

Laid on table by Hon. Fredrick Ruhu
Deputy Attorney General / Minister of State
~~Justice and Constitutional~~

**BILLS
SUPPLEMENT No. 1**

18th January, -

BILLS SUPPLEMENT

28/21

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Bill No. 3

Geographical Indications

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THE GEOGRAPHICAL INDICATIONS BILL, 2008

★ 24 FEB 2012 ★

MEMORANDUM.

ACC. No:

CALL No:

1. The object of this Bill is to provide for the regulation and registration of geographical indications, duration of protection of geographical indications and remedies for infringement or prohibited use of geographical indications and for related purposes.
2. Uganda currently does not have any legislation governing geographical indications.
3. Geographical indications are protected in accordance with national laws and under a wide range of concepts, such as laws against unfair competition, consumer protection laws, laws for the protection of certification marks or special laws for the protection of geographical indications or appellation of origin. In essence, unauthorised parties may not use geographical indications if that use is likely to mislead the public as to the true origin of the product.
4. The Bill therefore seeks to provide for the regulation and registration of geographical indications.
5. The Bill defines a geographical indication as any indication which identifies a good as originating in a particular country, region or locality where a given quality, reputation or other characteristic of the goods is essentially attributable to its geographic origin.

209

PART I—PRELIMINARY

Part I of the Bill provides for preliminary matters including the commencement, application of the Act and interpretation.

PART II—PROTECTION OF GEOGRAPHICAL INDICATIONS

7. Part II of the Bill deals with description and presentation of goods and the use of geographical indications in the designation or presentation of goods.

8. Clause 5 provides for prohibited acts that relate to geographical indications. For instance, the clause prohibits use of geographical indications to create confusion and false allegations in the course of trade about geographical indications.

9. Clauses 6 and 7 provide for designation of a registrar and a register of geographical indications respectively. Clause 7 provides that in determining whether a geographical indication is registrable, the registrar shall consider quality, reputation or other characteristics attributable to natural factors or human factors or a combination of natural or human factors.

10. Clause 8 provides for application for registration of a geographical indication in a prescribed form and the for prescribed fee.

11. Clause 9 provides that the registrar shall cause the application for registration of a geographical indication to be examined and if the conditions for registration are met, shall enter it in the register and issue a certificate of registration. Where conditions for registration are not met, the applicant is invited to amend the application but where the conditions are not met, the application shall be rejected.

12. Clause 10 provides for appeal from a decision of the registrar where an application is rejected.

13. Clause 11 provides for removal from the register or alteration of conditions of registration of geographical indications by any interested person and the person must set out the reasons for the proposed removal.

14. Clause 12 provides for invalidation of a geographical indication by any interested person and the procedure for invalidation shall be as prescribed for invalidation or rejection of registration of trademarks.

15. Clause 13 provides for the right to institute proceedings to prevent the unlawful use of geographical indications.

16. Clause 14 provides for the term of protection of a geographical indication which shall be ten years from registration and may be renewed by application for a period of ten years for an unlimited number of times.

17. Clause 15 provides that a person holding the right to use the name of the place of origin of goods is entitled to put the name on the goods and the name of the place of origin of goods may be registered by several persons and shall belong to those persons.

18. Clause 16 provides that the right to use a geographical indication shall not be subject to licence or assignment but that the owner of a registered geographical indication may transfer the registration with that part of the business to which it pertains subject to the following conditions—

- (a) the transfer shall be in writing and the request to transfer must be filed with the registrar;
- (b) the transfer shall be reviewed to determine that all material conditions remain unchanged except for the identity of the entity producing the goods that are subject to the registration; and.
- (c) a person shall not acquire the right to use the name of the place of origin of goods on the basis of a licence or assignment.

19. Clause 17 prohibits registration of an exclusive geographical name by the registrar of trademarks.

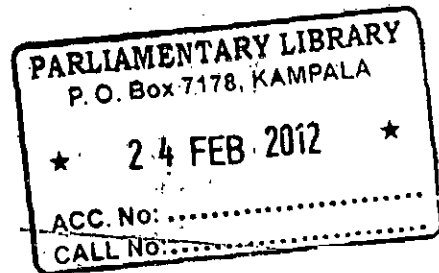
20. Clause 18 provides for protection of a certification mark which indicates the certification of the geographic origin of goods. The protection provided shall be as provided for geographical indications.

Clause.

PART IV—MISCELLANEOUS

24. Fees
25. Regulations
26. Power of Minister to amend Schedule

SCHEDULE—CURRENCY POINT



A Bill for an Act

ENTITLED

THE GEOGRAPHICAL INDICATIONS ACT, 2008.

An Act to provide for the protection and registration of geographical indications; to provide for the duration of protection of geographical indications; to provide for the appointment of a registrar; for remedies for infringement or prohibited use of geographical indications; and for related matters.

BE IT ENACTED by Parliament as follows:

PART I—PRELIMINARY.

1. Commencement.

This Act shall come into force on a date to be appointed by the Minister by statutory instrument.

2. Application of Act.

This Act applies to any natural or legal person, including any individual, government agency, firm, association, partnership, corporation, joint stock company, syndicate, receiver, common law trust, conservator, statutory trust, or any other concern by whatever name known or however organised, formed or created and includes not-for-profit corporations, associations, educational and religious institutions, political parties, community, civic, or other organisations.

3. Interpretation.

In this Act, unless the context otherwise requires—

“certification mark” means a mark on a commercial product which legally enables bounding and indicates the following—

- (a) the existence of a legal follow up or product certification agreement between the manufacturer of a product and an organisation that possesses accreditation by a national government for both testing and product certification;
- (b) legal evidence that the product was successfully tested in accordance with a nationally accredited standard;
- (c) legal assurance that the accredited certification organisation has ensured that the item that was successfully tested is identical to that which is offered for sale;
- (d) legal assurance that the successful test has resulted in a certification listing which is considered public information and sets out the tolerances and conditions for use of a certified product to enable bounding; and
- (e) legal assurance that the manufacturer is regularly audited by the certification organisation at unannounced intervals to ensure the maintenance of the original standard that was employed in the manufacture of the test specimen that passed the test;

“commercial use” means any use in connection with the sale, rental, lease, barter or any other transaction involving valuable consideration or offering or advertising of items;

“court” means the High court;

“currency point” has the value given to it in the Schedule to this Act;

“geographical indication” means any indication which identifies goods as originating in a particular country, region or locality where a given quality, reputation or other characteristic of the goods is essentially attributable to its geographic origin;

“goods” means a natural or agricultural product or animal product or a product of handcraft or industry;

“Minister” means the minister responsible for justice;

“producer” means—

(a) ~~a producer of agricultural products or a person exploiting natural products;—~~

(b) a manufacturer of products of handcraft or industry; and

(c) a trader dealing in the products referred to in paragraphs (a) and (b).

“register” means the register of geographical indications maintained under section 7;

“registrar” means the registrar of geographical indications designated under section 6;

“substantially similar” means the existence of common or similar elements with a protected geographical indication to the extent that it leads to confusion of the public or that portion of the public concerned with the product;

“unfair competition” means any act of competition contrary to honest practices in industrial or commercial matters;

“use” means use in any way, including without limitation, use as part of or in connection with—

(a) any transaction, including a purchase, sale, gift, or exchange;

(b) any importing or exporting;

(c) any advertisement; or

(d) any other related activity.

PART II—PROTECTION OF GEOGRAPHICAL INDICATIONS

4. Reference to description or presentation of goods.

In this Act, a reference to the description or presentation of goods includes a reference to a name, address, place, sign, design, trademark or other matter used in relation to the goods whether or not it appears—

- (a) on a container, wrapping or label or on the goods;
- (b) on a document relating to the use, or a transaction involving the transport of the goods; or
- (c) in an advertisement relating to the goods.

5. Similarity of geographical indication and prohibitions.

(1) A person shall not use a geographical indication in the designation or presentation of goods—

- (a) where the designation or presentation suggests that the goods originate in a geographical area other than the true place of origin;
- (b) where the use constitutes an act of unfair competition; and
- (c) where the goods do not originate in the territory indicated by the geographical indication, even where the true origin of the goods is indicated or the geographical indication is used in translation or accompanied by expressions such as “kind”, “type”, “style”, “limitation”.

(2) The following acts as they relate to geographical indications are prohibited—

- (a) use of geographical indications of such a nature as to create confusion with the establishment, the goods or the industrial or commercial activities of a competitor;

- (b) false allegations, in the course of trade, about geographical indications where the allegations are of such a nature as to discredit the establishment, the goods or the industrial or commercial activities of a competitor; or
- (c) geographical indications or allegations regarding ~~geographical indications, the use of which in the course of trade is likely to mislead the public as to the nature, the manufacturing process, the characteristics, the suitability~~ for their purpose or the quantity of the goods.

(3) The following differences shall not be taken to prevent a geographical indication from being substantially similar to another geographical indication—

- (a) translation into a different language;
- (b) grammar or spelling; or
- (c) type, font, colour or incorporation with graphical elements of other aspects of presentation.

6. Designation of registrar.

(1) The Minister shall designate a registrar of geographical indications.

(2) The registrar shall have a seal of such device as may be approved by the Minister but until the seal has been obtained, a stamp in a form that the Minister may approve shall be used instead of the seal.

(3) Impressions of the seal or stamp shall be judicially noticed.

(4) Any act or thing directed to be done by or to the registrar may be done by or to any officer authorised by the Minister.

7. Register of geographical indications.

(1) The registrar shall establish and maintain a register of geographical indications and shall receive applications for registration.

(2) A geographical indication shall be entered on the register where—

- (a) the indication identifies the goods to which the indication pertains and identifies the goods as originating in a particular country, region or locality;
- (b) a given quality, reputation or other characteristic of the goods is essentially attributable to its geographic origin;
- (c) as applied to the goods identified in the application, the indication does not contravene the provisions of this section; and
- (d) an application for registration is filed with the registrar in the prescribed form.

(3) In determining whether a geographical indication is registrable, the registrar shall consider quality, reputation or other characteristics attributable to natural factors or human factors or a combination of natural factors and human factors.

(4) The name of the place of origin of goods may be a traditional or historical name of the country, region or locality that is the place of origin of the goods.

(5) Registration of a geographical indication shall be prima facie evidence that the owner of the registration is entitled to use the registered geographical indication on the goods described in the application and that the goods originate from the place stated in, and have the qualities described in the registration.

8. Application for registration.

(1) An application for the registration of a geographical indication shall be made in the prescribed form and shall be accompanied by the prescribed fee.

- (2) The application referred to in subsection (1) shall specify—
 - (a) the name, address and nationality of the applicant and the capacity in which the applicant is applying for registration;
 - (b) the geographical indication for which registration is sought;
 - (c) the geographical areas to which the geographical indication applies;

- (d) the goods for which the geographical indication applies; and
- (e) the quality, reputation or other characteristic of the goods for which the geographical indication is used.

9. Examination of application.

(1) The registrar shall cause the examination of the application referred to in section 8 in accordance with regulations made under this Act and where the conditions for registration referred to in section 8 are met, shall enter the geographical indication on the register and issue a certificate of registration.

(2) Where the registrar finds that conditions for registration have not been met, the applicant may be invited to supplement or amend the application, in accordance with regulations made under this Act.

(3) Where the applicant fails to meet the conditions for registration, the application shall be rejected.

10. Appeal from decision of registrar.

An applicant whose application is rejected by the registrar may appeal to the court in the same manner as for trademarks under the law regulating the registration of trademarks.

11. Removal from register or alteration of conditions.

(1) A person may apply to the registrar for the removal from the register or alteration of the conditions of registration of a registered geographical indication.

(2) The application referred to in subsection (1) shall be in the prescribed form, shall set out the reasons for the proposed removal or alteration and shall be accompanied by the prescribed fee.

12. Invalidation of geographical indication.

(1) A person may apply to the court to invalidate a geographical indication on the ground that one or more of the conditions for protection have not been met or have ceased to exist.

(2) The procedure for invalidation of a geographical indication shall be as prescribed for invalidation or rejection of registration of a trademark under the law regulating the registration of trademarks.

13. Right to institute proceedings.

(1) The owner of a registered geographical indication has the right to institute proceedings in court to prevent the unlawful use of a geographical indication.

(2) The owner of a registered geographical indication has the right to—

- (a) demand that a person who is unlawfully using a geographical indication discontinue its use;
- (b) remove the unlawfully used geographical indication or a geographical indication that is substantially similar, from the goods, their packaging, forms and other documentation;
- (c) demand for the destruction of the imprints of geographical indication or marking that is substantially similar to it; or
- (d) if it is impossible to perform the acts referred to in paragraphs (a) to (c), withdraw and destroy the goods or their packaging.

(3) The owner of a registered geographical indication is entitled to demand from any person who infringes on his or her rights, compensation for the infringement suffered.

14. Term of protection.

(1) Registration of a geographical indication shall be effective for a period of ten years from the date of registration.

(2) Registration may be renewed for a period of ten years for an unlimited number of times, by filing an application for renewal during the final year of the term.

(3) An application for renewal shall be made in the prescribed form and shall be accompanied by the prescribed fee.

15. Use of name of place of origin.

Notwithstanding section 14—

- (a) a person holding the right to use the name of the place of origin of goods is entitled to put the name on goods, packaging, advertisements, signboards, billboards or otherwise to the commercial use of the name in connection with those goods;
- (b) the name of the place of origin of goods may be registered by several persons either jointly or independently of each other; and
- (c) the right to use the name of the place of origin of goods shall belong to the persons referred to in paragraph (b) and the persons may mark the goods with the name of the place of origin of the goods where the marking is not in contravention of section 17.

16. Prohibition of licence or assignment of geographical indication or name of place of origin.

(1) The right to use a geographical indication shall not be subject to licence or assignment.

(2) The owner of a registered geographical indication may transfer the registration with that part of the business to which it pertains, subject to the following conditions—

- (a) the transfer shall be in writing and a request to transfer the registration shall be filed with the registrar; and
- (b) the transfer shall be reviewed in accordance with regulations made under this Act to determine that all material conditions remain unchanged except for the identity of the entity producing the goods that are subject to the registration; and where no differences are noted, the transfer will be recorded and a corrected certificate issued,

and if not, the transfer will be refused, subject to the right of the new owner of the business to file an original application to register the geographical indication.

(3) The right to use the name of the place of origin of goods shall not be subject to transfer, licence or assignment.

17. Prohibition of registration of exclusive geographical name.

(1) The registrar of trademarks shall refuse to register a mark that consists exclusively of a geographical name unless the mark is determined to be distinctive by the registrar of trademarks or by the court.

(2) The registration of a trademark for wines which contains or consists of a geographical indication identifying wines, or of a trademark for spirits which contains or consists of a geographical indication identifying spirits, shall be refused or invalidated by the registrar on the registrar's motion or at the request of an interested party with respect to the wines or spirits not having that origin.

18. Protection of certification mark.

(1) A certification mark shall be subject to the protection provided for geographical indications.

(2) An application to register a certification mark may, upon the request of the applicant, be freely converted to an application to register a geographical indication.

(3) An application to register a geographical indication may, upon request of the applicant, be freely converted to an application to register a certification mark.

(4) The conversion of an application under subsection (2) or (3) is subject, in each case, to the payment of the prescribed fee and examination in accordance with regulations made under this Act for the registration requested.

19. Use of person's name.

This Act shall not prevent a person from using, in the course of trade, that person's name or the name of the person's predecessor-in-title, except where the name is used in such a manner as to mislead the public.

PART III—REMEDIES FOR UNLAWFUL USE OF GEOGRAPHICAL INDICATIONS

20. Civil action.

(1) Except as expressly provided to the contrary, any person who uses, in Uganda, a geographical indication in a manner specified under section 5 is liable in a civil action by any person aggrieved by use or by the owner of the geographical indication.

(2) A person aggrieved by the use of a geographical indication referred to in subsection (1) is entitled to request that the court issue an order—

(a) prohibiting the defendant from further use of the geographical indication; and

(b) where applicable, granting any of the remedies specified under section 22.

(3) The owner of a geographical indication is entitled to recover—

(a) the defendant's profits attributable to the infringement; and

(b) any damages he or she has sustained attributable to the infringement.

(4) There shall be no double recovery for profits under subsection (3)(a) and damages under subsection (3)(b).

(5) In assessing profits, the plaintiff shall be required to prove the defendant's sales only and the defendant shall prove all elements of cost or deduction.

(6) In assessing damages, the court may enter a judgment for a sum above the amount found as actual damages not exceeding three times the amount.

(7) Where the court finds that the amount of recovery based on profits is either inadequate or excessive, the court may, in its discretion, enter judgment for the sum as it determines is fair according to the circumstances of the case.

21. Orders of court.

Except as expressly provided to the contrary, the use in Uganda of a geographical indication in a manner specified under section 5 shall be punishable as follows—

- (a) for commercial use, by a fine not exceeding forty eight currency points;
- (b) for repeated offences, the court may order a fine not exceeding one hundred and forty currency points; and
- (c) by imprisonment for a term not exceeding two years where the court finds that—
 - (i) the offence has resulted in harm to individuals or damage to property; or
 - (ii) the person committing the offence has previously been fined for contravening section 5.

22. Remedies.

(1) The court may make an order for the seizure, confiscation, forfeiture or disposal of items upon which a geographical indication is placed or used in contravention of section 5, including materials and implements, the predominant use of which has been in the commission of violation, without compensation or any payment to the person from whom they have been taken.

(2) Where the court in a civil action finds that a registered geographical indication has been used in contravention of section 17, the court may make an order requiring the delivery of the following items to the court or to the plaintiff for destruction—

- (a) labels;
- (b) signs;
- (c) prints;
- (d) products;
- (e) packages;

- (f) wrappers;
- (g) receptacles;
- (h) advertisements; and
- (i) ~~other material~~ in the defendant's possession or control that bear the registered geographical indication.

(3) The court shall, in addition to an order in subsection (1) and (2), make an order requiring the delivery of a counterfeit or copy of the registered geographical indication including any materials and implements, the predominant use of which has been the contravention, without compensation to the owner or any payment to the person from whom they have been taken.

(4) The court may order the closure of business, the predominant activity of which has involved the contravention of section 5.

(5) The court may issue a public notice of the order referred to in subsection (4) by publication in a newspaper of wide circulation.

(6) The court may permit the business referred to in subsection (4) to be reopened upon proof by the owner of the business that he or she has taken steps to conduct the activities of the business without contravening section 5.

23. Suspension of importation of goods in violation.

(1) A person who has reason to suspect that goods may be imported in contravention of section 5 may file a written petition to the court for a temporary order requiring the Uganda Revenue Authority to suspend the importation of the goods.

(2) Subsection (1) shall not apply to the importation of small quantities of goods of a non-commercial nature.

(3) The owner, importer or consignee of goods the entry of which has been prohibited under this section may appeal to court.

(4) The temporary order referred to in subsection (1) shall not be effective until the petitioner submits a bond, warranty, surety or other security in an amount sufficient to indemnify the owner, importer or consignee of the goods for any damage for wrongful detention of the goods.

(5) An order suspending importation shall not have continuing effect unless proceedings leading to a decision on the merits of the case is filed by a person other than the defendant, in court within ten working days following notice to the petitioner and the importer of the goods.

(6) The court may extend the period referred to in subsection (5) by an additional ten working days.

PART IV—MISCELLANEOUS

24. Fees.

There shall be paid in respect of applications, registration and other matters under this Act, such fees as may be prescribed by the Minister by statutory instrument.

25. Regulations.

(1) The Minister may make regulations prescribing all matters that are required or permitted by this Act to be prescribed for giving effect to the purposes of this Act.

(2) Notwithstanding the Interpretation Act, regulations made under this section may prescribe, in respect of a contravention of the regulations, that the offender is liable to a fine not exceeding forty eight currency points, or to imprisonment for a term not exceeding two years, or both.

26. Power of Minister to amend Schedule.

The Minister may, with the approval of Cabinet, by statutory instrument, amend the Schedule to this Act.

SCHEDULE.

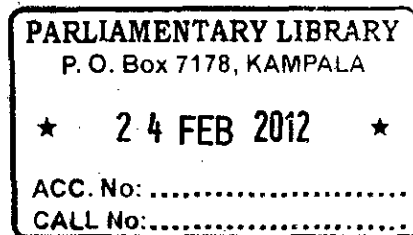
S. 3, 26

CURRENCY POINT

A currency point is equivalent to twenty thousand shillings.

Cross References

Interpretation Act, Cap. 2



201