

ZAMBIA

Simon Kapampa, Luyando DK Malundu

(Musa Dudhia & Co)

LEGAL FRAMEWORK

Domestic law

1. What is the primary legislation governing trademarks in your jurisdiction?

The Trade Marks Act Chapter 401 of the Laws of Zambia as amended by Act No. 2 of 2010 (the TMA) and its attendant regulations, and the Merchandise Marks Act Chapter 405 of the Laws of Zambia are the primary pieces of legislation governing trademarks in Zambia.

International law

2. Which international trademark agreements has your jurisdiction signed?

Zambia has signed the following international trademarks agreements:

- the World Trade Organization Agreement on Trade-Related Aspect of Intellectual Property Rights (WTO/TRIPS);
- the Paris Convention for the Protection of Industrial Property (Paris Convention); and
- the Madrid Protocol relating to the International Registration of Marks (Madrid Protocol).

Regulators

3. Which government bodies regulate trademark law?

The Patents and Companies Registration Agency, which is established under the Ministry of Commerce, Trade and Industry, is the government body that regulates trademark law in Zambia.

REGISTRATION AND USE

Ownership of marks

4. Who may apply for registration?

Any person (ie, natural person, body corporate or firm) claiming to be the proprietor of a trademark used or proposed to be used by that person can apply for registration of the relevant trademark.

Scope of trademark

5. What may and may not be protected and registered as a trademark?

A trademark may be protected and registered if it is distinctive and contains or consists of at least one of the following essential particulars:

- a name of a company, individual or firm, represented in a special or a particular manner;
- the signature of the applicant for registration or some predecessor in the applicant's business;
- an invented word or invented words;
- a word or words having no direct reference to the character or quality of the goods;
- a word or words not being (according to its ordinary signification) a geographical name or surname; and
- any other distinctive mark (ie, a device, brand, heading, label, ticket, letter,

numeral or any combination thereof).

The following cannot be registered as a trademark under the Trade Marks Act (TMA);

- all marks that do not meet the requirements of the TMA (ie, marks that lack distinctiveness);
- a mark with the words 'Patent', 'Patented', 'Registered', 'Registered Design', 'Copyright', 'Entered at Stationers Hall', 'To counterfeit this is a forgery' or words of like effect;
- representations of the President or any colourable imitations thereof;
- any words such as 'the President', 'Republic' or 'Zambia' or any letters or devices if used in such a manner as to be likely to lead persons to think that the applicant either has or recently has had patronage or authorization of the President or from the government of the Republic of Zambia, whether or not such may be the case;
- the words 'Red Cross' or 'Geneva Cross' and representations of the Geneva and other crosses in red or of the Swiss federal cross in white on a red ground or silver on a red ground, or such representations in a similar colour or colors;
- representations of Armorial Ensigns of Zambia or devices so nearly resembling it as to be likely to be mistaken for it;
- representations of the national flag of Zambia;
- a mark that is either identical to or closely resembles an already existing registered trademark in respect of the same goods or description of goods, as to be likely to deceive or cause confusion;
- a mark that is contrary to law or morality;

- a scandalous design;
- generic terms. A mark is generic if the mark is the known name of the product; and
- marks that are descriptive (ie, marks that describe the character or quality of a product for which the mark is being registered).

The TMA grants a registered user of a trademark the exclusive right to the use of the registered mark in relation to the particular goods or classes of goods. This right encompasses two things: the right to use the trademark and the right to exclude others from using it (ie, by instituting proceedings in the courts of law in respect of an infringement of the registered trademark).

Certification marks may be registered under the TMA. However, the TMA does not provide for the protection or registration of service marks. In practice, however, owners of service marks seeking to protect their marks in Zambia have to register them in the goods classes that are most closely associated to the relevant services in relation to which the service mark is used by the proprietor. Although this is the avenue that owners of service marks have opted to use in order to protect their service marks, it remains to be tested whether the courts would uphold the registrations of a service mark and relevant claim of infringement. Similarly, the TMA does not recognize or afford protection to collective marks and non-traditional marks such as sounds, smells or designs.

Unregistered trademarks

6. Can trademark rights be established without registration?

Full trademark protection can only be properly secured by registration. This is because an individual who uses a trademark that is not registered does not have the exclusive right to use the trademark or to institute proceedings in the courts in respect of an infringement of the trademark under the TMA. For instance, in the case of *DH Brothers Industries (PTY) Limited v Olivine Industries (PTY)*

Limited [2012] ZMSC 17, the court held that the appellant's trademark could not be accorded protection

on account of non-registration even though the appellant had shown sufficient prior use of the mark in Zambia. The only available right to a proprietor of a non-registered trademark is to bring an action under the common law tort of passing off, which can be used by a proprietor of an unregistered trademark to prevent third parties from using or passing-off the proprietor's mark as their own (*Trade Kings Limited v Unilever PLC & Others*) (SCZ 2 of 2000) [2000] ZMSC 2. The common law remedies under passing-off include damages and injunctive relief.

Famous foreign trademarks

7. Is a famous foreign trademark afforded protection even if not used domestically? If so, must the foreign trademark be famous domestically? What proof is required? What protection is provided?

Famous foreign trademarks (well-known marks) even if used domestically are not afforded protection by the TMA if not registered in Zambia (*Three Angels Message vs The Registrar of Companies (HP 897 of 2014) [2014] ZMHC 166*).

The only protection afforded to an unregistered well-known trademark under the law, whether or not it is used domestically, is under the common law tort of passing-off, which a proprietor can use to stop third parties from passing off the mark as their own.

The benefits of registration

8. What are the benefits of registration?

The following are the benefits of registration under the TMA;

- the exclusive right to use the mark on the particular goods or classes of goods and restrain others from using the mark in question;

- unlike proprietors of unregistered trademarks whose only remedy is to bring an action for passing off, registration of trademarks provides stronger protection to the proprietor because in the event of an infringement, a proprietor of a registered trademark is allowed to bring an action for infringement in the High Court of Zambia that, if successful, affords the proprietor a range of remedies such as injunctions, damages, account of profits, delivery up and/or destruction of the offending material, and removal of the offending trademark from the trademark register if it was invalidly registered; and
- the registration of a trademark entitles the proprietor to border protection measures provided for under the Merchandise Marks Act, which, inter alia, expressly prohibits the importation of any goods bearing a forged trademark or false trade description or any goods bearing a trademark or mark closely resembling a registered trademark so as to likely be deceptive.

Filing procedure and documentation

9. What documentation is needed to file a trademark application? What rules govern the representation of the mark in the application? Is electronic filing available? Are trademark searches available or required before filing? If so, what procedures and fees apply?

The application process for the registration of a trademark is as follows:

- the applicant filing an application form for registration in the prescribed form (which must contain, inter alia, a representation of the mark in the space provided on the application form for that purpose); and where the applicant acts through a trademark agent, a power of attorney simply signed with the Patents and Companies Registration Agency (PACRA) for approval of the Registrar. Once the application is filed, an applicant is then issued with a lodgement certificate that is used to track the progress of their application;

- the registrar may refuse the application or may accept it absolutely or subject to such amendments, modifications, conditions or limitations, if any, as he or she may think right;
- if the application is accepted (whether absolutely or subject to conditions imposed by the Registrar) PACRA issues a notice of acceptance and the applicant will be required to immediately advertise the trademark in the Trade Marks Journal. Any person is allowed, within two months of the advertisement, to give notice to the Registrar in the prescribed form of opposition to the registration; and
- if the application is unopposed within the prescribed period (ie, two months of the advertisement), the Registrar will register the trademark and issue a certificate of registration. However, if the application is opposed, the Registrar will give the parties a hearing to hear the evidence of either party and to determine whether the opposition has merit. If the opposition is unsuccessful, the Registrar will register the trademark and issue the applicant with a certificate of registration. If the opposition is successful, then the registration of the trademark may be refused.

Electronic filing of trademarks is not yet available.

Furthermore, trademark searches are available to an intending proprietor. It is not mandatory to conduct a trademark search; however, it is advisable to do so as this helps the would-be proprietor to know whether their trademark is available for registration.

Registration time frame and cost

10. How long does it typically take, and how much does it typically cost, to obtain a trademark registration? When does registration formally come into effect? What circumstances would increase the estimated time and cost of filing a trademark application and receiving a registration?

Registration must be completed within 12 months of the date of the application for registration.

In terms of costs, the following are the general cost that an applicant is likely to incur:

- search fees of 33.60 kwacha (approximately US\$1.3) if the person conducting the search is a Zambian citizen and 350.10 kwacha if the person conducting the search is a foreigner; and
- application fees for a single class of goods in relation to which the application is made amount to about 500.10 kwacha for a Zambian citizen and 1,500 kwacha for a foreigner.

Factors likely to affect the trademark registration and costs include applications opposing the registration of the trademark as additional fees may be incurred in relation to such application. Further, the use of trademark agents and legal representatives may increase the cost of the application.

Classification system

11. What classification system is followed, and how does this system differ from the International Classification System as to the goods and services that can be claimed? Are multi-class applications available and what are the estimated cost savings?

The classification system for the purposes of the registration of trademarks used in Zambia is the international (Nice) Classification of Goods and Services. However, multi-class applications are not available in Zambia.

Examination procedure

12. What procedure does the trademark office follow when determining whether to grant a registration? Are applications examined for potential conflicts with other trademarks? Are letters of consent accepted to

overcome an objection based on a third-party mark? May applicants respond to rejections by the trademark office?

The Registrar is mandated to conduct a search among the registered marks and pending applications. The search is conducted for purposes of determining potential conflicts with other trademarks or whether the current application for registration is in the register for the same class of goods or so nearly resembling it as to render the mark applied for likely to deceive or cause confusion.

Use of a trademark and registration

13. Does use of a trademark or service mark have to be claimed before registration is granted or issued? Does proof of use have to be submitted? Are foreign registrations granted any rights of priority? If registration is granted without use, is there a time by which use must begin either to maintain the registration or to defeat a third-party challenge on grounds of non-use?

No, use of a trade or service mark does not need to be claimed before registration. Prior use may be claimed before registration of the trademark but the TMA also acknowledges that that even though an individual has not begun to use, they are still eligible to apply for registration based on the intention to use the said trademark. If the application is granted without use, the proprietor of trademark is required to put the trademark to use within a period of five years. If the trademark is not used for a continuous period of five years or more, this puts the mark at risk of removal from the register.

Foreign registrations are granted priority if the trademark has been registered in a country that is a party to the Paris Convention and the proprietor files an application in Zambia. The proprietor may claim priority within a period of six months from the date of filing of the application for registration of the trademark in a country that is a party to the Paris Convention.

Markings

14. What words or symbols can be used to indicate trademark use or registration? Is marking mandatory? What are the benefits of using and the risks of not using such words or symbols?

™ is used to refer to unregistered trademarks and ® is used to make reference to registered marks. Although it is not mandatory to use such symbols, it is important to use the trademark symbols because they inform the public on one's rights in the good.

Appealing a denied application

15. Is there an appeal process if the application is denied?

Yes, both administrative and judicial appellate procedures are available under trademark law. Administrative appeals are available to an aggrieved party after the Registrar refuses to register the trademark or makes a decision that adversely affects them. The affected party may notify the Registrar regarding their intention to be heard on the matter and the Registrar at PACRA will issue a hearing date. Further, a party aggrieved by the decision of the Registrar is entitled to appeal to the High Court of Zambia. A person dissatisfied with the decision of the High Court may apply to the Court of Appeal and finally the Supreme Court of Zambia, which is the last appellate court.

Third-party opposition

16. Are applications published for opposition? May a third party oppose an application prior to registration, or seek cancellation of a trademark or service mark after registration? What are the primary bases of such challenges, and what are the procedures? May a brand owner oppose a bad-faith application for its mark in a jurisdiction in which it does not have protection? What is the typical range of costs associated with a third-party opposition or cancellation proceeding?

Applications for registration are published in the Trade Marks Journal for period of two months and it is from this publication that third parties may oppose the registration of a trademark. The application to oppose is made prior to the registration of the trademark. It is made by filing with the Registrar a notice of opposition and supporting evidence in the prescribed form and upon payment of a prescribed fee. However, the third party must have the necessary *locus standi* if the application is to be successful (ie, they must be a registered proprietor or must have sufficient interest to successfully oppose the registration of the trademark in question).

The grounds of opposition are that the trademark for which the application is sought is similar to a registered trademark for the same class of goods or so nearly resembling it as to render the mark applied for likely to deceive or cause confusion.

The following is the procedure for opposing an application of registration of a trademark:

- the interested party must file a notice of opposition with the Registrar within two months of publication of the trademark intended to be registered in the Trade Marks Journal, which notice must be shared with the applicant as soon as it is received by the Registrar;
- within two months from receipt of the application for opposition, the applicant must send a counterstatement to the Registrar;
- the Registrar must share the counter statement with the opponent upon receipt of the same. The opponent is then required, within two months of receiving the counterstatement, to provide the Registrar with evidence in opposition;
- upon completion of the evidence, the Registrar is required to give notice to the parties of the date when the Registrar will hear the arguments in the case; and

- at the end of the hearing, the Registrar may decide to refuse the registration of such a trademark or register it subject to conditions.

Duration and maintenance of registration

17. How long does a registration remain in effect and what is required to maintain a registration? Is use of the trademark required for its maintenance? If so, what proof of use is required?

Registration of a trademark remains in force for seven years from the date of application for registration and for a term of 14 years from the date of expiration if renewed. Use of a trademark is required to maintain its registration because if a proprietor does not use their trademark for a continuous period of five years or more, a person may apply to the Registrar for the removal of such trademark from the register. However, the Registrar shall not remove a trademark from the register if the proprietor furnishes proof of special circumstances that prevented them from using the trademark.

Surrender

18. What is the procedure for surrendering a trademark registration?

Where a proprietor intends to surrender their trademark, they shall make an application for cancellation of the registered trademark to the Registrar in the prescribed form and upon payment of the prescribed fee. Thereafter, after receipt of such application shall cause the Registrar to strike out the trademark from the register.

Related IP rights

19. Can trademarks be protected under other IP rights?

No, no other IP rights confer protection on trademarks.

Trademarks online and domain names

20. What regime governs the protection of trademarks online and domain names?

A domain name is registered through an internet service provider (ISP). ISPs are licensed to register domain names by the Zambia Information and Communications Technology Authority. Once a domain name has been registered, a similar domain name cannot be registered if there is a likelihood that it will cause confusion.

LICENSING AND ASSIGNMENT

Licences

21. May a licence be recorded against a mark in the jurisdiction? How? Are there any benefits to doing so or detriments to not doing so? What provisions are typically included in a licensing agreement?

Yes, a licence may be recorded against a mark in the jurisdiction. This is achieved by the registered proprietor and proposed registered user making an application in the prescribed form for the registration of the licence in Zambia with the Registrar.

Assignment

22. What can be assigned?

Trademarks both with and without goodwill may be assigned in the prescribed manner and payment of the prescribed fees. The assignment may be whole or partial to the goods in relation to which that particular trademark is registered. Other business assets do not need to be assigned to make the transaction valid.

Assignment documentation

23. What documents are required for assignment and what form must they take? What procedures apply?

The form for assignment of trademarks is that it must be in writing and no notarization. The registered proprietor is required to lodge a prescribed form with the Registrar and pay the prescribed fee.

Validity of assignment

24. Must the assignment be recorded for purposes of its validity?

Yes, it must be recorded in the Register of trademarks with the Patents and Companies Registration Agency.

Security interests

25. Are security interests recognized and what form must they take? Must the security interest be recorded for purposes of its validity or enforceability?

The Trade Marks Act (TMA) does not provide for the registration of security interests in relation to trademarks. However, trademarks may be used as security. Such security interest must be registered in the Collateral Registry in line with the Movable Property (Security Interest) Act No. 3 of 2016.

ENFORCEMENT

Trademark enforcement proceedings

26. What types of legal or administrative proceedings are available to enforce the rights of a trademark owner against an alleged infringer or dilutive use of a mark, apart from previously discussed opposition and cancellation actions? Are there specialized courts or other tribunals? Is there any provision in the criminal law regarding trademark infringement or an equivalent offence?

There is no special tribunal set up to enforce matters relating to infringement of trademarks and the High Court for Zambia is the designated court that settles disputes arising from infringement of trademarks. To this extent, the proprietor

of the trademark has the right to commence legal proceedings in the High Court of Zambia for any infringement of the registered trademark.

Yes, the Trade Marks Act (TMA) provides for criminal liability for the following offenses:

- submission of false information to the Registrar for purposes of deceiving the Registrar.
- making false entries in the register of trademarks; and
- falsely representing a trademark as registered or registered in respect of certain goods;
- giving false evidence.

Any person found guilty of these offenses may be liable to a fine or imprisonment or both.

Contained in section 377 of the Penal Code Chapter 87 of the Laws of Zambia, which provides for the offence of counterfeiting trademarks as a misdemeanor. The Penal Code Cap 87 of the Laws of Zambia codifies its own definition of what amounts to a trademark, which is contained in section 376.

Procedural format and timing

27. What is the format of the infringement proceeding?

Infringement proceedings are undertaken in the High Court of Zambia before the Principal or Commercial Registry of the High Court. Rules relating to discovery, testimony and expert witnesses will be as laid out in the rules of procedure of the relevant courts. However, it must be noted that discovery, live testimony and testimony of experts are generally allowed.

It is not possible to give an estimate of the period of enforcement proceedings as the duration of legal proceedings in Zambia varies.

In relation to criminal enforcement mechanism, the Zambia Police (Intellectual Property Unit) is responsible for prosecutions relating to trademark infringement.

Burden of proof

28. What is the burden of proof to establish infringement or dilution?

The requisite burden of proof in an infringement action is the same as in any civil matter, that is, on a balance of probabilities.

Standing

29. Who may seek a remedy for an alleged trademark violation and under what conditions? Who has standing to bring a criminal complaint?

A trademark proprietor or licensee of a permitted user may seek recourse for an alleged violation of a registered trademark.

In Zambia, the state has the requisite standing to bring action in a criminal matter.

Border enforcement and foreign activities

30. What border enforcement measures are available to halt the import and export of infringing goods? Can activities that take place outside the country of registration support a charge of infringement or dilution?

The Merchandise Marks Act expressly prohibits the importation of any goods bearing a forged trademark or false trade description or any goods bearing a trademark or mark closely resembling a trademark so as to likely be deceptive. The Zambia Police (Intellectual Property Unit), the Zambia Revenue Authority and the Zambia Bureau of Standards are the regulatory authorities mandated by law to prevent importation of such goods (ie, by seizure of the goods and in some cases prosecution of offenders). Activities that take place outside Zambia cannot support an infringement charge because trademark rights are territorial

and can only be enforced in the country of registration.

Discovery

31. What discovery or disclosure devices are permitted for obtaining evidence from an adverse party, from third parties, or from parties outside the country?

In terms of infringement proceedings instituted into court, discovery or disclosure devices are permitted in line with the rules of court, such as written documentation, tape recordings, video films and computer data bases.

Timing

32. What is the typical time frame for an infringement or dilution, or related action, at the preliminary injunction and trial levels, and on appeal?

Time frames in litigation are not standard because they are usually judge driven. This entails that the time taken to dispense certain matters is largely affected by the workload of the particular judge and their efficiency. Therefore, dispensation of an infringement action at the preliminary stage (ie, opposition applications) is faster than that of actual trial and appeal. It can take anywhere from six months to three years.

Limitation period

33. What is the limitation period for filing an infringement action?

The TMA does not provide a limitation period within which an action for infringement can be commenced in court. However, the Limitation Act, 1939 prescribes six years as the time period within which civil suits should be made from the date of the cause of action.

Litigation costs

34. What is the typical range of costs associated with an infringement or dilution action, including trial preparation, trial and appeal?

Litigation costs are generally based on what has been agreed upon between the lawyer and the client. In certain circumstances the lawyer may opt to charge on an hourly rate and the rate may be different according to the experience of the lawyer. Therefore, it is not possible to give an estimate on costs related to an infringement action. However, a successful party can recover costs (ie, all legal costs and expenses related to the action), which costs are rewarded at the court's discretion and taxed in default of agreement.

Appeals

35. What avenues of appeal are available?

The following avenues of appeal are available:

- a party aggrieved with the decision of the Registrar may appeal to the High Court;
- appeals from decisions of the High Court lie to the Court of Appeal; and
- appeals from a decision of the court of appeal lie to the Supreme Court.

Defenses

36. What defenses are available to a charge of infringement or dilution, or any related action?

The defenses available to a charge of infringement or dilution or related action vary depending on the grounds on which such action is commenced. However, the following defenses may be available: consent; and that there is no likelihood of confusion, where an application is made on the ground that a registered trademark is identical to or closely resembles a trademark registered earlier.

Remedies

37. What remedies are available to a successful party in an action for infringement or dilution, etc? What criminal remedies exist?

The following remedies are available to a successful party in an action for infringement or dilution:

- damages;
- delivery up and/or destruction of the offending goods;
- an account for profits;
- injunctions or interdict. The injunction can either be to compel or restrict a party from carrying on the infringing act; and
- criminal sanctions such as a fine or imprisonment or both.

ADR

38. Are ADR techniques available, commonly used and enforceable? What are the benefits and risks?

The TMA is silent as to whether trademark rights can be enforced by way of arbitration. In practice, however, ADR techniques may be used. This is primarily because within the Zambian jurisdiction ADR is available when it has been prescribed by legislations or when parties to a contract agree to submit any dispute arising out of the contract to one of the ADR mechanisms such as arbitration, mediation and conciliation. To this extent, given that both statutes providing for arbitration and court annexed mediation do not exclude intellectual property disputes from being amenable to those ADR techniques, trademark-related disputes may be resolved through arbitration and mediation.

The benefits of ADR mechanisms are as follows:

- they are quicker as opposed to litigation;

- they are less costly;
- most ADR mechanisms have a greater degree of party autonomy; and
- there is confidentiality.

The following are the risks of ADR mechanisms:

- ADR mechanisms such as mediation are not binding unless undertaken through the court system (court annexed mediation). However, parties are not mandated to conclude their dispute through court annexed mediation; and
- ADR techniques such as arbitration may not be as cheap in comparison to litigation.

UPDATE AND TRENDS

Key developments of the past year

39. Are there any emerging trends, notable court rulings, or hot topics in the law of trademark infringement or dilution in your jurisdiction?

As of 26 December 2023, the Trade Marks Act No. 11 of 2023 (the New TMA) was enacted into law.

However, the New TMA is not yet operational and will only become operation at a date designated by the minister by statutory instrument. The New TMA has brought about tremendous developments in Zambia such as the recognition and protection of well-known marks, services marks, collective marks and geographical indications. Further, the Act seeks to domesticate the Madrid Protocol relating to the international registration of marks.

** The information in this chapter was accurate as at January 2024.*