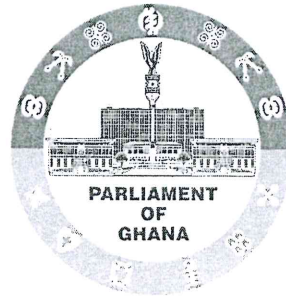


**IN THE SECOND SESSION OF THE SIXTH  
PARLIAMENT OF THE FOURTH REPUBLIC OF  
GHANA**



**REPORT OF THE COMMITTEE ON  
CONSTITUTIONAL, LEGAL AND  
PARLIAMENTARY AFFAIRS**

**ON THE  
TRADEMARKS (AMENDMENT) BILL, 2013**

***FEBRUARY, 2014***

## **1.0 INTRODUCTION**

1.1 The **Trademarks (Amendment) Bill, 2013** was presented and laid in Parliament on **Thursday, 21<sup>st</sup> November 2013**. In accordance with Article 106(4) and (5) of the Constitution and Order 179 of the Standing Orders of the House, Mr. Speaker referred the Bill to the Committee on Constitutional, Legal and Parliamentary Affairs for consideration and report.

1.2 The Acting Registrar-General, Mrs. Jemima Oware and other officials from the Registrar-General Department, the Attorney-General Department and the Ministries of Justice and Trade and Industry led the Committee in the discussions. The Committee is grateful to them for the assistance.

## **2.0 REFERENCE**

2.1 The Committee referred to the following documents during its deliberations.

- i. The 1992 Constitution
- ii. The Standing Orders of Parliament
- iii. Trademarks Act, 2004 (Act 664)
- iv. Trademarks Act, 1963 (Act 270)
- v. Trademarks Regulations, 1970, LI 667

### **3.0 BACKGROUND**

3.1 Ghana enacted the Trademarks Act, 1963 (Act 270) to provide for the protection of trademarks and for other related matters. The Law after almost four decades in operation, was replaced by the enactment of the Trademarks Act, 2004 (Act 664). The enactment of Trademarks Act, 2004 (Act 664) was to update Trademarks Act, 1963 (Act 270) and to incorporate some provisions of the Trade-Related Aspects of Intellectual Property Rights (TRIPS) Agreement into the laws of Ghana. The TRIPS Agreement inter alia, establishes minimum standards for intellectual property protection to be adhered to by member countries. Ghana being a signatory to the TRIPS Agreement had to internalise provisions of the Agreement into our domestic law.

3.2 The Madrid Agreement Concerning the Intellectual Registration of Trade of Marks adopted at Madrid on the 14<sup>th</sup> day of April 1981, as subsequently revised and amended and its subsequent Protocol adopted at Madrid on the 27<sup>th</sup> day of June, 1989 as amended from time to time created the need for revision and updating of our law. These international agreements and protocols reflected the dynamics and changing circumstances of creativity and innovation and

improved the standards for the protection of intellectual property rights.

- 3.3 Some of the obligations under the revised Protocols could be provided for in regulations. There are also issues of procedure to be followed when dealing with requests for extension of protection to Ghana and communication of information to the International Bureau.

#### **4.0 OBJECT OF THE BILL**

- 4.1 The Bill seeks to amend the Trademarks Act, 2004 (Act 664) to give the Minister responsible for Justice the authority to make provisions to give effect to some of the obligations of the Country under the Madrid Protocol and other related Treaties. This authority had earlier not been granted by existing law.
- 4.2 The Bill also seeks to create a single system with respect to the renewal of trademarks by reconciling the earlier provisions in the Trademarks Act, 2004 (Act 664) and the repeals and savings provisions of the same Law in respect of renewal periods for the registration of trademarks in the Country.
- 4.3 The Law as it stands is that the repealed Trademarks Act, 1963, (Act 270) provided that the registration

period of a trademark was 7 years and the renewal period was 14 years. This was replaced by section 10 of the Trademarks Act, 2004 (Act 664) which provides that the registration of a trademark is for a period of 10 years and be renewed for consecutive periods of 10 years. The repeals and savings provision of Trademarks Act, 2004 (Act 664) however provide that trademarks registered under Trademarks Act, 1963 (Act 270) are to be renewed for a period of 14 years from the date of the original registration or of the last renewal of registration.

## **5.0 OBSERVATIONS**

- 5.1 The Committee observed that under the Trademarks Act, 2004 Act (664), trademarks are registered without recourse to the goods and services to which they are applicable. The Bill under consideration however, makes it obligatory on any person registering a trademark to attach to the application, a reproduction of the trademark and a list of goods and services for which the registration of the trademark is required. This would introduce clarity and clear doubts as to the identity of the goods or services covered by the trademark.
- 5.2 The Committee also noted with concern the activities of people who pirate on other people's trademarks by

introducing similar and identical signs with the intent to deceive the public. The Committee was informed that piracy of trademarks is on the increase. This calls for tougher measures including stiffer punishments. It is therefore gratifying that the Bill introduces a new provision under Clause 9 criminalising such a conduct and prescribes a penalty. The new offence relates to applying a sign identical to a registered trademark to goods with intent to sell the goods or for purposes of labeling, packaging or advertising the goods.

- 5.3 As stated in paragraph 4.3 above, the savings clause of the Trademarks Act, 2004 (Act 664) created a dual system of registration of trademarks in the country. The solution to this problem is the proposal in Clause 13 of the Bill introducing uniformity in the renewal regime.

## **6.0 CONCLUSION**

- 6.1 After a thorough scrutiny and deliberation, the Committee is very convinced that the Bill when passed, will ensure that international standards are met, simplicity and clarity of the trademarks regime in Ghana is obtained and Ghanaian entrepreneurs and creators better protected and motivated to invest more in intellectual property.

6.2 The single and direct linkage to the global registration system will greatly reduce cost of trademarks registration and also ensure trademarks owners benefit from access to the global market. The benefits to the country are obvious and immense.

6.3 The Committee therefore recommends to the House to adopt its Report and pass the Bill subject to the amendments attached.

Respectfully submitted.



**HON. ALBAN S.K. BAGBIN**  
*Chairman, Committee on  
Constitutional, Legal and  
Parliamentary Affairs*



**ERIC OWUSU-MENSAH**  
*Clerk, Committee on  
Constitutional, Legal and  
Parliamentary Affairs*

**FEBRUARY 2014**

## **APPENDIX**

### **AMENDMENTS PROPOSED TO THE TRADEMARKS (AMENDMENT) BILL, 2013**

- i. Clause 1 – Section 1 of Act 664 – Amendment proposed – line 2 of opening statement, after “amended” delete “in section 1”.
- ii. Clause 1 – Section 1 of Act 664 – Amendment proposed – Delete Sub-clause 2, Paragraph (a) and substitute the following:  
“(2) A trademark may consist of
  - (a) Words, personal names, designs, letters, colours, numerals, shapes, holograms, sounds or a combination of any of these elements”.
- iii. Clause 2 – Section 2 of Act 664 – Amendment proposed – delete lines 1 and 2 and substitute the following:  
“The principal enactment is amended by the substitution for section 2 of”.
- iv. Clause 5 – Section 5 of Act 664 – Amendment proposed – delete lines 1 and 2 and substitute the following: “The principle enactment is amended by the substitution for section 5 of”.
- v. Clause 7 – Section 15 of Act 664 – Amendment proposed – line 2, delete “(6)” and substitute “(5)”.



- vi. Clause 7 – Section 15 of Act 664 – Amendment proposed – Paragraph (7), before “the owner” delete “(7)” and substitute “(6)”
- vii. Clause 7 – Section 15 of Act 664 – Amendment proposed – Paragraph (8), before “Unless” delete “(8)” and substitute “(7)”.
- viii. Clause 8 – Section 16 of Act 664 – Amendment proposed – Delete Sub-section (4) and substitute the following:
  - “(4) A license contract is not valid if
    - (a) that license contract does not provide for quality control; or
    - (b) the quality control is not effectively carried out”.
- ix. Clause 8 – Section 16 of Act 664 – Amendment proposed – Delete Sub-section (5) and substitute the following:
  - “(5) A Court may declare the mark as abandoned by the owner”.
- x. Clause 8 – Section 16 of Act 664 – Amendment proposed – Insert a new Sub-clause 6 as follows:
  - “(6) An owner may plead abandonment as a personal defence in infringement proceedings.”
- xi. Clause 9 – Section 26 of Act 664 – Amendment proposed – Sub-section 5, line 1, after “who” delete “with a view to” and substitute “for the purpose of”.

- xii. Clause 9 – Section 26 of Act 664 – Amendment proposed – Delete Sub-section 7.
- xiii. Clause 10 – Amendment proposed – Headnote, after “32A” insert “of Act 664”.
- xiv. Clause 10 – Amendment proposed – Delete Sub-clause 1, Paragraph (c), and substitute the following:  
“(c) articles specifically designed or adapted for making copies of a registered trademark that person may apply to the Court for an order for the forfeiture of the goods, material or articles; and that person may apply to the Court for an order for the forfeiture of the goods, materials or articles”.
- xv. Clause 10 – Amendment proposed – Sub-clause 3, Paragraph (a), line 3, after “articles;” delete “or” and substitute “and”.
- xvi. Clause 11 – Amendment proposed – delete Clause 11 and substitute the following:  
“The principal enactment is amended in section 51 by the addition of a new subsection (3)  
(3) Regulation made under this section may make provision for giving effect to the provisions of the Madrid Protocol and may in particular provide for  
(a) applications for international registrations by way of the Trademark Office as Office of origin;

- (b) procedures to be followed where the basic application or registration fails or ceases to be in force;
- (c) procedure to be followed where the office receives from the International Bureau, a request for extension of protection to Ghana;
- (d) effect of a successful request for extension of protection in Ghana;
- (e) transformation of an application for an international registration, into a national application for registration;
- (f) communication of information to the International Bureau: and
- (g) payment of fees and amounts prescribed in respect of applications for international registration, extensions of protection and renewals.”.

xvii. Clause 12 – Section 52 of Act 664 – Amendment proposed – after the definition for “International Trademark” insert a definition for “well-known trademark” as follows:

“well-known trademark” means the trademark of a person who is

- (a) a national of a country that is a party to the Paris Convention; or

(b) domiciled in or has a real and effective commercial establishment in a country that is a party to the Paris Convention, and the trademark is recognized or known in the relevant public sector as belonging to that person.

- xviii. Clause 14 – Amendment proposed – lines 1 and 2, delete and substitute “The principal enactment is amended by the addition of a new Section 54”.
- xix. Clause 15 – Amendment proposed – line 1, delete “insertion” and substitute “addition”.
- xx. Clause 15 – Amendment proposed – Paragraph IA, line 1, delete “shall apply” and substitute “applies”.
- xxi. Clause 15 – Amendment proposed – Paragraph IE, Sub-paragraph 2, line 4, delete “he” and substitute “be”.
- xxii. Clause 15 – Amendment proposed – Paragraph IE, Sub-paragraph 6, line 2, after “trade mark” delete “designated” and substitute “that designates”.