

**ETHIOPIA**  
**Trademarks Law**

Trademark Registration and Protection Proclamation No. 501/2006

ENTRY INTO FORCE: July 7, 2006

TABLE OF CONTENTS

PART ONE GENERAL PROVISIONS

1. Short Title
2. Definitions
3. Scope of Application

PART TWO ACQUISITION OF RIGHTS AND REGISTRATION OF TRADEMARK

4. Acquisition of Rights
5. Trademarks Eligible for Registration
6. Trademarks Inadmissible for Registration
7. Refusal of Registration of Trademarks on Grounds of Third Party Rights

PART THREE PROCEDURES FOR REGISTRATION OF TRADEMARK

8. Application for Registration
9. Withdrawal of Application
10. Right of Priority
11. Examination of Application
12. Publication of Notice of Invitation for Opposition
13. Opposition
14. Pending Cases
15. Registration of the Trademarks and Issuance of Certificate
16. Notification of Registration
17. The Right to Appeal

PART FOUR COLLECTIVE TRADEMARKS AND WELL-KNOWN MARKS

18. Registration of Collective Trademarks
19. Persons Eligible to Apply for the Registration of Collective Trademark
20. Cancellation of Registration of Collective Trademarks
21. In the event of cancellation of a collective
22. Amendment of statutes
23. Well-known Trademarks

PART FIVE DURATION AND RENEWAL OF REGISTRATION OF TRADEMARKS

24. Duration of Registration
25. Renewal of Registration

PART SIX RIGHTS CONFERRED BY REGISTRATION AND LICENSE CONTRACTS

26. Rights Conferred by Registration
27. Limitation of Rights Conferred by Registration
28. Transfer of Right
29. License contracts
30. Nullity of license contracts
31. Invalid Clauses of License Contracts
32. Right to Grant Further Licenses
33. Right of licensee

PART SEVEN RENUNCIATION, CANCELLATION AND INVALIDATION OF A RIGHT ON A REGISTERED TRADEMARK

34. Renunciation of Right
35. Cancellation of trademark for Non use
36. Invalidation of Registration
37. Effects of Invalidation
38. Extension of Time

PART EIGHT ENFORCEMENT OF RIGHTS

39. Provisional measures
40. Civil Remedies
41. Criminal Sanctions
42. Measures at customs port and stations

PART NINE MISCELLANEOUS PROVISIONS

43. Trademarks Bulletin
44. Registration of Trademark Agents
45. Access to Information
46. Transitory Provisions
47. Power to Issue Regulations
48. Inapplicable Laws and Practices
49. Competent Court
50. Effective Date

## **PART ONE GENERAL PROVISIONS**

### **1. Short Title**

This Proclamation may be cited as the "Trademark Registration and Protection Proclamation NO.501/2006".

### **2. Definitions**

In this Proclamation, unless the context otherwise requires:

(1) "collective trademark" means a trademark distinguishing the goods or services of members of an association, which is the owner of the trademark, from those of other undertakings;

(2) "court" means the court referred to in Article 49 of this Proclamation;

(3) "earlier trademark" means a trademark which has entered in the register of marks or has a date of application for registration earlier than that of the trademark in question;

(4) "foreigner" means a person who is not domiciled or has no registered business in Ethiopia;

(5) the terms "customs port" and "customs station" shall have the meanings assigned to them under the Re-Establishment and Modernization of Customs Authority Proclamation No. 60/1997;

(6) "international classification" means the classification of goods or services under the Nice Convention of Goods and Services for the purpose of Registration of Trademarks established by an agreement concluded at the Nice Diplomatic Conference, on June 15, 1957, and revised at Stockholm, in 1967, at Geneva, and amended in 1979;

(7) "license contract" means a contract whereby the owner grants to any other person to use a trademark for all or part of goods or services in respect of which the trademark is registered;

(8) "Office" means the Ethiopian Intellectual Property Office;

(9) "person" means a physical or juridical person;

(10) "priority date" means the date of an earlier application that serves as the basis for the right of priority;

(11) "regulations" means Council of Ministers Regulations to be issued pursuant to Article 47 of this Proclamation;

(12) "trademark" means any visible sign capable of distinguishing goods or services of one person from those of other persons; it includes words, designs, letters, numerals, colours or the shape of goods or their packaging or the combinations thereof;

(13) "surname" means a name shared in common to identify the members of a family, as distinguished from each member's given name.

### **3. Scope of Application**

Subject to the principles of reciprocity or in accordance with any treaty that Ethiopia is a party to, foreigners shall have the same rights and obligations as Ethiopians under this Proclamation.

## **PART TWO ACQUISITION OF RIGHTS AND REGISTRATION OF TRADEMARK**

### **4. Acquisition of Rights**

Ownership rights of a trademark shall be acquired and be binding on third parties upon the grant of a trademark registration certificate.

### **5. Trademarks Eligible for Registration**

(1) Any trademark that is capable of clearly distinguishing goods or services of a person from those of other persons shall be eligible for registration.

(2) A trademark may be registered in black-and-white or color. A trademark, which is registered in black-and-white, shall be protected in all color combinations; a trademark, which is registered in color, shall only be protected in the color combination in which it is registered.

(3) A trademark eligible for registration may include elements which are not subject to protection unless they decrease the distinctive character of the trademark or infringe the rights of other persons.

### **6. Trademarks Inadmissible for Registration**

(1) The following trademarks may not be admissible for registration:

(a) a trademark which does not conform to the provisions of Article 5 of this Proclamation;

(b) a trademark which consists of sound or smell;

(c) a trademark which is incapable of distinguishing the goods or services of one person from those of other persons;

(d) a trademark that is contrary to public order or morality;

(e) a trademark consisting exclusively of signs or indications which designate the kind, quality, quantity, intended purpose, value, geographical origin of goods or services, the time of production of the goods or rendering of the services, or other characteristics of the goods or services;

(f) a trademark consisting exclusively of signs or indications which have become customary in the current language use in relation to such goods or services for which the registration of a trademark is applied for, or which have become customary in economic and business activities;

(g) a trademark consisting exclusively of a shape which results from the nature of the good itself or that is necessary to obtain a technical result of the good or that gives substantial value to the good;

(h) a trademark that is likely to mislead the public or the business community,

in particular as regards the geographical origin of the goods or services concerned, or their nature or characteristics;

- (i) unless authorized by a competent authority, a trademark which is identical with or an imitation of or contains an armorial bearing, flag or other emblem, a name or abbreviation or initials of the name of, or official sign or hallmark adopted by any state, intergovernmental organization, or other organization created by international conventions;
- (j) a trademark that consists exclusively the surname of the applicant;
- (k) a trademark mark that consists exclusively the full name of an alive individual without his consent.

(2) The provisions of Sub-Article (1) (e), (f) and (j) of this Article do not apply if it is certified that by the date of receipt of an application for registration of a trademark, the trademark has, as a result of its use become well known in Ethiopia.

#### **7. Refusal of Registration of Trademarks on Grounds of Third Party Rights**

A trademark shall not be registered because of the following third party priority rights:

- (1) when it is identical with an earlier trademark of another person in respect of the same goods or services or closely related goods or services, or if it so nearly resembles such a trademark as to be likely to deceive or cause confusion;
- (2) when it is identical with or confusingly similar to, or contains a translation of a trademark, that is well known or established by use in Ethiopia for identical or similar goods or services of another person;
- (3) when it is identical with or confusingly similar to, or constitutes translation of, a trademark which is registered in Ethiopia for goods or services which are not identical or similar to those in respect of which the registration is applied for, provided that the use of the trademark in relation to those goods or services would indicate a connection between those goods or services and that the interest of the owner of the registered trademark is likely to be damaged by such use;
- (4) when it contains anything which may be understood as the characteristic title of another person's protected literary or artistic rights or another person's right to a photograph or design without his written consent.

## **PART THREE PROCEDURES FOR REGISTRATION OF TRADEMARK**

### **8. Application for Registration**

(1) Application for registration of a trademark shall be made in the prescribed form and filed with the Office accompanied by payment of the application fee prescribed by the Regulations.

(2) An application for registration shall cover only one trademark.

(3) The applicant shall, after completing the application form prescribed by the Regulations, submit the following documents:

(a) three copies of a reproduction of the trademark;

(b) a list of goods and services classified in accordance with the international classification of goods and services for which registration of the mark is requested and the class numbers of the classification;

(c) when the application for registration is filed through an agent, it shall be accompanied by a duly authenticated power of attorney;

(d) a document certifying payment of the fee referred to in Sub-Article (1) of this Article or a copy thereof;

(e) other particulars determined by the Regulations.

(4) An applicant who is a foreigner shall appoint an agent who is domiciled in Ethiopia.

### **9. Withdrawal of Application**

The applicant may withdraw the application any time while it is pending.

### **10. Right of Priority**

(1) Where any applicant files his application in Ethiopia within six months from the date on which he first filed in a foreign country an application for the same trademark in respect of same goods or services, the date on which the application was first filed in the foreign country shall be regarded as the date of filing if the applicant claims the right of priority and furnishes within the prescribed time limit a copy of the earlier application certified as correct by the office with which it was filed and other documents and information as prescribed.

(2) Where the Office finds that the declaration submitted does not fulfil the requirements of Sub-Article (1) of this Proclamation and the Regulations, the said declaration shall be considered not to have been made.

### **11. Examination of Application**

The Office shall, when an application for the registration of a trademark is submitted to it:

- (1) undertake examination as to form, whether the application fulfils the requirements of Article 8 of this Proclamation and the Regulations;
- (2) undertake examination as to substance, to ensure that the trademark complies with the provisions of Articles 6 and 7 of this Proclamation;
- (3) reject the application when it ascertains that the application does not fulfil the requirements of this Proclamation and the Regulations and inform the applicant in writing the reasons for the rejection within the time limit provided for in the Regulations;
- (4) the Office shall, before making a decision of rejection under Sub-Article (3) of this Article, fix a reasonable time for the applicant to submit his opinion in writing or to rectify the defect.

### **12. Publication of Notice of Invitation for Opposition**

When the Office finds that the trademark application is acceptable, it shall publish a notice of invitation for opposition regarding the registration of the trademark in the Intellectual Property Gazette or a newspaper having nationwide circulation at the cost of the applicant. This may be supplemented by a radio or television broadcast or a website notice as deemed necessary.

### **13. Opposition**

(1) Any person who objects the registration of the trademark may, within the period and in the manner, prescribed by the Regulations and upon payment of the prescribed fee, notify in writing to the Office stating the ground of opposition and attaching the supporting documents.

(2) The Office shall send a copy of the opposition together with supporting evidence to the applicant, within the period and in the manner prescribed by the Regulations.

(3) The applicant may send to the Office a counter statement of the grounds which would support his application, within the period and in the manner prescribed by the Regulations, if he fails to submit the counter statement, it shall be deemed that he has abandoned the application.

(4) The Office shall furnish a copy of the counter-statement of the applicant to the person who made opposition and reach a decision within the period and in the manner prescribed by the Regulations, after examining the merits



of the case.

(5) The Office shall furnish copies of its decision under Sub-Article (4) of this Article to the applicant and the person who made the opposition within the period prescribed by the Regulations.

#### **14. Pending Cases**

(1) After an application is published and until the registration of the trademark, the applicant has the same privileges and rights as he would have, if the trademark had been registered; provided, however, that it shall be valid defense to an action brought in respect of an act done after the application was published, if the defendant establishes that the trademark could not have been validly registered at the time the act was done.

(2) Infringement proceedings may not be initiated before the date on which the trademark is in fact registered.

#### **15. Registration of the Trademarks and Issuance of Certificate**

The Office shall register a trademark and issue to the applicant a certificate of registration upon payment of the fee prescribed by the regulations where it finds that:

(1) the conditions referred to in this Proclamation and the Regulations are fulfilled; and

(2) the request for registration of the trademark has not been opposed, or it had been opposed and the opposition has been rejected.

#### **16. Notification of Registration**

The Office shall notify the registration of a trademark, in an intellectual property gazette or in a newspaper having nationwide circulation, or in a radio or television or website at the expense of the applicant.

#### **17. The Right to Appeal**

(1) Any person aggrieved by the final decision of the Office on the registration of a trademark shall have the right to appeal to the court having jurisdiction.

(2) An appeal pursuant to Sub-Article (1) of this Article shall be submitted to the court within 60 days from the date of notification of the decision to the person concerned.

## **PART FOUR COLLECTIVE TRADEMARKS AND WELL-KNOWN MARKS**

### **18. Registration of Collective Trademarks**

(1) An application for registration of a collective trademark shall designate the trademark as collective trademark and shall be accompanied by a copy of the statutes governing the use of the collective trademark.

(2) The Provisions of this Proclamation concerning the registration of trademarks shall also apply to the registration of collective trademarks.

(3) The statutes referred to in Sub-Article (1) of this Article shall specify the name, headquarters, objectives and representatives of the association. It shall also indicate the group of persons entitled to use the trademark, the conditions for use and the rights and obligations of the parties concerned in the event of infringement of the trademark.

(4) The owner of the registered collective trademark shall notify the Office of any changes made in respect of the statutes submitted pursuant to Sub-Article (1) of this Article.

### **19. Persons Eligible to Apply for the Registration of Collective Trademark**

Trade unions, trade union federations or association may, in order to protect the rights of their members, apply for the registration of collective trademarks.

### **20. Cancellation of Registration of Collective Trademarks**

(1) The registration of a collective trademark shall be cancelled:

- (a) upon dissolution of the registered owner;
- (b) when the registered owner no longer satisfies the requirements of this Proclamation;
- (c) when the registered owner has used the trademark or knowingly allowed it to be used in conditions other than those prescribed in the statutes;
- (d) when the statutes contain provisions contrary to public order or morality.

(2) In the event of cancellation of a collective trademark, it may not be appropriated in respect of the same goods or services by a new registration, nor be used in any other way until a period of seven years has lapsed.

### **21. Statutes to be open for Inspection**

The statute governing the use of a registered collective trademark shall

be open to public inspection.

## **22. Amendment of statutes**

(1) An amendment of the statute governing the use of a registered collective trademark shall not be effective unless the amended statute is filed with the Office and registered.

(2) The Office, before registering any amended statute, may cause its publication, where it finds it necessary, with a view to inviting opposition and observations.

## **23. Well-known Trademarks**

(1) A trademark which is entitled to protection, under an international convention to which Ethiopia is a party, as a well-known trademark shall be protected under this Proclamation if it is well-known in Ethiopia and is a trademark of a person who is:

(a) the national of a state party to the convention; or

(b) domiciled in or has a real and effective industrial or commercial establishment in a state party to the convention,

whether or not such person carries on business or has any goodwill in Ethiopia.

(2) In determining whether a trademark is well-known in Ethiopia, for the purposes of Sub-Article (1) of this Article, due regard shall be given to the knowledge of the trademark in the relevant sector of the public, including knowledge which has been obtained as a result of the promotion of the trademark.

## **PART FIVE DURATION AND RENEWAL OF REGISTRATION OF TRADEMARKS**

### **24. Duration of Registration**

Without prejudice to the provisions of Article 35 to 37 of this Proclamation, the registration of a trademark shall remain valid for a period of seven years from the date of submission of the application for registration.

### **25. Renewal of Registration**

(1) Registration of a trademark may, upon request of the owner, be renewed for consecutive periods of seven years. The owner of the trademark shall attach a document showing the payment of renewal fee prescribed by the regulations.

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

(3) Renewal of the registration of a trademark shall be made within three months after the expiry of the registration period; provided, however, that after the expiry of the three months period, the registration may be renewed within the next six months, by paying in addition to the regular renewal fee, a penalty prescribed by the Regulations.

(4) The Office shall record renewal of the registration and notify same in an intellectual property gazette or in a newspaper having nationwide circulation, or in a radio or television or website at the cost of the owner of the trademark.

(5) A trademark not renewed within the time limit stated in Sub-Article (3) of this Article shall be considered to have been waived or cancelled.

(6) The Office shall remove the trademark from the register when it is not renewed in accordance with the provisions of this Article.

(7) Nothing under Sub-Articles (5) and (6) of this Article may prohibit any person including the former owner from seeking a registration for a trademark that has been waived or cancelled.

## **PART SIX RIGHTS CONFERRED BY REGISTRATION AND LICENSE CONTRACTS**

### **26. Rights Conferred by Registration**

(1) The owner of a registered trademark shall have the right to use or authorize any other person to use the trademark in relation to any goods or services for which it has been registered.

(2) Registration of a trade mark shall confer upon its owner the right to preclude others from the following:

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

(b) any use of a trademark, or a sign resembling it, without just cause and in conditions likely to be prejudicial to his interests; and

(c) other similar acts.

(3) For the purpose of the provisions of Sub Article (2) of this Article, a likelihood of confusion shall be presumed, in case of the use of an identical sign for identical goods or services.

(4) The provisions of Sub-Article (3) of Article 26 shall apply, mutatis mutandis, in any action instituted by the owner of a well-known trademark against any person in respect of the unlawful use of the well-known trademark.

### **27. Limitation of Rights Conferred by Registration**

(1) Registration of the mark shall not confer upon the owner the right to preclude third parties from using the trademark in relation to the goods lawfully sold in any country under that trademark, provided that these goods have not undergone any change.

(2) Registration of a trademark shall not confer upon its owner the right to preclude third parties from bona fide use of their names, addresses, pseudonyms, a geographical name, or exact indications concerning the kind, quality, quantity, destination, value, place of origin, time of production or supply of their goods or services, in so far as such use is confined to the purposes of mere identification or information and cannot mislead the public as to the source of the goods or services.

## **28. Transfer of Right**

(1) A right on a registered trademark or an application for registration of a trademark may be assigned or licensed in whole or in part.

(2) A request for transfer of rights on a registered trademark or an application for registration of a trademark shall be submitted in writing to the office. The application shall be accompanied with the agreement of transfer of right.

(3) Shares in a trademark, which is a subject of co-ownership, may not be transferred without the consent of all the co-owners.

(4) The right to a trademark can be transferred in or without connection with the business in which it is used. In case where there is a transfer of the business, the right to the trademark that is attached to the business passes over to the new owner, unless otherwise agreed.

(5) The Office may, refuse to effect the transfer, under Sub-Article (4) of this Article, of a trademark separately from the business where it finds that use of the trademark by the new owner may mislead the public.

(6) The Office, after examining the request for the transfer of right and upon payment of the fee prescribed by the Regulations, shall register and cause publication of the transfer.

## **29. License contracts**

(1) The owner of a registered trademark or of an application for registration of a trademark may by contract, grant to any other person a license to use the trademark. The contract shall be made in writing and shall indicate whether it is for all or part of the goods or services in respect of which the trademark is registered or an application is filed for.

(2) A license contract on a registered trademark or an application for registration of a trademark, as well as modification or termination of the license contract shall be submitted to the Office. The Office shall register the contract as well as its modification and termination and, by keeping the details as confidential, cause its publication in an intellectual property gazette or a newspaper having nationwide circulation. The license contract shall have no effect against third parties until so registered.

(3) A registered collective trademark or an application for the registration, of a collective trademark may not be the subject of a license contract.

### **30. Nullity of license contracts**

Any license contract on a registered trademark or an application for registration of a trademark, shall be null and void when it does not contain a provision for an effective control, by the licensor, of the quality of the goods or the services in connection with which the trademark may be used.

### **31. Invalid Clauses of License Contracts**

(1) Clauses in a license contract shall be null and void in so far as they impose upon the licensee restriction not deriving from the rights conferred by the registration of the trademark or unnecessary for the safeguarding of these right.

(2) Notwithstanding the provisions of Sub-Article (1) of this Article, the following shall not be deemed to constitute such restriction:

(a) limitation concerning the scope, territory or duration of use of the trademark or the quality of goods or services in connection with which the trademark may be used;

(b) justified control by the owner of the trademark under this Proclamation;

(c) the obligation imposed upon the licensee to abstain from all acts capable of prejudicing the validity of the registration of the trademark.

### **32. Right to Grant Further Licenses**

(1) In the absence of any provision to the contrary in the license contract, the grant of a license shall not prevent the owner of a registered trademark from using the trademark himself.

(2) When an exclusive license has been granted to a licensee, the owner of the trademark may not grant further licenses to third parties and, in the absence of any provision to the contrary in the license contract, may not use the trademark himself.

### **33. Right of licensee**

In the absence of any provision to the contrary in a license contract, the licensee shall be entitled to use a trademark during the duration of the registration, including renewals, in respect of all the goods or services for which the trademark is registered.

**PART SEVEN RENUNCIATION, CANCELLATION AND INVALIDATION OF A RIGHT ON A REGISTERED TRADEMARK**

**34. Renunciation of Right**

(1) The owner of a registered trademark, who wishes to renounce the registration either wholly or in respect of part of the goods or services for which the trademark is registered, may submit his application to the Office for the cancellation of the registration of the trademark.

(2) When a registered trademark has been subject to a license contract, the request for the renunciation of the right shall be accepted only upon submission of a written declaration by which the licensee consents to the renunciation.

(3) The Office upon receiving the application submitted pursuant to Sub-Article (1) of this Article shall cause the publication of such renunciation in an intellectual property gazette or a newspaper having nationwide circulation. Renunciation shall be effective only after the decision for cancellation has been entered into the register.

**35. Cancellation of trademark for Non use**

(1) Any interested person may submit a request in writing for the cancellation of the registration of a trademark to the Office on the ground that the trademark has not been in use.

(2) A trademark shall be considered of non use, where it is proved that the trademark has not, without legitimate reason, been used in Ethiopia during a continuous period of at least three years preceding the date of the request for the cancellation of the trademark, by the registered owner or a licensee in respect of any of the goods or services for which it was registered.

(3) The Office shall cancel the registration of the trademark upon ascertaining the fulfillment of the conditions specified under Sub-Article (2) of this Article. Where the owner can prove the non-use of the trademark only for some of the registered goods, the Office shall make partial cancellation.

(4) The registration may not be cancelled when the owner or a licensee proves that the non-use of the trademark was due to force majeure.



(5) The use of a trademark in a form differing in elements, which do not alter its distinctive character in which it was registered, shall not be a ground for cancellation of the trademark.

### **36. Invalidation of Registration**

(1) The registration of a trademark may be invalidated, by a written request of any interested person or by the initiative of the Office itself, when it is proved not to have initially fulfilled the conditions laid down under this Proclamation.

(2) The Office, prior to the invalidation, shall inform the owner, in writing, the ground for invalidation of the registration of a trademark.

(3) When the invalidation is made in respect of parts of the goods or services for which a trademark is registered, such invalidation shall affect those parts only.

### **37. Effects of Invalidation**

(1) The decision declaring the invalidation of registration of a trademark shall be effective as of the date of such registration. The Office shall publish the invalidation of the registration in an intellectual property gazette or a newspaper having nationwide circulation.

(2) Notwithstanding Sub-Article (1) of this Article, when the trademark has been subject to a license and if the licensor has benefited from the license contract, the invalidation of the registration shall not enable the licensee to claim the repayment of money.

### **38. Extension of Time**

The Office may, when it is satisfied that the circumstance so justifies upon receiving a written request and upon notice to the parties concerned and upon such terms as it may direct, extend the time limit prescribed for the execution of any act under this Proclamation and the Regulations. The extension may be granted though the time for doing the act has already expired.

## **PART EIGHT ENFORCEMENT OF RIGHTS**

### **39. Provisional measures**

(1) The competent court shall order prompt and effective provisional measures to:

(a) prevent an infringement of a right from occurring, in particular to prevent the entry into the channels of commerce of import and export goods after completing customs formalities; or

(b) preserve relevant evidence in regard to an alleged infringement of a right.

(2) The court shall, without summoning the defendant, have the power to adopt provisional measures where it finds it appropriate, in particular where any delay is likely to cause irreparable harm to the applicant or where there is a demonstrable risk of evidence being destroyed.

(3) In a suit for restraining the defendant from committing an infringement, the plaintiff may apply to the court for a temporary injunction to restrain the infringements until the suit is disposed of.

(4) The court, in deciding on an application of injunction submitted under Sub-Article (3) of this Article,

(a) shall consider if the threatened interest cannot be redressed by awarding damages, whether the threat is imminent, the prima facie strength of the action and the gravity of the prejudices a decision for or against may cause to either of the parties;

(b) may determine the duration of the injunction and the amount of money to be deposited or other security to be furnished by the applicant, as it thinks fit;

(c) may make a deeper investigation of the relative strength of the parties before granting the temporary injunction where the application of the criteria under paragraph (a) of this Sub-Article put the parties on equal position.

(5) Where an act that infringes the rights protected under this Proclamation is committed, the Provisions of the Civil Procedure Code and the Criminal Procedure Code on search and seizure shall be applicable.

(6) Whether provisional measures have been adopted without summoning the defendant, he shall be given notice, without delay after the execution of the measures at the latest. A review, including a right to be heard,

shall take place upon request of the defendant with a view to deciding, within a reasonable period after the notification of the measure, whether these measures shall be modified, revoked or confirmed.

(7) where provisional measures are revoked due to any act or omission by the applicant or upon subsequently ascertaining that there has been no infringement or threat of infringement of a trademark right, the court shall order the applicant upon request of the defendant to provide the defendant with appropriate compensation for any injury caused by such measures.

#### **40. Civil Remedies**

(1) The court hearing a case of infringement of a trademark owner's right may:

(a) pass an injunction to stop the defendant from continuing the act of infringement; and

(b) order the defendant to compensate the damage inflicted to the claimant due to the infringement.

(2) The amount of compensation to be awarded pursuant to Sub-Article (1)(b) of this Article shall be equal to the net profit derived by the defendant from the use of the trademark or the amount of royalty the defendant could have been charged had he used the trademark under the terms of a license contract whichever is higher, plus an amount that shall cover the expenses incurred by the claimant in connection with the suit.

(3) The whole of the net profit derived from the sale of the defendant's goods or services in connection with the use of the trademark shall be attributed to the use of the trademark unless the defendant proves that part of the profit is attributive to other marker factors.

#### **41. Criminal Sanctions**

(1) Unless heavier penalty is provided for under the Criminal Code, whoever intentionally violates a right protected under this Proclamation shall be punished with rigorous imprisonment of a term of not less than 5 years and not more than 10 years.

(2) Unless heavier penalty is provided for under the Criminal Code, whoever by gross negligence violates a right protected under this Proclamation shall be punished with rigorous imprisonment of a term not less than 1 year and not more than 5 years.

(3) The penalty, where appropriate shall include the seizure, forfeiture and destruction of the infringing goods and of any materials and implements use in the commission of the offense.

**42. Measures at customs port and stations**

(1) The Customs Authority may, on the basis of a written application accompanied with a certificate of trademark registration and other relevant evidence made by the right holder, and upon sufficient guarantee provided by the applicant, seize and detain goods which are subject to the alleged infringement of the applicant's right.

(2) The Customs Authority shall forthwith inform the applicant and the owner of the goods of the measure taken to seizer the said goods.

(3) The Customs Authority shall release the seized and detained goods after crediting the gurantee furnished unless the applicant brings court injunction within ten working days.

## **PART NINE MISCELLANEOUS PROVISIONS**

### **43. Trademarks Bulletin**

Without prejudice to matters to be published, pursuant to this Proclamation, in an intellectual property gazette or a newspaper having nationwide circulation, the Office may publish a trademarks bulletin to publicize trademarks.

### **44. Registration of Trademark Agents**

(1) Trademark agents shall be registered with the Office.

(2) The conditions for registration of agents shall be determined by the Regulations.

### **45. Access to Information**

(1) Any person may request for search of a trademark and obtain search report upon payment of fee prescribed in the Regulations.

(2) The Office shall, upon payment of the fee prescribed in the regulations, give permit to any person to inspect the Register and give a copy of extracts thereof.

### **46. Transitory Provisions**

(1) Trademarks deposited before the entry into force of this Proclamation shall be submitted for registration within eighteen months beginning from the entry in to force of this Proclamation.

(2) The Office shall examine and decide to or not to register deposited trade marks based on the requirements of this Proclamation.

(3) The competent court in accordance with Article 49 of this Proclamation shall have Jurisdiction over cases pending in different court prior to the coming in to force of this proclamation.

### **47. Power to Issue Regulations**

The Council of Ministers shall have the power to issue Regulations necessary for the implementation of this Proclamation.

### **48. Inapplicable Laws and Practices**

Any law or practice which is inconsistent with this Proclamation shall not be applicable with respect to matters provided for in this Proclamation.

**49. Competent Court**

The Federal Courts shall have jurisdiction over disputes and related matters that are governed by this Proclamation and the Regulations.

**50. Effective Date**

This Proclamation shall enter into force on the date of its publication in the Federal Negarit Gazeta.