

Trade Marks (Madrid Protocol) Regulations 2017

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Note by Veritas

These draft regulations were approved by resolution of the National Assembly on 2nd March 2017 and of the Senate on 7th March. They will not be come law until published in the Government Gazette.

When moving the adoption of the resolutions in Parliament, Vice-President Mnangagwa stated that he was doing so to comply with section 97B(4) of the Trade Marks Act, as enacted by the General Laws Amendment Act, 2016. That provision is as follows—

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

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IT is hereby notified that the Minister of Justice, Legal and Parliamentary Affairs has, in terms of section 104 of the Trade Marks Act [*Chapter 26:04*], made the following regulations:—

CHAPTER I

PRELIMINARY

Title

1. These regulations may be cited as the Trade Marks (Madrid Protocol) Regulations, 2017.

Definitions

2. In these Regulations, except where the context otherwise requires—

“Act” means the Trade Marks Act [*Chapter 26:04*];

“applicant” means the natural person or legal entity in whose name the international registration is filed;

“basic application” means an application for registration of a trade mark, filed with the Registrar under the Act [provide the title] and these regulations, and which is used as a basis for the filing of an international application under the Madrid Protocol;

“basic registration” means a trade mark registered by the Registrar under the Trade Marks Act [Chapter 26:04] and these regulations, and which is used as the basis for the filing of an international application under the Madrid Protocol;

“Common Regulations” means the Common Regulations under the Madrid Agreement and the Madrid Protocol;

“designation” means the request for extension of protection (territorial extension) under Article 3ter(1) or (2) of the Madrid Protocol; it also means such extension as recorded in the International Register;

“designated Contracting Party” means a Contracting Party for which the extension of protection (territorial extension) has been requested under Article 3ter(1) or (2) of the Madrid Protocol, or in respect of which such extension has been recorded in the International Register;

“Gazette” means the periodical gazette referred to in Rule 32 of the Common Regulations;

“holder” means the natural person or legal entity in whose name an international registration is recorded in the International Register;

“International application” means an application to the International Bureau for registration of a trade mark in the International Register;

“International Bureau” means the International Bureau of the World Intellectual Property Organization;

“International Classification of Goods and Services” means the Classification established by the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of June 15, 1957, as revised at Stockholm on July 14, 1967, and at Geneva on May 13, 1977;

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“International Register” means the official collection of data concerning international registrations of marks maintained by the International Bureau;

“international registration” means the registration of a trade mark in the International Register;

“Invalidation” means a decision by the competent authority (whether administrative or judicial) of Zimbabwe revoking or cancelling the effects, in the territory of Zimbabwe, of an international registration with regard to all or some of the goods or services covered by the designation of Zimbabwe.

“Journal” means the Patents and Trade Mark Journal referred to in section 103 of the Act;

“Madrid Agreement” means the Madrid Agreement Concerning the International Registration of Marks of April 14, 1891;

“Madrid Protocol” means the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks, adopted at Madrid on June 27, 1989;

“Office of origin” or “Office” means the Office of origin defined in Article 2(2) of the Madrid Protocol;

“Register” means the Register of Trade Marks kept in terms of section 5 of the Act;

“Transformation application” means an application filed for the purpose of transformation of an international registration into national application, under Article 9quinquies of the Madrid Protocol;

Application of Trade Marks Regulations and Act to International Registrations

3 (1) For the purpose of these regulations, the Trade Marks Regulations and the Act apply, to the extent applicable and with all necessary modifications, to any holder of an international registration designating Zimbabwe, and to any applicant of an international application originating from Zimbabwe.

(2) In the event of conflict between the provisions of the Trade Marks Regulations and Act and those of the Madrid Protocol and the Common Regulations thereunder, the provisions of the Madrid Protocol and the Common Regulations shall prevail.

CHAPTER II

INTERNATIONAL REGISTRATIONS WHERE ZIMBABWE IS A DESIGNATED CONTRACTING PARTY

Examination of International Registrations Designating Zimbabwe

4(1) Where the Registrar has been notified of an international registration where Zimbabwe is designated, this should be examined for absolute and relative grounds.

(2) All documents should be submitted in English, provided that where a document or part thereof is submitted in a foreign language, a notarised translation must be provided.

No Grounds for Refusal – Statement of Grant of Protection

5. Where all procedures before the Registrar have been completed and there is no ground for the Registrar to refuse protection, the Registrar shall, as soon as possible and before the expiry of the refusal period applicable under Article 5 of the Madrid Protocol, send to the International Bureau a statement to the effect that protection is granted to the mark in Zimbabwe.

Ex Officio Provisional Refusal of Protection

6. (1) If the Registrar makes a decision that the international registration does not or partially meets the prescribed requirements in relation to some of the goods and services in respect of which protection is being requested for in Zimbabwe, the Registrar must—

- (a) give notification of provisional refusal to the International Bureau before the expiry of the 18-month time limit set out in Article 5(2) of the Madrid Protocol, containing the relevant information as set out in Rule 17 of the Common Regulations;
- (b) the holder will have 2 months from the date of notification by WIPO to respond to the provisional refusal, and the holder will need to appoint a local representative to act on his or her behalf before the Registrar.

(2) An extension of time of up to one month to respond may be requested by the holder and must be filed with the Registrar before the expiry of the time referred to in subsection (1) (b).

Advertisement for Opposition

7.(1) If the Registrar is satisfied that the international registration designating Zimbabwe meets all the requirements in relation to some or all of the goods and services specified therein the Registrar must publish the particulars of the international registration designating Zimbabwe in the Journal.

(2) Any person who wishes to oppose the protection of an international registration designating Zimbabwe may file a notice of opposition with the Registrar within two months from the date of publication in the Journal.

(3) The Registrar, if requested, may extend the deadline for filing a notice of opposition by one month without the consent of the holder of the international registration and up to two months with the holder's consent.

(4) The Register must not extend the deadline if the request for extension is received after the deadline has expired.

Provisional Refusal Based on an Opposition

8. (1) Where an opposition is filed with the Registrar in respect of an international registration designating Zimbabwe, the Registrar shall, before the expiry of the refusal period applicable under Article 5 of the Madrid Protocol, notify that fact to the International Bureau as a provisional refusal

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based on an opposition, in accordance with the provisions of the Madrid Protocol and the Common Regulations.

(2) The holder of the international registration concerned shall enjoy the same remedies in this section as if the mark had been filed for registration directly with the Registrar.

Counter Statement

9(1) A holder of an international registration to whom a notice of opposition has been sent must file with the Registrar a counter-statement within two months after the date of refusal.

(2) For the avoidance of doubt, if the holder fails to comply with subsection (1) in relation to any class of goods or services in respect of which protection is opposed—

(a) the Registrar is entitled to treat the holder's request for protection in Zimbabwe in respect of those goods or services as withdrawn; and

(b) the Registrar's refusal applies in respect of those goods or services.

(3) The holder may request the Registrar to review a provisional refusal of his or her international registration if he or she has reason to believe that such a decision has been erroneously made.

Final Decision Following the Notification of a Provisional Refusal

10(1) Where the Registrar has notified to the International Bureau a provisional refusal of protection in accordance with Sections 7 or 9, and all the procedures before the Office having been completed, such provisional refusal has been either totally or partially withdrawn, the Registrar shall send to the International Bureau either—

(i) a statement to the effect that the provisional refusal is withdrawn and that protection of the mark is granted in Zimbabwe for all the goods and services for which protection has been requested, or

(ii) a statement indicating the goods and services for which protection of the mark is granted in Zimbabwe.

(2) Where the Registrar has sent to the International Bureau a notification of total provisional refusal in accordance with sections 7 or 9, and all the procedures before the Office having been completed, and the Registrar has decided to confirm such refusal of protection of the mark in Zimbabwe for all the goods and services for which protection has been requested, the Registrar shall send to the International Bureau a statement to that effect.

(3) The holder who is aggrieved by the decision of the Registrar may appeal against such decision in accordance with section 64 of the Act

Further Decision Affecting Protection of a Mark

11. Where, following the sending of a statement in accordance with section 11(a) or (b), there is a further decision which affects the protection of a mark in Zimbabwe, the Registrar shall, to the extent that the Registrar is aware of that decision, send to the International Bureau a further statement indicating the goods and services for which the mark is protected in Zimbabwe.

Effects of an International Registration

12(1) An international registration designating Zimbabwe shall have the same effect, as from the date of the international registration, as if an application for the registration of the mark had been filed directly with the Registrar under the Act.

(2) If no refusal is notified by the Registrar to the International Bureau in accordance with the Madrid Protocol and the Common Regulations, or if a refusal has been so notified but has been subsequently withdrawn, or if a statement of grant of protection is sent by the Registrar, the protection of the mark in Zimbabwe shall be the same as if the mark had been registered directly by the Registrar on the date of the international registration.

Invalidation

13. Where the effects of an international registration are invalidated in Zimbabwe and the invalidation is no longer subject to appeal, the Registrar shall, provided that the Registrar is aware of that decision, notify the International Bureau in accordance with the relevant provisions of the Madrid Protocol and the Common Regulations.

Recordings in the International Register

14. Any recording made in the International Register in respect of an international registration, shall, to the extent that it applies to Zimbabwe as a designated Contracting Party, have the same effect as if it had been recorded by the Registrar in the register of marks.

Duration of Protection

15 (1) Registration of a mark at the International Bureau is effected for ten years, with the possibility of renewal under the conditions specified in Article 7 of the Madrid Protocol.

(2) The Registrar shall keep a record of any renewals of protection for international registrations with effect for Zimbabwe in the register.

Collective and Certification Marks

16 Where an international registration designating Zimbabwe is a collective mark or a certification mark, the regulations governing the use of such collective mark or certification mark shall be submitted directly, by the holder of that international registration, to the Registrar, within the prescribed time limit.

Replacement

17(1) Where—

- (a) a mark registered in Zimbabwe is also the subject of an international registration, and the protection resulting therefrom extends to Zimbabwe, and
- (b) the same person is recorded as holder of the registration in Zimbabwe and of the international registration, and
- (c) all the goods and services listed in the registration in Zimbabwe are also listed in the international registration in respect of Zimbabwe, and
- (d) the extension of that international registration to Zimbabwe took effect after the date of registration of the mark in Zimbabwe,

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the holder of the international registration may request the Registrar to take note of that international registration in the register.

(2) A request filed with the Registrar in accordance with subsection (1), shall be made on Form TMM1 as found in the Second Schedule and shall be subject to the payment of the prescribed fee.

(3) Where the Registrar has taken note of an international registration in accordance with subsection (1), the Registrar shall notify the International Bureau accordingly.

(4) Such notification shall indicate the following—

- (a) the number of the international registration in question;
- (b) where some of the goods and services listed in the international registration are concerned, those goods and services;
- (c) the filing date and number of the application for registration of the mark in Zimbabwe;
- (d) the registration date and number of the registration in Zimbabwe;
- (e) the priority date, if any, of the registration in Zimbabwe.

Transformation

18(1) This section applies when an international registration designating Zimbabwe is cancelled at the request of the Office of origin under Article 6(4) of the Madrid Protocol in respect of all or some of the goods or services listed in the international registration.

(2) The holder may make an application to the Registrar for registration in Zimbabwe of the same trade mark in respect of the goods or services covered by the list of goods and services contained in the international registration.

(3) Subject to subsection (4) and (6), the provisions applicable to a trademark application filed directly with the Registrar shall apply *mutatis mutandis* to an application resulting from transformation.

(4) The application resulting from transformation shall be made on Form TMM2 found in the Second Schedule and must be made within 3 months from the date on which the international registration was cancelled in the International Register and must include the following information—

- (a) the international registration number of the trade mark;
- (b) a statement that the application is made by way of transformation;
- (c) the date on which the cancellation of the international registration was recorded in the International Register;
- (d) the date of the said international registration, or the date of recording of the territorial extension made subsequently to the international registration, as appropriate;
- (e) whether the transformation application request relates to all the goods and services covered by the list of goods or services in the international registration and, if not, a list of goods and services to which the transformation application relates and the respective class numbers;
- (f) an address for service in Zimbabwe.

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(5) An application resulting from transformation shall be subject to the payment of the prescribed transformation fees.

(6) Where a mark that is the subject of an international registration—

- (a) has become protected in Zimbabwe on or before the date on which the international registration was cancelled and, provided that all the requirements relating to an application resulting from transformation have been met, that trademark shall be registered by the Registrar and the date of registration shall be the date of the cancelled international registration, or the date of recording of the territorial extension to Zimbabwe made subsequently to the international registration, as appropriate, and that registration shall enjoy any priority enjoyed by the cancelled international registration.
- (b) has not yet become protected in Zimbabwe on or before the date on which the international registration was cancelled, any procedures or measures already undertaken on or before the date on which an application resulting from transformation is filed for the purpose of the international registration shall be considered as having been undertaken for the purposes of the application resulting from transformation, the filing date of the application resulting from transformation shall be the date of the international registration or the date of recording of the territorial extension to Zimbabwe made subsequently to the international registration, as appropriate.

Corrections

19(1) The Registrar shall record details of any correction notified by the International Bureau in terms of Rule 28 of the Common Regulations and the record is prescribed as a matter to be entered in the register.

(2) The Registrar shall have the right to declare in a notification of provisional refusal addressed to the International Bureau that it considers that protection cannot, or can no longer, be granted to the international registration as corrected with sections 7 and 9 applying mutatis mutandis, it being understood that the period allowed for sending the said notification shall be counted from the date of sending the notification of the correction to the International Bureau.

CHAPTER III

INTERNATIONAL APPLICATIONS ORIGINATING IN ZIMBABWE (ZIMBABWE IS THE OFFICE OF ORIGIN)

Entitlement to File an Application for International Registration

20 (1) A person who is an owner of a registered trade mark or an applicant for registration of a trademark may apply for international registration of the trade mark.

(2) The person must—

- (a) be a Zimbabwean citizen; or
- (b) be domiciled in Zimbabwe; or

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(c) have a real and effective industrial or commercial establishment in Zimbabwe.

(3) Two or more persons may jointly apply for international registration of a trade mark as allowed by Rule 8 of the Common Regulations.

Application for International Registration

21(1) An application for international registration must—

- (a) comply with the requirements of the Madrid Protocol and the Common Regulations; and
- (b) be filed with the International Bureau through the intermediary of the Registrar.

(2) For the purpose of subsection (1)(b), the application may be submitted to the Registrar through an Agent.

Language

22. Any communication, including an international application, for transmittal to the International Bureau through the intermediary of the Registrar, shall be in English.

Functions of Registrar

23(1) The Registrar must perform the functions, under the Madrid Protocol and the Common Regulations, of the Office of origin in relation to—

- (a) the international application; and
- (b) if the international application results in an international registration, the international registration.

Examination of International Applications where Zimbabwe is the Office of Origin

24. Where an international application is filed with the Registrar for transmittal to the International Bureau, the Registrar shall verify that the Office of Zimbabwe may be considered as the Office of origin in respect of that application, and that the relevant particulars appearing in the international application correspond to the relevant particulars appearing in the basic application or basic registration, as the case may be, in accordance with the provisions of the Madrid Protocol and the Common Regulations.

Certification

25(1) Where the international application complies with the prescribed requirements, the Registrar shall so certify in the international application, indicating also the date on which the international application was received, and shall forward the international application to the International Bureau.

(2) The Registrar must take all reasonable steps to ensure that the application is received by the International Bureau within two months from the date on which it was received by the Registrar.

(3) Where the international application does not comply with the prescribed requirements, the Registrar shall not forward it to the International Bureau, and shall inform the applicant accordingly.

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Handling Fee

26. The prescribed handling fee shall be due and payable to the Registrar for the certification and transmittal to the International Bureau of an international application originating in Zimbabwe.

Fee for Filing an International Application

27. Fees payable under the Madrid Protocol and the Common Regulations in respect of international applications where Zimbabwe is the Office of origin shall be paid directly to the International Bureau.

Ceasing of Effect of the Basic Application or Basic Registration

28. Where, in accordance with Article 6 of the Madrid Protocol, the basic application, the registration resulting from such application, or the basic registration, ceases to have effect, the Registrar shall inform the International Bureau accordingly and shall request the cancellation of the international registration in respect of the goods and services affected.

Evidence of Certain Matters Relating to an International Registration

29(1) In all legal Proceedings relating to an international registration trade mark, the registration of a person as the holder of an international mark shall be *prima facie* evidence of the validity of the original international registration and of any subsequent assignment or other transmission of it.

(2) Judicial notice shall be taken of the following—

- (a) the Madrid Protocol and the Common Regulations;
- (b) copies issued by the International Bureau of entries in the International Register
- (c) copies of the Gazette.

(3) A document—

- (a) purporting to be a copy of or an extract from an entry in an instrument; or
- (b) any other act of the International Bureau; or
- (c) which is referred to in subsection 2 (b) or (c) above,

shall, without further proof, be admissible in evidence in any legal proceedings and shall be deemed to be a true copy of or extract from such entry or such document until the contrary is proved.

(4) For purposes of this section, "legal proceedings" shall be interpreted to include proceedings before the Registrar.

Communications to the International Bureau

30. The Registrar may communicate to the International Bureau any information, which Zimbabwe is required to communicate pursuant to these regulations; the Madrid Protocol or the Common Regulations.

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FIRST SCHEDULE(*section 26 and 27*)

FEES

<i>Matter Proceeding</i>	<i>Fee (US\$)</i>
1. On request for replacement of Zimbabwean National Application/ registration with an international registration in terms of section 18 (1) (b) of these regulations.....	\$50
2. On application for transformation of an international Application/registration into a national application/registration in terms of section 19 (4) of these regulations	\$100
3. Handling fee due and payable to the Registrar in terms of section 27 of these regulations.....	\$150

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SECOND SCHEDULE (Sections 17 and 18)

FORMS

TRADE MARK (MADRID PROTOCOL) REGULATIONS, 2016

FORM: TMM1

REF.....

ZIMBABWE

Section 18 (1) of the Regulations

Fee: \$50

Trade Marks Act (Chapter 26:04)

*Application to Replace a National Registration
With an International Registration*

I/We.....

Legal Nature.....

Address.....

Hereby make a request to replace a Zimbabwean National registration with an International Registration;

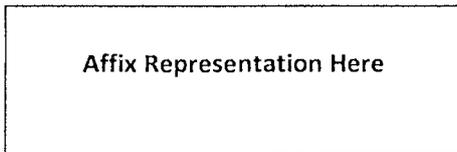
Details of International Registration:

International Registration Number.....

International Registration Date.....

Priority Details.....

Trade Mark Representation (and description)



Class(es) to be affected by the Replacement.....

Details of National Registration to be Replaced:

National Registration Number.....

National Registration Date.....

Class(es) to be Replaced.....

Applicant / Representative / Agent Details:

Applicant / Representative / Agent Name.....

Address for Service.....

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.....
Signature.....Dated.....

TO: The Registrar of Trade Marks
Trade Marks Office
HARARE

Trade Mark (Madrid Protocol) Regulations, 2016

FORM: TMM2

REF.....

ZIMBABWE

Section 19 (4) International of the Regulations

Fee: \$100

Trade Marks Act (Chapter 26:04)

*Application to transform a Madrid Designation
into a National Application / Registration*

I/We.....

Legal Nature.....

Address.....

*Hereby apply that the following Madrid Protocol Designation be transformed into a Zimbabwe
National Trade Mark Application / Registration;*

International Registration Number.....

International Registration Date.....

Priority Details.....

Trade Mark Representation (and description)

Affix representation here

Class(es) to be affected by the Transformation.....

.....

Disclaimer if any.....

Translation/Transliteration if any.....

Other descriptions.....

Cancellation details:

Date of Cancellation of the International Registration

Or were cancellation proceedings are not yet complete:

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Date Cancellation request was filed with the International Bureau.....,

Applicant / Representative / Agent Details:

Applicant / Representative / Agent Name.....

Address for Service.....

.....

Signature.....Dated.....

TO: The Registrar of Trade Marks

Trade Marks Office

HARARE