

LEGISLATIVE DIGEST

An assessment of Trademarks
legislative framework in Ghana

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Legislation

**Trademarks Act, 2004 (Act 664) as amended
by Act 876**

Purpose of the legislation

**To provide the protection of trademarks
and for related matters**

Implementing institution

**Trademarks Registry, Registrar-General's
Department**

Affected industry

**All businesses and professional service
providers**

KEY DEFINITIONS IN THE ACT

Trademarks¹: A “trademark” means a sign or combination of signs capable of distinguishing the goods or services of one undertaking from the goods and services of another undertaking. It may consist of:

- a) Words, personal names, designs, letters, colours, numerals, shapes, holograms, sounds, or a combination of any of these elements or
- b) Slogans, where they are not long enough to be protected by copyright.
- c) A reference to a collective mark or certification mark.

Collective mark²: A collective mark is a visible sign of an association of manufacturing, trading, or service enterprise that serves to distinguish the goods or services of the members of the association from those of other enterprises.

Certification mark³: A certification mark is a sign or combination of signs capable of designating any specific characteristic, including quality, origin, or methods of production, material, mode of manufacture of goods, or performance of services.

Goods⁴: Anything which is the subject of trade, manufacture, or merchandise.

¹Section 1, Trademarks (Amendment) Act, 2014 (Act876)

²Section 2, Trademarks (Amendment) Act, 2014 (Act876)

³Section 2, Trademarks (Amendment) Act, 2014 (Act876)

⁴Section 52, Trademarks Act, 2004 (Act 664)

Name⁵: A name includes an abbreviation of a name.

Trade name⁶: A trade name means a name or designation which identifies and distinguishes an enterprise.

RIGHTS CONFERRED BY THE ACT

1. The right to be issued a registration certificate if the registration is not opposed within the prescribed time limit or the registration has been opposed but the opposition was decided in favor of the applicant.⁷
2. The right of exclusive use by the registered owner of a trademark in relation to any goods or services for which the trademark was registered for a period of ten (10) years from the filing date of the application for registration and subject to renewal. (A grace period of 6 months is allowed for late payment of renewal fee upon the payment of the prescribed surcharge).⁸
3. The right of the registered owner to institute legal action against any person who infringes a registered trademark by using the registered mark without permission or performing acts presupposes that an infringement may occur.⁹
4. The right of the registered owner to consent to the use of the registered mark by other persons or such consent to the transfer in whole or in part of the registered trademark for the goods or services for which it has been registered.¹⁰
5. The right of the registered owner to prevent the use of a sign similar to the registered trademark and use in relation to goods or services similar to those for which the mark has been registered where confusion may arise in the public.¹¹
6. The right to request the removal of a trademark for non-use for a continuous period of five years or longer.¹²
7. The right of a registered owner to change ownership of a registered trademark.¹³

⁵Section 52, Trademarks Act, 2004 (Act 664)

⁶Section 52, Trademarks Act, 2004 (Act 664)

⁷Section 7, Trademarks Act, 2004 (Act 664)

⁸Section 10 and 11, Trademarks Act, 2004 (Act 664)

⁹Section 9 (2) (a) (b), Trademarks Act, 2004 (Act 664)

¹⁰Section 15, Trademarks (Amendment) Act, 2014 (Act 876)

¹¹Section 9 (4), Trademarks Act, 2004 (Act 664)

¹²Section 14 (1), Trademarks Act, 2004 (Act 664)

¹³Section 15 (1) (a) (b), Trademarks Act, 2004 (Act 664)

8. The right of application to rectify, expunge, or vary entries in the register of trademarks.¹⁴

OBLIGATIONS IMPOSED UNDER THE ACT

1. The obligation to apply for trademark registration in the prescribed form, by paying the prescribed fees.¹⁵
2. The obligation to provide accurate and true descriptions of subject matter marks for registration as trademarks.¹⁶
3. The obligation to furnish the Registrar with information relating to a change in ownership of a registered trademark and a license contract.¹⁷
4. The obligation on persons to provide information as informants in relation to trade descriptions and fraudulent marks¹⁸
5. The obligation to pay the award of cost made by the Registrar.¹⁹
6. The obligation to monitor the unauthorized use of registered trademarks and take the necessary steps to stop and prevent further uses.

SANCTIONS IMPOSED UNDER THE ACT

1. The power of the High Court to invalidate the registration of a trademark or a collective mark on proven infractions specified by Act 664 (as amended)²⁰
2. Prosecution of persons who falsely apply a trademark or mark to goods without the consent of the owner of the trademark or mark applied resembles the original as to likely to deceive.
3. Prosecution of persons who forges a trademark – without the consent of the owner of the trademark makes the trademark or mark so nearly resembling that trademark as to be likely to deceive or falsifies a genuine trademark, whether by alteration, addition, effacement, or otherwise.
4. A person commits an offense and is liable on a summary conviction to a fine not exceeding 500 penalty units or to a term of imprisonment not exceeding two years or to both if the person contravenes the provisions relating to trademarks and trade descriptions.

¹⁴Section 20, Trademarks Act, 2004 (Act 664)

¹⁵Section 4, Trademarks (Amendment) Act, 2014 (Act 876)

¹⁶Section 5, Trademarks (Amendment) Act, 2014 (Act 876)

¹⁷Section 15, Trademarks Act 2004 (Act 664)

¹⁸Section 28, Trademarks Act 2004 (Act 664)

¹⁹Section 34 (1), Trademarks Act 2004 (Act 664)

²⁰Section 11 and 12, Trademarks Act 2004 (Act 664)

5. A person commits an offence and is liable on summary conviction to a fine not less than 250 penalty units and not more than 750 penalty units or to a term of imprisonment of not less than 5 years and not more than 15 years or to both if the person for the purposes of gain for that person or any other person or with the intent to cause loss to any other person and without consent of the owner of a registered trademark uses or applies the trademarks in a manner prohibited by Act 664 (as amended).
6. A person commits an offence when he or she knowingly makes or causes a false entry to be made in the register of trademarks and is liable on summary conviction to a fine not exceeding 500 penalty units or to imprisonment for a term not exceeding one year or to both.
7. A person who commits an offence of falsely representing a trademark as registered is liable on summary conviction to a fine not exceeding 250 penalty units or to imprisonment for a term not exceeding six months or to both and in the case of a continuing offence, a further fine not exceeding 25 penalty units for each day on which the offence continues.
8. A person who commits the offence of unlawful use of official badges is liable on summary conviction to a fine not exceeding 250 penalty units or to imprisonment for a term not exceeding six months or to both and in the case of a continuing offence, a further fine not exceeding 25 penalty units for each day on which the offence continues or to imprisonment not exceeding three months instead of a fine.

NB. Limitation of prosecution: A prosecution for an offence shall not be commenced after the expiration of three years from the commission of the offence, or one year after the first discovery of the commission, whichever occurs first.

DEFENCES TO SANCTIONS UNDER THE ACT²¹

1. Where a person is charged with an offence in relation to the contravention of trademarks and trade descriptions, it is a good defence if that person proves the act was done without the intent to defraud.
2. Where a person is charged with the offence of applying a false trade description to goods, falsely applying to goods a trademark or mark so nearly resembling a trademark as to be likely to deceive or use an article or instrument to forge a trademark or cause the infringement of a mark, it is a good defence if that person proves:
 - a. that being in the business of making articles or other instruments to make trademarks, the person applied marks or descriptions to goods and was not interested in the goods for profit or commission dependent on the sale of the goods.

²¹Section 27, Trademarks Act 2004 (Act 664)

- b. that reasonable precautions were taken against committing the offence charged.
 - c. that at the time of the commission of the alleged offence, there was no reason, as an employee, to doubt the genuineness of the trademark, mark, or trade and description.
 - d. that the police officer was given the relevant information with respect to the persons on whose behalf the trademark, mark, or description was applied.
3. Where a person is charged with the offence of selling or exposing for or possessing for sale or for any purpose of trading or manufacturing any goods or things to which a forged trademark or false trade description is applied or to which a trademark or a mark so nearly resembling a trademark as to be likely to deceive is applied, it is a good defence for that person to prove:
- a. that having taken reasonable precautions against committing an offense, that person, did not at the time of the commission of the alleged offenses have a reason to doubt the genuineness of the trademark, mark, or trade description and that on demand made by or on behalf of the police officer, gave the information that was required with respect to the persons from whom the goods or things were obtained or that otherwise, that person had acted innocently.

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