SUDAN

Trade **M**ark**s Act, 1969**

Act No. 8 of 1969

Title
1. This Act May be cited as" the Trade Marks Act, 1969".

Repeal
2. The Trade Marks Ordinance 1931 shall be repealed.

Definitions
3. In this Act, unless the context otherwise required, the flowing words shall have the meanings herein respectively assigned to them:

"The Court": means the High Court.

"Trade Mark": means any visible sign used or proposed to be used upon, in connection with or in relation to goods for the purpose of distinguishing the goods of a person from those of others. Provided it is not inadmissible, a trade mark may consist of any distinctive sign, including a ward, name, pseudonym device, brand arbitrary or fanciful designation, heading, label, ticket, signature, letter, numeral, slogan package, emblem container or any combination thereof.

"Service Mark": means any visible sign used or proposed to be used to distinguish the services of a person from those of other.

"Indication of Origin": means any expression or sign used to indicate that a product or service originates in a given country, group of countries, region or locality.

"Minister": means the Minister of commerce and Supply.

"Prescribed": means prescribed by this Act or by Orders or Rules or Regulations made under this Act.

Register of Trademarks

4. (1) There shall be kept for the purpose of this Act, a register of Trade Marks wherein shall be entered all registered trade marks with the names and addresses of their owners, notifications of assignments, the names and addresses of all registered users, disclaimers, conditions limitations, renewals, renunciations, cancellations, and such other matters relating to trade marks as may be prescribed.

(2) The Register shall be kept at the offices of the Commercial Registry, Ministry of Commerce and Supply, Khartoum or at such other places as may be appointed by the Minister or Order published in the Gazette.

Appointment of the Registrar

A Register shall be appointed by the Minister to keep the register and carry out the functions conferred upon him by this Act.

Trademark Registered for Particular Goods

5. (1) A trade mark shall be registered for the particular goods for which the mark will be used, with an indication of the appreciate class, as set out in the classification of goods in the schedule to the Trade Mark Rules made under this Act, provided that one and the same registration cannot validity cover all the goods in one class.

(2) Any question as to the class within which any goods fall shall be decided by the Registrar.

Public Inspection

6. (1) The Registrar kept under this Act shall at all convenient times be open for inspection by public subject to such rules as may be prescribed.

(2) Certified copies of any entry in such Register shall be given to any person requiring the same on payment of the prescribed fee.

Registration of Trademarks and Priority

7. (1) The exclusive right to a mark, conferred by this Act shall be acquired by registration in accordance with the provisions of this Act.

(2) Registration of mark can validity be granted only to the person who has first fulfilled the conditions for a valid application or who is the first to claim validity the earliest priority for such application.

(3) Trade Marks may be registered with limitations as to colours to be used thereon.

Restriction on Registration

8. (1) The following cannot be validly registered as trade marks:

a) Marks which consist of shape or forms impose by the inherent nature of the goods or by their industrial function.

b) Marks which consist exclusively of a sign or indication which may serve, in the course of trade to designate any particularity, such as quality, quantity, purpose, value and place of origin.

c) Marks, which have become, in the current language or in the bona fide and established practices of the trade of the country, a customary designation of the goods concerned.

d) Marks which are contrary to morality or public order and which, in particular, are calculated to deceive or confuse trade circles or the public as to the nature, the source, the manufacturing process, the characteristics or the suitability for their purpose, of the goods concern.

e) Marks which reproduce or imitate armorial bearings, flags and other emblems, initials, names or abbreviations of names of any state or of any intergovernmental international organization or any organization created by an international convention, unless authorized by the competent authority of that state or international organization.

f) Marks which reproduce or imitate official signs or Hall marks adopted by a State, unless authorized by the competent authority of that State.

g) Marks identical with or similar to emblems of exclusively religious, sectarian or tribal organization.

h) Marks which resemble or depict the portrait of a religious or tribal leader or of any sectarian significance.

(2) Except with the consent of the interested third party the following marks are not registerable:

a) Marks which resemble, in such a way as to be likely to mislead the public, a mark already validly filed or registered by a person validly claiming priority, in respect of the same goods, or of other goods in connection with which use of such marks might be likely to mislead public.

b) Marks which constitute a reproduction, in whole or in part, an imitation, a translation, or a transcription, likely to mislead the public, a mark which is well known in the country and belongs to a third party.

c) Marks which infringe other third party rights or are contrary to the rules for the prevention of unfair competition.

Application for Registration

9. (1) The application for registration of a mark shall be made to the Registrar in the prescribed forms and shall contain:

A. Request for the registration of the mark,

B. The complete name and address of the applicant and, if the applicant is outside the country, his application must be lodged through an approved agent as is required by Section 15 of this Act.

(2) If the application is filed through an agent, other than a member of the Sudanese Bar, it shall be accompanied by a power of attorney signed by the applicant.

(3) If an application is incomplete, and not completed within three months from its filing, the Registrar may, after giving notice of the non-completion to the applicant in writing in the prescribed manner, consider the application as abandoned unless it is complete within the time specified in such notice.

Particulars of Application

10.(1) On application for the registration of a trade mark the applicant shall state his nationality, and as proof thereof every such application shall, subject to subsection (3) hereof, be accompanied by a certificate of incorporation, certificate of partnership registration, extract from an official commercial register, or such other document as shall satisfy the Registrar.

(2) On application to record the assignment of a trade mark the assignee, as proof of his nationality, shall subject to subsection (3) hereof submit along with the application to record the assignment a certificate of incorporation, extract from an official commercial register, or such other document as shall satisfy the Registrar.

(3) When such certificate, extract, or other document is already on file at the Registry the Registrar may dispense with its being furnished again, provided however he may in any particular case require it to be furnished again. If the certificate, extract, or other document is not either in Arabic or English, a certified translation of it into Arabic or English must be supplied.

(4) Before the issue of a certificate of registration of a trade mark the applicant shall furnish to the Registrar a declaration on oath that his

nationality has not changed since he lodged with the Registrar his application for the registration of the trade mark.

Rival Claims to Identical Marks

11. Where each of several persons claims to be proprietor of the same trade mark, or of nearly identical trade marks in respect of the same goods or description of goods, and to be registered as such proprietor, the Registrar shall refer the issue to the Court, which in determining the right of the parties shall have regard to the date of the registration in the country of origin, and the priority of user of the mark in the Sudan.

International Arrangements

12. (1) If at any time Republic of Sudan shall become a party to any international convention for the mutual protection of trade marks, then any person who has duly filed a first application for registration of a mark in another State party to such connection, or his successor in title, shall, on his request, be deemed to have applied for registration in the Republic of Sudan on the day of such first application, provided that the application in the Republic of Sudan is made within six months from the first application and provided that the registered owner of the mark shall not be entitled to recover damages for infringement prior to the date on which the mark is registered in the Republic of Sudan.

(2) The application for registration of a mark who wishes to avail himself of the right of priority referred to in the preceding subsection, shall do so in the prescribed manner.

Validity and Reclassification

13. Trade Marks which have been advertised in the Gazette under the provisions of the Trade Marks Ordinance 1931 herein before repealed, shall be deemed to be registered under this Act, provided that the registered owner of such trade mark or his agent makes an application to the Registrar in the prescribed from and upon payment of the prescribed fee within five years from the date at which this Act comes into force for the purpose of reclassification in accordance with the Schedule to the Trade Marks Rules.

Application for Registration

14. (1) An application for registration and an opposition to registration and all other communications between an applicant, an opponent, and the Registrar, and between the registered owner of a trade mark and the Registrar or any other person, may be made by or through an agent.

(2) Any such applicant, opponent, or owner may appoint an agent to

represent him in the matter of the trade mark by sending to the Registrar a signed authority to that effect. In case of any owner of a registered trade mark shall be deemed to be service upon the person so appointing him.

(3) In case of non-residents, applications for registration opposition or any other correspondences or communications shall be made through an approved agent as is provided by Section 15 of this Act.

Qualifications of an Agent

15. (1) The following are eligible to act as marks Agent:

a) Sudanese advocates practicing in Sudan;

b) Sudanese Chartered and certified accountants, practicing in the Sudan;

c) With the written consent of the Minister which may be withdrawn at any time and subject to such conditions as he may think fit.

(2) The Registrar shall not be bound to recognize as such agent any person who has been convicted by a criminal Court or struck off the Roll of Advocates or has been retrained from acting as a chartered or a certified accountant.

Registrar's Power to Refuse, Accept, Amend, or Modify Application for Registration

16. (1) The Registrar may refuse the application for the registration of a trade mark or may accept it absolutely or subject to conditions, amendments, or modifications, or to such limitations, if any as to mode or place of use or otherwise as he may think right to impose, subject to the provisions of this Act.

(2) Any refusal by the Registrar to register a mark or any condition, amendment, modification or limitation imposed by him shall be subject to appeal to the Court.

Publication

17. When an application for registration of a trade mark has been accepted, whether absolutely or subject to conditions and limitations, the Registrar shall, as soon as possible be advertised in the prescribed manner, which advertisement shall set forth all conditions and limitations subject to which the application has been accepted.

Opposition to Registration

18. (1) When an application is advertised as accepted any interested person resident in the Sudan, may, within six months from the date of such advertisement oppose the registration of the trade mark. Any person outside the Sudan may also within eight months from the date of advertisement of an application for the registration of a trade mark, file with the registrar an opposition to such registration on any of the following grounds:

(a) That the mark is not entitled to registration under the provisions of this Act.

(b) That the mark has been obtained by fraud.

(c) That at the date application there was no bona fide intention to use the mark or that the applicant has effectively abandoned his mark.

(2) Any opposition to the registration of a mark has to be filed in the applicant has effectively abandoned his mark.

(3) The Registrar shall send a copy of the notice of opposition to the applicant for registration and within the prescribed time after receipt thereof the application shall send to the Registrar, in the prescribed manner, a counter- statement of the grounds on which he relies for his registration, and if he does not so, he shall be deemed to have abandoned his application.

(4) If the applicant sends a counter-statement as aforesaid the Registrar shall furnish a copy thereof to the person having given notice of opposition. The Registrar shall after hearing the parties if so required, and subject to what conditions, amendments, registration is to be permitted.

(5) In any hearing as aforesaid before the Registrar the evidence shall be given by affidavit, but in any case in which the Registrar thinks it right to do so he may take evidence viva voce in lite or require addition to the evidence by affidavit.

(6) The decision of the Registrar shall be subject to appeal to the Court.

(7) If no opposition is filed within the prescribed period or after final decision of the Registrar or the Court granting registration, the Registrar shall subject to conditions, amendments, modifications or limitation if any, proceed to register the mark and shall issue a certificate of registration under his hand in the prescribed manner. The mark when registered shall be registered as on date of the application and such date shall be given for the purposes of this Act to be the date of registration.

Duration of Registration and Renewals

19. (1) The period of duration of the registration of a trade mark shall be ten years from the date of registration. At any time within six months before the expiration of such term or any subsequent term of ten years, the registration may be renewed upon the filing of an application therefore in the prescribed form and upon payment of the prescribed fee.

(2) At the time of renewal, no change may be made in the mark or in the list of goods in respect of which the mark is registered, except that goods may be eliminated from the list.

(3) A period of grace of six months shall be allowed for the renewal of a registered trade mark after its term has expired, subject to the payment of an extra charge for the delay as prescribed.

(4) For the purpose of Section 22 of the Act the duration of the registered user shall not in any case exceed that of the mark itself.

Rights Conferred by Registration

20. Registration of the mark shall confer upon its registered owner the right to preclude third parties from the following acts:

(a) Any use of the mark, or of a sign resembling it in such a way as to be likely to mislead the public, for goods in respect of which the mark is registered, or for other goods in connection with which the use of the mark or sign is likely to mislead the public.

(b) Any other use of the mark, or of a sign a trade name resembling it, without just cause and in conditions likely to be prejudicial to the interest of the registered owner of the mark.

Assignment and Transfer of Registration

21. (1) A trade mark may be assigned or transferred independently of the transfer of all or part of the business of the owner as regards all or part of the goods for which it is registered, provided however, that the mark shall be used by the assignee so that no deception or confusion is involved.

(2) The assignment must be recorded, at the instance of either party, within a period of six months from the date of the instrument and upon payment of the prescribed fee. On failure of such recorded the assignment will be null and void. On receipt of the application for assignment or transmission and on proof of title to his satisfaction the Registrar shall cause an entry to be made on the Register of assignment. Any decision of the Registrar under this Section shall be subject to appeal to the Court.

Licensing

22. (1) Where a trade mark is or be used with the consent of the registered owner, by other physical or juristic person, such used is deemed as may be the registered owner, provided that the relations or arrangements existing between the registered owner of the user ensure an effective control by the owner of the use of the trade mark with respect to the nature and quality of the goods and provided that the trade mark is not used in such a manner as to deceive the public.

(2) Arrangements relating to the use of a registered trade mark by related persons must be recorded, at the instance of either part, within a period of six months from the date of the instrument and upon payment of the prescribed fee and the Registrar shall issue a certificate of registration under his hand in the prescribed from. The registration shall be as from the date of application and its duration shall not in any case exceed that of the mark itself. On failure of such recorded, the license shall be null and void.

(3) (a) The Minister may, by order, provide that agreements concerning the use of trade mark by related persons, and amendments or renewals of such agreements, which involve the payment of royalties abroad shall require his approval, taking into account the needs of the country and its economic development.

(b) The transfer of royalties abroad shall be subject to existing currency regulations.

Renounciation of Registration

23. The registered owner of a trade mark may renounce the registration, either wholly or in part of the goods for which the mark is registered, in the prescribed manner and upon payment of a publication fee as prescribed.

Cancellation of Registration

24. The cancellation of the registration of a trade mark shall be ordered by the Court on the request of any interested person or the Registrar:

(a) If the mark was not entitled to registration under the provisions of this Act, provided that grounds which no longer existed at the time of the decision shall not be taken into account.

(b) If the mark has been obtained by fraud.

(c) If the mark has, without legitimate reason, not been used in the Republic of Sudan, after registration, during five consecutive years preceding the regarding the allegation of non-use. The burden of proof regarding the allegation of non-use of the mark or the use of it shall be

decided by the Court according to the circumstances of the case.

Provisions on Service Marks

25. Provisions of this Act shall apply to Service Marks with respect to services designated in the registration.

Prima Facie Evidence of Validity

26. In all legal proceedings relating to a registered trade mark the fact that a person is registered as owner of such trade mark shall be prima facie evidence of the validity of the original registration of such trade mark and all subsequent assignments and transactions of the same.

Offences and Infringements

27. (1) Any person who represents a trade mark as registered in the Republic of Sudan which is not so, shall be liable for every offence to a fine not exceeding Ls. 200.

(2) No person shall be entitled to recover damages for the infringement of a trade mark not registered in the Republic of Sudan.

(3) In an action for infringement of trade mark the Court trying the question of infringement shall admit evidence of the usage of the trade in respect of the get-up of the goods for which the trade mark is registered and of any trade marks or get-up legitimately used in connection with such goods or by other persons.

(4) No registration under this Act shall interfere with any genuine use by a person of his own name or place of business or that of any of his predecessors in business or the character or the quality of his goods.

(5) Nothing in this Act shall be deemed to affect the right to bring an action against any person for unfair competition in respect of his trade or the remedies in respect thereof.

(6) Any person who, with intent to deceive, commits or attempts to commit, aide or abets any other person in committing any of the following acts, shall be guilty of an offence against this act and shall be liable upon conviction to imprisonment for a period not exceeding one year or with a fine not exceeding Ls.500 or with both.

(a) Uses a trade mark duly registered by another person under this Act, or an imitation of such trade mark, for goods in respect of which the mark is registered.

(b) Sells, stores for the purpose of sale or exposes for sale goods bearing

a mark the use of which is an offence under paragraph (a).

(c) Uses a mark duly registered by another person under this Act for the purpose of advertising in the public press or in any other manner, goods in respect of which the mark is registered.

(d) Marks, engraves, prints, or sells, any plate, dye, block or other representation of a mark duly registered by another persons, or any imitation thereof for the purpose of enabling any person other than the registered owner of such mark to make any use of such mark which is an offence under subsection (a), (b) and (c).

(e) Marks, packs or wraps, sells, store for the purpose of sale or exposes for sale, goods so got-up, packed, wrapped or otherwise prepared as to lead intending purchasers to believe that they are goods of another manufacturer or for the purpose of this subsection it shall be immaterial whether the goods, the packing, wrapping or get-up of which is imitated, bear a duly registered trade mark or not.

(f) To make direct or indirect use of a false or deceptive indication of origin even if the true origin of the product is indicated or if the indication of origin is accompanied by terms such as “kind”, “type,” “make,” “limitation” or the like.

(g) Imports any goods bearing a mark which would constitute an infringement of a duly registered mark or imports goods so got-up, wrapped, packed or prepared as to enable such goods to be passed off as the goods of another manufacturer.

(7) The Court before which any person charged under the foregoing subsection is brought, may order that all goods, wrapping, packing and advertising material, and blocks discs, and other apparatus and material for printing the mark or packing, wrapping advertising or other material in respect of which the offence is committed, be confiscated and destroyed.

Cognisance of Offences

28. Offences against this Act shall be tried a Court of a Magistrate of first class or by any superior Court.

Power of Minister

29. (1) Subject to the provisions of this Act the Minister may from time to time make such Rules, prescribe such forms, and generally do such things as he may think expedient: -

(a) for regulating the procedure under this Act.

(b) For classifying goods and service for the purpose of registration of trade marks.

(c) With the consent of the Minister of Finance and Economics for the fixing of fees payable under this Act.

(d) For making or requiring duplicates of trade marks and other documents.

(e) For securing and regulating the publishing and selling or distributing in such manner as the Registrar think fit, of copies of trade marks and other documents.

(f) Generally for regulating the business of the registry in relation to trade marks and all things placed by this Act under the direction or control of the Registrar.

Sequestration of Marks

30. When the registered owner of any trade mark is or becomes a national of a boycotted country all his rights in the trade mark shall cease and be sequestrated and shall vest in the Minister, as custodian thereof. The Minister shall have power to deal with any such trade marks in any manner whatsoever, and in particular he may transfer them and all rights therein to any person upon such terms and conditions as he may think fit.

Applications by Non-Residents

31. Applications by non-residents to the Registrar for assignments, transmissions, renewals, hearings and all matters relating to this Act may be made through an agent.