

DRAFT



TRADEMARK ACT OF LIBERIA, 2014

TRADEMARK ACT OF LIBERIA

It is enacted by the Senate and House of Representatives of the Republic of Liberia in Legislature Assembled:

CHAPTER I

PRELIMINARY PROVISIONS

§ 1.1. Short Title

This Trademark Act of Liberia may also be cited as “Liberia Trademark Act”.

§ 1.2. Repealer

Chapter 5 Marks, Trade Names and Acts of Unfair Competition, as well as Part V General Provisions as relate thereto, of the Industrial Property Act of Liberia, April 30, 2003, are hereby repealed.

§1.3. Definitions

In this Act, unless the context otherwise requires,

“ARIPO” means the African Regional Industrial Property Organization;

“Banjul Protocol” means the Protocol on Marks within the Framework of ARIPO;

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

“Business identifier” means any distinctive sign and shall include any mark, business symbol, trade name or emblem used by an enterprise to convey, in the course of industrial or commercial activities a particular commercial identity or commercial origin with respect to an enterprise or the products produced or the services rendered by that enterprise;

“Certification mark” means a sign that is used to indicate that specified standards or characteristics, including quality, origin or method of production, have been complied with in respect of goods or services as certified by or under the control of the holder of the registration of the mark;

“Collective mark” means any mark that belongs to a collective organization such as a cooperative, an association or a federation of industries, producers or traders;

“Court” means a court of justice of the Republic of Liberia;

“Director General” means the Director-General of the Liberia Intellectual Property Office;

“Distinctive sign” includes marks and trade names;

“Exclusive license” means a license granted to the effect that the licensor is bound to abstain from granting any equivalent license to another person in Liberia and, to abstain from exploiting the licensed industrial property right himself in Liberia;

“Holder of an international registration” means a natural or juristic person in whose name the international registration is recorded on the International Register;

“Intellectual Property Office: means the office in charge of the administration of all intellectual property in Liberia;

“International Classification” means as regards marks, the classification according to the Nice Agreement Concerning the International Classification of Goods and Services for the purpose of the registration of Marks, June 15, 1957 as last revised;

“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 Organization

“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;

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

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

“Mark” means any sign that can be represented graphically and is capable of distinguishing goods or services of one undertaking from those of other undertakings; marks include collective marks and certification marks;

“Paris Convention” means the Paris Convention for the Protection of Industrial Property, March 1983, as last revised;

“Priority date” means the date of the earlier application that serves as the basis for the right of priority provided for in the Paris Convention;

“Register” means the separate register to be kept at the Intellectual Property Office for trademarks; and

“Registrar” means the Registrar for intellectual property appointed in keeping with the Act Establishing the Intellectual Property Office of Liberia.

CHAPTER II

TRADEMARK AND TRADENAMES

§ 2.1. Acquisition of the exclusive right to a mark; Registrability

(a) The exclusive right to use a mark, as provided in this Act, shall be acquired by registration in accordance with the provisions hereof.

(b) A mark may consist, in particular, of words, letters, numerals, figures, pictures, combinations of colors, the shape of goods or of parts of the goods, or the packaging or other conditioning of goods.

(c) Any sign, or any combination of signs, capable of distinguishing the goods or services of one undertaking from those of other undertakings shall be capable of constituting a trademark and shall be visually perceptible. The nature of the goods or services of which a trademark is to be applied shall in no case form an obstacle to registration of the trademark.

§2.2. Unregistrable trademarks

(a) A sign shall not be validly registered as a mark if:

- (i) it is devoid of any distinctive character or is otherwise incapable of distinguishing the goods or services of one enterprise from those of other enterprises;
- (ii) it consists exclusively of a sign or indication that may serve in trade to designate the kind, quality, quantity, intended purpose, value, geographical origin, time of production of goods or of rendering of services, or other characteristics of goods or services in respect of which the mark is to be used;

- (iii) it consists exclusively of a sign or indication that has become customary in current language or in the *bona fide* established practices of the trade to designate goods or services in respect of which the mark is to be used, or that is a usual or recognized technical or scientific name of those goods or services;
 - (iv) it consists of the shape of a product or of its container or packaging where the shape results from the nature of the product, container or packaging, or it is a shape that provides a technical effect, functional advantage or substantial value to the goods;
 - (v) it is not distinct or separable from the goods or services to which it applies, or it consists of a feature or characteristic that results from the nature of the goods or services themselves;
 - (vi) it is contrary to public order or morality; however, the nature of the goods or services to which a mark is to be applied shall not be an obstacle to registration of the mark;
 - (vii) it is likely to deceive or mislead the public or trade circles, in particular as regards the geographical origin or provenance of the goods or services concerned or their nature, quality or other characteristics;
 - (viii) it is identical with, or is an imitation of or contains as an element, any sign covered under article 6ter of the Paris Convention, unless authorized by the competent authority of the State or organization concerned.
- (b) A sign cannot be validly registered as a mark if the use of such mark would conflict with prior third-party rights in force in Liberia, in particular where:
- (i) the sign is identical with or similar to an earlier registered mark or geographical indication belonging to a different person, or to a mark having an earlier filing or priority date, in respect of identical, similar or related goods or services, and this would be likely to cause confusion or a likelihood of association with the earlier mark or geographical indication;
 - (ii) the sign is a reproduction, imitation or translation of a distinctive sign that is well known in Liberia in respect of identical or similar goods or services of another person, or is well-known in Liberia for goods or services which are not identical or similar to those in respect of which registration is applied for, provided, in the latter case, that use of the sign in relation to those goods or services would be likely to cause confusion or a likelihood of association with the well known distinctive sign, or would indicate a connection between those goods or services and the owner of the well-known distinctive sign, or that the reputation of the sign or of the owner thereof would be damaged by such use, or such use without due cause would take unfair advantage of, dilute or otherwise be detrimental to, the distinctive character or the repute of the well-known distinctive sign;
 - (iii) the use of the sign in Liberia is liable to be prevented by virtue of any rule of law, in particular, protecting an unregistered mark, trade name, geographical indication or other sign used in the course of trade, or by virtue of an earlier intellectual property right, in particular the law of copyright or of industrial designs;

- (iv) the application for registration has been made in bad faith, or the registration of the sign would consolidate or facilitate an act of unfair competition.
- (c) For the purposes of subsection (b)(i), where the sign is identical with the earlier registered mark or geographical indication irrespective of identical goods or services, a likelihood of confusion shall be presumed.
- (d) For the purposes of subsection (b)(ii), in determining whether a distinctive sign is well known, Section 2.13 shall apply.
- (e) The prior user of a mark that is neither registered nor the subject of a pending application under subsection (b)(i), may oppose an application for a registration by another person of an identical or similar mark for identical or similar goods or services, provided he:
 - (i.) submits evidence that he has used that mark in Liberia in good faith prior to the filing date or the priority date, if applicable;
 - (ii.) submits evidence that he has acquired clientele or reputation in Liberia in connection with that mark; and
 - (iii.) files an application for registration of his own mark prior to filing the notice of opposition.
- (f) The Director General or the court shall have the authority to decide whether a mark has acquired in Liberia secondary meaning or distinctiveness through continued use and may, in such case, register the mark notwithstanding the provisions of subsection (2)(a)(ii) and (iii).

§ 2.3. Honest and concurrent use

In case of honest concurrent use, or of other circumstances in which the court or the Director General find it proper to do so, the court or the Director General may allow the registration of marks that are identical or nearly resemble each other in respect of the same goods or services or description of goods or services by more than one proprietor subject to such conditions and limitations, if any, as the court or the Director General, as the case may be, may impose.

§ 2.4. Registration to be in respect of particular goods

A trademark shall be registered in respect of goods or services falling in a particular class or classes in accordance with the prescribed classification, provided that the rights arising from the registration of a trademark shall be determined in accordance with prescribed classification applicable at the date of registration thereof.

§2.5. Application for registration; Right of priority

(a) The owner of a trademark used in commerce may request through submission of an application for registration of the trademark on the principal register therefor by paying the fees and filing in the Intellectual Property Office an application as may be prescribed by the Director General.

(b) The application for registration of a mark shall contain:

- (i) a request for registration;
- (ii) a sufficiently clear reproduction or representation of the mark, as prescribed;
- (iii) a list of the goods or services for which registration of the mark is requested, grouped in accordance with the applicable class or classes of the International Classification;
- (iv) proof of payment of the prescribed application fee; and
- (v) shall comply with other prescribed requirements.

(c) When the mark consists of a sign that is not visually perceptible, the application shall contain a graphic representation of the mark. Such representation may not consist of a written description of the sign.

(d) The application may contain a declaration claiming, in accordance with the Paris Convention, the priority of one or more earlier applications filed for the same mark in respect of corresponding goods or services, by the applicant or his predecessor in title, in or for any State party to the said Convention or any Member of the World Trade Organization.

(e) The period of priority shall be for six months and shall be computed in accordance with the provisions of Article 4 of the Paris Convention, that is from the date of filing of the first application, but shall exclude the day of filing in the six months period, and shall end on the last day of the period unless an official holiday or a day the Intellectual Property Office is not opened in which case the period shall be extended until the next working day.

(f) The effect of claiming priority shall be in compliance with the Paris Convention, in particular, an application filed within the priority period shall not be refused or invalidated by reason of any acts occurring during that period, in particular, another filing or the publication or used of the mark, and such acts shall not give rise to any third-part right or any right of personal possession.

(g) Where the application contains a declaration claiming priority the Director General may request the applicant to furnish, within the prescribed time limit which shall not be less than three months from the date of filing, a copy of the earlier application certified as correct by the foreign authority with which it was filed. The Director General may also request that the copy be accompanied by a certificate from that authority showing the date of filing, and by a translation into English.

(h) If the Director General finds that the conditions for the right of priority or the requirements for claiming priority have not been fulfilled, the declaration claiming priority shall be considered not to have been made.

(i) The filing date of an application for registration of a mark shall be the date on which the application is received at the Office if , at the time of receipt, it contains at least the following elements:

(i.) an express or implicit indication that the registration of a mark is applied for;

(ii.) sufficient information to identify the applicant and to contact the applicant or his representative;

(iii.) a sufficiently clear reproduction of the mark or a representation of the mark, as prescribed;

(iv.) a list specifying the goods or services for which the registration is sought;
proof of payment of the prescribed application fee;

(j) If the application omits one of the elements indicated in the previous paragraph, the Director General shall notify the applicant requesting that the omission be corrected. Until the omission is corrected, the application shall be regarded as not filed. The provisions of Section 2.6 (b) and (c) shall apply.

(k) The applicant may amend or correct the application at any time during the procedure. An amendment or correction shall not be accepted if it involves a change in the mark or results in an enlargement or a broadening of the scope of the list of goods or services specified in the initial application, but said list may be reduced or limited.

(l) The applicant may at any time during pendency divide his application in order to separate into two or more applications the goods or services specified in the initial application. A division shall not be accepted if it results in an enlargement or broadening of the scope of the list of goods or services specified in the initial application, but said list may be reduced or limited.

(m) Each divisional application shall retain the filing date and the right of priority of the initial application. After the division, each divisional application shall be independent. If publication of the application occurred before the division, the publication shall have effect for each divisional application.

(n) The applicant may at any time withdraw his application or limit the list of goods or services covered by the application.

§2.6. Examination; Publication; Opposition and Registration

(a) Upon the filing of an application for registration and payment of the prescribed fee, the Director General shall refer the application to the Registrar in charge of the registration of marks, who shall cause an examination to be made as to whether it appears that the applicant is entitled to registration or would be entitled to registration.

(b) If the application does not comply with the prescribed requirements, the Director General shall notify the applicant accordingly requesting him to correct the application within two months from the date of the notification.

(c) If the required correction is not made within the specified period, the application shall be considered withdrawn.

(d) Where the Director General finds that the conditions refer to under subsection (a) through subsection (c) of this section are fulfilled he shall cause the application to be published in the prescribed manner.

(e) Any interested person may, within the prescribed period and in the prescribed manner, file with the Director General a notice of opposition to the registration of the mark specifying the grounds that the opponent deems relevant to refuse the registration of that mark.

(e) The Director General shall notify the opposition to the applicant and, within the period of three months and in the prescribed manner, the applicant may send to the Director General a reply to the opposition.

(f) If the applicant sends a reply to the opposition, the Director General shall furnish a copy thereof to the person giving notice of opposition and shall hear the parties, if either or both wish to be heard.

(g) The Director General shall examine and determine whether the mark complies with the definition in Section 1.1 and is registrable under Section 2.2. Where one or more oppositions have been filed on grounds under Section 2.2, he/she shall also examine whether the mark is registrable under those grounds.

§2.7. Certificate of Registration

(a) Where the Director General finds that the conditions for registration are fulfilled, he/she shall refer the applicant to the Registrar for registration of the mark, publication of a reference to the registration and issue to the applicant a certificate of registration. . Otherwise, he shall refuse the application.

(b) Where an application for registration of a mark claims the benefit of Article 6*quinquies* of the Paris Convention that every trademark duly registered in the country of origin shall be accepted for filing and protection in Liberia as part of the Union under the Paris Convention, the Director General shall ensure that in deciding on the registration, a certificate of registration of the country of origin issued by the competent authority is produced by the applicant and that the country of origin is where the applicant has a real and effective industrial or commercial establishment, or is domiciled, or is a national of the country of origin. Trademarks covered by this subsection shall not be denied registration or invalidated except in keeping with rules and regulations issued by the Director General pursuant to said Article of the Paris Convention.

§2.8. Rights Conferred by Registration

(a) Registration of a mark shall confer on its registered holder the right to prevent any unauthorized third party from carrying out the following acts:

(i.) affixing a sign identical to the mark on goods for which the mark has been registered, on goods associated to the services for which the mark has been registered, or on the containers, wrapping or packaging of such goods;

(ii.) suppressing or distorting the mark for commercial purposes after it has been affixed as specified in subparagraph (a);

(iii.) manufacturing, selling, offering for sale, distributing or stocking material that bears the mark or may be used as labels, containers, wrappings, packaging, business paper or advertising;

(iv.) refilling or re-utilizing for commercial purposes containers or packaging bearing the mark;

(v.) using in the course of trade a sign that is identical or similar to the mark in respect of any goods or services, where such use may cause a risk of confusion or association with the holder of the registration, provided that where an identical sign is used for identical goods or services, a likelihood of confusion shall be presumed;

(vi.) using in the course of trade a sign that is identical or similar to the mark in respect of any goods or services where such use may cause unfair economic prejudice to the holder of the registration, or would take unfair advantage of, dilute or otherwise be detrimental to the distinctive character or advertising value of the mark, or would take unfair advantage of the reputation of the mark or its holder;

(vii.) using publicly a sign that is identical or similar to the mark, even for non-commercial purposes, where this may cause a dilution of the distinctive character or advertising value of the mark, or would take unfair advantage of the reputation of the registered mark or its holder.

(b) For the purposes of this section, the following acts, in particular, shall be regarded as use of a sign in the course of trade:

(i) introducing on the market, selling, offering for sale or distributing goods or services with the sign or with reference to the sign;

(ii) importing, exporting, storing or transporting goods that bear the sign or that refer to the sign;

(iii) using the sign in advertising, publications, business papers, commercial documents or written or oral communications, irrespective of the means of communication or media used;

(iv) using the sign for commercial purposes on the Internet or other electronic communication media or networks open to the public where such use is intended for Liberia or has a commercial effect in Liberia;

(v) adopting or using the sign as part of a domain name or other similar identification or designation on the Internet or other electronic communication media or networks open to the public.

(c) The rights conferred by registration of a mark may not be exercised to prevent:

(i.) any acts in respect of goods lawfully bearing the mark after those goods have been put on the market in Liberia or abroad by the registered holder or by a person acting with the holder's consent or having an economic tie to the holder, provided that the goods and the packaging or wrapping in direct contact with the goods have not suffered any material alteration or damage; to this effect an economic tie shall exist between two persons where one of them may exercise on the other a decisive influence with respect to the exploitation of the mark, or where a third party may exercise such an influence on both persons;

(ii.) use of the registered mark by any person for the purpose of indicating truthfully in the course of trade that the goods or services that bear the mark originate with the holder of the mark or a licensee thereof;

(iii) use of the registered mark by any person to provide information regarding the intended purpose, use or compatibility of a product or service, in particular with respect to accessories or spare parts;

(iv.) use of indications concerning the kind, quality, quantity, value, geographical origin, time of production of goods or of rendering of services, or other characteristics of goods or services;

(v.) use by a person in the course of trade of that person's name, address, place of business or place of production or distribution of goods or services, or those of that person's predecessor in business.

(d) The acts under subsection (c)(ii.), (iii.), (iv.) and (v.) shall be allowed subject to compliance with honest practices and provided such acts do not cause confusion regarding the provenance of the goods or services, and do not take unfair advantage of, or are detrimental to, the distinctive character or repute of the mark, and do not otherwise constitute unfair competition.

(e) The holder of a registered mark may assign it without transferring the business to which the mark belongs.

§2.9. Term of Registration; Renewal

(a) The term of registration of a mark shall be of ten years computed from the date of the registration.

- (b) The registration of a mark may be renewed for further consecutive periods of ten years each, upon compliance with the prescribed requirements and payment of the prescribed renewal fee.
- (c) A grace period of six months shall be allowed for renewal of the registration, on payment of the prescribed surcharge.
- (d) If renewal does not take place as prescribed, the registration of the mark shall lapse.

§2.10. Invalidation; Revocation

- (a) Any interested person may request the Director General or the court to invalidate the registration of a mark in respect of one, some or all the goods or services covered by the registration.
- (b) A request for invalidation on grounds of prior third-party rights may not be filed after the expiration of a period of five years counted from the date of the registration, unless the registration was obtained in bad faith. A request for invalidation on other grounds may be filed at any time.
- (c) The Director General or the court shall invalidate the registration if it is proven that the registered sign does not comply with the definition of ‘mark’ provided in Section 1.1 or that the mark was registered in contravention of any of the grounds specified in Section 2.1(c).
- (d) Any invalidation of the registration of a mark shall be deemed to have been effective as of the date of registration, and it shall be recorded and a reference thereto published as soon as possible.
- (e) The Director General may revoke the registration of a mark in respect of one, some or all the goods or services covered by the registration, on any of the following grounds:
 - (i.) within the period of three years following the date of completion of the registration procedure the mark has not been put to genuine use in Liberia in relation to the goods or services for which it is registered, and there are no justified reasons for such failure to use;
 - (ii.) substantive use of the mark has been suspended for an uninterrupted period of three years, and there are no justified reasons for such failure to use;
 - (iii.) in consequence of acts or inaction of the registered holder, the mark has become the common name or the only effective designation available for use in the ordinary course of trade in respect of a product or service for which the mark is registered;
 - (iv.) in consequence of the manner in which the registered holder used the mark or allows it to be used the mark is liable to mislead the public, particularly as to the nature, quality or geographical origin of the goods or services for which the mark is registered.

- (f) For the purpose of subsection (2) use of a mark includes use in a form differing in elements that do not alter the distinctive character of the mark in the form in which it was registered, and use in Liberia includes affixing the mark to goods or to the packaging of goods in Liberia solely for export purposes.
- (g) Where in any proceedings under this Act it is required to prove the use to which a mark has been put, including the duration, nature or scope of the use, the burden of such proof shall lie with the registered holder.
- (h) The registration of a mark shall not be revoked on the grounds mentioned in subsection (2)(a) or (b) if use of the mark is commenced or resumed after the expiry of the three-year period and not less than one month before the request for revocation is made.
- (i) Where grounds for invalidation or revocation exist in respect of only some of the goods or services for which the mark is registered, invalidation or revocation shall relate to those goods or services only.
- (j) Where the registration of a mark is revoked to any extent, the effects of revocation shall be deemed to have taken place to that extent as from the date of the request for revocation, and it shall be recorded and a reference thereto shall be published as prescribed, as soon as possible.
- (k) A request for invalidation or revocation may be made by any person, and may be made either to the Director General or to the court.
- (l) For the purposes of proceedings under this section, the provisions of § 3.46(2)(c) and (d) shall apply

§2.11. Collective Marks

- (a) Section 2.1 to Section 2.6 of this Act shall apply to collective marks. However, where a collective mark consist of, or contains, a geographical name that corresponds to the place of origin of the goods in respect of which the mark is to be registered, the Director General may decide not to apply Section 2.1 (c)(ii). as required.
- (b) A mark capable of distinguishing, in the course of trade, the goods or services of persons who are members of an association, from goods or services of persons who are not members of such association, shall on application in the prescribed manner, be registrable as a collective trade mark or service mark in respect of the goods or services in the name of such an association.
- (c) An application for the registration of a collective mark shall designate the mark as a collective mark and shall be accompanied by a copy of the rules governing the use of that mark, which shall be made of public record.
- (d) Any changes made in respect of the rules referred to in item (a) shall be communicated to the Director General, who shall record the changes.
- (e) A collective mark may not be the subject of a license contract other than for the members of the registered holder of the collective mark.
- (f) The Director General may refuse protection to a collective mark if the collective mark is contrary to the public interest.

§2.12. Certification Marks

- (a) Section 2.1 to Section 2.6 of this Act shall apply to certification marks. However, where a certification mark consist of, or contains, a geographical name that corresponds to the place of origin of the goods in respect of which the mark is to be registered, the Director General may decide not to apply Section 2.1 (c)(ii) as required.
- (b) The application for the registration of a certification mark shall designate the sign as a certification mark and shall be accompanied by a copy of the rules governing the use of that mark, which shall be made of public record.
- (c) Any changes made in respect of the rules referred to in item (a) shall be communicated to the Director General, who shall record the changes.
- (d) The holder of a certification mark may not use the mark to certify its own goods or services.
- (e) The Director General or the court shall invalidate the registration of a certification mark if it is proven that the registered holder has contravened the provision in subsection (c) of this section, or that he permits use of the mark in contravention of the rules referred to in subsection (a) of this section or in a manner liable to deceive trade circles or the public as to the origin or any other common characteristics of the goods or services concerned.

§2.13. Trade Names

- (a) Notwithstanding any laws or regulations providing for any obligation to register a business name or a company name, a trade name used in Liberia shall be protected, even prior to or without such registration, and whether or not it forms part of a trademark, against any unlawful act committed by third parties.
- (b) A name or designation may not be used as a trade name if by its nature or by the use to which it may be put in the course of trade, it would be contrary to public order or morality. In particular, such use shall not be allowed if it is liable to deceive the trade circles or the public as to the nature of the enterprise identified by that name or of the activities thereof.
- (c) Any unauthorized use of a trade name whether as a trade name, a mark or other business identifier, likely to mislead the public, shall be deemed unlawful.

§2.14. Well-known Signs

- (a) A well-known distinctive sign shall be infringed by the unauthorized use of a sign identical with or confusingly similar to that distinctive sign, where such use would indicate a connection between goods or services and the owner of the well-known sign or the reputation of the well-known distinctive sign or of its owner is likely to be damaged by such use.

(b) In determining whether a distinctive sign is well known, all relevant circumstances shall be taken into consideration, in particular the following factors:

(c) the degree of knowledge of the sign among members of the relevant sector of the public within the country;

(d) the duration, scope and geographical extension of the use of the sign, inside and outside the country;

(e) the duration, scope and geographical extension of the promotion of the sign, inside and outside the country, including advertising and presentation at fairs, exhibitions or other events, of the establishment, activity, goods or services to which the sign applies;

(f) the existence and age of any registration or registration application for the distinctive sign, in the country or abroad;

(g) the taking of actions to defend the distinctive sign, in particular any decision taken by a national or foreign authority, in which the sign has been recognized as being well known;

(h) the value of any investment made to promote the distinctive sign, or to promote the establishment, activity, goods or services to which the sign applies.

(i) For the purpose of recognizing a sign as well-known it shall be sufficient for the sign to be generally known in one relevant sector of the public.

(j) The following, in particular, shall be considered relevant sectors of the public for the purpose of recognizing a distinctive sign as well known:

(i) actual or potential consumers of the type of goods or services to which the distinctive sign applies;

(ii) persons involved in marketing or distribution channels of the type of goods or services to which the distinctive sign applies;

(iii) the entrepreneurs in the business circles relating to the type of goods, services, establishment or activity to which the sign applies.

(k) The following shall not be required as a condition to recognizing a distinctive sign as being well-known:

(i.) that the sign be registered or in the process of registration in Liberia or abroad;

(ii.) that the sign has been used or is being used in trade in the country or abroad;

(iii.) that the sign be well known abroad;

(iv.) that the sign be known to the general public in Liberia.

(l) When deciding an action relating to the unauthorized use of a well-known distinctive sign, the authority shall take into account the good or bad faith of the parties in the adoption and use of that sign.

§2.15. Service Marks

Subject to the provisions relating to the registration of trademarks, so far as they are applicable, service marks shall be registrable, in the same manner and with the same effect as are trademarks, and when registered they shall be entitled to the protection provided herein in the case of trademarks. Applications and procedures relative to this section shall conform as nearly as practicable to those prescribed for the registration of trade marks.

§2.17. Licensing and Assignment

(a) A registered mark or a mark for which an application to register has been filed shall be assignable with the good will of the business in which the mark is used, or with that part of the goodwill of the business connected with the use of any symbolized by the mark.

(b) The owner of a registered trademark shall have the right to assign the trademark with or without the transfer of the business to which the trademark belongs.

(c) Assignments shall be by instruments in writing duly executed.

(d) The Liberia Intellectual Property Office shall maintain a record of information on assignments in such form as may be prescribed by the Director General.

(e) Compulsory licensing of trademarks shall not be permitted

§2.18. Disclaimers

(a).The Director General may require the applicant to disclaim an unregistrable component of a mark otherwise registrable. An applicant may voluntarily disclaim a component of a mark sought to be registered.

(b) No disclaimer shall prejudice or affect the applicant's or registrant's rights then existing or thereafter arising in the disclaimed matter, or his right of registration on another application of the disclaimed matter be or shall have become distinctive of his goods or services.

§2.19 Goods Unlawfully bearing a mark or trade name; seizure on importation

All goods unlawfully bearing a trademark or trade name contrary to this Act shall be subject to seizure upon importation pursuant to customs laws and regulations, and the civil procedure law of Liberia.

§2.20. Regulations; Administrative Instructions

(a) Regulations shall be issued on trademarks by the Director General of the Office to further implement this Act and which shall include general provisions pertaining to:

- (i.) Border Measures;
- (ii.) Changes in Ownership;
- (iii.) Licenses/compulsory licenses;
- (iv.) Correction of errors;
- (v.) Extension of time;
- (vi.) The register;
- (vii.) Official Gazette;
- (viii.) Exercise of discretionary powers;
- (ix.) Representation;;
- (x.) Competence of the court;
- (xi.) Appeals.

(b)The Director General of the Office may also issue Administrative Instructions relating to the procedures under Act pertaining to trademarks.

CHAPTER III

INTERNATIONAL REGISTRATION UNDER THE MADRID PROTOCOL

SUBCHAPTER A. INTERNATIONAL APPLICATIONS ORIGINATING FROM LIBERIA

§3.1. Language

Any communication, including an international application, submitted to the International Bureau through the intermediary of the Office shall be in English.

§ 3.2. Examination of International Applications in Respect of which Liberia is the Country of Origin

Where an international application is filed with the Director General for transmittal to the International Bureau, the Director General shall verify that Liberia may be considered as the country of origin in respect of that application, and 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.

§ 3.3. Certification

(a) Where the international application complies with the prescribed requirements, the Director General shall so certify in the international application, indicating also the date on which the international application was received, and shall forward the international application to the International Bureau.

(b) Where the international application does not meet the prescribed requirements, the Director General shall not forward it to the International Bureau, and shall inform the applicant accordingly.

§ 3.4. Handling Fee

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

§ 3.5. Ceasing of Effect of the Basic Application or Basic Registration

In accordance with Article 6 of the Madrid Protocol stipulating that registration of a mark at the International Bureau is effected for 10 years but that upon expiration of a period of 5 years becomes independent of the basic application or registration resulting from such application or the basic registration which if they are revoked, cancelled or invalidated results in loss of the protection afforded by the international registration, where the basic application, the registration resulting from such application or the basic registration ceases to have effect the Director General shall inform the International Bureau and shall request the cancellation of the international registration in respect of the goods and services affected.

SUBCHAPTER B. INTERNATIONAL REGISTRATIONS; LIBERIA AS DESIGNATED CONTRACTING PARTY

§ 3.6. Advertisement of Application; Opposition

Where Liberia has been designated in an international application, the Director General shall advertise the international registration as prescribed. Opposition to the international registration shall be governed by the provisions of this Act regarding opposition to the registration of a mark before the Director General.

§ 3.7. *Ex Officio* Provisional Refusal of Protection

Where the Director General finds that, in accordance with this Act, the mark that is the subject of an international registration designating Liberia cannot be protected, the Director General 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. The holder of that international registration shall enjoy the same remedies as if the mark had been filed for registration directly with the Director General.

§ 3.8. Provisional Refusal Based on an Opposition

Where an opposition is filed with the Director General in respect of an international registration designating Liberia, the Director 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 of protection based on an opposition, in accordance with the provisions of the Madrid Protocol and the Common Regulations. The holder of the international registration concerned shall enjoy the same remedies as if the mark had been filed for registration directly with the Director General.

§ 3.9. No Grounds for Refusal - Statement of Grant of Protection

Where all procedures before the Director General have been completed and there is no ground to refuse protection to the mark, the Director General 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 Liberia.

§ 3.10. Final Decision Following the Notification of a Provisional Refusal

(a) Where the Director General has notified to the International Bureau a provisional refusal of protection of the mark in accordance with § 3.61 or § 3.62 and such provisional refusal is subsequently totally or partially withdrawn, the Director General shall send to the International Bureau either:

- (i.) a statement to the effect that the provisional refusal is withdrawn and that protection of the mark is granted in Liberia for all the goods and services for which protection has been requested, or
- (ii.) a statement indicating the goods and services for which protection of the mark is granted in Liberia.

(b) Where the Director General has sent to the International Bureau a notification of total provisional refusal of protection of the mark in accordance with § 3.61 or § 3.62 and the Director General subsequently decides to confirm such total refusal of protection, the Director General shall send to the International Bureau a statement to that effect.

§ 3.11. Further Decision Affecting Protection of a Mark

Where, following the sending of a statement in accordance with § 3.64, there is a further decision that affects the protection of a mark in Liberia, the Director General shall, to the extent that he 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 Liberia.

§ 3.12. Effects of an International Registration

(a) An international registration designating Liberia shall have the same effects, as from the date of the international registration, as if an application for the registration of the mark had been filed directly with the Director General under this Act.

(b) If no refusal is notified by the Director General to the International Bureau in accordance with the Madrid Protocol and the Common Regulations, or if a refusal has been so notified but has subsequently been withdrawn, or if a statement of grant of protection is sent by the Director General, the protection of the mark in Liberia shall be the same as if the mark had been registered directly by the Director General on the date of the international registration.

§ 3.13. Invalidation

(a) Where the effects of an international registration are invalidated in Liberia and the invalidation is no longer subject to appeal, the Director General shall, provided that the Director General is aware of that decision, notify the International Bureau in accordance with the relevant provisions of the Madrid Protocol and the Common Regulations.

(b) Invalidation of an international registration may not be pronounced without the holder of such international registration having been afforded the opportunity of defending his rights by the Director General.

§ 3.14. 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 Liberia as a designated Contracting Party, have the same effect as if it had been recorded in the register of marks of the Liberia Intellectual Property Office.

§ 3.15. Collective and Certification Marks

Where an international registration designating Liberia is a collective mark or a certification mark, the rules governing the use of such collective mark or certification mark shall be submitted directly, by the holder of that international registration, to the Director General, within the prescribed time limit.

§ 3.16. Replacement

(a) The Director General shall take note of an international registration in the register when requested by the holder of an international registration where:

- (i) a mark registered in Liberia is also the subject of an international registration that extends to Liberia, and
- (ii) the same person is recorded as holder of the registration in Liberia and of the international registration, and
- (iii) all the goods and services listed in the registration in Liberia are also listed in the international registration in respect of Liberia, and
- (iv) the extension of that international registration to Liberia took effect after the date of registration of the mark in Liberia,

(b) A request filed with the Director General in accordance with item (a), shall be made as prescribed.

(c) Where the Director General has taken note of an international registration in accordance with subsection (a) of this section, the Director General shall notify the International Bureau accordingly and such notification shall indicate the following:

- (i.) the number of the international registration in question,
- (ii.) where only some of the goods and services listed in the international registration are concerned, those goods and services,
- (iii.) the filing date and number of the application for registration of the mark in Liberia,
- (iv.) the registration date and number of the registration in Liberia,

(v.) the priority date, if any, of the registration in Liberia, and

(vi.) information relating to other rights acquired by virtue of the registration in Liberia.

(d) Where a mark that is the subject of a national registration in Liberia Intellectual Property Office is also the subject of an international registration and both registrations stand in the name of the same person, the international registration shall be deemed to replace the national registration without prejudice to any rights acquired by virtue of the latter provided that:

(i.) the protection resulting from the international registration extends to Liberia;

(ii.) all the goods and services listed in the national registration are also listed in the international registration;

(iii.) such extension takes place after the date of the national registration.

§ 3. 17. Transformation

(a) Where, in accordance with Article 9quinquies of the Madrid Protocol, an international registration designating Liberia is cancelled at the request of the Office of origin, in respect of all or some of the goods and services listed in the international registration, the person who was the holder of the international registration at the date of its cancellation may file an application to the Director General, within three months from the date on which the international registration was cancelled, to transform the cancelled international registration into a registration of the same mark in respect of any goods and services that were covered by that international registration.

(b) Subject to subsections (c) and (e), the provisions applicable under this Act to an application for registration of a mark filed directly with the Director General shall apply to an application resulting from transformation under this section.

(c) An application for transformation shall be made as prescribed and shall include the following:

(i.) a statement that the application is made by way of transformation,

(ii) the international registration number of the international registration which has been cancelled,

(iii) the date of the said international registration, or the date of recording of the territorial extension made subsequently to the international registration, as appropriate,

(iv) the date on which the cancellation of the international registration was recorded,

(v) where applicable, the date of any priority claimed in the international application and recorded in the International Register.

- (d) An application for transformation shall be subject to payment of the prescribed fee.
- (e) Where an international mark was protected in Liberia on or before the date on which its international registration was cancelled, the Director General shall register the mark, provided that all the requirements relating to an application for transformation have been met. The date of registration shall be the date of the cancelled international registration, or the date of recording of the territorial extension to Liberia made subsequently to the international registration, as appropriate, and that registration shall enjoy any priority enjoyed by the cancelled international registration.
- (f) Where an international mark was not protected in Liberia on or before the date on which its international registration was cancelled, any procedures or measures already undertaken in Liberia on or before the date of filing of an application for transformation shall be considered as having been undertaken for the purposes of the application for transformation.
- (g) The filing date of an application for transformation shall be the date of the international registration or the date of the subsequent recording of the territorial extension to Liberia, as the case may be.

§ 3.18. Extension of protection of an international registration to Liberia

Any request for extension of the protection resulting from the international registration to Liberia shall be specifically mentioned in the International Application. A request for such extension may also be made subsequent to the international registration. Any such request shall be recorded by the International Bureau which shall notify the Liberia Intellectual Property Office and published in the periodical gazette of the International Bureau. Such extension shall be effective the date it is recorded in the International Register and shall cease to be valid on the expiration of the international registration to which it relates.

§3.18. Renewal

Any international registration may be renewed for a period of 10 years from the expiration of the preceding period by the mere payment of the basic fee and any supplementary or complementary fees prescribed by the Director General.

§3.19. Regulations

The Director General may issue regulations regarding international registration in conformity with and to further implement the Madrid Protocol.

CHAPTER IV

ENFORCEMENT OF RIGHTS AND LEGAL PROCEEDINGS

§4.1. Infringement of Marks and Trade Names; Remedies

- (a) A registered mark or a well-known mark shall be infringed by the performance of any act referred to in §2.8(a) and (b) in Liberia by a person other than the holder of the right in the mark and without the holder's authorization, subject to the limitations and exceptions provided for in §2.8 (c) and (d).

(b) A well-known mark shall be infringed by the use of a sign identical with or confusingly similar to the well-known mark without the agreement of the owner of the well-known mark provided that the use of the sign in relation to goods or services would indicate a connection between those goods or services and the owner of the well-known mark or that the reputation of the well-known mark or of the owner thereof is likely to be damaged by such use.

(c) On the request of the holder of a registered mark or of a licensee if he has requested the holder of the mark to institute court proceedings for a specific relief and the holder of the mark has refused or failed to do so within ninety-days, the court may grant an injunction to prevent infringement, or an imminent infringement, award damages and grant any other remedy provided for in the general law or under this Act.

(d) A trade name shall be infringed by the performance of any act referred to in §2.14(a).

§4.2. Provisional Measures

(a) All provisional remedies under the Civil Procedure Law of Liberia including injunctions shall be applicable to civil proceedings relating to trademarks primarily to prevent an infringement from occurring and preserve relevant evidence in regard to the alleged infringement;

(b) Time limitations for action for damages under the Civil Procedure Law of Liberia shall be applicable to trademarks.

(c) The aggrieved party's entitlement to compensation shall be pursuant to the Civil Procedure Law of Liberia.

§4.3. Evidence

(a) Any party to proceedings relating to trademark infringement shall be governed by the provisions of the Civil Procedure Law relative to evidence including burden of proof, the right to compel production of documents and to designate documents as privileged or confidential.

(b) Any registration issued under this Act of a mark registered on the principal register for trademarks and owned by a party to an action shall be admissible in evidence and shall be prima facie evidence of the validity of the registered mark and of the registration of the mark, of the registrant's ownership of the mark, and of the registrants' exclusive right to use the mark.

§4.4. Damages

(a) An aggrieved party to proceedings involving trademark rights may seek and obtain a court order that the infringer pay the right holder damages adequate to compensate for the injury the right holder has suffered because of an infringement by an infringer who knowingly, or with reasonable grounds to know, engaged in infringing activity, inclusive of expenses such as attorney fees, or an order for the recovery of profits and or payment of pre-established damages where the infringer with reasonable grounds to know engaged in infringing activity.

(b) An order may also be sought and obtained that the infringer to inform the holder of the right of the identity of third persons involved in the production and distribution of the infringing goods or rendering

of services and of their channels of distribution, where this would be in proportion to the seriousness of the infringement.

§4.5. Indemnification of Defendant

Any party to trademark proceedings who abuses enforcement proceedings may be required by Court order to indemnify the defendant for injury suffered for such an abuse pursuant to the Civil Procedure Law of Liberia.

§4.6. Unfair Competition

Unfair competition legislation in Liberia prohibiting dishonest practices in industrial or commercial matters shall be applicable to trademarks.

§4.7. Appeals

(a) An applicant for registration of a mark, party to an opposition proceeding, or applicant for renewal or other infringement proceedings who is dissatisfied with the decision of the Director General may appeal to the courts.

(b) The appeal shall follow the procedure provided under the Civil Procedure Law of the Republic of Liberia.

§4.8. Further Sanctions

When a person has been found liable for infringement under this Act, to create an effective deterrent to further infringement, the infringer may be subjected to a court order for seizure, forfeiture or disposal of the infringing goods and of any materials and instruments the predominant use of which have been in the commission of the infringement.

CHAPTER V

OFFENSES

§5.1. Fraud in relation to registers

(a) A person is guilty of the offense of fraud in relation to registers, which shall constitute a felony of the second degree under the Penal Law of Liberia, who:

- (i.) makes or causes to be made a false entry in a register for trademarks maintained by the Liberia Intellectual Property Office; or
- (ii.) makes or causes to be made a writing falsely purporting to be a copy of an entry in any such register; or
- (iii.) produces or tenders or causes to be produced or tendered as

evidence any such entry or copy thereof knowing it to be false.

§5.2. False statement for the purpose of deceiving

(a) A person is guilty of the offense of false statement for the purpose of deceiving or influencing the Director General, the Registrar or other officer of the Liberia Intellectual Property Office, which shall constitute a felony of the second degree, who makes a false statement for the purpose of:

- (i.) deceiving the Director General, the Registrar or any officer in the execution of the provisions of this Act;
- (ii.) procuring or influencing the doing or omission of anything in relation to this Act or any matter thereunder; or
- (iii.) makes a false representation knowing it to be false.

§5.3. Falsely representing trademark as registered

(a) A person is guilty of falsely representing trademark as registered, which shall constitute a felony of the second degree, under the Penal Law of Liberia, who:

- (i.) makes a representation with respect to a mark not being a registered trademark, to the effect that it is a registered trademark;
- (ii.) makes a representation with respect to a part of a registered trademark not being a part separately registered as a trademark, , to the effect that it so registered;
- (iii.) makes a representation that a registered trademark is registered in respect of any goods or services in respect of which it is not registered;

makes a representation that the registration of a trademark gives an exclusive right to the use thereof in any circumstances in which, having regard to limitations entered in the register, the registration does not give that right;

This Act shall take effect immediately upon publication into Handbills by the Ministry of Foreign Affairs.

ANY LAW TO THE CONTRARY NOT WITHSTANDING