

Industrial Property (Amendment) Act, 2015



THE GAMBIA

NO. 5 OF 2015

Assented to by The President,

this 20th day of July, 2015



YAHYA A. J. J. JAMMEH
President

AN ACT to amend the Industrial Property Act to incorporate provisions relating to the registration of marks under the Madrid Protocol and for connected matters.

ENACTED by the President and the National Assembly.

[20th July, 2015]

1. Short title

This Act may be cited as the Industrial Property (Amendment) Act, 2015.

2. Amendment of Cap. 95.01

The Industrial Property Act (in this Act referred to as the "Principal Act") is amended as set out in this Act.

3. Amendment of section 13

Section 13 of the Principal Act is amended in sub-section (1) by substituting for the words "fifteen years", the words "twenty years".

4. Insertion of section 34A

There is inserted immediately after section 34 of the Principal Act, the following new section –

"34A. International registration of Marks ("the Madrid Protocol")

The provisions of the Madrid Protocol relating to the international registration of Marks are attached to this Act as the Second schedule.

"Second Schedule"

(section 34A)

5. Amendment of section 43

Section 43 of the Principal Act is amended in sub-section (4) by substituting for the words –

- (a) "five thousand dalasis", the words "five hundred thousand dalasis";
- (b) "six months", the words "three years".

SECOND SCHEDULE

(section 34A)

PART I - PRELIMINARY

1. Interpretation

For the purpose of this Schedule –

“basic application” means an application for registration of a mark, filed with the Registrar General under this Act, and which is used as a basis for the filing of an international application under the Madrid Protocol;

“basic registration” means a mark registered by the Registrar General under this Act, 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 Madrid Protocol;

“international application” means an application to obtain registration of a mark under the Madrid Protocol;

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

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

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

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

**PART II INTERNATIONAL APPLICATIONS
ORIGINATING FROM THE GAMBIA**

2. Language

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

3. Examination of international applications in respect of which The Gambia is the country of origin

Where an international application is filed with the Registrar General for transmittal to the International Bureau, the Registrar General shall verify –

- (a) that The Gambia may be considered as the country of origin in respect of that application; and
- (b) 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.

4. Certification

(1) Where the international application complies with the prescribed requirements, the Registrar General shall –

- (a) so certify in the international application, indicating the date on which the international application was received; and
- (b) forward the international application to the International Bureau.

(2) Where the international application does not meet the prescribed requirements, the Registrar General shall not forward it to the International Bureau, and he or she shall inform the applicant accordingly.

5. Handling fee

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

in The Gambia.

6. Ceasing of effect of the basic application or basic registration

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 General shall –

- (a) inform the International Bureau accordingly; and
- (b) request the cancellation of the international registration in respect of the goods and services affected.

PART III - INTERNATIONAL REGISTRATIONS IN RESPECT OF WHICH THE GAMBIA IS A DESIGNATED CONTRACTING PARTY

7. Advertisement of application; opposition

(1) Where in respect of an international registration in which The Gambia has been designated, the Registrar General finds that the conditions referred to in sub-section (1) of section 29 of the Act are fulfilled, he or she shall cause the international registration to be published as provided in the Act.

(2) Opposition to the international registration shall be governed by the provisions of the Act regarding opposition, *mutatis mutandis*.

8. Ex officio provisional refusal of protection

(1) Where the Registrar General finds that in accordance with the provisions of the Act, the mark that is the subject of an international registration designating The Gambia cannot be protected, he or she shall, before the expiry of the refusal period applicable under Article 5 of the Madrid Protocol, notify to the International Bureau a provisional refusal of protection, complying with the requirements of the Madrid Protocol and the Common Regulations.

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

9. Provisional refusal based on an opposition

(1) Where an opposition is filed with the Registrar General in respect of an international registration designating The Gambia, the Registrar General 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 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 as if the mark had been filed for registration directly with the Registrar General.

10. No grounds for refusal – statement of grant of protection

Where all procedures before the Registrar General have been completed and there is no ground for the Registrar General to refuse protection, he or she 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 The Gambia.

11. Final decision following the notification of a provisional refusal

(1) Where the Registrar General has notified the International Bureau a provisional refusal of protection in accordance with paragraph 8 or 9 and after all the procedures before the Office have been completed, such provisional refusal has been either totally or partially withdrawn, the Registrar General shall send to the International Bureau either—

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

(b) a statement indicating the goods and services for which protection of the mark is granted in The Gambia.

(2) Where the Registrar General has sent to the International Bureau a notification of total provisional refusal in accordance with paragraph 8 or 9 and after all the

procedures before the Office have been completed, the Registrar General has decided to confirm such refusal of protection of the mark in The Gambia for all the goods and services for which protection has been requested, the Registrar General shall send to the International Bureau a statement to that effect.

12. Further decision affecting protection of a mark

Where following the sending of a notification of provisional refusal in accordance with paragraph 8 or 9, or a statement in accordance with paragraph 10 or sub-paragraphs (1) or (2) of paragraph 11, there is a further decision which affects the protection of a mark in The Gambia, the Registrar General shall to the extent that he or she 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 The Gambia.

13. Effects of an international registration

(1) An international registration designating The Gambia 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 General under the Act.

(2) If –

- (a) no refusal is notified by the Registrar General to the International Bureau in accordance with the Madrid Protocol and the Common Regulations;
- (b) a refusal has been so notified but has been subsequently withdrawn; or
- (c) a statement of grant of protection is sent by the Registrar General,

the protection of the mark in The Gambia shall be the same as if the mark had been registered directly by the Registrar General on the date of the international registration.

14. Invalidation

Where the effects of an international registration are invalidated in The Gambia and the invalidation is no longer subject to appeal, the Registrar General shall, provided that

he or she is aware of that decision, notify the International Bureau accordingly of the invalidation in accordance with the relevant provisions of the Madrid Protocol and the Common Regulations.

15. Recordings in the international register

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

16. Collective marks

Where an international registration designating The Gambia is a collective mark, the regulations governing the use of such collective mark shall be submitted directly by the holder of that international registration to the Registrar General.

17. Replacement

(1) Where—

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

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

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

(3) The notification shall indicate the following –

- (a) the number of the international registration in question;
- (b) where only 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 The Gambia;
- (d) the registration date and number of the registration in The Gambia;
- (e) the priority date if any, of the registration in The Gambia; and
- (f) information relating to other rights acquired by virtue of the registration in The Gambia.

- 18. Transformation

(1) Where an international registration designating The Gambia is cancelled at the request of the office of origin, in accordance with Article 6(4) of the Madrid Protocol, in respect of all or some of the goods and services listed in the international registration, an application may be made to the Registrar General within three months from the date on which the international registration was cancelled by the person who was the holder of the international registration at the date of its cancellation, for registration of the same trademark (“an application resulting from transformation”), in respect of goods and services covered by the list of goods and services contained in the international registration.

(2) Subject to sub-paragraphs (3) to (8), the provisions applicable to a trademark application filed directly with the Registrar General shall apply *mutatis mutandis* to an application resulting from transformation.

(3) An application resulting from transformation shall include the following –

- (a) a statement that the application is made by way of transformation;
- (b) the international registration number of the international registration which has been cancelled;

- (c) the date of the said international registration, or the date of recording of the territorial extension made subsequently to the international registration, as appropriate;
 - (d) the date on which the cancellation of the international registration was recorded; and
 - (e) where applicable, the date of any priority claimed in the international application and recorded in the International Register.
- (4) An application resulting from transformation shall be subject to the payment of the prescribed transformation fees.
- (5) Where an international mark has become protected in The Gambia 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 General.
- (6) The date of registration shall be the date of the cancelled international registration, or the date of recording of the territorial extension to The Gambia made subsequently to the international registration, as appropriate, and that registration shall enjoy any priority enjoyed by the cancelled international registration.
- (7) Where an international mark has not yet become protected in The Gambia 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.
- (8) 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 The Gambia made subsequently to the international registration, as appropriate.

19. Further details concerning international registrations

Further details concerning international registrations may be included in the implementing Regulations.

INDUSTRIAL PROPERTY (AMENDMENT) ACT, 2015.

PASSED in the National Assembly this Thirtieth day of June, in the
year of Our Lord Two Thousand and Fifteen.

D. C. M. Kebbeh
Clerk of the National Assembly.

THIS PRINTED COPY has been carefully compared by me with the Bill
which has passed in the National Assembly, and found by me to be a true and
correct copy of the Bill.

D. C. M. Kebbeh
Clerk of the National Assembly.

