before the Registrar, and such appeal must be filed and prosecuted as prescribed.
- (3) Any change or amendment or correction of any document forming part of an application for a patent or utility model certificate applied for or of a patent or utility model certificate granted under this Chapter, or any change or amendment or correction of, or any provision or condition in, any document forming part of an application for a compulsory licence or the grant of a compulsory licence under this Chapter may, on application by an interested party to the Tribunal, be set aside by the Tribunal if such change or amendment or correction, or such provision or condition, does not comply with the provisions of this Act.

## **Chapter 3 Industrial designs**

### **Part 1 – Industrial designs**

### **92. Definitions**

For the purposes of this Chapter -



“**article**” means any article of manufacture, including an item of handicraft;

“**design**” means any feature or combination of features of form or shape or configuration, or any feature or combination of features of pattern or ornamentation, including any composition of lines or colours, applied to an article to give it an appearance having such features discernable by the eye, but does not include any feature serving solely to obtain a functional or technical result;

“**design registration**” means the title granted under this Act to protect a design;

“**exploit**”, in relation to a registered design, means the doing of any act mentioned in section 107 for commercial purposes;

“**International Classification**” means the classification according to the Locarno Agreement of 1968 establishing an International Classification for Industrial Designs; and

“**set of articles**” means a number of articles of the same general character intended to be used or sold together, and in respect of which the same design, with such modifications as may be appropriate, is applied to each article.

### 93. Registrable designs

- (1) A design is capable of registration if it is new.
- (2) A design for an article which is not intended to be multiplied for commercial purposes is not registrable under this Act.
- (3) No feature of an article insofar as it is necessitated solely by the function which the article is intended to perform, or no method or principle of construction may afford the registered owner of the design any rights under the registration.
- (4) A design which is contrary to public order or morality may not be registered, as contemplated in section 18 as if the design is an invention.

### 94. Definition of novelty

- (1) A design is new if it has not been disclosed to the public anywhere in the world, by publication in any form, or by use or in any other way, prior to the filing date or, where applicable, the priority date of the application for registration.
- (2) For the purposes of subsection (1) disclosure to the public of the design may not be taken into consideration if it occurred within 12 months preceding the filing date or, where applicable, the priority date of the application, and if it was by reason or in consequence of -
  - (a) acts committed by the applicant or his or her predecessor in title, or of an unauthorised disclosure; or
  - (b) an abuse committed by a third party with regard to the applicant or his or her predecessor in title.

## Part 2 – Right to legal protection

### 95. Right to legal protection

- (1) Designs registered under this Act are entitled to protection as provided for in this Chapter but such protection does not exclude any other rights provided for in law, in particular rights derived from copyright.
- (2) Subject to this section and section 97, the right to apply for the registration of a design belongs to the creator of the design.
- (3) Where two or more persons have jointly created a design, the right to apply for registration belongs to them jointly.

- (4) Where two or more persons have created the same design independently of each other, the person whose application has the earliest filing date or, if priority is claimed, the earliest validly claimed priority date and which application leads to the registration of a design has the right to the design registration for the duration of the registration.
- (5) The right to apply for the registration of a design may be assigned, or may be transferred by succession or otherwise by operation of law.

## 96. Naming of creator

Where the applicant is not the creator of the design -

- (a) he or she must, if the Registrar calls therefore, furnish the Registrar with a statement, in writing and in the prescribed manner, justifying the applicant's right to the registration of the design;
- (b) the creator of the design need not be named in the application.

## 97. Design created by employee or person commissioned

- (1) When a design is created in the execution of a commission contract or in the course of an employment contract, the right to register that design belongs, in the absence of written contractual provisions to the contrary, to the person who commissioned the work or to the employer, as the case may be.
- (2) The provisions of section 21(2) to (7) relating to the legal relationship between an employee and an employer or a person who has commissioned work do apply as if the design is an invention and the design creator is an inventor.

## 98. Judicial assignment of right to a design application or design registration

- (1) Where a dispute arises between persons as to their rights to obtain a design registration, or as to the right to or title in a design registration, any such party may apply to the Tribunal to decide the matter in dispute.
- (2) If the Tribunal is satisfied that a person is unable or unwilling to exercise his or her right to file or to participate in an application for a design registration, the Tribunal may order that person to execute an assignment, in order that the application may be made without such participation, provided that where it appears to the Tribunal to be just and equitable, the Tribunal may order the payment of compensation to the non-participating person.
- (3) In any order declaring that a person has a right to the exclusion of any other person to apply for or to be the owner of a design registration, the Tribunal may direct that such other person must execute any deed of assignment that may be required and that such deed of assignment extends to countries outside Namibia.

## Part 3 – Application procedure

### 99. Who may apply for registration

- (1) The owner of a design may, in the prescribed manner and on payment of the prescribed fee, apply for the registration of the design.
- (2) The owner of a design must be -
  - (a) the creator of the design;
  - (b) where the creator of the design executed the work for another person, as contemplated in section 97, such other person;
  - (c) where the ownership in the design has passed to another person, including by assignment or by operation of law or assignment under section 98, such other person; or

- (d) by an agent duly authorised to act on behalf of any of the persons referred to in paragraphs (a) to (c).

### **100. Application for registration**

- (1) An application for the registration of a design must be filed with the Registrar in the manner prescribed and must contain the following -
  - (a) a request, in writing, that the design is to be registered, including the name of and other prescribed information concerning the applicant;
  - (b) drawings, photographs or other graphic representations of the article embodying the design;
  - (c) a statement, in writing, indicating the type of products in respect of which the design is to be used;
  - (d) an indication of the class or classes of the International Classification in which the design is to be registered; and
  - (e) the prescribed application fee.
- (2) Where the design is two dimensional, a specimen of the article embodying the design may be lodged instead of a representation.
- (3) Where the applicant is not the creator of the design, he or she must, if the Registrar calls therefore, furnish the Registrar with a statement, justifying the applicant's right to the registration of the design as provided in section 96.
- (4) The application may, at the time of filing, contain a request that the publication of the design, upon registration, be deferred for a period not exceeding 12 months from the date of filing or, if priority is claimed, from the date of priority, of the application.
- (5) The applicant may, at any time before the registration of a design, withdraw his or her application.
- (6) An application under this section may be made in respect of two or more designs relating to articles in the same class of International Classification or to a set of articles.
- (7) An application for the registration of a design as contemplated in this section must be accompanied by the payment of the prescribed fee in the manner prescribed.

### **101. Right of priority**

The provisions of section 29 relating to the right of priority do apply as if the design is an invention and the application for registration of the design is an application for a patent.

### **102. Filing date of application**

- (1) Subject to subsection (2), the Registrar must accord as the filing date the date of receipt of the application.
- (2) Despite subsection (1), the Registrar must accord as the filing date the date referred to in subsection (1) only if the application meets the following requirements:
  - (a) the prescribed application fee is paid;
  - (b) the application contains the name or indications allowing the identity of the applicant to be established; and
  - (c) the application contains a graphic representation of the article embodying the design.
- (3) Section 34(2), (3) and (4) relating to corrections to an application do, with the necessary changes, apply as if the application for a design is an application for a patent.

### **103. Examination as to form and substance**

- (1) After according a filing date, the Registrar must, in the prescribed manner, further examine whether the application complies with the requirements of section 100(1), (2) and (3).
- (2) If the Registrar finds that the application complies with the requirements of subsection (1), the Registrar must further examine whether the design complies with the requirements of sections 92, 93 and 94.

## **Part 4 – Registration of industrial design and amendment of design applications or registrations**

### **104. Registration of industrial design**

- (1) Where the Registrar finds that the requirements referred in section 103 have been satisfied, either initially or after changes as contemplated in subsection (3), the Registrar must register the design.
- (2) Where the Registrar finds that the requirements referred to in subsection (1) have not been satisfied, the Registrar must notify the applicant in the manner prescribed that the application does not comply with the requirements, setting out the reasons for the finding, and inviting the applicant to make such changes to the documents as filed as may be necessary to satisfy the requirements.
- (3) The Registrar must, on request of the applicant within the prescribed period, make such changes to the application as would remove the reasons for non-compliance as referred to in subsection (2), provided that no such change will be allowed if it would result in the introduction of matter not in substance disclosed in the initial application, or have the result of substantially changing the appearance of the design.
- (4) Where the Registrar finds that no changes as referred to in subsection (3) have been made or that despite any such changes the requirements of section 103 have not been satisfied, the Registrar must refuse the application.

### **105. Recordal of registration, issuance of certificate and publication of registered design**

- (1) Once the Registrar has registered the design, the Registrar must record the registration in the register and issue to the applicant a certificate of registration of the design.
- (2) After the design has been registered, the Registrar must publish in the bulletin a reference to the registration.

### **106. Amendment of a design application or registration**

- (1) The applicant for or the owner of a design registration may, at any time, request the Registrar to amend the application or registration by making changes in the representations or in the statement indicating the type of products in respect of which the design is to be used, in order to amend the protection conferred by the registration, except that no such change will be allowed which would result in the introduction of matter not in substance disclosed in the initial application on the basis of which the registration was applied for or granted, or would have the result of substantially changing the appearance of the design.
- (2) Where the request for the amendment takes place after registration of the design, it must be published in the bulletin in the prescribed manner.
- (3) In the circumstances of subsection (2), any person may oppose such request for amendment within the prescribed time and in the prescribed manner.
- (4) Any opposition to an amendment must be dealt with by the Registrar in the prescribed manner, and the Registrar must determine whether and on what conditions, if any, the amendment ought to be allowed.
- (5) If the Registrar is satisfied that the requirements of subsection (1) have been complied with, and if there is no opposition as provided for in subsection (3) or, if there is opposition and the Registrar is satisfied that such opposition is without merit, he or she must make the requested changes in the application or

registration.

- (6) If the Registrar is not satisfied that the requirements of subsection (1) have been complied with, or if there is opposition as provided for in subsection (3) and the Registrar is satisfied that the opposition has merit, he or she must refuse to make the requested changes in the application or registration.

## **Part 5 – Rights conferred by registration of industrial design**

### **107. Rights conferred by registration**

The person registered as the owner of a design registration has, for the duration of the registration and subject to the provisions of this Act and to any rights appearing from the register of designs to be vested in any other person, the right to exclude all others from making, importing, using or disposing or offering to dispose of in Namibia any article included in the class or classes in which the design is registered and bearing or embodying the registered design or a design not substantially different from the registered design, when such acts are undertaken for commercial purposes.

### **108. Limitations of rights**

The rights of the owner of a registered design do not extend to -

- (a) acts in respect of articles which have been put on the market in Namibia by such owner, or with his or her written consent;
- (b) the use of articles on aircraft, land vehicles, or vessels of other countries which temporarily or accidentally enter the airspace, territory or waters of Namibia;
- (c) acts related to experimental use of the design or acts done on a non-commercial scale for scientific research;
- (d) use of the design for teaching purposes; or
- (e) acts that are done privately and on a non-commercial scale, or for a non-commercial purpose.

### **109. ARIPO designs**

- (1) Where an application for the registration of an industrial design in ARIPO is filed with the Registration Office as the receiving office, the Registrar must, without delay, transmit the application to the office of ARIPO, whereupon the application must be processed further in accordance with the provisions of the Harare Protocol.
- (2) If the office of ARIPO decides to register a design on an application and notifies the Registrar, the Registrar must -
  - (a) examine the application in accordance with section 103;
  - (b) if the Registrar finds that the requirements referred to in section 103 are not complied with, communicate in writing to the office of ARIPO within six months from the date on which the Registrar was notified, that if a design registration is granted by the office of ARIPO that design registration has no effect in Namibia;
  - (c) if the Registrar finds that the requirements referred to in section 103 are complied with, deal with the application in accordance with sections 104(1) and 105.
- (3) An industrial design registration granted by ARIPO by virtue of the Harare Protocol and in respect of which Namibia is a designated State, has the same effect in Namibia as a design registration under this Act unless the Registrar has communicated to ARIPO in respect of the application therefor, a decision as contemplated in subsection (2)(b).

## **Part 6 – Duration, renewal and restoration**

### 110. Duration of registered designs

Subject to section 111, the registration in respect of a design expires 15 years after the filing date of the application for its registration.

### 111. Renewal of registered designs

- (1) In order to maintain a design registration, a prescribed annual renewal fee must be paid to the Registrar in the manner prescribed, starting one year after the filing date of the application for the registration of the design.
- (2) The Registrar must, on payment of such surcharge by the owner of a design registration as may be prescribed, give the owner a period of grace of six months for the late payment of a renewal fee.
- (3) If an annual renewal fee is not paid in accordance with the provisions of subsection (1) or (2), the design registration lapses.

### 112. Restoration of design registrations

- (1) Where a design registration has lapsed owing to the non-payment of any prescribed renewal fee within the prescribed period or the grace period referred to in section 111, the owner of the registration may, in the prescribed manner and on payment of the prescribed fee, apply to the Registrar for the restoration of the registration.
- (2) If the Registrar is satisfied that the omission was unintentional and that no undue delay has occurred in the making of the application, he or she must publish the application for restoration in the bulletin in the prescribed manner, and thereupon any person may within such period as prescribed, give notice in the prescribed manner of opposition to the restoration of the registration.
- (3) If there is no opposition as provided for in subsection (2), or if there is opposition and the Registrar is satisfied that such opposition is without merit, he or she must restore the registration.
- (4) Any such restoration of the registration is subject to the payment of such renewal fees as contemplated in section 111 as remain unpaid at the date of the restoration.
- (5) If there is opposition as provided for in subsection (2) and the Registrar is satisfied that the opposition has merit, he or she must refuse to restore the registration.
- (6) The owner of a design registration restored in accordance with subsections (1) to (4) is not be entitled, in terms of section 124, to institute any proceedings against or recover damages from any person who exploited the registered design after the lapse of a period of six months from the date on which the renewal fee was due and before the date on which the request for restoration was published, or who commenced exploitation of the registered design during the aforesaid period and thereafter continues to exploit the registered design.

*[The word "be" in the phrase "is not be entitled" is superfluous.]*

- (7) Where a design registration has been restored in accordance with subsections (1) to (4), any person who during the period referred to in subsection (6) expended any money, time or labour with a view to exploiting the registered design and who is prevented from such exploitation by the restoration of the registration, may apply to the Tribunal for compensation to be paid by the owner of the design registration in respect of the money, time and labour so expended.
- (8) If the owner fails to pay the compensation, if any, found to be payable by the Tribunal, the design registration lapses.

## Part 7 – Change in ownership and joint ownership of design applications and design registrations

### 113. Change in ownership of applications or registrations

- (1) Any change in the ownership of a registered design or design application, must be in writing and signed by the transferor, unless the transferor is deceased or has ceased to exist.
- (2) The owner of a registered design or design application or any interested party may in the prescribed manner request the Registrar to change ownership of the registered design or design application.
- (3) On receipt of an application made under subsection (2) -
  - (a) the Registrar must record the change in the appropriate register; and
  - (b) except in the case of the transfer of an application, the Registrar must publish any such change in the bulletin.
- (4) A change in the ownership of any title mentioned in this section has no effect against third parties unless it has been recorded by the Registrar in the appropriate register.

### 114. Joint ownership of design applications

- (1) Where two or more persons have jointly filed an application for registration of a design, the joint applicants have, in the absence of an agreement to the contrary, equal undivided shares in the application, and none of them may without the consent of the other joint applicant or applicants deal in any way with the application, but if any proceedings are required to save the application from becoming abandoned, any applicant may institute such proceedings on behalf of himself or herself and any other joint applicant.
- (2) If any dispute arises between joint applicants as to their respective rights in and to an application for a design or as to the manner in which the application is to be proceeded with or the manner in which they may deal with the application or exploit the invention, any such joint applicant may apply to the Tribunal to decide the matter in dispute.
- (3) Unless the Tribunal otherwise directs, the person who makes as applications in terms of subsection (2) is liable for all costs and expenses incurred in respect of proceedings in terms of that subsection.
- (4) If the Tribunal is satisfied that a joint applicant, is unable or unwilling to proceed as joint applicant, the Tribunal may in the manner contemplated in section 98, order that he or she assign his or her rights to any joint applicant able and willing so to proceed, provided that where it appears to the Tribunal to be just and equitable, the Tribunal may order the payment of compensation to the assignor.
- (5) In any proceedings in terms of subsection (2) the Tribunal must, unless it appears that there are good reasons to the contrary, resolve the dispute in a manner which will lead to the preservation of the application and the registration of the design.

### 115. Joint ownership of rights conferred by registration

- (1) Where registration of a design is granted to two or more persons jointly, each of them is, in the absence of an agreement to the contrary, entitled to an equal undivided share in the registered design.
- (2) Subject to the provisions of subsections (5) and (7), a joint registered owner is, in the absence of an agreement to the contrary and in the absence of consent of the other joint registered owner or owners, not entitled-
  - (a) to perform any of the acts reserved exclusively for a registered owner in section 107;
  - (b) to grant a licence or to assign the whole or any part of his or her interest in the registered design; or
  - (c) to take any steps or institute any proceedings relating to the registered design.
- (3) Despite subsection (2), a joint registered owner may pay any renewal fee that is payable without recourse to any other design owner, unless the Tribunal directs otherwise in proceedings in terms of subsection (7).
- (4) Where an article embodying a registered design or a design not substantially different from the registered



design is disposed of by a joint registered owner, the acquirer or any person claiming through him or her is entitled to deal with it in the same manner as if the article had been disposed of by the registered owners jointly.

- (5) Any joint registered owner may institute proceedings for infringement and must give notice thereof to every other joint registered owner, and any such other joint registered owner may intervene as co-plaintiff and recover any damages in respect of any damage he or she may have suffered as a result of the infringement.
- (6) If in any proceedings under subsection (5) damages are awarded to a plaintiff, damages must be awarded as if he or she were the sole registered owner, and the defendant is not obliged to compensate any other joint registered owner in respect of the infringement in question.
- (7) Where any dispute arises between joint registered owners as to their respective rights in or to the registered design, the institution of proceedings relating to the registered design or the manner in which they should deal with the registered design, any joint registered owner may apply to the Tribunal to decide the matter in dispute.
- (8) If in considering any application under subsection (7) the Tribunal is satisfied that a joint registered owner is unable or unwilling to remain a registered owner, the Tribunal may order him or her to assign his or her rights to any other joint registered owner able and willing so to remain, provided that where it appears to the Tribunal to be just and equitable, it may order the payment of compensation to the joint registered owner who is so ordered to assign his or her rights.
- (9) In considering any application under subsection (7) the Tribunal must, unless it appears to it that there are good reasons to the contrary, resolve the dispute in a manner which will lead to the preservation and exploitation of the registered design.

## **Part 8 – Voluntary licences**

### **116. Voluntary licence**

- (1) The owner of an application for a design registration or a design registration may enter into a licence contract with one or more other persons to authorise such person or persons to exploit the design covered by the registration or the application in Namibia (herein referred to as a “voluntary licence”).
- (2) A voluntary licence contract concerning an application for a design registration or a design registration must be submitted to the Registrar in the prescribed manner and within the prescribed period.
- (3) The Registrar must -
  - (a) record the grant of the licence in the appropriate register;
  - (b) keep contents of the licence confidential; and
  - (c) publish a reference to the grant of the licence in the bulletin.
- (3) A licence contract has no effect against third parties until such recordal is effected.
- (4) The recordal of a licence under subsection (1) may be cancelled on request to the Registrar in the prescribed manner, accompanied by proof that the licence has expired or has been terminated.

### **117. Invalid contractual terms in licences**

Any condition in a contract relating to the sale of an article bearing or embodying a registered design, or to a licence under a design registration of which the effect will be -

- (a) to prohibit or restrict the purchaser or licensee from purchasing or using any article or class of articles, whether registered or not, supplied or owned by any person other than the seller or licensor or his or her nominee;



- (b) to prohibit or restrict the licensee from using any article or process not protected by the design registration;
- (c) to require the purchaser or licensee to acquire from the seller, licensor or his or her nominee any article or class of articles not protected by the design registration;
- (d) to require or induce the purchaser to observe a specified minimum resale price in respect of any article or class of articles protected by the design registration; or
- (e) to prohibit or restrict the making, using or disposing of articles bearing or embodying the registered design in any country in which the design is not protected,

is invalid.

### **118. Rights of licensee**

In the absence of an agreement to the contrary -

- (a) a voluntary licence to make an article bearing or embodying a registered design carries with it the right to exploit the article, including the right to use or offer to dispose of or dispose of the article; and
- (b) an exclusive voluntary licence carries with it the right for the licensee to exploit articles bearing or embodying the registered design to the exclusion of all others, including the owner of the design registration, except that such licensee has no right to institute proceedings against third parties for the infringement of the design registration unless the licence contract provides for such right.

### **119. Effect of invalidity on registration of licence**

- (1) Any contract, in so far as it relates to a licence under a design application or a design registration to make, use, offer to dispose of, dispose of or import a protected article, terminates on the date on which a design application is refused, or on which the design registration, under which the licence was granted, expires, is revoked or otherwise ceases to protect such article.
- (2) Where a contract relates to licences under more than one application or registration, such part of the contract as relates to any particular licence terminates when the application or the registration under which it was granted is refused or expires, is revoked or otherwise ceases to protect the article concerned, and that the contract as a whole terminates when all the registrations under which all such licences were granted and which were in force at the time when the contract became operative, expire, are revoked or otherwise cease to protect the relevant articles.
- (3) Nothing in this section affects any right to terminate a contract or a condition in a contract independently of this section.

## **Part 9 – Surrender and invalidation of registration**

### **120. Surrender of registration**

- (1) The owner of a design registration may at any time, by giving notice in the prescribed manner to the Registrar, offer to surrender the registration, and the Registrar must give notice of the offer to any person shown in the register to have an interest in the registration.
- (2) Any person may, within the prescribed time, lodge in writing with the Registrar an objection to the surrender of the registration.
- (3) If no objection is so lodged or if any such objection is overruled by the Registrar or the Tribunal after having given the owner of the registration and the objector an opportunity to be heard, the registration must be deemed to have been revoked as from the date of receipt by the Registrar of the offer of surrender, and the Registrar must advertise the revocation of the design registration in the bulletin and make the necessary entries in the register.

- (4) An offer to surrender a design registration may not be considered as long as any proceedings for infringement or revocation of that registration are pending before the Tribunal, except by consent of the parties to such proceedings.

### 121. Invalidation of registered designs

- (1) Any person may apply to the Tribunal in the prescribed manner to invalidate the registration of a design.
- (2) An application for invalidation must be served on the owner of the design registration or his or her agent and must be notified to the Registrar in the prescribed manner.
- (3) Subject to subsection (4), the Tribunal must invalidate the design registration if the person requesting the invalidation proves that -
  - (a) the design is not a design as defined in section 92;
  - (b) the requirements of section 93 or 94 are not complied with;
  - (c) the registered owner of the design is not the creator as contemplated in section 95 or his or her successor in title; or
  - (d) any ground exists on which the Registrar could have refused to register the design.
- (4) Despite subsection (1), if the Tribunal is satisfied that an amendment of the design registration will remove the ground of invalidity, it may uphold the design registration subject to such amendment and subject to such terms or conditions as it deems fit.
- (5) The final decision of the Tribunal must be notified to the Registrar who must record it and as soon as possible publish it in the bulletin.

### 122. Effects of invalidation

An invalidated design registration must be regarded as null and void from the date of the grant of the certificate of registration of the design.

## Part 10 – Infringement

### 123. Acts of infringement

- (1) No person other than the owner of the design registration may exploit, in Namibia, a design registered in Namibia in regard to articles included in the class or classes in which the design is registered unless he or she has been authorised to do so by the owner of that design registration by way of licence, in writing and signed by the licensor.
- (2) The provisions of section 115 apply in respect of such licence.
- (3) For purposes of this section, the provisions of section 108 apply.

### 124. Infringement proceedings

- (1) The registered owner of a design has, in addition to any other rights, remedies or actions available to him or her, the right to institute legal proceedings against any person who infringes the design registration by performing, without the owner's written contract, any of the acts referred to in section 107 for commercial purposes, or who performs acts which make it likely that infringement will occur.
- (2) Proceedings for infringement must be institute and prosecuted in the manner prescribed.  
*[The verb "institute" should be "instituted" to be grammatically correct.]*
- (3) In any proceedings for infringement the defendant may counterclaim for the revocation of the design and, by way of defence, rely upon any ground on which a design may be revoked.

- (4) Before the owner institutes proceedings in terms of this section, he or she must give notice in writing of his or her intention to do so to every licensee whose name is recorded in the register, and any such licensee is entitled to intervene in such proceedings and to recover any damages he or she may have suffered as a result of the infringement.
- (5) A licensee under a voluntary licence may call upon the owner of the design registration to institute proceedings in respect of an infringement of the design registration, and if the owner refuses to do so, the licensee may institute such proceedings in his or her own name.

## 125. Remedies

The provisions of section 71 apply to proceedings instituted in terms of section 124 as if a design registration is a patent.

## Part 11 – International deposits under the Hague Agreement

### 126. Definitions

For the purposes of this Part -

“**International Bureau**”, “international application” or “international registration” mean the International Bureau, an international application or an international registration as defined in Article 1 of the Hague Agreement;

“**the Hague Agreement**” means the Act of the Hague Agreement signed in the Hague on November 6, 1925 as amended and amplified from time to time, and the Regulations issued under the Geneva Act, 1999, as amended from time to time; and

“**the Regulations**” mean the Regulations issued under the Geneva Act, 1999 of the Hague Agreement.

### 127. Protection of design which is subject to international deposit

- (1) Subject to section 128, a design which is the subject of an international registration in which Namibia is designated must be protected in Namibia in the same manner as if the design had been registered under this Act.
- (2) The Registrar must deal with international registrations in accordance with the provisions of section 128 and of the Hague Agreement and the Regulations issued thereunder, but, if there is any conflict between the provisions of the Hague Agreement or the Regulations issued thereunder and the provisions of this Act, the Hague Agreement and its Regulations prevail.

### 128. Notification of International Bureau by Registrar

- (1) Where the Registrar is notified by the International Bureau that an international registration of a design contains a designation of Namibia, the Registrar must proceed in accordance with section 103 as if the relevant design is the subject of an application under this Act.
- (2) Where the Registrar finds that the requirements referred to in section 103(2) are not complied with, the Registrar must notify the International Bureau that protection of the design has been refused.
- (3) No such notification as referred to in subsection (2) may be given after the expiry of a period of six months from the date on which the Registration Office received from the International Bureau a copy of the publication in which the international registration of the design concerned was published.
- (4) Where the Registrar finds that the requirements referred to in section 103 have been complied with, the Registrar must -
  - (a) register the design;
  - (b) issue the registered owner with a registration certificate; and

- (c) subject to subsection (5), publish a reference to the design registration in the bulletin.
- (5) A publication in terms of subsection (4)(c) may not take place before the copy of the publication of the international registration by the International Bureau has been received by the Registration Office in accordance with the Hague Agreement.
- (6) Where an international application for the registration of a design under the Hague Agreement is filed at the Registration Office, the Registrar must record the date on which the application was received by that Registration Office as the filing date of the international application, and the Registrar must transmit the application to the International Bureau within one month of that date.
- (7) The Registrar must, at the time of transmitting an international application to the International Bureau in terms of subsection (6), notify the International Bureau of the date on which the office of the Registrar received the application, and must notify the applicant of this date and of the fact that the application has been transmitted to the International Bureau.

### **129. Registrar to notify International Bureau concerning invalidation**

Where a design registration registered in Namibia under the Hague Agreement has been invalidated in accordance with section 121, the Registrar must, as soon as possible, notify the International Bureau accordingly.

## **Part 12 – General**

### **130. Appeals**

- (1) The Tribunal has jurisdiction in all cases of dispute relating to the matters provided for in this Chapter, and in all matters which under this Chapter may be referred to the Tribunal.
- (2) Any decision taken by the Registrar under this Chapter, including in regard to the registration of a design, or in regard to the rejection of an application for such registration, may be the subject of an appeal to the Tribunal by an interested party in the matter before the Registrar, and such appeal must be filed and prosecuted as prescribed.
- (3) Any change or amendment or correction of any document forming part of an application for a design registration applied for or of a design registration granted under this Chapter, or any change or amendment or correction of, or any provision or condition in, any document forming part of an application for a licence or the grant of a licence under this Chapter may, on application by an interested party to the Tribunal, be set aside by the Tribunal if such change or amendment or correction, or such provision or condition, does not comply with the provisions of this Act.

## **Chapter 4**

### **Trade marks, collective and certification marks, and trade names**

#### **Part 1 – Introductory provisions**

### **131. Definitions**

For the purpose of this Chapter -

“**Banjul Protocol**” means the Protocol on Marks within the Framework of ARIPO adopted in Banjul, between 15-19 November 1993, and the Regulations issued thereunder, as amended from time to time;

“**certification trade mark**” means a mark capable of distinguishing, in the course of trade, goods or services certified by any person in respect of kind, quality, quantity, intended purpose, value, geographical origin or other characteristics of the goods or services, or the mode or time of production of the goods or of rendering of the services, as the case may be, from goods or services not so certified;

“**collective trade mark**” means a mark 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 thereof;

“**mark**” means any sign capable of being represented visually, including a device, name, signature, word, letter, numeral, figurative element, shape, colour or container for goods, or any combination of such signs;

“**International Classification of Goods and Services**” means the classification under the Nice Agreement of 1957, as revised from time to time;

“**registered user**” means a person registered to use a registered trade mark in terms of section 170;

“**trade mark**”, other than a certification or a collective trade mark, means a mark used or proposed to be used by a person in relation to goods or services for the purpose of distinguishing those goods or services from the same kind of goods or services connected in the course of trade with any other person;

“**trade mark registration**” means the title granted under this Act to protect a trade mark;

“**trade name**” means the name or designation identifying a business enterprise and distinguishing that enterprise from other business enterprises.

### **132. Exclusive right to mark**

- (1) The right to a mark, as conferred by this Act, may be acquired by registration of the mark as a trade mark, a certification trade mark or a collective trade mark in accordance with the provisions of this Act.
- (2) Nothing in this Act may detract from the right of any person to institute proceedings and enforce any rights under common law.

### **133. Classification of registration**

- (1) For purposes of registration of a trade mark, the goods or services for which registration of the mark is requested must be classified in a particular class or classes as provided for in the International Classification of Goods and Services, and the application for registration must indicate the applicable class or classes of the International Classification of Goods and Services or any prescribed classification of goods or services.
- (2) Any question arising as to the class within which any goods or services fall under must be determined by the Registrar.

## **Part 2 – Requirements for registration**

### **134. Distinctiveness**

- (1) In order to be registrable, a trade mark must be capable of distinguishing the goods or services of a person in respect of which it is proposed to be registered from the goods or services of other persons, either generally or, where the trade mark is proposed to be registered subject to limitations, in relation to use within those limitations.
- (2) A trade mark is considered to be capable of distinguishing within the meaning of subsection (1) if, at the date of application for registration, it is inherently capable of so distinguishing or if it became capable of distinguishing by reason of prior use thereof.

### **135. Limitation of colours**

- (1) A trade mark may be limited in whole or in part to a particular colour or colours, and in case of any application for the registration of a trade mark the fact that the trade mark is so limited must be taken into consideration in deciding whether it is capable of distinguishing.
- (2) If and in so far as a trade mark is registered without limitation of colour, it is deemed to be registered for all colours.

### 136. Disclaimer

If a mark contains matter which is not capable of distinguishing within the meaning of section 134, the mark may be registered subject to a condition -

- (a) disclaiming any right to the exclusive use of such matter; or
- (b) making such other disclaimer or endorsement as may be deemed necessary for the purpose of defining the rights under the registration,

except that such disclaimer or endorsement does not affect any other rights of the applicant in respect of the mark except as arising out of the registration.

### 137. Prohibition of registration: objective grounds

A mark is not registrable and cannot be validly registered if -

- (a) it is incapable of distinguishing the goods or services of one person from those of other persons;
- (b) it is contrary to public order or morality;
- (c) it is inherently deceptive or the use thereof is likely to mislead or deceive the public or other traders, including as regards the geographical origin of the goods or services concerned, or their nature or characteristics;
- (d) it consists exclusively of a sign or indication which serves, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, or time or mode of production of the goods or rendering of the services;
- (e) it consists exclusively of a sign or indication which has become customary in the current language or amongst bona fide traders in regard to the goods or services concerned;
- (f) it is identical with, or is an imitation of or contains as an element, an armorial bearing, flag or other emblem of, a name of 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;

*[Act 8 of 2016 makes a global substitution of "staff member" for "official", but that substitution has not been applied here as the result would be nonsensical.]*

- (g) its use would be likely to cause confusion or would offend any class of person or would be contrary to law;
- (h) the applicant for registration has no bona fide claim to proprietorship or no bona fide intention of using it as a trade mark; or
- (i) the application for registration was mala fide.

### 138. Prohibition of registration: third party rights

(1) A mark is not registrable and cannot validly be registered if -

- (a) subject to subsection (2), it is identical with or confusingly similar to, or it or an essential element thereof constitutes a reproduction, imitation or a translation of, a trade mark which is entitled to protection under the Paris Convention as a well-known trade mark and which is well known in Namibia, if the use of the mark is to be in relation to the identical or similar goods or services in respect of which the trade mark is well known, and such use of the mark is likely to cause deception or confusion;
- (b) it is identical with or confusingly similar to, or it or an essential element thereof constitutes a reproduction, imitation or translation of a trade mark which is well known and registered in Namibia for goods or services which are not identical or similar to those in respect of which registration is applied for, if the use of the mark would be likely to take unfair advantage of, or be

detrimental to the distinctive character or the repute of the well-known mark or the interests of the owner of the well-known trade mark are likely to be prejudiced by such use, despite the absence of deception or confusion; or

- (c) it is identical to a registered trade mark or to a trade mark in an application belonging to a different proprietor with an earlier filing or priority date, in respect of the same goods or services or closely related goods or services, or if it so nearly resembles such a trade mark as to be likely to deceive or cause confusion.
- (2) Subsection (1)(a) does not apply in relation to any trade mark application or registration having a filing date or priority date prior to the date on which this Act comes into force or to the date on which the well-known trade mark becomes entitled, in Namibia, to protection under the Paris Convention, whichever date is the later date.

## Part 3 – Procedure for registration

### 139. Who may apply for registration

Any person who has a bona fide claim to proprietorship of the mark and bona fide uses or intends to use the mark as a trade mark may apply for the registration of the mark as a trade mark.

### 140. Application for registration

- (1) An application for the registration of a mark as a trade mark must be made in the prescribed manner and, in the prescribed manner, be filed with the Registrar and must contain the following -
- (a) a request for registration;
  - (b) a representation of the mark; and
  - (c) a specification of the goods or services for which registration of the mark is requested; and
  - (d) an indication of the applicable class or classes of the International Classification of Goods and Services or any prescribed classification of goods or services.
- (2) The Registrar or the Tribunal, as the case may be, may at any time, whether before or after acceptance of the application, correct any error in or in connection with the application, or may permit the applicant to amend his or her application upon such conditions as the Registrar or the Tribunal, as the case may be, may think fit.

### 141. Application fee

An application for the registration of a mark as a trade mark must be accompanied by the prescribed fee.

### 142. Right of priority

- (1) The application may contain a declaration claiming the priority, as provided for in the Paris Convention, of an earlier national, regional or international application filed by the applicant or his or her predecessor in title, provided that the application is made within six months after the date of the earlier application.
- (2) The effect of the said declaration is as provided in the Paris Convention, but, if the Registrar finds that the requirements under subsection (3) have not been fulfilled, the said declaration is deemed not to have been made.
- (3) Where the application contains a declaration claiming the priority as provided for in the Paris Convention, the Registrar may require that the applicant furnish, within the prescribed time, a copy of the earlier application, certified as correct by the office with which it was filed.

### 143. Date of filing

The Registrar must accord as the date of an application, the date on which the request for registration, the representation of the mark and the prescribed fee are lodged with the Registrar.

#### **144. Withdrawal, restriction or amendment of application**

The applicant for a trade mark registration may, at any time before the mark is registered, in the prescribed manner withdraw, restrict or amend the application as long as any such amendment will not substantially affect the identity of the mark.

#### **145. Examination as to form and substance**

- (1) After according a date to the application, the Registrar must examine the application to determine whether it complies with the requirements of section 140(1).
- (2) If the Registrar is satisfied that the requirements of subsection (1) are complied with, the Registrar must determine whether the mark is a mark as defined in section 131 and is registrable as a trade mark under sections 134, 137 and 138.

#### **146. Acceptance or refusal of application**

- (1) The Registrar must consider the application and he or she may -
  - (a) if he or she is satisfied that the application complies with the requirements of section 145, accept the application;
  - (b) if he or she deems it appropriate, accept the application subject to such amendments, modifications, conditions or limitations as he or she may deem fit; or
  - (c) if he or she is satisfied that the application does not comply with the requirements of section 145, refuse the application.
- (2) The Registrar must advise the applicant for registration in writing within a reasonable period from the date of application of his or her decision in terms of subsection (1), and in the case of a decision in terms of subsection (1)(c) must, on application by the applicant within the prescribed period and in the prescribed manner, state in writing the grounds for the decision.
- (3) Where the Registrar has advised the applicant of a decision in terms of subsection (1)(c), and unless within the prescribed period from the date of the advice or from the date on which grounds for the decision were furnished in terms of subsection (2), whichever is the later date, the applicant submits arguments, in writing, or applies for a hearing or an extension of time, the application is deemed to have been abandoned.
- (4) In the case of a decision in terms of subsection (1)(b), the Registrar, if he or she finds that the mark contains matter which is not capable of distinguishing within the meaning of section 134, may require as a condition of the mark being registered as contemplated in section 136, that the applicant -
  - (a) disclaims any right to the exclusive use of such matter; or
  - (b) makes such other disclaimer or endorsement as the Registrar deems necessary for the purpose of defining the rights under the registration,but such disclaimer or endorsement does not affect any other rights of the applicant in respect of the mark except as arising out of the registration.
- (5) If the Registrar accepts an application subject to any amendments, modifications, conditions or limitations, or any disclaimer or endorsement as contemplated in subsection (1)(b) or in subsection (4) and -
  - (a) the applicant does not accept such amendments, modifications, conditions or limitations, or such disclaimer or endorsement he or she may within the prescribed period from the date of the advice



- of conditional acceptance submit arguments, in the prescribed manner, apply for a hearing or for an extension of time, failing which the application is deemed to have been abandoned;
- (b) the applicant accepts such amendments, modifications, conditions or limitations, or such disclaimer or endorsement he or she must within the prescribed period so notify the Registrar, in the prescribed manner, whereupon the application is deemed to have been accepted; or
  - (c) the applicant accepts such amendments, modifications, conditions or limitations, or such disclaimer or endorsement but fails to notify the Registrar within the prescribed period and in the prescribed manner, the application is deemed to have been abandoned.
- (6) In the case of a decision in terms of subsection (1)(a), or a decision in terms of subsection (1)(b) and which is accepted by the applicant, the Registrar must, within such time and in a manner prescribed, publish that application in the bulletin.

#### **147. Examination after opposition**

- (1) After the publication of a notice under section 146(6), any person may, within the prescribed period and in the prescribed manner, give notice to the Registrar of opposition to the registration of the mark on the ground that one or more of the requirements for the registrability of the mark as contained in any provision of this Chapter has not been complied with.
- (2) Any opposition must follow the procedure and require such evidence as provided for in this section and as may be prescribed.
- (3) The Registrar must as soon as possible after receiving the notice contemplated in subsection (1), send a copy of the notice to the applicant who must, within such period and in such manner as may be prescribed, send to the Registrar a counter-statement of the grounds on which he or she relies in support of his or her application.
- (4) If the applicant fails to comply with the provisions of subsection (3), the application must be considered as having been abandoned.
- (5) Where the applicant files a counter-statement, the Registrar must as soon as possible furnish a copy thereof to the person opposing who may, within the prescribed period and in the prescribed manner, lodge a replying statement.
- (6) A person who gives notice of opposition as contemplated in subsection (1), and an applicant who files a counter-statement as contemplated in subsection (5) must submit evidence in support of the opposition or counter-statement as may be prescribed.
- (7) The Registrar must, after hearing the parties and considering the merits of the case, decide whether or not the mark should be registered.
- (8) After the publication of the application and until the registration of the mark, the applicant has the same right to damages as he or she would have had if the mark had been registered, but it is a valid defence to an action brought under this section in respect of an act done after the application was published, if the mark has in fact not been registered or if the defendant proves that the mark could not validly have been registered at the time the act was done.

#### **148. Registration and issuance of certificate**

- (1) Where the Registrar is satisfied that -
  - (a) the application for the registration of a mark complies with the requirements of sections 131, 134, 137, 138 and 140; and
  - (b) the registration of the mark has -
    - (i) not been opposed under section 147 within the prescribed time limit; or

- (ii) been opposed but the Registrar has decided in the applicant's favour,  
the Registrar must register the trade mark in the appropriate register and issue to the applicant a certificate of registration.
- (2) Where -
- (a) the requirements for the registration of a mark as contemplated in subsection (1) are not complied with; or
- (b) an application for the registration of a mark has been successfully opposed under section 147,  
the Registrar must refuse to register that mark as a trade mark.
- (3) If, by reason of default on the part of the applicant, after acceptance of the application in terms of section 146(1)(a), the registration of a trade mark has not been completed within the prescribed period from the date of such acceptance, the Registrar must give notice of the non-completion to the applicant, and, if at the expiration of the prescribed period from that notice or of such further time as the Registrar may allow, the registration is not completed, the application must be considered as having been abandoned.
- (4) If the application is conditionally accepted in terms of sections 146(1)(b) or 146(4) or 146(5)(b) and the applicant fails to take such steps as are available to him or her under this Act to complete the registration of the trade mark within the prescribed period, or such further time as the Registrar may allow, the application must be considered as having been abandoned.

#### **149. Registration of parts trade marks**

- (1) Where the proprietor of a trade mark claims to be entitled to the exclusive use of any part thereof separately, he or she may apply to register the whole and any such part as separate trade marks.
- (2) Each such separate trade mark must satisfy all the requirements for registration of a trade mark under this Act and must for all purposes be a registered trade mark.

#### **150. Publication of registered marks**

When the Registrar has registered the trade mark as provided for in section 148, the Registrar must publish, in the bulletin, a reference to the registration of the trade mark.

### **Part 4 – Rights conferred by registration**

#### **151. Exclusive right**

- (1) Subject to sections 153, 154 and 155, the registered owner of a trade mark has the right to exclude all other persons from using the registered trade mark in the course of trade in the manner contemplated in section 152, unless that other person has been authorised, in writing, to do so by the registered owner of that mark.
- (2) A trade mark must be registered in respect of goods and services falling in a particular class or classes as provided for in the International Classification of Goods and Services or any prescribed classification of goods or services, as contemplated in section 133, and the rights arising from the registration of a trade mark are determined in accordance with the classification applicable at the date of registration.

#### **152. Rights conferred by registration**

- (1) The registered owner of a trade mark or a registered licensee in the circumstances as contemplated in section 170(4) has, in addition to any other rights, remedies or actions available to him or her, the right to institute legal proceedings against any person who infringes the trade mark by using the mark in the course of trade, as contemplated in section 182, and without the owners written authorisation, as contemplated in section 151, or who performs acts which make it likely that infringement will occur.

*[There should be an apostrophe after the word "owners" in the phrase "owners written authorisation".]*

- (2) The rights referred to in subsection (1) are in respect of the use of a mark identical to or so similar to the registered trade mark as to be likely to deceive or cause confusion, and in relation to goods or services in respect of which the trade mark is registered, or goods or services so similar to those for which the trade mark has been registered that it is likely that deception or confusion may arise among members of the public.
- (3) In case of such use of an identical mark for identical goods or services, a likelihood of deception or confusion must be presumed.
- (4) The registered owner of a well-known trade mark as contemplated in section 138(1)(a) or (b) or a registered licensee of such a trade mark as contemplated in section 167 has, in addition to any other rights, remedies or actions available to him or her, the right to institute legal proceedings against any person who infringes the trade mark by using the mark in the course of trade and without the written authorisation of the registered owner in the circumstances contemplated in section 138(1)(a) or (b) or 182(c).

### 153. Exhaustion of rights

The right to institute proceedings conferred by the registration of a trade mark does not extend to -

- (a) acts in respect of articles to which the trade mark has been applied and which have been put on the market in any country by the registered owner or with his or her written consent;
- (b) the use of the trade mark in respect of or in relation to goods to be sold or otherwise traded in, or services to be performed in, any place to which the registration does not extend, or the use of the trade mark in a manner or in circumstances to which, having regard to any conditions or limitations entered in the register, the registration does not extend.

### 154. Right to continue to use

- (1) Nothing in this Act entitles the proprietor of a registered trade mark to interfere with or restrain the use by any person of a trade mark identical to a trade mark or nearly resembling it in respect of goods or services in relation to which that person or a predecessor in title of his or hers has made continuous and bona fide use of that trade mark from a date prior 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; or
  - (b) to 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,
 whichever is the earlier, or to object (on such use being proved) to the trade mark of that person being registered in respect of those goods or services.
- (2) Nothing in this Act entitles the proprietor of a trade mark entitled to protection of such trade mark under the Paris Convention as a well-known trade mark -
  - (a) to interfere with or restrain the use by any person of a trade mark (herein the "used trade mark") which constitutes, or the essential parts of which constitute, a reproduction, imitation or translation of the well-known trade mark in relation to goods or services in respect of which that person or a predecessor in title has made continuous and bona fide use of the used trade mark from a date prior to the commencement of this Act or to the date on which the well-known trade mark became entitled, in Namibia, to protection under the Paris Convention, whichever date is the latter date; or
  - (b) to object (on such use being proved) to the used trade mark of that person being registered in relation to those goods or services.

### 155. Bona fide use of name or description

- (1) The right to institute proceedings conferred by the registration of a trade mark do not extend to -
  - (a) any bona fide use by a person of his or her own name, or the name of any of his or her predecessors in business, or the name of his or her or their place of business;
  - (b) the use by a person of any bona fide description or indication of the kind, quality, quantity, intended purpose, value, geographical origin or other characteristics of his or her goods or services, or the mode or time of production of the goods or the rendering of the services;
  - (c) the bona fide use of the trade mark in relation to goods or services where such use is reasonable to indicate the intended purpose of such goods, including spare parts and accessories, and such services;
  - (d) the bona fide use by any person of any utilitarian features embodied in a container, shape or colour which is registered as a trade mark;
  - (e) the use of any identical or confusingly or deceptively similar trade mark which is also registered.
- (2) Subsection (1)(a) does not apply to the name of any juristic person which name was registered after the date of registration of the trade mark, and the use contemplated in subsection (1)(a) to (d) is consistent with fair practice.

### 156. ARIPO trade marks

- (1) Where an application for the registration of a trade mark in ARIPO is filed with the Registration Office as the receiving office in terms of the Banjul Protocol, the Registrar must, without delay, transmit the application to the office of ARIPO, after which the application must be processed further in accordance with the provisions of the Banjul Protocol, including that the Registrar must -
  - (a) accord the application a filing date;
  - (b) examine the application for registration in respect of the formal requirements as prescribed by the Banjul Protocol;
  - (c) if the application does not comply with the formal requirements, notify the applicant and invite him or her to comply with the requirements within the prescribed period, failing which the Registrar must refuse the application; and
  - (d) if the application complies with the formal requirements, notify each designated State within the prescribed period.
- (2) Where, in an application for the registration of a trade mark in ARIPO, the Registration Office is notified that Namibia is a designated State in terms of the Banjul Protocol, the Registrar must -
  - (a) examine the application for registration in accordance with the provisions of this Act;
  - (b) if the Registrar finds that the mark is not registrable as a trade mark in terms of this Act, communicate to the office of ARIPO within 12 months from the date on which the Registration Office was notified of the designation, that the registration of the mark will have no effect in Namibia;
  - (c) if the Registrar finds that the mark is registrable as a trade mark in terms of this Act, notify the office of ARIPO within 12 months from the date on which the Registration Office was notified of the designation, that the mark has no effect in Namibia until such time as any possible opposition to the registration in accordance with this Act has been resolved, and then the provisions of subsections (3) and (4) apply.
- (3) The Registrar must, after notifying the office of ARIPO as contemplated in subsection 2(c), as soon as is possible, publish the application in terms of section 146(6), after which the provisions of section 147 apply.

- (4) If the registration of the mark is not opposed under section 147, or where the registration of the mark has been opposed but the Registrar has decided in the applicant's favour, the Registrar must -
  - (a) notify the office of ARIPO that the mark has been found to be registrable;
  - (b) deal further with the application as provided for in section 148(1) and section 150.
- (5) A mark in respect of which Namibia is a designated State, registered by ARIPO by virtue of the Banjul Protocol and in respect of which the provisions of subsection (4) have been complied with, has the same effect and enjoy the same protection in Namibia as a trade mark registered under this Act.  
*[The verb "enjoy" should be "enjoys" to be grammatically correct.]*

## **Part 5 – Duration, renewal and alteration of registered trade mark**

### **157. Duration of registration**

The registration of a trade mark is valid for a period of 10 years from the date of the application for registration.

### **158. Renewal of registration**

- (1) The registration of a trade mark may, on a written request by the registered owner prior to, or within the prescribed period of grace after, the expiration of a 10 year period, be renewed for consecutive periods of 10 years so long as the registered owner pays the prescribed renewal fee in respect of each such period.
- (2) A period of grace of six months is allowed for the late payment of the renewal fee on payment of the prescribed surcharge.
- (3) At the prescribed time before the expiration of a 10 year period, the Registrar must send a notice in the prescribed manner to the registered owner, at his or her address for service, of the expiration of the period and the date by which the renewal is to be requested and the prescribed renewal fee to be paid.
- (4) If the renewal is not requested and the prescribed renewal is not paid at the expiration of the period of grace provided for in subsection (2), the trade mark registration lapses and must be removed from the register, and the Registrar must, if he or she becomes aware of this position, remove the trade mark from the register.
- (5) Where a trade mark has been removed from the register for the non-payment of the renewal fee, it may be restored to the register in the circumstances and by the procedure as contemplated in section 159.

### **159. Restoration of registration**

- (1) Where a trade mark registration has lapsed owing to the non-payment of any prescribed renewal fee within the prescribed period or the grace period referred to in section 158, the owner of the trade mark may in the prescribed manner and on payment of the prescribed fee, apply to the Registrar for the restoration of the trade mark registration.
- (2) If the Registrar is satisfied that the omission was unintentional and that no undue delay has occurred in the making of the application, he or she must publish the application for restoration in the bulletin in the prescribed manner, after which any person may within such period as prescribed, give notice in the prescribed manner of opposition to the restoration of the trade mark registration.
- (3) Any opposition to the restoration of a trade mark must follow the opposition procedure prescribed in the regulations.
- (4) If there is no opposition as provided for in subsection (2), or if there is opposition and the Registrar is satisfied that such opposition is without merit, he or she must restore the trade mark registration.
- (5) Any such restoration of the trade mark registration is subject to the payment of such renewal fees as contemplated in section 158 as remain unpaid at the date of the restoration.

- (6) If there is opposition as provided for in subsection (2) and the Registrar is satisfied that the opposition has merit, he or she must refuse to restore the trade mark registration.
- (7) The owner of a trade mark registration restored in accordance with subsections (1) to (5) is not entitled, in terms of the provisions of section 152, to institute any proceedings against or recover damages from any person who commenced using the trade mark after the lapse of a period of six months from the date on which the annual fee was due and before the date on which the notice of the application for restoration was published.
- (8) Where a trade mark registration has been restored in accordance with subsections (1) to (5), any person who during the period referred to in subsection (7) expended any money, time or labour with a view to using the trade mark and who is prevented from such use by the restoration of the trade mark, may apply to the Tribunal for compensation to be paid by the owner of the trade mark registration in respect of the money, time and labour so expended.

### **160. Alteration or amendment of trade mark**

- (1) The registered owner of a trade mark may apply in the prescribed manner to the Registrar for permission to add to or alter the trade mark in any manner not substantially affecting the identity thereof, and the Registrar may refuse leave or may grant it on such terms and subject to such limitations as he or she may think fit.
- (2) After granting an application to alter a trade mark in terms of subsection (1), the Registrar must request the applicant to advertise the grant of the application for alteration in the prescribed manner.
- (3) Any person may, within three months from the date of the advertisement referred to in subsection (2) or such further period as the Registrar may allow, oppose the grant of the application for alteration.
- (4) Any opposition to the amendment or alteration of a trade mark must follow the opposition procedure as prescribed.
- (5) The Registrar may, on request made in the prescribed manner by the registered owner of a trade mark, amend or alter the register by -
  - (a) correcting any error in the name or address of the registered owner of the trade mark or any error in the register relating to such trade mark;
  - (b) altering the name or address or address for service of the registered owner who has changed his or her name or address or address for service;
  - (c) cancelling the registration of the trade mark;
  - (d) deleting any goods or services or classes of goods or services from those in respect of which the trade mark is registered; or
  - (e) entering a disclaimer or memorandum relating to the trade mark which does not in any way extend the rights given by the registration of the trade mark.
- (6) The Registrar may, on request made in the prescribed manner by the registered owner\* or a registered user of a trade mark as contemplated in section 170, enter in the register any change in the name or address of such registered user.
- (7) Where, after the registration of a trade mark, the International Classification of Goods and Services is amended, the registered owner of the trade mark may, at any time, apply to the Registrar in the prescribed manner for the revision of the class or classes in which the trade mark is registered.
- (8) If the amendment of the International Classification of Goods and Services results in -
  - (a) two or more identical registered trade marks owned by the same owner and previously registered with the same registration date in different classes, to fall within a single class, the owner has the right to require the Registrar to consolidate the registrations in a single registration;

- (b) a single registered trade mark owned by the owner to fall within two or more different classes, the owner has the right to require the Registrar to register the trade mark as separate registrations with the same registration date in such two or more classes.
- (9) The Registrar may correct any error in the register made by an staff member of his or her office.

*[As a result of the global substitution of “staff member” for “official” by Act 8 of 2016, the article “an” should now be “a”.]*

## **Part 6 – Change in ownership and joint ownership of trade mark applications and registered trade marks**

### **161. Change in ownership of applications or trade marks**

- (1) The registered owner of a registered trade mark or a trade mark which is the subject of an application for registration may transfer his or her rights in the registered trade mark or application by way of cession, assignment or testamentary disposition, either with or without the goodwill of the business concerned, or ownership or rights in such trade mark or application may be transferred by operation of law.
- (2) No cession or assignment as contemplated in subsection (1) is -
- (a) of any force or effect unless it is in writing and signed by or on behalf of the registered owner or, if the owner is deceased or ceased to exist, by the person authorised to dispose of the assets of the registered owner;
  - (b) valid and enforceable against third parties unless it is recorded by the Registrar in the appropriate register on application by the new owner within 12 months after the date of the cession or assignment or such further time as the Registrar may allow on payment of the prescribed fee.

### **162. Associated trade marks**

- (1) Where a trade mark that is registered or is the subject of an application for registration -
- (a) so resembles another trade mark that is registered; or
  - (b) is the subject of an application for registration in the name of the same proprietor,
- that the use of both such trade marks by different persons in relation to goods or services in respect of which they are respectively registered or proposed to be registered would be likely to deceive or cause confusion, the Registrar may at any time require that the trade marks be entered in the register as associated trade marks.
- (2) Where a trade mark and any part or parts thereof are, by virtue of section 149(1), registered as separate trade marks in the name of the same proprietor, they are deemed to be, and must be registered as, associated trade marks.
- (3) Any association of a trade mark with any other trade mark registered in the name of the same proprietor is deemed to be an association with all trade marks associated with that other trade mark.
- (4) Trade marks that are registered as, or that are deemed by virtue of this Act to be, associated trade marks may only be assignable or transmissible together and not separately, but they must for all other purposes be deemed to have been registered as separate 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 regards any of them if he or she 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) When under the provisions of this Act use of a registered trade mark is required to be proved for any purpose, the Registrar or the Tribunal, as the case may be, may, if and so far as he, she or it deems fit,



accept proof of the use of an associated registered trade mark or of the trade mark with additions or alterations not substantially affecting its identity, as equivalent to proof of the use required to be proved.

- (7) The use of the whole of a registered trade mark must for the purposes of this Act be deemed to be the use also of any registered trade mark being a part thereof and registered in the name of the same proprietor by virtue of section 149(1).

### **163. Joint ownership of trade mark applications**

- (1) Where two or more persons have jointly filed an application for a trade mark registration, the joint applicants have, in the absence of an agreement to the contrary, equal undivided shares in the application, and none of them may without the consent of the other joint applicant or applicants deal in any way with the application, but if any proceedings are required to save the application from becoming abandoned, any applicant may institute such proceedings on behalf of himself or herself and any other joint applicant.
- (2) If any dispute arises between joint applicants as to their respective rights in and to an application for a trade mark registration or as to the manner in which the application is to be proceeded with or the manner in which they may deal with the application or use the trade mark, any such joint applicant may apply to the Tribunal to decide the matter in dispute.
- (3) Unless the Tribunal otherwise directs, the person who makes an application in terms of subsection (2) is liable for all costs and expenses incurred in respect of proceedings in terms of that subsection.
- (4) If the Tribunal is satisfied that a joint applicant, is unable or unwilling to proceed as joint applicant, the Tribunal may order that such joint applicant assign his or her rights to any joint applicant able and willing so to proceed, provided that where it appears to the Tribunal to be just and equitable, the Tribunal may order the payment of compensation to the assignor.
- (5) In any proceedings in terms of subsection (2) the Tribunal must, unless it appears that there are good reasons to the contrary, resolve the dispute in a manner which will lead to the preservation of the application and the grant of the registration.

### **164. Joint ownership of trade mark registrations**

- (1) Where a trade mark is registered in the name of two or more persons jointly, each of the joint patent owners is, in the absence of an agreement to the contrary, entitled to an equal undivided share in the registration.
- (2) Subject to the provisions of subsection (4), a joint trade mark registration owner is, in the absence of an agreement to the contrary and in the absence of consent of the other joint patent owner or owners, not entitled -
  - (a) to use the trade mark in the course of trade;
  - (b) to grant a licence or to assign the whole or any part of his interest in the trade mark registration; or
  - (c) to take any steps or institute any proceedings relating to the trade mark.
- (3) Despite subsection (2), a joint trade mark owner may pay any renewal fee that is payable without recourse to any other trade mark owner, unless the Tribunal directs otherwise in proceedings in terms of subsection (7).
- (4) Where an article to which the registered trade mark has been applied is disposed of by a joint trade mark owner, the acquirer or any person claiming through him or her is entitled to deal with it in the same manner as if the article had been disposed of by the trade mark owners jointly.
- (5) Any joint trade mark owner may institute proceedings for infringement and must give notice thereof to every other joint trade mark owner, and any such other trade mark owner may intervene as co-plaintiff and recover any damages in respect of any damage he or she may have suffered as a result of the infringement.



- (6) If in any proceedings under subsection (5) damages are awarded to a plaintiff, damages must be awarded as if he or she were the sole trade mark owner, and the defendant is not obliged to compensate any other joint trade mark owner in respect of the infringement in question.
- (7) Where any dispute arises between joint trade mark owners as to their respective rights in or to a trade mark, the institution of proceedings relating to the trade mark or the manner in which they should deal with the trade mark, any joint trade mark owner may apply to the Tribunal to decide the matter in dispute.
- (8) If in considering any application under subsection (7) the Tribunal is satisfied that a joint trade mark owner is unable or unwilling to remain a trade owner, the Tribunal may order him or her to assign his or her rights to any other joint trade mark owner able and willing so to remain but, where it appears to the Tribunal to be just and equitable, it may order the payment of compensation to such joint trade mark owner who is so ordered to assign his or her rights.  
*[The phrase "trade owner" should be "trade mark owner".]*
- (9) In considering any application under subsection (7) the Tribunal must, unless it appears that there are good reasons to the contrary, resolve the dispute in a manner which will lead to the preservation and use of the trade mark.

## **Part 7 – Voluntary licences, registered users and transfers**

### **165. Voluntary licences**

- (1) The owner of a trade mark application or a registered trade mark may enter into a contract with one or more other persons to authorise such person or persons to use the trade mark covered by the application or the registered trade mark in Namibia (herein referred to as a "voluntary licence").
- (2) A voluntary licence contract concerning a trade mark application or a registered trade mark must be in writing and signed by the licensor and may be submitted in the prescribed manner as contemplated in section 171 to the Registrar who must keep its contents confidential but must, record the grant of the licence in the appropriate register.
- (3) Any licence contract made in respect of a trade mark which is the subject of an application for registration or a registered trade mark must provide for the effective control, by the licensor, of the quality of the goods or services of the licensee in connection with which the mark is to be used.
- (4) The Registrar must publish a reference to the grant of a voluntary licence in the bulletin.
- (5) A licence contract has no effect against third parties until such recordal is effected.
- (6) The recordal of a licence under subsection (2) may be cancelled on request to the Registrar in the prescribed manner, accompanied by proof that the licence has expired or has been terminated.
- (7) The registration of a certification trade mark or a collective trade mark, or an application for such registration, may not be the subject of a licence contract other than a licence granted to any person in terms of the rules governing the use of such marks as contemplated in section 188(1) and (2).

### **166. Invalidation of licences**

- (1) If a licence contract as provided for in section 165 does not provide for such quality control as contemplated in section 165(3), the licence contract is invalid.
- (2) If a licence has been recorded as provided for in section 165(2) and such quality control is not effectively carried out, any registered user may apply to the Registrar for the right granted to the licensee to use the trade mark to be cancelled as contemplated in section 173(1).

### **167. Effect of licences**

Where a licence has been recorded in accordance with section 165(2) -

- (a) the licensee must be a registered user of the trade mark as contemplated in section 171;
- (b) the licensee has the right, in the circumstances as contemplated in section 170(4), to institute action against any person who infringes the trade mark as provided for in section 152 or section 183, unless the licence agreement has a contrary provision.

### **168. Assignability of licences or user rights**

- (1) Where a licence is granted to use a registered trade mark as contemplated in section 165, or where a person is allowed to use a registered trade mark as contemplated in section 170, such licence or user right may only be transferred to another person -
  - (a) with the agreement and consent of the trade mark owner; or
  - (b) if the transfer takes place with the transfer of the enterprise or business of the person to whom the licence or user right was granted.
- (2) Any assignment or transfer contrary to subsection (1) is invalid.

### **169. Effect of invalidity of registration on licence**

- (1) Any contract, in so far as it relates to a licence under a trade mark application or a registration to use such trade mark, terminates on the date on which the trade mark application is refused, or on which the trade mark registration, under which the licence was granted, expires, is revoked removed or otherwise ceases to protect such trade mark.

*[There should be a comma after the phrase "is revoked".]*

- (2) Where a contract relates to licences under more than one application or registration, such part of the contract as relates to any particular licence terminates when the application or the registration under which it was granted is refused or expires, is revoked or otherwise ceases to protect the trade mark concerned, and the contract as a whole terminates when all the registrations under which all such licences were granted and which were in force at the time when the contract became operative, expire, are revoked or otherwise cease to protect the relevant trade marks.
- (3) Nothing in this section affects any right to terminate a contract or a condition in a contract independently of this section.

### **170. Registered use**

- (1) Where a registered trade mark is used by a person other than the owner thereof but with the licence of the owner, whether in terms of a licence agreement or by reason of another instrument of control, and whether or not such licence or other instrument has been recorded as contemplated in sections 165(2) and 167, such use is deemed to be permitted use for the purposes of subsection (2).
- (2) The permitted use of a trade mark referred to in subsection (1) is deemed to be use by the owner and may not be regarded as use by a person other than the owner for the purposes of section 176 or for any other purpose for which such use is material under this Act or at common law.
- (3) Subject to the provisions of this section, a person, other than the owner of a registered trade mark, who uses such trade mark with the licence of the owner, may be registered as a registered user in terms of section 171 in respect of all or any of the goods or services in respect of which the trade mark is registered.
- (4) Despite any agreement to the contrary subsisting between the parties, a registered user of a registered trade mark is entitled to request the owner of the trade mark to institute infringement proceedings, and, if the owner refuses or neglects to do so within two months after being so requested, the registered user may institute proceedings, as contemplated in section 152, in his or her own name as if he or she were the

owner, citing the owner as a co-defendant, but an owner so cited is not liable for any costs unless he or she enters an appearance and takes part in the proceedings.

- (5) In all proceedings relating to a registered trade mark, the registration of a person as a registered user must be considered as prima facie evidence that the use of the registered trade mark by him or her is permitted use as contemplated by subsection (1).

### **171. Registration of registered user**

- (1) Where it is proposed that a person be registered as a registered user of a trade mark, the owner of the trade mark or the proposed registered user must apply in writing to the Registrar in the prescribed manner giving particulars of -
- (a) the name and address of the proposed registered user;
  - (b) the relationship, existing or proposed, between the owner and the proposed registered user; and
  - (c) the goods or services in respect of which the person is to be registered as a registered user of the trade mark.
- (2) Where the requirements of subsection (1) have been complied with, the Registrar must register the proposed registered user as a registered user in respect of the relevant goods or services.

### **172. Guarantee of control**

The provisions of sections 165(3) and 166 apply to a registered user as if the registered user is a licensee.

### **173. Variation and cancellation**

- (1) Without derogating from the provisions of section 171, the registration of a person as a registered user -
- (a) may be cancelled or varied by the Registrar on application in writing in the prescribed manner by the registered owner or by such registered user or by any other registered user of the trade mark;
  - (b) must be cancelled by the Registrar where the trade mark in respect of which such person has been registered has been assigned and application has in terms of section 161 been made for recordal of the assignment, unless the subsequent owner registered in terms of the said section requests the Registrar in the prescribed manner not to cancel any such registration and furnishes the Registrar with the particulars referred to section 171(1)(a) and (b).
- (2) The Registrar may at any time 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.

### **174. Transferability of trade marks**

- (1) As contemplated in section 161 a registered trade mark or an application for registration of a trade mark may be -
- (a) assigned or transferred either in connection with or without the goodwill of the business concerned; or
  - (b) assigned or transferred in respect of either all of the goods or services to which the trade mark applies, or in respect of some but not all of those goods or services.
- (2) Despite the provisions of subsection (1), any assignment or transfer of exclusive rights to more than one person in circumstances which are likely to deceive or cause confusion, is invalid.

## **Part 8 – Surrender, removal and invalidation**

### **175. Surrender of registered trade mark**

The registered owner of a trade mark registration may at any time during the duration of the registration, in the prescribed manner, request the Registrar to cancel the registration, either partially or totally in respect of the goods or services in respect of which it is registered.

### **176. Removal for non-use**

- (1) Any person may by application request the Registrar to remove, partially or totally, a trade mark from the register in respect of any or all of the goods or services in respect of which it is registered on the ground that up to three months prior to filing the application and after the date of issue of the registration certificate, there had been no bona fide use of the mark in the course of trade by the registered owner or a licensee as contemplated in section 167 or a registered user as contemplated in section 170, as they were recorded in the register from time to time, during a continuous period of three or more years.
- (2) An applicant is not entitled to rely for the purposes of subsection (1) on any non-use of a trade mark if the registered owner can show that such non-use was due to special circumstances in the trade 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.
- (3) Subsection (1) does not apply to a trade mark in respect of which protection may be claimed under the Paris Convention as a well-known trade mark within the meaning of section 196.

### **177. Removal when mark becomes generic name**

Where a registered trade mark is or contains matter which is not or no longer capable of distinguishing within the meaning of section 134, any interested person may apply to the Registrar to require that the registered owner must -

- (a) disclaim any right to the exclusive use of such matter; or
- (b) make such other disclaimer or endorsement as may be necessary for defining the rights under the registration; or
- (c) remove the registration,

but, any such disclaimer or endorsement or removal does not affect any other rights of the registered owner in respect of the trade mark except as arising out of the registration.

### **178. Procedure and effect of removal**

- (1) An application under section 176 or 177 must be filed with the Registrar in the form and manner as prescribed, and must be accompanied by a statement setting out the ground or grounds on which the applicant relies for the registration to be removed.
- (2) An application for the removal of a trade mark from the register of marks, together with the statement setting out the ground or grounds on which the applicant relies, must, in the prescribed manner, be served on the owner of the mark.
- (3) The owner has the right to submit, in the prescribed manner, to the Registrar his or her reply to the application for the removal of the trade mark.
- (4) The parties must follow the procedure and submit such evidence as prescribed and the Registrar must, in the manner contemplated in section 147, decide the matter and determine the relief, if any, to be granted.
- (5) The Registrar may not remove a trade mark from the register if the owner of that mark can show that special circumstances in the trade existed which prevented the use of the mark and that there was no intention not to use the mark in respect of those goods or services, or that there was no intention to abandon the use of the mark in respect of those goods or services, as contemplated in section 176(2).

### **179. Invalidation of registration**

- (1) Any interested person may apply to the Tribunal for the invalidation of the registration of a trade mark on the ground that the requirements of section 131, 137 or 138 have not been complied with or are no longer complied with.
- (2) An application under subsection (1) must be made in the prescribed manner and be accompanied by a statement setting the ground or grounds on which the applicant relies for the registration to be invalidated.
- (3) An application for the invalidation of a registration of a trade mark, together with the statement setting out the ground or grounds on which the applicant relies, must be served on the owner of the trade mark in the prescribed manner.
- (4) The owner has the right to submit, in the prescribed manner, to the Tribunal, his or her reply to the application for the invalidation of the registration.
- (5) The parties must follow the procedure and submit such evidence as prescribed and the Tribunal must, taking into account the requirements of section 147, decide the matter and determine the relief, if any, to be granted.
- (6) If the Tribunal is satisfied that an amendment of the trade mark registration will remove the ground of invalidity, it may uphold the trade mark registration subject to such amendment and subject to such terms or conditions as it deems fit.
- (7) The final decision of the Tribunal must be notified to the Registrar who must record it and as soon as possible publish it in the bulletin.

### **180. Effect of invalidation**

Any order for the removal or invalidation of a registration or the entry on the register of an amendment or disclaimer relating to the registration of a mark must be deemed to have been effective -

- (a) from the date of the application for such order; or
- (b) if the Registrar is satisfied that grounds for such order existed at an earlier date, such earlier date.

### **181. Notification, recording and publication of surrender, removal or invalidation**

A notice of any surrender, removal or invalidation of, or any amendment or disclaimer in respect of, a registered trade mark must be published in the bulletin by the Registrar as soon as possible after the respective order.

## **Part 9 – Infringement**

### **182. Acts of infringement**

The rights acquired by registration of a trade mark are infringed by -

- (a) the unauthorised use in the course of trade in relation to goods or services in respect of which the trade mark is registered, of an identical mark or of a mark so nearly resembling it as to be likely to deceive or cause confusion;
- (b) the unauthorised use of a mark which is identical or similar to the registered trade mark, in the course of trade in relation to goods or services which are so similar to the goods or services in respect of which the trade mark is registered, that in such use there exists the likelihood of deception or confusion;
- (c) the unauthorised use in the course of trade in relation to any goods or services of a mark which is identical or similar to a registered trade mark registered, if such trade mark is well known in Namibia and the use of the said mark would be likely to take unfair advantage of, or be prejudicial or detrimental to, the distinctive character or the repute of the registered trade mark, despite the absence of confusion or deception.

### 183. Infringement proceedings and remedies

- (1) Where a trade mark registered in terms of this Act has been infringed and legal proceedings are instituted by the registered owner or a licensee as contemplated in section 152, the Tribunal may grant the registered owner or the licensee the following relief, namely -
  - (a) an interdict;
  - (b) an order -
    - (i) for the removal of the infringing mark from all infringing goods or materials; and
    - (ii) where the infringing mark is inseparable or incapable of being removed, an order that all such goods or materials be delivered up to the claimant;
  - (c) damages, including those arising in terms of section 147(8);
  - (d) in lieu of damages, at the option of the claimant, a reasonable royalty which would have been payable by a licensee for the use of the trade mark concerned, including any use which took place after advertisement of the acceptance of an application for registration and which, if taking place after registration, would amount to infringement of the rights acquired by registration.
- (2) For the purposes of determining the amount of any damages or reasonable royalty to be awarded under this section, the Tribunal may direct an enquiry to be held and may determine such procedures for conducting such enquiry as it may deem fit.
- (3) Before a person institutes proceedings in terms of this section in respect of the infringement of a trade mark registration he or she must give notice in writing of the intention to do so to the registered owner, if applicable, and to every other registered owner or registered user or licensee concerned whose name is recorded in the register in respect of that registration, and the registered owner or any such other person is entitled to intervene in such proceedings and to recover any damages he or she may have suffered as a result of the infringement.

### 184. Meaning of infringing goods

For purposes of section 183, "infringing goods" include -

- (a) goods that are the same or so similar to the goods in respect of which the trade mark is registered that the use of the trade mark on such goods is likely to cause deception or confusion, if the registered trade mark or a mark so closely resembling it as to be likely to deceive or confuse has been applied to or is used, without the authorisation of the owner of the trade mark registration, in relation to such goods manufactured, produced or made without the authority of such owner; and
- (b) printing plates or other equipment or materials used or intended to be used for applying a registered trade mark without the authorisation of the trade mark owner, or the manufacture, production or making of the unauthorised goods as contemplated in paragraph (a).

### 185. Order as to disposal of infringing goods

- (1) Where an order is made for the delivery up of any goods or materials as contemplated in section 183(1), the Tribunal may, if it deems it appropriate in the circumstances, refer such order to the Registrar for his or her consideration and determination under subsection (2).
- (2) If a referral is made under subsection (1), the Registrar must consider whether or not the infringing trade mark can be removed from those goods and, after the removal of the infringing trade mark, whether or not any of such goods could be re-used without causing prejudice or harm to the owner of the trade mark or a registered licensee or registered user, including prejudice to the distinctive character or repute of the registered trade mark, and if the Registrar comes to the conclusion that such re-use would be possible he or she must refer the matter back to the Tribunal with his or her recommendation for the Tribunal to make an appropriate order.

### **186. Remedy for groundless threats of infringement proceedings**

- (1) Any person threatened with infringement proceedings who can prove that the acts performed or to be performed by him or her do not constitute infringement of a trade mark may request the Tribunal to grant an interdict to prohibit such threats and award damages for financial loss resulting from the threats.
- (2) Proceedings under subsection (1) may not be instituted after five years from the date of the threats.
- (3) The mere notification of the existence of a trade mark registration does not constitute a threat within the meaning of subsection (1).
- (4) The person making such threats and against whom relief is sought in proceedings under subsection (1) may apply by way of a counterclaim for any relief to which he or she would be entitled in separate proceedings in respect of any infringement by the plaintiff of the trade mark registration to which the threat relates.

## **Part 10 – Certification and collective marks**

### **187. Applicability of other provisions**

- (1) Subject to subsection (2) and (3) and sections 188, 189 and 190, the provisions of this Chapter do, insofar as they can be applied, apply to certification and collective trade marks, save that references in the said provisions to a trade mark must be read as being references to a certification or a collective trade mark, as the case may be.

*[The word “subsection” should be plural to be grammatically correct.]*

- (2) Geographical names or other indications of geographical origin may be registered as certification or collective trade marks.
- (3) In applying the provisions of this Chapter in respect of the use of a certification or collective mark, the rules governing the use of a certification or collective mark as referred to in section 188 must be taken into account.

### **188. Application for registration of certification or collective mark**

- (1) An application for the registration of a certification trade mark must designate the mark as a certification mark and must be accompanied by a statement by the applicant containing the information as prescribed, and by a copy of the rules governing the use of certification mark.
- (2) An application for the registration of a collective trade mark must designate the mark as a collective mark and must be accompanied by a copy of the rules governing the use of the collective trade mark and containing the information as prescribed.
- (3) For the purposes of subsections (1) and (2), “rules” means the rules made by the person under whose control the certification or collective mark may be used.
- (4) The registered owner of a certification mark or a collective mark must notify the Registrar, in writing and in the manner prescribed, of any changes made in respect of the rules referred to in subsection (3).

### **189. Examination of application for registration**

If the Registrar is satisfied that the requirements of section 188 have been met, he or she must accept the application as provided for in section 146 and deal further with the application as contemplated in that section.

### **190. Invalidation of registration of certification or collective mark**

- (1) In addition to the grounds referred to in sections 176, 177 and 179, the Registrar may invalidate the registration of a certification trade mark or a collective trade mark if the person requesting the



invalidation proves that the trade mark is used in a manner contrary to the rules referred to in section 188, or that its use is permitted in a manner which is likely to deceive trade circles or the public as to the origin or any other common characteristics of the goods or services concerned.

- (2) An application for the invalidation of a certification or a collective trade mark must be served on the owner of the trade mark in the manner and within the time prescribed.

## **Part 11 – Trade names and acts of unfair competition**

### **191. Prohibited trade names**

- (1) A name or designation may not be used as a trade name if, by its nature or the use to which it may be put, it will be contrary to public order or morality or if it will be likely to deceive trade circles or the public as to the nature of the enterprise identified by that name.
- (2) Any use of a trade name that is likely to mislead the public must be regarded as unlawful.

### **192. Protection of trade names**

Despite any law providing for the registration of trade names, such names are protected by common law, even prior to or without registration, against any unlawful act committed by third parties.

### **193. Transferability of trade names**

- (1) A trade name may be -
  - (a) assigned or transferred with the goodwill of the business in relation to which it is used; or
  - (b) assigned or transferred in respect of some or all of the goods or services in respect to which it is used in the conduct of that business.
- (2) Despite the provisions of subsection (1), any assignment or transfer of the rights to a trade name in circumstances which are likely to deceive or cause confusion, is invalid.

### **194. Acts of unfair competition**

- (1) Any act of competition contrary to honest practices in industrial or commercial matters is unlawful.
- (2) Without derogating from what constitutes a restrictive business practice prohibited under Part I or Part II of Chapter 3 of the Competition Act, 2003 (Act No. 2 of 2003), for purpose of this Act the following acts are deemed to constitute acts of unlawful competition -
  - (a) acts of such nature as to create confusion in any manner or by any means with the establishment, the goods, or the industrial or commercial activities of a competitor;
  - (b) the making of false allegations in the course of trade of such nature as to discredit the establishment, the goods, or the industrial or commercial activities of a competitor;
  - (c) the disclosure, acquisition or use in a manner contrary to honest commercial practices of secret information without the written consent of the person lawfully in control of that information; and
  - (d) indications or allegations in the course of trade that are likely to mislead the public as to the nature, the manufacturing process, the characteristics, the suitability for their purpose, or the quality of the goods of a competitor.

### **195. Indication of source and origin**

- (1) Any person who sells or distributes in Namibia any goods which were not made or produced in Namibia, and to which there is applied any name or mark being or purporting to be the name or mark of any manufacturer, producer or trader in Namibia or the name of any place or district in Namibia, commits an



offence, unless there is added to that name or mark, in a conspicuous manner, the name of the country in which the goods were made or produced, with a statement that they were made or produced there.

- (2) Any person who sells or distributes in Namibia any goods which were not made or produced in Namibia, and to which there is applied any trade mark, mark or trade description in any official language of Namibia, commits an offence, unless there is added to that mark or description, in a conspicuous manner, the name of the country in which the goods were made or produced, with a statement that they were made or produced there.

*[Act 8 of 2016 makes a global substitution of “staff member” for “official”, but that substitution has not been applied here as the result would be nonsensical.]*

- (3) A person who intentionally or recklessly contravenes or fails to comply with subsection (1) or (2) is liable to a fine not exceeding N\$10 000 or to imprisonment for a period not exceeding 24 months or to both the fine and imprisonment.

## Part 12 – International matters

### 196. Protection of well-known trade marks

- (1) References in this Act to a trade mark which is entitled to protection under the Paris Convention as a well-known trade mark are to a mark which is well known in Namibia as being the mark of -
- (a) a person who is a national of a convention country; or
  - (b) a person who is domiciled in, or has a real and effective industrial or commercial establishment in, a convention country, whether or not such person carries on business, or has any goodwill, in Namibia.
- (2) In determining for the purposes of subsection (1) whether or not a trade mark is well-known in Namibia, due regard must be given to the knowledge of the trade mark in the relevant sector of the public of Namibia, including knowledge which has been obtained as a result of the promotion of the trade mark.
- (3) A reference in this Act to the owner of such a mark must be construed in accordance with subsection (1).
- (4) The owner of a trade mark which is entitled to protection under the Paris Convention as a well-known trade mark, even though it is not registered in Namibia, is entitled to restrain the use in Namibia of a trade mark which constitutes, or the essential part of which constitutes, a reproduction, imitation or translation of the well-known trade mark in relation to goods or services which are identical or similar to the goods or services in respect of which the trade mark is well known and where the use is likely to cause deception or confusion.
- (5) The provisions of subsection (4) apply only from a date prior to the commencement of this Act or to the date on which the well-known trade mark became entitled, in Namibia, to protection under the Paris Convention, whichever date was later.
- (6) Where authorisation of the competent authority of a convention country or an international organisation is required for the registration of a mark as a trade mark, such authority or organisation is entitled to restrain the use in Namibia of such a mark without such authorisation.

### 197. National emblems and emblems of international organisations

- (1) The following marks may not be registered as trade marks or, if registered, are liable to be removed from the register -
- (a) a mark which consists of or contains the national flag of Namibia or a convention country, or an imitation from a heraldic point of view, without the authorisation of the competent authority of Namibia or convention country, as the case may be, unless it appears to the Registrar that use of the flag in the manner proposed is permitted without such authorisation;
  - (b) a mark which consists of or contains the armorial bearings or any other state emblem of Namibia or

a convention country, or an imitation from a heraldic point of view, without the authorisation of the competent authority of Namibia or convention country, as the case may be;

- (c) a mark which consists of or contains an official sign or hallmark adopted by Namibia or a convention country, or an imitation from a heraldic point of view, and which indicates control and warranty, in relation to goods or services of the same or a similar kind as those in relation to which it indicates control and warranty, without the authorisation of the competent authority of Namibia or convention country, as the case may be;

*[Act 8 of 2016 makes a global substitution of “staff member” for “official”, but that substitution has not been applied here as the result would be nonsensical.]*

- (d) a mark which consists of or contains the flag, the armorial bearings or any other emblem, or an imitation from a heraldic point of view, or the name, or the abbreviation of the name, of any international organisation of which one or more convention countries are members, without the authorisation of the organisation concerned, unless it appears to the Registrar that use of the flag, armorial bearings, other emblem or imitation or the name or abbreviation in the manner proposed, is not such as to suggest to the public that a connection exists between the organisation and the mark, or is not likely to mislead the public as to the existence of a connection between the organisation and the proprietor of the mark.

(2) The provisions of subsection (1)(b), (c) and (d) apply -

- (a) to a state emblem and an official sign or hallmark of a convention country and an emblem, the name, or the abbreviation of the name, of an international organisation only if and to the extent that -

- (i) the convention country or international organisation, as the case may be, has notified Namibia in accordance with Article 6ter of the Paris Convention that it desires to protect that emblem, official sign or hallmark, name or abbreviation, as the case may be;
- (ii) such notification remains in force; and
- (iii) Namibia has not objected to it in accordance with Article 6ter of the Paris Convention or any such objection has been withdrawn; and

- (b) only in relation to applications for registration made more than two months after receipt of the notification referred to in paragraph (a)(i).

*[Act 8 of 2016 makes a global substitution of “staff member” for “official”, but that substitution has not been applied to paragraph (a) or subparagraph (i) as the result would be nonsensical.]*

(3) The provisions of subsection (1)(b) or (c) may not prevent the registration of a trade mark by a national of any country who is authorised to make use of a state emblem or official sign or hallmark of that country, despite the fact that it is similar to that of another country.

*[Act 8 of 2016 makes a global substitution of “staff member” for “official”, but that substitution has not been applied here as the result would be nonsensical.]*

## Part 13 – International registration under the Madrid Protocol

### 198. Definitions

For the purposes of this Part -

“**basic application**” means an application for the registration of a trade mark made in Namibia and which is used as a basis for an international application under the Madrid Protocol, and “basic registration” has a corresponding meaning;

“**date of the designation of Namibia**” means the date of an international application in which Namibia was designated or the date of a subsequent designation of Namibia, as the case may be;

“**Common Regulations**” mean the Common Regulations of 1996 made under the Madrid Agreement Concerning the International Registration of Marks and the Protocol Related to that Agreement;

“**date of international registration**”, “date of subsequent designation”, “designation”, “holder”, “international application”, “International Bureau”, “international registration”, and “subsequent designation” have the same meaning as in the Madrid Protocol or in the Common Regulations, as the case may be;

“**Madrid Agreement**” means the Madrid Agreement Concerning the International Registration of Marks of 1891; and

“**Madrid Protocol**” means the Protocol relating to the Madrid Agreement concerning the International Registration of Marks, adopted in Madrid on June 27, 1989 and the Regulations issued thereunder, as amended from time to time.

### **199. Protection of mark containing designation of Namibia**

- (1) Where an international registration of a mark contains a designation of Namibia, the protection of the mark in Namibia is, subject to section 200, as from the date of the designation of Namibia the same as if the mark had been the subject of an application for registration filed under this Act.
- (2) The Registrar must deal with international applications or international registrations in accordance with the provisions of sections 200 and 201 and, in accordance with the Madrid Protocol and the Common Regulations issued thereunder.
- (3) If there is a conflict between the provisions of the Madrid Protocol or the Common Regulations issued thereunder and the provisions of this Act, the Madrid Protocol and the Common Regulations prevail.

### **200. International registration containing designation of Namibia**

- (1) Where the Registrar is notified by the International Bureau that an international application or an international registration of a mark contains a designation of Namibia, the Registrar must proceed in accordance with section 145 as if the relevant mark is the subject of an application under this Act.
- (2) Where the Registrar finds that the requirements referred to in section 145 are not complied with or have only partly been complied with, the Registrar must notify the International Bureau that, to the extent that the said requirements are not complied with, protection of the mark in Namibia is refused.
- (3) After notice of refusal has been given to the International Bureau in terms of subsection (2), the holder of the international application or international registration may take such steps as are available to an applicant under this Act within such period as may be prescribed, and the Registrar must, once a final decision has been made, notify the International Bureau of that decision.
- (4) Where, in the circumstances contemplated in subsection (3), the holder of the international application or international registration fails to take such steps within the prescribed period, the application must be considered as having been abandoned.
- (5) Where an application is based on a designation of Namibia as contemplated in subsection (1), the publication of the international registration in terms of Article 3(4) of the Madrid Protocol is deemed to be a publication as contemplated in section 150, except that the Registrar must also publish the designation in the bulletin as contemplated in section 150.
- (6) Any person may, within the prescribed period after the publication in terms of subsection (5) and in the prescribed manner, give notice to the Registrar of opposition to the protection of the mark on the grounds that one or more of the requirements referred to in section 131, 134, 137 or 138 are not complied with.
- (7) Upon receipt of the notice of opposition referred to in subsection (6), the Registrar must as soon as is reasonably possible notify the International Bureau of such opposition.
- (8) The subsequent procedure applicable to the application must be in accordance with section 147(2) to (5) and references to the applicant must be construed as references to the holder of the international registration.

- (9) Once a final decision has been made by the Registrar in an opposition as contemplated in subsections (6), (7) and (8), the Registrar must notify the International Bureau of that decision.
- (10) No notification in accordance with subsection (2) or (7) may be sent to the International Bureau after the expiry of a period of one year from the date on which the International Bureau notified the Registrar of the designation concerned.
- (11) Where the Registrar finds that -
- (a) the requirements referred to in section 145(2) have been complied with; and
  - (b) no opposition has been entered in terms of subsection (6) or such opposition, if any, has not been successful,
- the Registrar must register the trade mark in the appropriate register and issue the registered owner with a registration certificate, and must publish a reference to the trade mark registration in the bulletin.
- (12) Where a basic application for the registration of a mark filed with the Registration Office, or where a basic registration of a trade mark registered by the Registration Office is to be used as the basis for an international registration under the Madrid Protocol, the Registrar must determine whether such basic application or registration complies with the requirements for an international application under the Madrid Protocol, and if the Registrar is satisfied that it does, he or she must -
- (a) certify the particulars appearing in the international application as provided by the Madrid Protocol and the Common Regulations;
  - (b) indicate the date of the international application in accordance with the Madrid Protocol and the Common Regulations; and
  - (c) transmit the international application to the International Bureau within two months of the date referred to in paragraph (b).

## **201. Invalidation of a trade mark registered under the Madrid Protocol**

Where a trade mark registration registered in Namibia under the Madrid Protocol has been invalidated in terms of section 179 or removed in terms of section 176, the Registrar must as soon as possible notify the International Bureau accordingly.

## **Part 14 – General**

### **202. Appeals**

- (1) The Tribunal has jurisdiction in all cases of dispute relating to the registration of a trade mark under this Chapter, and in all matters which under this Chapter may be referred to the Tribunal.
- (2) Any decision taken by the Registrar under this Chapter, including in regard to the registration of a trade mark or a certification trade mark or a collective trade mark, or in regard to the rejection of an application for such a registration, may be the subject of an appeal to the Tribunal by an interested party in the matter before the Registrar, and such appeal must be filed and prosecuted as prescribed.
- (3) Any change or amendment or correction of any document forming part of an application or a trade mark registration or the registration of a certification or collective trade mark may, on application by an interested party to the Tribunal, be set aside by the Tribunal if such change or amendment or correction does not comply with the provisions of this Act.

## **Chapter 5 General provisions**

### **Part 1 – Register as evidence, functions and powers of registrar**

### 203. Evidence of register and certain documents

- (1) The register is prima facie evidence of any matter directed or authorised by this Act to be entered therein.
- (2) A certificate purporting to be signed by the Registrar, to the effect that any entry authorised by this Act to be made, has or has not been made, or that any other thing so authorised to be done, has or has not been done, is prima facie evidence of the matters specified in that certificate.
- (3) A copy or an extract purporting to be a copy of an entry in the register or of a document kept at the Registration Office or an extract from the register or any such document, and purporting to be certified by the Registrar and to be sealed with the seal of the Registration Office, will be admitted in evidence before the Tribunal or any other court without further proof or production of the originals.

### 204. Evidence of ownership

- (1) The person appearing from the register to be the owner of a patent or a utility model certificate or an industrial design registration or the registration of a trade mark, including a certification or collective trade mark, or an applicant in an application for any such title under this Act has, subject to any right appearing from the register to be vested in any other person, the power to deal with such industrial property title or application as the owner thereof.
- (2) In all legal proceedings relating to a registered industrial property title under this Act, the fact that a person is registered as the owner of the title is prima facie evidence of the validity of the original registration of ownership of the title and of all subsequent assignments and transmissions of such ownership.
- (3) The provisions of subsections (1) and (2) do not protect any person dealing with an owner or applicant otherwise than as a bona fide licensee, purchaser, hypothecary or judgment creditor and without notice of any fraud on the part of such owner or applicant.
- (4) Except as expressly otherwise provided in this Act, a document or instrument in respect of which no entry has been made in the register may not be admitted in evidence in any proceedings in proof of the title to a patent or a utility model certificate or an industrial design registration or the registration of a trade mark, including a certification or collective mark, or an application to any such title, or to any interest therein, unless the Registrar, Tribunal or the court, on good cause shown, otherwise directs.
- (5) Except as expressly otherwise provided in this Act, no person who does not appear from the register as having an interest in an industrial property title under this Act or an application therefore, may be allowed to prove such interest in any proceedings, unless the Registrar, Tribunal or the court, on good cause shown, otherwise directs.

### 205. Loss of document

If any document issued by the Registrar or lodged with the Registrar is lost, the Registrar must, on the request of any person entitled to such document and on payment of the prescribed fee, furnish such person with a copy of such document issued or lodged insofar as this is possible, or, if a copy cannot be furnished, furnish such person with a certificate in respect thereof.

### 206. Exercise of discretionary powers by Registrar

- (1) If the Registrar is satisfied that the circumstances justify it, the Registrar may, on receiving a written request to extend the time for doing any act or taking any proceeding under this Act, on such terms as the Registrar may determine, extend the time.
- (2) In exercising any discretion vested in the Registrar by this Act, the Registrar must give any party to a proceeding before him or her, or any other party who appears from the register to be an interested party, an opportunity to be heard before exercising such discretion adversely to that party.
- (3) The extension referred to in subsection (1) may be granted even though the time for doing the act or

taking the proceeding has expired.

### 207. General powers of Registrar

- (1) The Registrar may, for the purposes of hearing and determining any proceedings in terms of this Act -
  - (a) receive evidence and determine whether and to what extent it may be given by affidavit or orally on oath or affirmation;
  - (b) summon witnesses;
  - (c) issue commissions de bene esse in the same manner that a magistrates' court would do pursuant to section 53 of the Magistrates Act 1944 (Act No. 32 of 1944);
  - (c) order discovery or inspection, and require the due production of documents;
  - (d) consider any interlocutory or other matters as may seem expedient;
  - (e) award costs against any party to any proceedings before him or her,

and generally the Registrar has in connection with any proceedings before him or her all such powers and jurisdiction as are possessed by the Tribunal.

*[The paragraph lettering is reproduced above as it appears in the Government Gazette; there are two paragraphs lettered (c).]*

- (2) Where express provision is not contained in this Act on any matter of procedure, the Registrar may have recourse to the rules governing procedure in the Tribunal.
- (3) Any party to proceedings before the Registrar may appeal to the Tribunal against any decision or order pursuant to such proceedings.

### 208. Venue of proceedings and taxation of costs

- (1) The place where any proceedings before the Registrar under this Act are to be heard and determined in any particular case is determined by the Registrar after consultation with the party or parties concerned, and such proceedings must be heard and determined by the Registrar at that place.
- (2) Any costs awarded by the Registrar must 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.

### 209. Correction of errors

- (1) The Registrar may -
  - (a) correct any clerical error or error in translation or transcription in any application filed under this Act, or in any document filed or lodged in pursuance of such application;
  - (b) correct any clerical error in any register maintained pursuant to this Act.
- (2) Subsection (1) may not be construed as giving the Registrar any power to correct or amend an application, document or register in any material manner.
- (3) A correction made in pursuance of this section may be made by the Registrar on his or her own accord, or on the request of any interested person.
- (4) A request pursuant to subsection (3) must be made to the Registrar in the prescribed manner and on payment of the prescribed fee.

### 210. Rectification of register

- (1) The Registrar may order the register to be rectified by the making, amendment or deletion of any entry

therein, and such order may be made either on a request in the prescribed manner or without such request.

- (2) If the Registrar intends to make an order referred to in subsection (1) otherwise than on a request, he or she must give notice of the intention to do so to the owner of or the applicant for the relevant title, as the case may be, and to any other person who appears or to be concerned, and the Registrar must give such owner or applicant or other person an opportunity of being heard before making the order.

## Part 2 – Industrial property agents

### 211. Agents and their functions

- (1) Where the ordinary residence or principal place of business of an applicant for any title under this Act or in any matter or proceeding as provided for by this Act is outside Namibia, he or she must be represented by an agent as contemplated in subsection (4) read with section 212.
- (2) Where the ordinary residence or principal place of business of an applicant is in Namibia, he or she may be represented by an agent as contemplated in subsection (4) read with section 212.
- (3) The Registrar must permit an agent to do on behalf of the person for whom such agent has been appointed as an agent, any act in connection with any registration or application under this Act or any related proceedings, except that no person other than a person as contemplated in subsection (4) read with section 212 may be permitted so to act.
- (4) An agent is -
  - (a) a legal practitioner resident and practising in Namibia in accordance with the Legal Practitioners' Act, 1995 (Act No. 15 of 1995); or  
*[The correct name of the Act cited above is the "Legal Practitioners Act" (without an apostrophe).]*
  - (b) a person registered by the Registrar as an agent as provided in section 212.

### 212. Registration of agents

- (1) The Registrar must keep a register of agents in which the name of every person registered by the Registrar in terms of subsection (2) must be recorded, and the register must contain such information concerning such agents as prescribed.
- (2) The Registrar must, on application in the prescribed manner and on payment to the Registrar of the prescribed fee, register as an agent -
  - (a) a person who produces proof that he or she has been authorised under any law repealed under section 239 to act as an agent for purposes of representing an applicant under such repealed law, and who is deemed to have been authorised to act as an agent under this Act;
  - (b) a person who produces proof to the satisfaction of the Registrar that he or she holds a qualification recognised by the Minister through regulations made under section 236 as being a suitable qualification to enable such person to act as an agent; or
  - (c) a person residing in Namibia who produces proof of passing the examination prescribed by the Minister.

### 213. Removal of names from register of agents

- (1) The Registrar may, at the request of an agent and after notice as prescribed, remove from the register of agents the name of that agent.
- (2) The Tribunal or court may, on the application of the Registrar or any other interested party, after notice as prescribed to the person concerned, who is entitled to be heard, remove the name of any person registered or deemed to be registered as an agent under section 214 from the register of agents if the



Tribunal or court is satisfied that such person is -

- (a) guilty of conduct as the Tribunal or court may consider sufficient to justify such removal; or
- (b) not a fit and proper person to continue to practise as an agent.

#### **214. Entitlement to practice**

- (1) A person may not -
  - (a) practise as an agent; or
  - (b) in any manner hold himself or herself out as an agent or use any words or any name, title or description indicating, or calculated to lead persons to infer, that he or she is an agent or is recognised as such by law,unless he or she -
  - (i) is registered as an agent under section 212 and his or her name has not been removed as contemplated in section 213; or
  - (ii) is a legal practitioner as contemplated in section 211(4)(a); or
  - (iii) practises in partnership with a person who is registered as an agent under section 212.
- (2) A person who contravenes subsection (1) commits an offence and on conviction is liable to a fine not exceeding N\$10 000 or to imprisonment for a period not exceeding 24 months or to both the fine and imprisonment.

### **Part 3 – Industrial Property Tribunal and appeals**

#### **215. Industrial Property Tribunal**

- (1) There is established a tribunal to be known as the Industrial Property Tribunal.
- (2) The Tribunal consists of three members, appointed by the Minister after consultation with the Minister responsible for justice, of whom -
  - (a) one must be a person with legal qualifications and who has been practising law for a period of not less than five years, and who will be the chairperson; and
  - (b) two are persons who have skills, knowledge or experience in intellectual property matters, economical or financial matters.
- (3) The Minister must, by regulation, prescribe the terms and conditions of appointment of members of the Tribunal, the remuneration to be paid to such members, the termination of such appointments and the filling of vacancies vacated by such members.
- (4) Despite the provisions of this section, the judge-president of the court, at the request of the Minister, may, pending the appointment of members of the Tribunal as contemplated in subsection (2), designate one or more judges or acting judges of the court to exercise the powers and perform the functions and duties conferred on the Tribunal by this Act.

#### **216. Oath of office**

A member of the Tribunal appointed in terms of section 215(2) may not perform any function as such a member unless he or she has taken an oath or made an affirmation, which must be subscribed to by him or her, in the form as is prescribed.

#### **217. Right of audience**



In any proceedings before the Tribunal under this Act -

- (a) the parties to such proceedings may appear in person or be represented by an agent as contemplated in section 211(4) read with section 212; and
- (b) where the Tribunal deems fit, it may grant to the Registrar leave to intervene, and the Registrar may thereafter appear or be represented as provided in paragraph (a).

## 218. Assessors

- (1) The Tribunal may appoint any person with special expert knowledge to act as an assessor in an advisory capacity in any case where it appears to the Tribunal that such knowledge is required for the proper determination of the case.
- (2) The Minister may prescribe the terms and conditions applicable to the appointment of assessors, and the remuneration payable to assessors.
- (3) The Tribunal must give due consideration to, but is not bound by, the opinion of any assessor.

## 219. Secretary of Tribunal

- (1) The Minister must, subject to the Public Service Act 1995 (Act [No 13 of 1995](#)), appoint a staff member to be the secretary of the Tribunal who is in charge of the administrative functions of the Tribunal.

*[There should be a full stop after "No" in the phrase "Act No. 13 of 1995".]*

- (2) The Minister may in like manner appoint such other staff members as may be necessary to assist the secretary in the performance of his or her functions.

## 220. Seat and jurisdiction of Tribunal

- (1) The seat of the Tribunal is Windhoek, but the functions of the Tribunal may be performed at any such place in Namibia as the chairperson of the Tribunal may determine.
- (2) The Tribunal has jurisdiction to -
  - (a) decide any appeal lodged with it in terms of any provision of this Act;
  - (b) consider and give a decision on any application made to it in terms of any provision of this Act;
  - (c) generally to inquire and adjudicate upon any matter which is required or permitted to be referred to it under any provision of this Act or any other law.
- (3) Without derogating from the generality of subsection (2) -
  - (a) any decision taken by the Registrar under this Act, including in regard to the grant of a patent or a utility model certificate or a registration of an industrial design or of a trade mark or a certification trade mark or a collective trade mark, or in regard to the rejection of an application for such a grant or registration, may be the subject of an appeal to the Tribunal by an interested party in the matter before the Registrar, and such appeal must be filed and prosecuted as prescribed; and
  - (b) any change or amendment or correction of any document forming part of an application or of a patent or a utility model or an industrial design registration or a trade mark registration or the registration of a certification or collective trade mark may, on application by an interested party to the Tribunal, be set aside by the Tribunal if such change or amendment or correction does not comply with the provisions of this Act.
- (4) The Tribunal has, in connection with any proceedings before it, all such powers and jurisdiction as are possessed by a single judge of the court in a civil matter before the court.
- (5) Any decision, order or determination of the Tribunal may be executed as if it were a decision, order or a determination made by the court.

- (6) An appeal against any decision by the Tribunal lies to the court.

### **221. References to Tribunal by Registrar**

- (1) When any matter to be decided by the Registrar under this Act appears to him or her to involve a point of law or to be of unusual importance or complexity, he or she may, after giving notice to the parties, refer such matter to the Tribunal for a decision and must thereafter, in relation to such matter, act in accordance with the decision of the Tribunal or any decision substituted therefor on appeal to the Tribunal.
- (2) Where any matter has been referred to the Tribunal in terms of subsection (1), the Registrar and the parties are entitled to be heard by the Tribunal before any decision is made in such matter and may appear or be represented as provided for in section 218.

### **222. General powers of Tribunal**

- (1) In any appeal to the Tribunal under section 220, the Tribunal may -
- (a) accept evidence by affidavit or take oral evidence on oath or affirmation;
  - (b) allow any witness to be cross-examined on his or her affidavit or oral evidence;
  - (c) confirm, set aside or vary the order or decision in question;
  - (d) exercise any of the powers which could have been exercised by the Registrar in proceedings in connection with which the appeal is brought; and
  - (e) make such order as to costs as it may deem fit.
- (2) The Tribunal must, in any proceedings before it in terms of this section, record the proceedings and any evidence heard by it and the decision made by it and the reasons therefor.

### **223. Proceedings of Tribunal**

- (1) Proceedings before the Tribunal must be conducted in accordance with the rules of the Tribunal prescribed by the Rules Board referred to in section 227.
- (2) The Tribunal is not be bound by the rules of evidence applicable in civil proceedings.

*[The word "be" is superfluous.]*

### **224. Summoning of witnesses**

- (1) A party to any proceedings before the Tribunal, may procure the attendance of any witness in the manner provided for in the rules of the Tribunal.
- (2) Any member of the Tribunal and any sitting person as an assessor in any proceedings before the Tribunal may put any question to any witness appearing before it.
- (3) If any person who has been duly subpoenaed to attend any proceedings before the Tribunal for the purpose of giving evidence or producing any book, record, document or thing in his or her possession or under his or her control, fails without reasonable cause to attend or to give evidence or to produce that book, record, document or thing according to the subpoena or, unless excused by the Tribunal, to remain in attendance throughout the proceedings, the Tribunal may, on being satisfied upon oath or affirmation or by return of the person by whom the subpoena was served, that such person has been duly subpoenaed and that his or her reasonable expenses have been paid or offered to him or her, impose upon the said person a fine not exceeding N\$5 000, or in default of payment, imprisonment for a term not exceeding 12 months or both such fine and imprisonment.

### **225. Costs**

The Tribunal may in any proceedings before it make an order as to costs as it thinks fit.

## 226. Contempt of Tribunal

A person who -

- (a) insults, disparages or belittles any member of the Tribunal in that capacity, or prejudices, influences or anticipates the proceedings or findings of the Tribunal;
- (b) wilfully interrupts the proceedings of the Tribunal or misconducts himself or herself in any manner during such proceedings;
- (c) does anything in relation to the Tribunal which if done in relation to a court of law would have constituted contempt of court,

commits an offence and on conviction is liable to a fine not exceeding N\$5 000 or to imprisonment for a term not exceeding 12 months or to both such fine and such imprisonment.

## 227. Rules of Tribunal

- (1) There is established the Industrial Property Tribunal Rules Board ("the Rules Board") which consists of -
  - (a) the judge-president of the court or any judge of that court designated from time to time by the judge-president, who is the chairperson of the Rules Board;
  - (b) one practising legal practitioner nominated by the Law Society of Namibia;
  - (c) one legal practitioner serving in the Ministry responsible for justice designated by the Minister responsible for justice; and
  - (d) one staff member serving in the Ministry designated by the Minister.
- (2) The Rules Board may make rules in relation to -
  - (a) the conduct of the proceedings of the Tribunal;
  - (b) the manner in which any matter to be heard and determined by the Tribunal may be brought and continued before it;
  - (c) the tariff of fees chargeable by agents;
  - (d) the fees payable in respect of the service or execution of any process of the Tribunal and the tariff of costs and expenses which may be allowed in respect of such service or execution;
  - (e) the taxation of bills of costs;
  - (f) the hours during which the office of the secretary of the Tribunal is open for the transaction of business;
  - (g) the period within which and the manner in which an appeal from a decision of the Tribunal to the court may be noted;
  - (h) the fees to be paid to assessors; and
  - (i) generally, any matter which may be necessary or expedient to prescribe in order to ensure the proper dispatch and conduct of the proceedings of the Tribunal.
- (3) Rules made in terms of subsection (2) may provide for the summary determination of any appeal which appears to the Tribunal to be frivolous or vexatious or brought for the purpose of delay.
- (4) No rule made by the Rules Board under subsection (2) is of any force and effect unless it is published in the Gazette by the chairperson of the Rules Board.

## 228. Appeals to Court

- (1) In addition to any right of appeal specifically conferred in respect of proceedings under this Act, any party to any proceedings before the Tribunal may appeal against any decision, order or determination, given by the Tribunal as if it were a judgment or an order given in civil proceedings by a magistrates' court being appealed against to the court.
- (2) In addition to any other powers conferred upon it by this Act, the court may in relation to such appeal -
  - (a) confirm, vary or reverse the order or decision appealed against, as justice may require;
  - (b) if the record does not furnish sufficient evidence or information for the determination of the appeal, remit the matter to the Registrar, Board or Tribunal with instructions in regard to the taking of further evidence or the setting out of further information;
  - (c) order the parties or either of them to produce at some convenient time in the court of appeal such further proof as to it deems necessary or desirable;  
*[The word "to" in the phrase "as to it deems necessary" is superfluous.]*
  - (d) take any other course which may lead to the just, speedy and effective settlement of the case; and
  - (e) make such order as to costs as justice may require.
- (3) Every appeal to the court must be noted and prosecuted in the manner prescribed by law for appeals to it against a judgment, order or decision of a magistrates' court.

## 229. Expenses of Tribunal

The expenditure incidental to the performance of functions of the Tribunal must be defrayed from the money appropriated by Parliament and made available to the Ministry responsible for trade and industry for the purposes of the Tribunal.

## Part 4 – Offences and penalties

### 230. Falsification of documents

Any person who -

- (a) makes or causes to be made a false entry in the register;
- (b) makes or causes to be made a document falsely purporting to be a copy of an entry in the register; or
- (c) produces or tenders or causes to be produced or tendered as evidence any such false entry or copy thereof, knowing it to be false, commits an offence and on conviction is liable to a fine not exceeding N\$5 000 or to imprisonment for a period not exceeding 12 months or to both such fine and imprisonment.

### 231. Falsely representing industrial property rights

(1) Any person who -

- (a) falsely represents that any article is a patented article or that there is a registered design in respect of the article; or
- (b) represents that any article is the subject of a patent application or a design application, knowing that no such application has been made or that an application made in respect thereof has been refused or withdrawn or has lapsed,

commits an offence and on conviction is liable to a fine not exceeding N\$5 000 or to imprisonment for a period not exceeding 12 months or to both such fine and imprisonment.

- (2) If any person disposes of any article on which is stamped, engraved or impressed or to which is otherwise applied -
- (a) the word 'patent', 'patented' or any other word expressing or implying that the article is patented or is the subject of a patent application; or
  - (b) the word 'design' or 'registered design' or any other word expressing or implying that there is a registered design in respect of the article or that the article is the subject of a design application; or
  - (c) any marking is applied in any manner expressing or implying that the article is patented or the subject of a design registration,

he or she is deemed for the purposes of this section to represent that the article is a patented article or is subject to a design registration.

*[The Government Gazette uses single quotation marks in paragraphs (a) and (b), as reproduced above. Analogous sections of this Act, such as section 232, use double quotation marks.]*

- (3) 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;
  - (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;
  - (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 in the register, the registration does not give that right,

commits an offence and on conviction is liable to a fine not exceeding N\$5 000 or to imprisonment for a period not exceeding 12 months or to both such fine and imprisonment.

- (4) For the purposes of subsection (3), the use in Namibia in relation to a trade mark of the word 'registered' or of any abbreviation thereof or of any other word or letter which might reasonably be construed as referring to registration, including the symbol R, is deemed to import a reference to registration in the register except where the word, abbreviation, letter or symbol is used in relation to a mark registered as a trade mark under the laws of a country outside Namibia and in relation to goods to be exported to that country.

*[The reference to the symbol "R" was possibly meant to be "®".]*

- (5) The provisions of this section do not apply to a person who disposes of articles in good faith in the ordinary course of trade and, when called upon to do so, discloses the identity of the person from whom he or she acquired the article in question.
- (6) Any person who is of the opinion that he or she is prejudiced by a representation referred to in subsection (1) or (3) may apply to the Tribunal for an interdict against the continuation of that representation.

### **232. Improper use of words "industrial property office"**

Any person who uses on his or her place of business or on any document issued by him or her or otherwise the words "industrial property office", "patent office", "design office" or "trade mark office" or any other words suggesting that his or her place of business is, or is officially connected with, the Registration Office, commits an offence and on conviction is liable to a fine not exceeding N\$5 000 or to imprisonment for a period not exceeding 12 months or to both such fine and imprisonment.

### **233. Deceiving staff members**

Any person who -

- (a) for the purpose of deceiving the Registrar or the Tribunal or any staff member or staff member in the administration of the provisions of this Act; or

*[Act 8 of 2016 makes a global substitution of “staff member” for “official”; the result in paragraph (a) is a redundant phrase.]*

- (b) for the purpose of procuring or influencing the doing or omission of anything in relation to this Act or any matter thereunder,

makes a false statement or representation knowing the same to be false, commits an offence and on conviction is liable to a fine not exceeding N\$5 000 or to imprisonment for a period not exceeding 12 months or to both such fine and imprisonment.

## Part 5 – General

### 234. Application of international conventions

- (1) For purposes of this Part, the term “international convention” means any one of the following international or regional instruments, namely -
- (a) African Regional Intellectual Property Organisation (ARIPO) and the Banjul Protocol and Harare Protocol adopted by ARIPO;
  - (b) Locarno Agreement on the International Classification for Industrial Designs;
  - (c) Nice Agreement on the International Classification of Goods and Services;
  - (d) Madrid Agreement Concerning the International Registration of Marks and the Madrid Protocol adopted under that Agreement;
  - (e) Paris Convention for the Protection of Industrial Property;
  - (f) Patent Co-operation Treaty;
  - (g) the Hague Agreement Concerning the International Deposit of Industrial Designs; and
  - (h) any international agreement or convention which the Minister by notice in the Gazette declares, subject to Article 63(2)(e) of the Namibian Constitution, to be an international convention for the purposes of this Act.
- (2) In applying the provisions of this Act, the version of any international convention which is applicable for the purposes of this Act is that version of such convention and of any regulations issued thereunder which is in operation at the date of the commencement of this Act as contemplated in section 242.
- (3) If any international convention or any regulations issued under an international convention to which Namibia is party is amended the Minister may, subject to Article 63(2)(e) of the Namibian Constitution and taking into account the / advice of the Registrar, decide if such amendment is to be applicable for the purposes of this Act, and issue such regulations or notices as appear to him or her necessary for carrying out and for giving effect to any of the provisions of the amendment.’-
- [There are several superfluous symbols in subsection (3): “/” and “’-”. ]*
- (4) If Namibia subsequently becomes party to any other international or regional instruments, the Minister may, by way of the amendment of this Act or the regulations or notices issued thereunder, whichever is appropriate, implement the provisions of such instrument.

### 235. Hypothecation and attachment

- (1) A registered industrial property title under this Act may be hypothecated by a deed of security.
- (2) If a deed of security is lodged with the Registrar in the prescribed manner, the Registrar must endorse the

register to that effect.

- (3) Such endorsement must record the name and address of the person in whose favour the deed of security has been granted and the nature and duration thereof.
- (4) A deed of security in respect of which an endorsement has been made in accordance with the provisions of subsection (2) has the effect of a pledge of the title concerned to the person or persons in whose favour the deed of security has been granted.
- (5) An assignment or transmission of a registered title in respect of which a deed of security has been endorsed in terms of subsection (2) may not, without the written consent of the person in whose favour the deed of security has been granted, be recorded in the register by the Registrar.
- (6) Where the debt or obligation secured by a deed of security in respect of which the register has been endorsed in terms of subsection (2) has been discharged, any person may apply to the Registrar in the prescribed manner for the removal from the register of any endorsement in relation thereto made under subsection (2).
- (7) A registered industrial property title under this Act may be attached to found or confirm jurisdiction for the purposes of any proceedings before the Tribunal or a court of Namibia and may be attached and sold in execution pursuant to an order of the Tribunal or any such court.

## 236. Regulations

- (1) The Minister may make regulations -
  - (a) prescribing the functions and operations of the Registration Office, including the provision of information and other services to be provided by such office, as contemplated in sections 2 and 3;
  - (b) prescribing the procedure for consulting and obtaining extracts from registers referred to in section 7(1) and (2);
  - (c) prescribing fees for the grant of patents and utility model certificates, and the registration of industrial designs, trade marks including certification trade marks and collective trade marks, as well as fees for copies thereof and any related matters;
  - (d) prescribing the information required to be published in terms of section 9;
  - (e) relating to the processing and examination of patents, utility models, industrial designs, trade marks including certification trade marks and collective trade marks as well as trade names;
  - (f) designating and appointing an external search and examination authority as contemplated in section 37;
  - (g) relating to the filing and prosecution of appeals under this Act;
  - (h) prescribing any time limits referred to in this Act;
  - (i) prescribing provisions concerning the processing of international applications under this Act and related matters;
  - (j) prescribing the surcharge payable in respect of the late payment of any renewal fees;
  - (k) prescribing the period within which to oppose the registration of a trade mark and the manner in which this may be done in terms of section 147;
  - (l) prescribing the manner in which and the procedure by which the restoration of a patent, design or trade mark or the amendment of a patent, design or trade mark may be opposed as provided for in this Act;
  - (m) prescribing the manner of giving notice of, or applying for, the surrender or the invalidation of a patent or design in terms of sections 64 or 65 and 120 or 121 respectively;

- (n) prescribing the procedure for and evidence to be submitted to remove or invalidate the registration of a trade mark in terms of sections 178 and 179 respectively;
  - (o) prescribing the manner in which a request is to be made and the fee payable, to correct an error or rectify the register in terms of sections 209 and 210;
  - (p) prescribing the qualification which is to be recognised as a suitable qualification to enable a person to act as an agent as contemplated in section 212(2)(b);
  - (q) prescribing the examination to be passed to enable a person to qualify as an agent as contemplated in section 212(2)(c);
  - (r) prescribing the terms and conditions of persons to be appointed as members of the Tribunal in terms of section 215(2), including the remuneration to be paid, the termination of such appointments and the filling of vacancies;
  - (s) prescribing the oath or affirmation as contemplated in section 216(1);
  - (t) prescribing the terms and conditions applicable to the appointment of assessors as contemplated in section 218;
  - (u) prescribing the terms and conditions applicable to the appointment of members of the Rules Board as contemplated in section 227;
  - (v) regarding any matter which is required or permitted to be prescribed in terms of this Act; and
  - (w) generally, regarding any matter in respect of which the Minister considers it necessary or expedient to make regulations in order to achieve the object of this Act.
- (2) A regulation made under subsection (1) may prescribe a penalty, not exceeding a fine of N\$5 000 or imprisonment for a period not exceeding 12 months or both such fine and imprisonment, for any contravention or failure to comply with the provisions thereof.
- (3) Where any regulation made under this section involves State expenditure that regulation must be made with the concurrence of the Minister responsible for finance.

### **237. Administrative instructions**

- (1) The Registrar may issue administrative instructions relating to the procedure for the grant of industrial property rights and the administration of granted rights as well as other functions of the Registration Office.
- (2) If there is a conflict between the provisions of this Act or of the regulations made under this Act and the provisions of the administrative instructions, the provisions of this Act and the regulations prevail.

### **238. Application of Act**

- (1) Subject to the provisions of section 240, this Act applies to all patents, utility models, industrial designs and trade marks, including collective and certification trade marks, registered or deemed to be registered under the laws repealed by section 239.
- (2) Any proceedings done or commenced under the laws repealed by section 239 and in force or still pending immediately prior to the coming into force of this Act do, so far as it is not inconsistent with the provisions of this Act, continue to be in force and continue to be dealt with in terms of the repealed laws as if done under this Act.
- (3) Once such proceeding has been concluded, its outcome and effect will be as provided in this Act in respect of any similar proceedings.

### **238A. Fees**



Any fees and other money payable in terms of this Act are for the account of BIPA and any outstanding fees or any other money due and payable to BIPA are debt due to and recoverable by BIPA in any competent court.

*[section 238A inserted by Act 8 of 2016]*

### 239. Repeals

The Patents, Designs, Trade Marks and Copyright Act, 1916 (Act No. 9 of 1916) and any amendments thereto insofar as they are applicable to Namibia, the Patents, Designs and Trade Marks Proclamation, 1923 (Proclamation No. 17 of 1923), the Patents, Trade Marks and Copyright Proclamation, 1940 (Proclamation No. 33 of 1940) and the Trade Marks in South West Africa Act, 1973 (Act No. 48 of 1973) are repealed.

*[The name of Proclamation 17 of 1923 in section 239 is incorrect. This Proclamation was originally called the “Patents, Designs, Trade Marks and Copyright Proclamation”. Section 48(6) of the South African Copyright Act 63 of 1965, which was expressly made applicable to South West Africa, amended the name to “Patents, Designs and Trade Marks Proclamation”. Section 83(2) of the Trade Marks in South West Africa Act 48 of 1973 amended the name to “Patents and Designs Proclamation”.]*

### 240. Transitional and savings provisions

- (1) Despite the repeal of the laws referred to in section 239, patents granted and designs and trade marks including collective and certification trade marks, registered under the repealed laws remain in force but are, subject to subsections (2) and (3), deemed to have been granted and registered under this Act.
- (2) Patents thus granted and industrial designs thus registered remain in force for the unexpired portion of the period of protection provided for under the relevant repealed laws subject to the payment of the prescribed renewal fees, and may not be revoked or invalidated except upon any ground on which such patents or design registrations could have been revoked or invalidated in terms of the relevant repealed laws.
- (3) Trade marks, including collective and certification trade marks, registered under the repealed law relating to trade marks, will be due for renewal within the same period as under the repealed law or 10 years from the entry into force of this Act, whichever period first expires.
- (4) On renewal under subsection (3), the owner of the trade mark registration must classify the trade mark in accordance with the International Classification of Goods and Services or the prescribed classification of goods or services.
- (5) A trade mark registration as contemplated in subsections (3) and (4) may not be invalidated or removed except upon any ground on which such registration could have been invalidated in terms of the relevant repealed laws, except that such trade mark registration can be removed in terms of section 176 or 177, and a disclaimer or endorsement in respect of such trade mark registration may be required in terms of section 136.
- (6) A trade mark which has been validly registered in terms of the provisions of section 53 of the repealed Act must, from the date of commencement of this Act, be deemed to be a trade mark registered in terms of this Act, but may not be removed from the register in terms of the provisions of section 137(h) or of section 176 within a period of 10 years from the date of commencement of this Act.

### 241. Short title and commencement

- (1) This Act is called the Industrial Property Act, 2012 and comes into operation on a date determined by the Minister by notice in the Gazette.
- (2) Different dates may be determined under subsection (1) in respect of different provisions of this Act.
- (3) Any reference in any provision of this Act to the commencement of this Act must be construed as a reference to the date determined under subsection (1w) in relation to that particular provision.

*[The reference to subsection (1w) should refer to subsection (1).]*