

Trademark Act

(1969 Act No.8)

Pursuant to the provisions of 1969 law, the Sudanese legislator regulates the protection of the trademarks. Articles from 1-5 include definitions such as, the court, the trademark and service mark. They indicate the place of origin and the trademarks register. Then the rest of the articles indicate the registration, the protection period and its renewal, the mark assignments, offences peculiar to trademarks and how to solve them and the competent courts as well

Be it hereby enacted by the Constituent Assembly in accordance with the Sudan Transitional Constitute (Amended 1964) as follows:

Article (1)

Title

This Act shall be cited as "The Trademarks Act of 1969".

Article (2)

Repeal

The Trademarks Law of 1931 shall be repealed.

Article (3)

Definitions

In this Act, unless the context otherwise indicates, the following words shall have the meanings assigned to them respectively:

"The Court" shall mean the High Court.

"Trademark" shall mean 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 its use is not admissible, a trademark may consist of any distinctive sign, including a word, name, pseudonym, device, brand, arbitrary or fictional designation, heading, label, ticket, signature, letter, numeral, slogan, package, emblem, container or any combination thereof.

"Service Mark" shall mean any visible sign used or proposed to be used to distinguish the services of a person from those of others.

"Indication of Origin" shall mean expression, sign or service produced in a given country or group of countries, region or locality.

"Minister" shall mean the Minister of Supply and Internal Commerce.

"Prescribed" shall mean prescribed by this Act or by Orders or Rules or Regulations made under this act.

Article (4)

Register Of Trademarks

1. There shall be kept for the purposes of this Act, a register of trademarks wherein shall be entered all registered trademarks with names and addresses of their owners, notifications of assignments, the names and addresses of all registered beneficiaries, disclaimers, conditions, limitations, renewals, renunciations, cancellations, and such other matters relating to trademark as may be prescribed.

2. The Register shall be kept at the office of the Commercial Register at the Ministry of Supply and Internal Commerce in Khartoum or at such other places as may be appointed by the Minister by an Order published in the Official Gazette.

Appointment Of The Registrar

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

Article (5)

Trademark Shall Be Registered For Particular Goods

1. A trademark shall be registered for the particular goods for which the mark will be used, with an indication of the appropriate class, as set out in the classification of goods in the schedule to the Trademark Rules made under this Act, provided that one and the same registration cannot validly cover all the goods in one class.
2. Any question as to the class within which any goods fall shall be decided by the Register.

Article (6)

Public May Inspect & Obtain Certified Copies Of Entries

1. The Register kept under this Act shall at all convenient times be open for inspection by public subject to such rules which 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.

Article (7)

Registration Of Trademark & Priority

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 a mark shall validly be granted only to the person who has first fulfilled the conditions for a valid application or who is the first to claim validly the priority for such application.
3. Trademarks may be registered with limitations as to colours to be used thereon.

Article (8)

Restriction On Registration

- (1) The following cannot be registered as trademark:
- (a) Marks which consist of shapes or forms imposed by the inherent nature of the goods or by their industrial functions.
 - (b) Marks which consist exclusively of a sign or an 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 current in language or commonly used in the trade of the country as a customary designation for goods in particular.
 - (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 opinion as to the nature, the source, the manufacturing process, the characteristics or the suitability for their purpose, of the goods concerned.
 - (e) Marks which resemble or imitate armorial bearing, flags and other emblems, initials of names of any State or the names of any state or 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 resemble 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 any sectarian significance.

(2) Except with the consent of the concerned third party, the following marks are not registrable:

(a) Marks which resemble, in such a way as to be likely to mislead the public, a mark already filed or registered by a third party or 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 the public.

(b) Marks which constitute a reproduction, in whole or in part, an imitation, a translation, or a transcription, likely to mislead the public opinion, of 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 repression of unfair competition.

Article (9)

Application For Registration

(1) The application for registration of a mark shall be made to the Registrar in the prescribed form and upon payment of the prescribed fees and shall contain:

(a) request for the registration of a 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 Article 15 of this Act.

(2) If the application is filed through an agent, other than a member of the Bar association, 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 date, 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 completed within the time specified in such notice.

Article (10)

Particulars Of Application

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

(2) On application to record the assignment of a trademark the assignee, as proof of his nationality, shall subject to paragraph (3) hereof submit along with the application to record the assignment a certificate of incorporation, certificate of partnership registration, extract from an official commercial register, or any other document as will satisfy the Register.

(3) When such certificate, extract, or document is already on file at the Register the Registrar shall 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 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 trademark, the applicant shall furnish the Registrar with a declaration on oath that his nationality has not changed since he lodged with the Registrar his application for the registration of the trademark.

Article (11)
Rival Claims Of Identical Marks

Where each of several persons claims to be proprietor of the same mark, or of nearly identical trademark in respect of the same goods or class of goods, and to be registered as such proprietor, the Registrar shall refer the issue to the Court which is determining the rights which the parties will have with regard to the date of the registration in the country of origin and the priority of use of the mark in Sudan.

Article (12)
International Conventions

(1) If at any time the Republic of Sudan becomes a party to any international convention for the mutual protection of trademark, then any person who has duly filed a first application for registration of a mark in another State party to such convention, 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 will not be entitled to recover the damages for infringement prior to the date on which the mark is registered in the Republic of Sudan.

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

Article (13)
Validity & Rearrangement Of Previous Registrations

Trademarks which have been advertised in the Gazette under the provisions of the trademark Law of 1931, which has been repealed on the issuance of this Act, shall be deemed to be registered under this Act, comes into force for the purpose of rearrangement in accordance with Schedule to the Trademark Rules.

Article (14)
Application For Registration & Opposition Of Registration May Be Filed By An Agent

(1) An application of the registration and an opposition to registration and all other communications between the opposition applicant and the Register, and between the registered owner of a trademark and the Registrar or any other person may be made through an agent.

(2) Any such applicant, opposer, or owner may appoint an agent to represent him in the matter of the registration of the trademark by sending to the Register a signed application to that effect. In case any owner of a registered trademark appoints such an agent, such agent of the document relating to such trademark shall be deemed to be serving the person so appointing him.

(3) Any non-resident in Sudan shall submit applications for registration or opposition to registration or any other correspondence or communications through an authorized agent as provided by Article 15 of this Act.

Article (15)
Qualifications Of An Agent

(1) The following are eligible to act as trademark Agents:

- (a) Sudanese Advocates practising 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.

(i) University or Higher Institute Sudanese graduates, who took Commercial law.

(ii) Sudanese who have had at least five years experience in a public or private trademark Office.

(iii) Other persons whom the Minister 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 restrained from acting as chartered or a certified accountant.

Article (16)

Registrar's Authority To Refuse, Accept, Amend Or Modify Application For Registration.

(1) The Registrar may refuse the application for the registration of a trademark 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 may think fit 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.

Article (17)

Advertisement Of Application

When an application for the registration of a trademark has been accepted, whether absolutely or subject to conditions and limitations, the Registrar shall, soon after such acceptance, cause the application as accepted to be advertised in the prescribed manner, such advertisement shall set forth all the conditions and limitations subject to which the application has been accepted.

Article (18)

Opposition To Registration

(1) When an application is advertised as accepted any interested person resident in Sudan may, within six months from the date of such advertisement oppose the registration of the trademark. Any person outside Sudan may also, within eight months from the date of advertisement of an application for the registration of a Trademark, 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 on the date of application there was no intention to use the mark or that the applicant has completely abandoned his mark.

(2) Any opposition to the registration of a mark has to be filed in the prescribed manner.

(3) The Registrar shall send a copy of the notice of opposite to the applicant for registration and within the prescribed time and after receipt thereof the applicant shall send to the Registrars, in the prescribed manner, a counter-statement on the grounds on which he relies for his registration, and if he does not do 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 notice of opposition. The Registrar shall, after hearing the parties if so required, and considering the evidence, decide whether, and subject to what conditions, amendments, modifications or limitations, if any, the registration is to be accepted.

(5) In any hearing as aforesaid in paragraph (4) before the Registrar, the evidence shall be given by affidavit, but in case in which the Registrar thinks it fit to do so, he may take evidence via voice or require an addition to the evidence by an 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 consider the conditions, amendments, modifications or limitations if any or 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 of the date of the application and such shall be given for the purposes of this Act to be the date of registration.

Article (19)

Duration Of Registration & Renewal

(1) The duration of the registration of a trademark 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 shall be renewed upon the filing of an application thereof 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 grace period of six months shall be allowed for the renewal of a registered trademark after its term has expired, subject to the payment of an extra charge for the delay as prescribed.

(4) For the purpose of Article 22 of this Act, the exploitation period of a trademark by another person shall not exceed the registration period of the mark itself.

Article (20)

Rights Conferred By Registration

Registration of the mark shall confer upon its 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 or trade name resembling it, without just cause and in conditions likely to be prejudicial to the interest of the registered owner of the mark.

Article (21)

Assignment & Transfer Of Registration

(1) A trademark shall be assignable or transferable 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 that the mark is used by the assignee so that no deception or confusion should be 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 shall be null and void. When the registrar is satisfied with the procedures of the assignment or transmission, he shall record the same. The Registrar's decision in this course shall be subject to appeal before Courts.

Article (22)

Licensing

(1) Where a trademark is used with the consent of the registered owner, by another juristic person or a corporate body, such use shall be deemed as made by the registered owner, provided that the relations or arrangements existing between the registered owner and the user

ensure an effective control by the owner of the use of the trademark with respect to the nature and quality of the goods and provided that the trademark is not used in such a manner as to deceive the public.

(2) Agreements relating to the use of a registered trademark by related persons must be recorded, at the request of either party, within a period of six months from the date of the agreement and upon the payment of the prescribed fee and the Registrars shall issue a certificate of registration under his hand in the prescribed form. The registration shall be valid 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 licence shall be null and void.

(3) a) The Minister may, by order, provide that, agreements concerning the use of trademark 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 remittance of royalties abroad shall be subject to existing currency regulations.

Article (23) Renunciation Of Registration

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

Article (24) Cancellation Of Registration

The cancellation of registration of a trademark 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 according to Articles 3 and 8 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 reasons, not been used in the Republic of Sudan, after registration for five consecutive years preceding 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

Article (25) Provisions Of The Act To Apply To Service Mark

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

Article (26)

Registration To Be Prima Facie Evidence Of Validity Of Ownership Of The Trademark
In all legal proceedings relating to a registered trademark the fact that a person is registered as owner of such trademark shall be prima facie evidence of the validity of the original registration of such trademark and all subsequent assignments and disposals of the same.

Article (27) Offences & Infringements

- (1) Any person who represents a trademark as registered in the Republic of Sudan which is not so shall be liable, for every offence, to a fine not exceeding 200 SP.
- (2) No person shall be entitled to recover damages for infringement of a trademark not registered in the Republic of Sudan.
- (3) In an action for the infringement of trademark 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 trademark is registered and of any trademark or get-up legitimately used in connection with such goods or by other persons.
- (4) The registration under this Act shall not affect any genuine use by a person of his own name or place of business or the name or place of business of a commodity or the use by any person of any genuine description of 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, aids 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 500.SP or with both.
 - (a) Uses a trademark duly registered by another person under this Act, or an imitation of such trademark, for goods in respect of which the mark is registered.
 - (b) Sells, stores for the purposes of sale or exposes for sale goods bearing a mark the use of which is an offence under sub-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 person, 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 sub-paragraphs (a), (b) and (c).
 - (e) Makes, packs or wraps, sells, stores for the purpose of sale goods to get-up, packed, wrapped, or otherwise prepared as to lead intending purchasers to believe that they are goods of another manufacturer or of an origin other than its true origin. For the purpose of this sub-paragraph it shall be immaterial whether the goods, the packing, wrapping or get-up of which is imitated, bear a duly registered trademark or not.
 - (g) Imports any goods bearing a mark which would constitute an infringement of a duly registered mark or imports goods to get-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 sub-paragraph 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 and to be confiscated and destroyed.

Article (28)

Cognizance Of Offences

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

Article (29)

The Minister's Authorities To Make Rules

- (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 procedures under this Act.



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- (b) For classifying goods and services for the purpose of registration of trademark.
- (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 certified duplicates of trademark and other documents.
- (e) For securing and regulating the publishing and selling or distributing in such manner as the Registrar thinks fit, of copies of trademarks and other documents.
- (f) Generally for regulating the business of the registry in relation to trademark and all things placed by this Act under the direction or control of the Registrar.

Article (30)

Sequestration Of Marks When Registered Owner Becomes A National Of A Boycotted Country
When the registered owner of any trademark becomes a national of a boycotted country, he shall forfeit all his rights in the trademark and the mark shall be sequestrated and deposited with the Minister. The Minister shall have the authority to deal with any such trademark in any manner, and in particular he may transfer them and all rights therein to any person upon such terms and conditions as he may think fit.

Article (31)

Applications By Non-Residents

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