

Statutory Instrument No. 69 of 2012

INDUSTRIAL PROPERTY ACT
(Act No. 8 of 2010)

INDUSTRIAL PROPERTY ACT (DATE OF COMMENCEMENT) ORDER, 2012
(Published on 31st August, 2012)

ARRANGEMENT OF PARAGRAPHS

PARAGRAPH

1. Citation
2. Commencement of Act No. 8 of 2010

IN EXERCISE of the powers conferred on the Minister of Trade and Industry by section 1 of the Industrial Property Act, 2010, the following Order is hereby made —

1. This Order may be cited as the Industrial Property Act (Date of Citation Commencement) Order, 2012.
2. The 31st August, 2012 is hereby appointed as the date on which the Commencement of Act No. 8 of 2010 Industrial Property Act, 2010, shall come into operation —

MADE this 27th day of July, 2012.

DORCAS MAKGATO-MALESU,
Minister of Trade and Industry.

C.700

Statutory Instrument No. 70 of 2012

INDUSTRIAL PROPERTY ACT, 2010
(Act No. 8 of 2010)

INDUSTRIAL PROPERTY REGULATIONS, 2012
(Published on 31st August, 2012)

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IN EXERCISE of the powers conferred on the Minister of Trade and Industry by section 137 of the Industrial Property Act, 2010, the following Regulations are hereby made —

PART I — Preliminary

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|----------------|--|
| Citation | 1. These Regulations may be cited as the Industrial Property Regulations, 2012. |
| Interpretation | 2. (1) In these Regulations, unless the context otherwise requires —
“abstract” means a concise summary of the technical disclosure of a patent document enabling a reader to quickly ascertain the subject matter covered;
“claim” means a part of a patent document which defines the matter for which protection is sought;
“description” means the technical field to which an invention relates, and includes a brief summary of the technical background of the invention and shall indicate at least one mode known in which the invention can be performed; and
“drawings” means the aid necessary for the understanding of an invention. |

PART II — Applications and Procedure for Grant of Patents

- | | |
|-------------------------------------|---|
| Application for a patent | 3. Subject to section 12 of the Act, an application for a patent shall —
(a) be made in Form 1 set out in the First Schedule; and
(b) be accompanied by —
(i) a fee set out in the Second Schedule,
(ii) a statement, where the applicant is the inventor, and
(iii) a statement justifying the applicant’s right to the patent, where the applicant is not the inventor. |
| Marking of application for a patent | 4. (1) Upon receipt of an application under regulation 3, the Registrar shall mark, on each document making up the application, the actual date of receipt and the application number consisting of the letters “BW”, slant, the letter “A”, slant, the four-digit numbers of the year in which the initial papers were received, slant, and a five-digit number allocated in the sequential order in which applications are received. |

(2) Where any corrections or other documents are later filed on different dates, the Registrar shall mark the actual dates of receipt for any documents which are later filed with him or her or for which any corrections were made in the appropriate place of the application for the grant of the patent.

(3) The application number allocated under subregulation (1) shall be quoted in all subsequent communications concerning the application.

5. (1) A description shall first state the title of the invention as it appears in the application for a patent and shall — Description

- (a) specify the technical field to which the invention relates;
- (b) indicate the background art which, as far as known to the applicant, can be regarded as useful for the understanding, searching and examination of the invention, and, where necessary, cite the documents reflecting such art;
- (c) disclose the invention in such terms that it can be understood and state its advantageous effects, if any, with reference to the background art;
- (d) briefly describe the figures in the drawings, if any;
- (e) set out, in terms of examples and with reference to drawings, where appropriate, at least one mode contemplated by the applicant for carrying out the invention; and
- (f) indicate explicitly, when it is not obvious from the description or nature of the invention, the way in which the invention is industrially applicable and the way in which it can be made or used.

(2) The manner and order specified in subregulation (1) shall be followed except where, because of the nature of the invention, a different manner or a different order would result in a better understanding and a more concise presentation.

6. (1) Where there are several claims forming part of an application for a patent, they shall be numbered consecutively in Arabic numerals. Claims

(2) One or more claims forming part of an application for a patent, shall be fully supported by the description and the drawings.

(3) Whenever appropriate, a claim shall contain —

- (a) a statement indicating those technical features of the invention which are necessary for the definition of the invention but which, in combination, are part of the prior art; and
- (b) a characterising portion, preceded by the words “characterised in that”, “characterised by”, “wherein the improvement comprises” or any other words to the same effect stating concisely the description which, in combination with the features stated under (a), it is desired to protect.

(4) Where the application for a patent contains drawings, the technical features mentioned in the claims shall, where necessary, be followed by the reference signs relating to such features; and where reference signs are used they shall be placed between parentheses.

(5) Where the inclusion of reference signs under subregulation (4) does not facilitate quicker understanding of a claim, such signs shall not be made.

(6) A claim submitted after the filing date of an application for a patent and which is not identified with the other claims previously filed in the application shall, at the choice of the applicant, be submitted either as an amended claim or as a new claim.

(7) A claim submitted after the filing date of an application for a patent shall not contain anything new or that was not disclosed before.

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Drawings

7. (1) Drawings forming part of an application for a patent shall —
- (a) be on sheets the usable surface area of which shall not exceed 26.2 cm by 17 cm;
 - (b) be on sheets which do not contain frames around the usable or used surface; and
 - (c) have minimum margins as follows —
 - (i) top 2.5 cm,
 - (ii) left side 2.5 cm
 - (iii) right side 1.5 cm, and
 - (iv) bottom 1.0 cm
- (2) Without derogating from subregulation (1), drawings forming part of an application for a patent shall be executed as follows —
- (a) without colouring in durable, black sufficiently dense and dark, uniformly thick and well-defined lines and strokes to permit satisfactory reproduction;
 - (b) cross-sections shall be indicated by hatching which does not impede the clear reading of the reference signs and leading lines;
 - (c) the scale of the drawings and the distinctness of their graphical execution shall be such that a photographic reproduction with a linear reduction in size to two-third of the size would enable all details to be distinguished without difficulty, and where, as an exception, the scale is given on a drawing it shall be represented graphically;
 - (d) all numbers, letters and reference signs appearing in the drawings shall be simple and clear, and brackets, circles and inverted commas shall not be used in association with numbers and letters;
 - (e) elements of the same figure shall be in proportion to each other, unless a difference in proportion is indispensable for the clarity of the figure;
 - (f) the height of the numbers and letters shall not be less than 0.32 cm and for the lettering of drawings, the Latin and, where customary, the Greek alphabets shall be used;
 - (g) the same sheet of drawings may contain several figures and where figures drawn on two or more sheets are intended to form one whole figure —
 - (i) the figures on the several sheets shall be arranged so that the whole figure can be assembled without concealing any part of the partial figures,
 - (ii) the different figures shall be arranged without wasting space, clearly separated from one another, and
 - (iii) the different figures shall be numbered consecutively in Arabic numerals, independently of the numbering of the sheets;
 - (h) reference signs not mentioned in the description or claims shall not appear in the drawings, and vice versa and the same features, when denoted by reference signs, shall, throughout the application, be denoted by the same signs;
 - (i) the drawings shall not contain textual matter, except, when required for the understanding of the drawings, a single word or words such as “water”, “steam”, “open”, “closed”, “section on AA” and, in the case of electric circuits and block schematic or flow sheet diagrams, a few short catchwords; and
 - (j) the sheets of the drawings shall be numbered in accordance with regulation 10 (9).

(3) Flow sheets and diagrams shall, for purposes of these Regulations, be considered to be drawings.

8. (1) An abstract forming part of an application for a patent shall be so drafted that it can efficiently serve as a scanning tool for purposes of searching in the particular art. Abstract

(2) An abstract shall —

- (a) have a summary of the disclosure as contained in the description, the claim and any drawings indicating the technical field to which the invention pertains;
- (b) be drafted in a way that merely serves as a source of technical information; and
- (c) where applicable, contain the chemical formula which, among all the formulae contained in the application, best characterises the invention.

(3) An abstract shall be as concise as the disclosure permits, containing not less than 50 but not more than 150 words.

(4) An abstract shall not contain statements on the presumed merits or value of the invention or on its speculative application.

(5) Each main technical feature mentioned in the abstract and illustrated by a drawing in the application shall be followed by a reference sign, placed between parentheses.

9. (1) In an application for a patent, the following shall be used — Measures,
terminology
and signs

- (a) units of weights and measures in terms of the metric system;
- (b) temperatures in degrees celsius; and
- (c) density in metric units.

(2) For indications of heat, energy, light, sound, and magnetism, as well as for mathematical formulae and electrical units, rules in general use shall be observed; and for chemical formulae, the symbols, atomic weights, and molecular formulae, in general use, shall be observed.

(3) In general, only such technical terms, signs and symbols as are generally accepted in the art shall be used.

(4) The terminology and the signs shall be consistent throughout the application.

10. (1) Three copies, or such number as the Registrar may require, of the application for a patent and any accompanying statements or documents, shall be filed. Number of
copies and
physical
requirements

(2) All elements of an application for a patent shall be so presented so as to enable direct reproduction by photography, electrostatic processes, photo offset and microfilming.

(3) Only one side of each sheet contained in an application shall be used.

(4) All elements of an application for a patent shall be on paper which is flexible, strong, white, smooth, non-shiny and durable.

(5) The size of the sheets shall be A4 (29.7 cm x 21 cm), or such other size as the Registrar may determine.

(6) The minimum margins of sheets shall be as follows —

- (a) upper margin of each page, except the first page: 20 mm;
- (b) upper margin of the first page: 30 mm;
- (c) side margin adjacent to the binding: 25 mm;
- (d) other side margin: 20 mm; and
- (e) bottom margin: 20 mm.

(7) All sheets shall be numbered at the top of the sheet, in the middle, in consecutive Arabic numerals.

(8) In effecting the sequential numbering of the sheets, the elements of an application for a patent shall be placed in the following order —

- (a) a request;
- (b) a description;
- (c) one or more claims;
- (d) drawings; and
- (e) an abstract.

(9) The sequential numbering of the sheets shall be effected by using the following three separate series of numbering —

- (a) the first series applying to the application only and commencing with the first sheet of the application;
- (b) the second series commencing with the first sheet of the description and continuing through the claims until the last sheet of the abstract,
- (c) and the third series being applicable to the sheets of the drawings only and commencing with the first sheet of the drawings.

(10) The text matter of the application shall be typed in black, except for the graphic symbols, chemical or mathematical formulae and certain characters which may be handwritten or drawn.

Declaration of
priority and
translation of
earlier
application

11. (1) Where priority is claimed in an application for a patent, a declaration in terms of section 17 (1) of the Act, shall provide —

- (a) a certified copy of the application earlier filed;
- (b) the date of filing of the earlier application;
- (c) the symbol of the International Patent Classification which has been allocated to the earlier application, subject to subregulation (3);
- (d) the country in which the earlier application was filed or, where the earlier application is a regional or an international application, the country or countries for which it was filed; and
- (e) where the earlier application is a regional or an international application, the office with which it was filed.

(2) Where at the time of filing the declaration referred to in subregulation (1), a copy of the application earlier filed is not found, that copy shall be furnished within three months from the date on which the application containing the declaration was filed:

Provided that the Registrar may extend the time limit referred to in this subregulation for an additional period of three months, if the applicant supplies evidence that, due to circumstances beyond the applicant control, the applicant was not able to comply with the prescribed time limit.

(3) Where a symbol of the International Patent Classification has not been allocated to the earlier application, or had not yet been allocated at the time of filing the declaration referred to in subregulation (1), the applicant shall state this fact in the said declaration and shall communicate such symbol as soon as it has been allocated.

(4) The period for furnishing the certified copy of the earlier application under section 17 (2) of the Act, shall be three months from the date of filing the application, and where a copy has already been furnished for another application, the applicant may respond by making a reference to that other application.

(5) Where the earlier application is in a language other than English, the applicant shall, within two months from the date of the aforementioned request, furnish an English translation of the earlier application.

12. (1) The time limits to be specified for furnishing the information requested by the Registrar under section 19 (2) of the Act, shall not be less than two but not more than six months from the date a request is made.

(2) Where the applicant is unable to submit the information requested under section 19 of the Act, the Registrar may suspend the procedure for the examination of the application until such time as the documents are furnished.

13. (1) An application for a patent shall be withdrawn by written declaration submitted to the Registrar and signed by each applicant or an agent.

(2) The application and publication fee shall not be refunded if the application is withdrawn.

(3) Any amendment in terms of section 13 (2) of the Act shall be subjected to the payment of the fee set out in the Second Schedule.

14. (1) The Registrar shall request the applicant to supply any missing information under section 20 (3) of the Act, within two months from the date of the request, together with the payment of the fee set out in the Second Schedule.

(2) Where in terms of section 20 (5) of the Act, a request is made to an applicant to furnish any missing part or drawings to the Registrar, such information shall be furnished within two months.

(3) Where in terms of section 23 (2) of the Act, there is any requirement or observation that is missing from a patent application, the Registrar shall notify the applicant in writing, inviting him or her to comply with the missing requirement or to submit any observation within three months from the date of notification by the Registrar.

15. (1) Subject to section 21 of the Act, an application for a patent shall be published in the Journal in Form 2 set out in the First Schedule upon the request of the applicant.

(2) The applicant shall pay the fee set out in the Second Schedule to the Registrar for publication of his or her application in the Journal.

16. (1) Where the Registrar grants a patent in terms of section 23 (3) of the Act, he or she shall issue a certificate of the patent in Form 3 set out in the First Schedule and a copy of the patent in Form 4 set out in the First Schedule.

(2) The Registrar shall allot to each patent granted, a publication number of the patent in the sequential order of grant.

(3) The Registrar shall, upon payment of the fee set out in the Second Schedule, make a copy of the patent to any person who requests such copy in terms of section 23 (4) of the Act.

(4) The publication of the reference to the grant of the patent in terms of section 23 (3) (c) of the Act, shall include —

- (a) the number of the patent;
- (b) the name and address of the owner of the patent;
- (c) the name and address of the inventor, except where he or she has asked not to be named in the patent;
- (d) the name and address of the agent, if any;
- (e) the filing date;

Time for
furnishing
information
on foreign
applications

Withdrawal
and
amendment of
application

Accordinging and
notifying filing
date

Publication of
the patent
application

Grant of patent,
publication of
reference and
issuance of
certificate

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- (f) if priority has been claimed and the claim has been accepted, a reference to the declaration of priority, the priority date and the name of the country or countries in which or for which the earlier application was filed;
- (g) the effective date of grant of the patent;
- (h) the title of the invention;
- (i) the abstract;
- (j) the most illustrative of the drawings, if any; and
- (k) the symbol of the International Patent Classification.
- 17.** (1) Subject to section 28 (2) of the Act, a patentee shall pay the fee set out in the Second Schedule, which shall be the annual maintenance fees.
- (2) The Registrar shall record and publish a notification of the lapse of a patent.
- (3) A patentee who is late in paying the annual maintenance fees shall pay a surcharge fee set out in the Second Schedule on condition that he or she shall pay the full annual maintenance fees within six months from the date of payment of the surcharge.
- 18.** (1) The Registrar shall record and publish, by notice in the *Gazette*, the decision of the Minister to authorise a government agency, other person or body to exploit a patented invention in the public interest.
- (2) If the decision of the Minister is the subject of an appeal, the Registrar of the High Court shall notify the Registrar of the Court's decision once it becomes final, and the Registrar shall record the decision and publish it by notice in the *Gazette*.
- 19.** (1) A request for a compulsory licence under section 33 (4) of the Act, shall be made in Form 5 set out in the First Schedule and accompanied by the fee set out in the Second Schedule.
- (2) The Master of the High Court shall notify the Registrar of the Court's decision regarding any application for the grant of a compulsory licence, as provided for under section 33 (3) of the Act, once the decision becomes final, and the Registrar shall record the decision in the journal and cause it to be published in the *Gazette*.
- 20.** (1) Where the provisions of section 36 (1) of the Act apply only to some of the claims or some parts of the claims, such claim or parts of a claim shall be invalidated.
- (2) The patent owner shall, in writing, notify any licensee of any court proceedings instituted for the invalidation of the patent.
- (3) The person requesting invalidation shall notify any beneficiaries of compulsory licences granted under sections 31 to 34 of the Act.
- (4) Where the ground of invalidity invoked under subregulation (3) is that the patent owner is not the inventor or his or her successor in title, the person alleged to have the right to the patent shall also be informed.

PART III — *Utility Model Certificates*

- 21.** (1) Any applicant who wishes to convert a patent application into an application for utility model certificate in terms of section 18 of the Act shall pay the fee set out in the Second Schedule.
- (2) The Registrar shall, within two months of the receipt of the request to convert, notify the applicant of his or her decision, in writing, and, where the Registrar refuses the request, he or she shall state the reasons for such refusal.

(3) Where the Registrar grants a utility model certificate in terms of section 42 of the Act, he or she shall issue a copy of a utility model certificate in Form 6 set out in the First Schedule.

22. (1) Upon receipt of an application made under regulation 21, the Registrar shall mark, on each document making up the application, the actual date of receipt and the application number consisting of the letters "BW", slant, the letter "U", slant, the four-digit numbers of the year in which the initial papers were received, slant, and a five-digit number allocated in the sequential order in which applications are received.

Marking of application for utility model certificate

(2) Where any corrections or other documents are later filed on different dates, the Registrar shall mark the actual dates of receipt for any documents which are later filed with him or her or for which any corrections were made in the appropriate place of the application for utility model certificate.

(3) The application number allocated under subregulation (1) shall be quoted in all subsequent communications concerning the application.

PART V — *Industrial Designs*

23. (1) Subject to section 46 of the Act, an application for the registration of an industrial design shall —

Application for registration of an industrial design

- (a) indicate the applicant's name, address, nationality and residence;
- (b) be made in Form 7 set out in the First Schedule;
- (c) be signed by the applicant or applicants; and
- (d) be accompanied by the fee set out in the Second Schedule.

(2) Where the applicant is the creator, the request shall contain a statement to that effect, and, where the applicant is not the creator, it shall indicate the creator's name and address and be accompanied by the statement justifying the applicant's right to the registration of the industrial design.

(3) If the applicant is represented by an agent, the request shall indicate so and state the agent's name and address.

(4) An application for the registration of a design under section 46 (4) of the Act shall be limited to one hundred (100) designs in one application.

24. (1) The application for the registration of an industrial design shall be accompanied by the following —

Number and size of representations and specimen

- (a) four graphic representations or four drawings or tracings, if the industrial design is two-dimensional; or
- (b) four graphic representations or four drawings or tracings of each of the different sides of the industrial design, if the industrial design is three-dimensional.

(2) A specimen forming part of the application for the registration of an industrial design referred to in subregulation (1) shall be of a size not exceeding 20 cm x 20 cm x 20 cm.

(3) A graphic representation, drawing or tracing of the industrial design shall not exceed 10 cm x 20 cm, and such representations, drawings or tracings shall be affixed on four sheets of cardboard of A4 size.

(4) Drawings and tracings forming part of the application for the registration of an industrial design referred to in subregulation (1) shall be in black ink.

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Marking of application for registration of an industrial design

25. (1) Upon receipt of an application made under regulation 23, the Registrar shall mark, on each document making up the application for the registration of a design, the actual date of receipt and the application number consisting of the letters “BW”, slant, the letter “F”, slant, the four-digit numbers of the year in which the initial papers were received, slant, and a five-digit number allocated in the sequential order in which applications are received.

(2) Where any corrections or other documents are later filed on different dates, the Registrar shall mark the actual dates of receipt for any documents which are later filed with him or her or for which any corrections were made in the appropriate place of the application for the registration of a design.

(3) The application number allocated under subregulation (1) shall be quoted in all subsequent communications concerning the application.

Registration of an industrial design

26. (1) Subject to section 50 of the Act, the Registrar shall issue a certificate of registration of the design in Form 8 set out in the First Schedule.

(2) The Registrar shall allocate to each industrial design he or she registers the same number as the number allocated under regulation 25.

(3) The registration of an industrial design shall include a representation of the industrial design and shall specify —

- (a) the number of the industrial design;
- (b) the name and address of the registered owner;
- (c) the name and address of the agent, if any;
- (d) the name and address of the creator, except where he or she has asked not to be named in the registration;
- (e) if the priority has been claimed, and the claim has been accepted, the priority date and the country or countries in which or for which the earlier application was filed; and
- (f) the kind of products for which the industrial design is to be used.

(4) The publication of the reference to the registration of an industrial design, under section 50 (2) (c) of the Act, shall contain the particulars specified in subregulation (3).

Refusal for registration of an industrial design

27. (1) The Registrar shall notify the applicant, in writing, of his or her decision to register or to refuse the application, and, in the case of a decision to grant the application, the Registrar shall request the applicant to pay the registration and publication fee set out in the Second Schedule within one month from the date of the notification.

(2) Refusal of an application by the Registrar shall not affect its filing date which shall remain valid.

Renewal of registration of an industrial design

28. (1) The renewal of the registration of an industrial design under section 56 (1) shall be made by the registered owner or his or her agent during the six months period preceding the expiry of the registration.

(2) The renewal of the registration of an industrial design shall be subject to the payment of the fee set out in the Second Schedule within the period specified in subregulation (1) or, upon payment of the surcharge fee set out in the Second Schedule, within the grace period allowed under section 56 (2) of the Act.

(3) The renewal of registration of an industrial design shall be recorded in the register and shall be published.

(4) The Registrar shall mark the original certificate as renewed and provide the next date of expiry in accordance with section 56 (1) of the Act.

29. (1) Any person who wishes to inspect the representations, drawings and specimens of a registered design in terms of section 58 of the Act, shall pay the fee set out in Second Schedule.

Inspection
of registered
design

(2) Any person who wishes to make a copy of the representations, drawings and specimens of a registered design or any other documents of a registered design shall pay the applicable fee set out in the Second Schedule.

PART V — *Layout Designs of Integrated Circuits*

30. Subject to section 66 of the Act, an application for the registration of a layout design shall —

Application
for registration
of a layout
design

- (a) be made in Form 9 set out in First Schedule;
- (b) be signed by the applicant or applicants; and
- (c) be accompanied by the fee set out in the Second Schedule.

31. (1) Upon receipt of an application for the registration of a layout design under regulation 30, the Registrar shall mark, on each document making up the application, the actual date of receipt and the application number consisting of the letters BW, slant, the letter L, slant, the four-digit numbers of the year in which the initial papers were received, slant, and a five-digit number allocated in the sequential order in which applications are received and where any corrections or other documents are later filed on different dates.

Marking of
application
for registration
of a layout
design

(2) The Registrar shall mark the actual dates of receipt for any documents which are later filed with him or her or for which any corrections were made in the appropriate place of the application for the grant of a layout design.

(3) The application number allocated under subregulation (1) shall be quoted in all subsequent communications concerning the application.

32. (1) A drawing forming part of the application for the registration of a layout design shall be of a size not exceeding 20 centimetres x 20 centimetres x 20 centimetres.

Size of draw-
ings and repre-
sentations

(2) A graphic representation, drawing of the layout design shall not exceed 10 centimetres x 20 centimetres, and such representations, drawings shall be affixed on four sheets of cardboard of A4 size.

(3) A drawing forming part of the application for the registration of a layout design shall be in black ink.

33. (1) Subject to subregulation (2), where the application meets all the requirements of section 66 of the Act, the Registrar shall register the layout design and issue to the applicant a certificate of registration in Form 10 set out in the First Schedule.

Registration of
layout design
and issuance
of
certificate

(2) The Registrar shall notify the applicant, in writing, of his or her decision to register the application and shall request the application to pay the registration and publication fee set out in the Second Schedule within one month from the date of notification.

(3) The Registrar shall allocate to each layout design he or she registers, the same number as the number allocated under regulation 31.

(4) The registration of a layout design shall include a representation of the layout design and shall specify —

- (a) the number of the layout design;
- (b) the name and address of the registered owner;
- (c) the name and address of the agent, if any;

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- (d) the name and address of the creator, except where he or she has asked not to be named in the registration; and
 - (e) the information defining the electronic function which the integrated circuit is intended to perform.
- (5) The publication of the reference to the registration of the layout design, under section 68 (2) (c) of the Act, shall contain the particulars specified in subregulation (4).

PART V — *Marks*

Application for registration of a mark

34. Subject to section 76 of the Act, an application for the registration of a mark shall —

- (a) be made in Form 11 set out in the First Schedule;
- (b) be in respect of goods or services listed in the applicable class or classes of the International Classification;
- (c) be contained in a durable graphic reproduction of the mark;
- (d) be accompanied by three additional reproductions of the mark, and the additional reproductions shall be identical to the mark on the applications and shall in all cases be noted with any such particulars, signed by the applicant or his or her authorised agent, as may be required by the Registrar; and
- (e) be accompanied by an application fee set out in the Second Schedule.

Marking of application for registration of a mark

35. (1) Upon receipt of an application for the registration of a mark made under regulation 34, the Registrar shall mark, on each document making up the application, the actual date of receipt and the application number consisting of the letters “BW”, slant, the letter “M”, slant, the four-digit numbers of the year in which the initial papers were received, slant, and a five-digit number allocated in the sequential order in which applications are received.

(2) Where any corrections or other documents are later filed on different dates, the Registrar shall mark the actual dates of receipt for any documents which are later filed with him or her or for which any corrections were made in the appropriate place of the application for the grant of a mark.

(3) The application number allocated under subregulation (1) shall be quoted in all subsequent communications concerning the application.

Reproduction of mark

36. (1) If the Registrar considers any reproduction of a mark unsuitable, he or she may, require a suitable reproduction to be substituted.

(2) Where a drawing or other reproduction cannot be given in the aforesaid manner, a specimen or copy of the mark may be sent either of full size or on a reduced scale and in such a form as the Registrar may consider appropriate.

Transliteration and translation of mark

37. Where a mark consists of or contains a word or words in characters other than Roman, the application, and the additional reproductions of the mark, shall be accompanied, unless the Registrar otherwise directs, by a sufficient transliteration and translation to the satisfaction of the Registrar.

Declaration of priority and translation of earlier application

38. (1) Where priority is claimed in an application for a registration of a mark, a declaration in terms of section 76 (2) of the Act, shall indicate —

- (a) a certified copy of the application earlier filed;
- (b) the date of the earlier application; and
- (c) the country in which the earlier application was filed or, where the earlier application is a regional or an international application, the office with which it was filed and the country or countries for which it was filed.

(2) Where at the time of filing the declaration referred to in subregulation (1), a certified copy of the application earlier filed is not found, that copy shall be furnished within three months from the date on which the application containing the declaration was filed:

Provided that the Registrar may extend the time limit referred to in this subregulation for an additional period of three months, if the applicant supplies evidence that, due to circumstances beyond the applicant control, the applicant was not able to comply with the prescribed time limit.

(3) Where the priorities of two or more earlier applications are claimed, in accordance with subregulation (1), the indication relating to those earlier applications may be included in a single declaration.

39. (1) The withdrawal of an application for a mark shall be made by a written declaration signed by the applicant or his or her authorised agent and submitted to the Registrar.

Withdrawal of application

(2) The application fee shall not be refunded if an application is withdrawn.

40. Subject to section 78 (3) of the Act, if the Registrar accepts the application he or she shall notify the applicant in writing, requesting him or her to pay the publication fee within one month from the date of the notification, and, subject to the payment of the publication fee within the period prescribed, the Registrar shall proceed to publish the application setting out —

Acceptance of application, etc.

- (a) the filing date and, where applicable, the priority date;
- (b) the representation of the mark;
- (c) the goods or services in respect of which the registration of the mark is requested, with an indication of the corresponding class or classes of the International Classification;
- (d) the name and address of the applicant; and
- (e) the name and address of the agent, if any.

41. (1) Any person who wishes to appose the registration of mark shall file with the Registrar a notice of opposition within three months from the date of publication in the Journal.

Opposition for registration of a mark

(2) A notice of opposition referred to in subregulation (1) shall be —

- (a) in Form 12 set out in the First Schedule;
- (b) accompanied by the fee set out in the Second Schedule; and
- (c) accompanied by supporting evidence, if any.

(3) The counter-statement required under section 79 (2) of the Act shall be given within two months from the date the notice of opposition is received by the applicant, in writing, stating the grounds upon which the applicant relies for his or her application and accompanied by supporting evidence, if any.

42. (1) Subject to section 80 of the Act, where an application for the registration of a mark —

Registration of mark; publication of reference; issuance of certificate

- (a) has not been opposed within the prescribed time limit; or
- (b) has been opposed and the opposition has been rejected,

the Registrar shall register the mark and issue to the applicant a certificate of registration in Form 13 set out in the First Schedule, upon payment of the registration fee set out in the Second Schedule.

(2) The Registrar shall allocate to each mark he or she registers the same number as the number allocated under regulation 35.

C.714

- (3) The registration of a mark shall include —
- (a) a representation of the mark;
 - (b) the number of the mark;
 - (c) the name and address of the registered owner;
 - (d) the name and address of the agent, if any;
 - (e) the filing date and date of registration;
 - (f) if priority has been claimed and the claim has been accepted, the country or countries in which or for which the earlier application was filed; and
 - (g) the list of goods or services in respect of which the registration of the mark had been made with an indication of the corresponding class or classes of the International Classification.
- (4) The publication of a reference to the registration of a mark under section 80 (1) (c) of the Act shall contain the particulars specified in subregulation (3).
- 43.** (1) A request for renewal of the registration of a mark under section 85 (1) of the Act shall —
- (a) be made during the six month period preceding the expiry of the registration;
 - (b) be signed by the registered owner or his or her authorised agent; and
 - (c) be made in Form 14 set out in the First Schedule.
- (2) Where the owner is late in applying for the renewal as provided for under section 85 (2) of the Act, he or she shall pay a surcharge set out in the Second Schedule.
- (3) The renewal of the registration of a mark shall be recorded in the register and shall be published in the Journal.
- (4) The Registrar shall mark the original certificate as renewed and provide the next date of expiry.
- 44.** (1) An application under section 86 (1) of the Act to invalidate the registration of a mark, shall be made in Form 23 set out in the First Schedule together with the payment of the fee set out in the Second Schedule.
- (2) A copy of the application under subregulations (1) and (2) shall be served on the owner of the registered mark by the applicant and filed with the Registrar.
- (3) The invalidation of a registered mark shall be published in the Journal.
- 45.** (1) An application under section 87 (3) of the Act, to remove a mark from the register on grounds of non-use, shall be made in Form 15 set out in the First Schedule together with the payment of the fee set out in the Second Schedule.
- (2) A copy of the application under subregulation (1) shall be served on the owner of the registered mark by the applicant and filed with the Registrar.
- (3) The removal of a mark from the register on the grounds of non-use shall be published by notice in the Journal.
- 46.** A request for reinstatement of a lapsed mark under section 88 of the Act shall be made to the Registrar in writing within two months of the lapse of rights over the mark, subject to the payment of the reinstatement fee set out in the Second Schedule.

Renewal of
registration
of mark

Invalidation
of registration
of a mark

Removal on
the ground
of non-use

Reinstatement
of lapsed mark
rights

- 47.** Regulations 34 to 46 shall apply, with the necessary modifications, to collective marks subject to the following —
- (a) an application for registration of a collective mark shall not be accepted unless, in the application for registration, the mark is designated as a collective mark, and unless the application is accompanied by a copy of the rules governing the use of the mark, duly certified by the applicant;
 - (b) the rules governing the use of the collective mark shall —
 - (i) define the common characteristics or quality of the goods or services which the collective mark shall designate and the conditions under which, and the persons by whom, it may be used,
 - (ii) shall provide for the exercise of effective control of the use of the mark in compliance with those rules, and
 - (iii) shall determine adequate sanctions for any use contrary to the said rules;
 - (c) a copy of the rules governing the use of the mark shall be appended to the registration of a collective mark;
 - (d) the publication of a reference to the registration of the collective mark, in accordance with regulation 52 (1), shall include a summary of the rules appended to the registration;
 - (e) all notification of changes effected in the rules governing the use of the mark shall be in writing;
 - (f) all notifications of changes shall be recorded in the register and shall be published by notice in the Journal, and all changes in the rules shall be regarded as having no effect until such recording; and
 - (g) for the purposes of use of the collective mark under section 87 (1) of the Act the registered owner of a collective mark may use the mark himself or herself provided it is also used by other authorised persons in accordance with the rules governing such use.

Collective marks

PART VII — *International Registration under the Madrid Protocol*

- 48.** The Registrar shall forward an international application to the International Bureau in compliance of section 94 (2) of the Act upon the applicant paying the transmittal fee set out in the Second Schedule.
- 49.** The holder of an international registration designating Botswana of a collective mark or a certification mark shall submit to the office within two months the rules governing the use of the collective mark or a certification mark.
- 50.** A request of the holder of an internationally registered mark, to record a note of that international registration in the register of the mark that was registered in Botswana, in terms of section 103 (2), shall pay the fee as set out in the Second Schedule.
- 51.** An application for registration of a cancelled international registration in terms of section 104 (4) of the Act, shall be made in Form 16 set out in the First Schedule accompanied by the fee set out in Second Schedule.
- 52.** (1) Any person who wishes to oppose the registration of internationally registered mark shall file, with the Registrar a notice of opposition within three months from the date of publication in the Journal.

Initial examination of international applications

Collective and certification marks

Replacement of internationally registered mark

Transformation

Opposition of registration of internationally registered mark

- (2) A notice of opposition referred to in subregulation (1) shall be —
 - (a) in Form 12 set out in the First Schedule;
 - (b) accompanied by the fee set out in the Second Schedule; and
 - (c) accompanied by supporting evidence, if any.
- (3) The counter-statement required under section 99 (2) of the Act shall be given within two months from the date the notice of opposition is received by the applicant, in writing, stating the grounds upon which the applicant relies for his or her application and accompanied by supporting evidence, if any.

PART VIII — *Geographical Indications*

Application for registration of a geographical indication

53. Subject to section 107 of the Act, an application for the registration of a geographical indication shall —

- (a) be made in Form 17 set out in the First Schedule;
- (b) be signed by the applicant or his or her authorised agent;
- (c) contain a durable graphic reproduction of the geographical indication; and
- (d) be accompanied by the fee set out in the Second Schedule.

Marking of application for registration of geographical indication

54. (1) Upon receipt of an application for the registration of a geographical indication made under regulation 53, the Registrar shall mark, on each document making up the application, the actual date of receipt and the application number consisting of the letters “BW”, slant, the letter “G”, slant, the four-digit numbers of the year in which the initial papers were received, slant, and a five-digit number allocated in the sequential order in which applications are received.

(2) Where any corrections or other documents are later filed on different dates, the Registrar shall mark the actual dates of receipt for any documents which are later filed with him or her or for which any corrections were made in the appropriate place of the application for the grant of a lay out design.

(3) The application number allocated under subregulation (1) shall be quoted in all subsequent communications concerning the application.

Acceptance of application, etc.

55. If the Registrar accepts the application for a geographical indication he or she shall proceed to publish the application subject to the payment of the fee set out in the Second Schedule setting out —

- (a) the filing date and, where applicable, the priority date;
- (b) the representation of the geographical indication;
- (c) the product in respect of which the registration of the geographical indication is requested;
- (d) the name and address of the applicant;
- (e) the name and address of the agent, if any;
- (f) the definition of the geographical area from which the designated product originates; and
- (g) the particulars of the certifying authority.

Opposition for registration of a geographical indication

56. (1) Any person who wishes to oppose the registration of a geographical indication shall file with the Registrar a notice of opposition within three months from the date of the publication of the application in the journal.

- (2) A notice of opposition referred to in subregulation (1) shall —
 - (a) be in Form 18 set out in the First Schedule;
 - (b) be accompanied by a fee set out in the Second Schedule; and
 - (c) be accompanied by supporting evidence, if any.

(3) The counter-statement required in terms of section 109 (2) of the Act, shall be given within two months from the date the notice of opposition is received by the applicant, in writing, stating the grounds upon which the applicant relies for his or her application and accompanied by supporting evidence, if any.

57. (1) Subject to section 108 of the Act, where an application for the registration of a geographical indication —

- (a) has not been opposed within the prescribed time limit; or
- (b) has been opposed and the opposition has been rejected,

the Registrar shall register the geographical indication and issue to the applicant a certificate of registration in Form 19 set out in the First Schedule upon payment of the registration fee set out in the Second Schedule.

(2) The Registrar shall allocate to each geographical indication he or she registers the same number as the number allocated under regulation 54.

(3) The registration of a geographical indication shall include —

- (a) a representation of the geographical indication;
- (b) the number of the geographical indication;
- (c) the name and address of the registered owner;
- (d) the name and address of the agent, if any;
- (e) the filing date and date of registration;
- (f) if priority has been claimed and the claim has been accepted, the country or countries in which or for which the earlier application was filed;
- (g) the list of products in respect of which the registration of the geographical indication had been made;
- (h) definition of geographical area from which the designated product originates;
- (i) description of the method of producing or obtaining the product; and
- (j) details of the link between quality of the product and its geographical origin.

(4) The publication of the reference to the registration of a geographical indication under subregulation (1) shall contain the particulars specified in subregulation (3).

58. (1) An application under section 113 (1) of the Act, to invalidate the registration of a geographical indication, shall be made in Form 23 set out in the First Schedule accompanied by the fee set out in Second Schedule.

(2) A copy of an application made under subregulation (1) shall be served on the owner of the registered geographical indication by the applicant and filed with the Registrar.

(3) The invalidation of a registered geographical indication shall be published in the Journal.

Registration of geographical indication and issuance of certificate

Invalidation of a registered geographical indication

PART IX — *Traditional Knowledge and Handicrafts*

59. An application for the registration of traditional knowledge shall be made in Form 20 set out in the First Schedule and shall be accompanied by the fee set out in the Second Schedule.

60. An application for the registration of a handicraft shall be made in Form 21 set out in the First Schedule and shall be accompanied by the fee set out in the Second Schedule.

Registration of traditional knowledge

Registration of handicrafts

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Marking of application for traditional knowledge and handicrafts

61. (1) Upon receipt of an application for the registration of a traditional knowledge or handicrafts made under regulations 59 or 60, the Registrar shall mark, on each document making up the application, the actual date of receipt and the application number consisting of the letters “BW”, slant, the letter “T”, for traditional knowledge and the letter “H” for handicrafts, slant, the four-digit numbers of the year in which the initial papers were received, slant, and a five-digit number allocated in the sequential order in which applications are received.

(2) Where any corrections or other documents are later filed on different dates, the Registrar shall mark the actual dates of receipt for any documents which are later filed with him or her or for which any corrections were made in the appropriate place of the application for the grant of a traditional knowledge.

(3) The application number allocated under subregulation (1) shall be quoted in all subsequent communications concerning the application.

PART X — *General*

Changes in ownership, etc.

62. (1) Any request, under section 128 of the Act, for the recording of a change of ownership of a title granted under the Act or of an application therefor shall be made to the Registrar in Form 22 set out in the First Schedule and shall be subject to the payment of the fee set out in the Second Schedule.

(2) The following documents shall be adequate to allow for the change of ownership —

(a) for an assignment —

(i) a deed of assignment, or

(ii) a Power of Attorney, where necessary;

(b) for a cession, a statement of undertaking from the present owner; and

(c) for a testamentary disposition —

(i) a written declaration from the claimant, or

(ii) a will, or a statement of claim countersigned by a tribal leader or such statement made under oath administered by a recognised Commissioner of Oaths.

(3) The publication of the change of ownership shall specify —

(a) the title of protection concerned;

(b) the filing date, the priority date, if any, and the date of registration or grant;

(c) the previous owner and the new owner; and

(d) the nature of the change of ownership.

(4) A licence contract submitted for recording under section 129 of the Act shall be accompanied by the fee set out in the Second Schedule.

Excluded days

63. When the last day for doing of any act or taking any proceeding falls on a day when the Office is not open to the public for business, it shall be lawful to do the act or to take the proceeding on the day when the Office is next open for business.

Inspection of registers, etc.

64. (1) Inspection of the registers shall be subject to the payment of the fee set out in the Second Schedule.

(2) Requests for certified copies of extracts from a register or for copies of documents shall be subject to the payment of the fee set out in the Second Schedule.

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65. An extension of time granted by the Registrar under section 133 of the Act shall be six months.

Extension of
time for
applications

66. Corrections of errors in the register, in accordance with section 131 of the Act, shall be made by the Registrar upon receipt of a request in writing, by an interested person and subject to the payment of the fee set out in the Second Schedule.

Corrections of
errors