

New Namibia Industrial Property Act imminent

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After years of anticipation, the Industrial Property Regulations were published in the Namibian Government Gazette on 1 June 2018. The effect of the publication is that the new Industrial Property Act No. 1 of 2012 will come into operation on 1 August 2018.

The Act repeals, amongst other legislation, the Trade Marks in South West Africa Act dating back to 1973 and introduces new legislation for patents, industrial designs, trade marks and trade names. Copyright protection is still mainly governed separately under the existing Copyright and Neighbouring Rights Protection Act 6 of 1994.

Insofar as trade marks are concerned, some of the noteworthy introductions include new requirements for assignments and provisions relating to restorations, alterations/amendments, joint ownership, licence contracts and registered users.

No provision is made in the new Act for defensive trade mark registrations, although existing registrations will remain valid. The Act also makes it possible to register collective marks, whereas previously only certification marks were registrable.

Another important change is that the non-use cancellation period has been shortened from 5 years to 3 years.

Arguably the most significant change is that trade mark infringement proceedings must now be brought before the newly-established Industrial Property Tribunal. The Tribunal will also be responsible for appeals from the Registrar. Appeals from the Tribunal to the Namibian High Court are possible.

Recognition has been afforded in the new Act to foreign well-known trade marks in accordance with Article 6bis of the Paris Convention for the Protection of Industrial Property.

Provisions are also now in place relating to multi-class applications and applications filed in terms of the Madrid Protocol and the Banjul Agreement. However, it remains to be seen how such applications will be dealt with practically by the trade marks registry.

Until such time as the Namibian Registry is capable of examining newly filed trade mark applications within WIPO's strict 12-18 month timelines for international (Madrid Protocol) registrations, it is highly recommended for brand owners to continue to secure national registrations for their valuable trade marks in order to avoid possible enforcement difficulties from arising. We are monitoring this situation closely, but given the Registry's present backlogs and examination timelines, it is unlikely that the Madrid system would become a viable solution for brand owners to reliably secure statutory protection for their trade marks in Namibia any time soon.

As far as Patents is concerned, the New Act is a drastic improvement on the very outdated 1923 Proclamation. It recognises Namibia's obligations in terms of several international treaties including the Patent Co-Operation Treaty (PCT), ARIPO, Madrid Agreement and the Hague Agreement.

The Act introduces absolute novelty and substantive examination for all patent applications. In addition, in a move that mirrors steps taken to protect and recognise the value of indigenous biological resources in other countries, the Act requires applicants to disclose details of this in the application if the subject matter of a patent application is derived from or developed with biological resources or associated indigenous or traditional knowledge.

Finally, the Act introduces a 20 year patent term and significant increases to the official fees for all IP matters.

For further updates, information and queries on copyright law, trade mark, patent and design filings in Namibia, please contact namibia@adamsadams.com



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