

ACTS OF GHANA

FOURTH REPUBLIC

INDUSTRIAL DESIGNS ACT, 2003 (ACT 660)

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THE SIX HUNDRED AND SIXTIETH

ACT OF THE PARLIAMENT OF THE REPUBLIC OF GHANA

ENTITLED

INDUSTRIAL DESIGNS ACT, 2003

AN ACT to revise the enactments on the protection of industrial designs and to provide for related matters.

DATE OF ASSENT: 31st December, 2003.

BE IT ENACTED by Parliament as follows

Section 1—Definition of Industrial Design

(1) For the purpose of this Act

(a) a composition of lines or colours, any three-dimensional form or any material, whether or not associated with lines or colours,

(b) a textile design

is an industrial design where the composition, form or material gives a special appearance to a product of industry or handicraft and can serve as a pattern for a product of industry or handicraft.

(2) The protection under this Act is not applicable to anything in an industrial design which serves solely to obtain a technical result to the extent that it leaves no freedom as regards arbitrary features of appearance.

Section 2—Registrable Industrial Design

(1) An industrial design is registrable if it is new.

(2) An industrial design is new or original if it significantly differs from known designs or combinations of known design features.

(3) For the purposes of subsection (2), disclosure to the public of an industrial design shall not be taken into consideration if the disclosure

(a) occurred within twelve months preceding the filing date or where applicable, the priority date of the application; and

(b) was as a result of acts committed by the applicant or the applicant's predecessor-in-title or of an abuse committed by a third party with regard to the applicant or the applicant's predecessor in title.

(4) An industrial design which is contrary to public order or public morality is not registrable.

Section 3—Right to Registration

(1) Where a person creates an industrial design, the right to the registration of that industrial design belongs to the creator.

(2) Where two or more persons create the same industrial design, the right to registration of that industrial design belongs to them jointly.

(3) Where two or more persons have created the same industrial design independently of each other, the person whose application has the earliest filing date or, if priority is claimed, the earliest validly claimed priority date, shall have the right to register the industrial design, as long as the application is not withdrawn, abandoned or rejected.

(4) The right to an industrial design may be assigned, transferred or devolve by succession.

(5) Where an industrial design is created in execution of an employment contract, the right to registration of the industrial design belongs, in the absence of contractual provisions to the contrary, to the employer.

Section 4—Naming the Creator

(1) The creator shall be named the creator in the registration of the industrial design unless the creator indicates in a special written declaration signed by the creator and addressed to the Registrar that the creator does not wish to be named.

(2) A promise or an undertaking by the creator made to any person to the effect that the creator will make a declaration referred to in subsection (1) is void.

Section 5—Application

(1) A person may apply to the Registrar for the registration of an industrial design.

(2) The application is subject to the payment of the prescribed fees and it shall contain

(a) a request, drawings, photographs or other adequate graphic representations of the industrial design;
and

(b) an indication of the article which constitutes the industrial design or in relation to which the industrial design is to be used.

(3) Where the applicant is not the creator, the application shall contain a statement justifying the applicant's right to the registration of the industrial design.

(4) The application may contain

(a) a specimen of the articles embodying the industrial design, where the industrial design is two-dimensional; and

(b) a declaration claiming priority, as provided for in the Schedule, of one or more earlier national or regional applications or international deposits filed by the applicant or applicant's predecessor-in-title in or for any state party to that Convention or member of the World Trade Organisation.

(5) Where an application contains a declaration referred to in subsection (4)(b), the Registrar may require the applicant to furnish, within the prescribed time limit, a copy of the earlier application or international deposit, certified as correct by the office with which it was filed, and the effect of that declaration shall be as provided for in the Schedule.

(6) Where the Registrar finds that the requirements under this section and the Regulations pertaining to a declaration are not fulfilled, the declaration shall be considered not to have been made.

(7) Two or more industrial designs may be the subject of the same application if they relate to the same class of the International Classification or to the same set or composition of articles.

(8) The applicant may withdraw the application during its pendency.

Section 6—Examination

(1) The Registrar shall record as the filing date, the date of receipt of the application, where, at the time of receipt, the application contains indications allowing the identity of the applicant to be established and the required graphic representations of the industrial design.

(2) Where the application did not at the time of receipt, fulfill the requirements referred to in subsection (1), the Registrar shall invite the applicant to file the required correction and shall record as the filing date the date of receipt of the required correction, but if no correction is made the application shall be treated as if it had not been filed.

(3) After recording the filing date, the Registrar shall ascertain whether

(a) the application complies with the requirements of section 5;

(b) the prescribed application fee has been paid; and

(c) the industrial design complies with sections 1 and 2(4).

Section 7—Opposition to Registration

(1) Any interested person may within the prescribed period and in the prescribed manner give notice to the Registrar of any opposition to the registration of an industrial design on the ground that one or more

requirements of sections 1 and 2 have not been fulfilled or that the applicant does not have a right to the registration of the industrial design.

(2) The Registrar shall send a copy of the notice to the applicant within the prescribed period.

(3) The applicant shall within the prescribed period and in the prescribed manner, send to the Registrar a counter-statement of the grounds on which the applicant relies for the application.

(5) If the applicant sends a counter-statement, the Registrar shall on receipt of the counter-statement send a copy of the counter-statement to the person giving the notice of opposition.

(6) The Registrar shall hear the parties if either or both wish to be heard and after considering the merits of the case, decide whether the industrial design is registrable.

Section 8—Registration and Publication

Where the Registrar finds that the conditions referred to in sections 1 and 2(4) are fulfilled and the registration of the industrial design

(a) has not been opposed within the prescribed time limit; or

(b) has been opposed and the opposition has been decided in the applicant's favour,

the Registrar shall register the industrial design, publish a reference to the registration and issue to the applicant a certificate of registration of the industrial design.

(2) Where the Registrar is satisfied that the industrial design is not registrable the Registrar shall refuse the application.

Section 9—Rights Conferred by Registration.

(1) The exploitation of a registered industrial design by persons other than the registered owner shall require the consent of the owner.

(2) For the purposes of subsection (1), "exploitation" of a registered industrial design means the making, selling, importing or otherwise distributing for commercial purposes, articles bearing or embodying a design which is a copy or substantially a copy of the industrial design.

(3) The rights conferred by registration are not applicable to acts in respect of articles which have been put on the market in any country by the registered owner or with the registered owner's consent.

(4) The registered owner may, in addition to any other rights, remedies or actions available under any enactment, institute court proceedings against any person who infringes the industrial design or who performs an act which makes it likely that infringement will occur.

Section 10—Duration and Renewal of Registration

(1) The registration of an industrial design shall be for a period of five years from the filing date of the application for registration.

(2) The registration may be renewed for two further consecutive periods of five years upon the payment of the prescribed fee.

(3) A grace period of six months shall be allowed for the late payment of the renewal fee on payment of the prescribed surcharge.

Section 11—Surrender of Registration

(1) A registered owner may surrender the industrial design by written declaration to the Registrar who shall record the surrender in the register and publish it in the prescribed manner.

(2) The surrender is effective from the date on which it is recorded.

Section 12—Cancellation of Registration

(1) Any interested person may apply to the Court to cancel the registration of an industrial design.

(2) The Court shall cancel the registration of an industrial design if the person requesting the cancellation proves that a requirement of sections 1 and 2 has not been fulfilled or if the registered owner is not the creator or successor in title.

(3) A cancelled registration of an industrial design or part of it is void from the date of the registration.

(4) The Registrar of the Court shall notify the Registrar of the decision of the Court and the Registrar shall record it and publish a reference to it.

Section 13—Changes in Ownership

(1) A change in the ownership of the registration of an industrial design or in the ownership of an application for an industrial design, shall be in writing and shall, upon the request of an interested party made to the Registrar, be recorded and, except in the case of an application, be published by the Registrar.

(2) A change under subsection (1) is of no effect against third parties until it has been recorded and published.

Section 14—Licence Contracts

(1) A copy of each licence contract concerning

(a) a registered industrial design,

(b) an application for the registration of an industrial design

shall be submitted to the Registrar who shall keep its contents confidential but shall record it and publish a reference of the licence contract.

(2) A licence contract is of no legal effect against third parties until it has been recorded in accordance with this section.

Section 15—Registrar

The Registrar shall be responsible for all the functions relating to the procedure for the registration of industrial designs and for the administration of registered industrial designs as specified in this Act.

Section 16—Register

(1) The Registrar shall maintain a Register in which shall be recorded all matters required by this Act to be recorded.

(2) The Register may be consulted by any person and extracts from the Register may be obtained subject to the prescribed conditions.

(3) The Registrar shall publish in the prescribed manner all the publications provided for under this Act.

Section 17—Correction of Errors

The Registrar may correct any error or translation or transcription, clerical error or mistake in any application or document filed with the Registrar or in any matter recorded pursuant to this Act.

Section 18—Extension of Time

(1) The Registrar on being satisfied that the circumstances justify it, may, upon receiving a written request, extend the time for doing any act or taking any proceeding under this Act, upon notice to the parties concerned and upon the terms as the Registrar may direct.

(2) The extension may be granted though the time for doing the act or taking the proceedings has expired.

Section 19—Exercise of Discretionary Powers

The Registrar shall, in exercising a discretionary power conferred by this Act, comply with article 296 of the Constitution.

Section 20—Representation

If the ordinary residence or principal place of business of an applicant under this Act is outside the country, the applicant shall be represented by a legal practitioner resident and practising in the country.

Section 21—Appeals

Any decision taken by the Registrar in the performance of the functions under this Act, is subject to appeal as of right by any interested party to the Court.

Section 22—Infringement and Offences

(1) Subject to section 9(3) any act specified in section 9(2) performed by a person other than the registered owner and without the consent of the owner constitutes an infringement of the Industrial design.

(2) On the application by

(a) the registered owner; or

(b) a licensee who has requested the registered owner to institute court proceedings for a specific relief and the registered owner has refused or failed to do so,

the Court may grant an injunction to prevent any infringement or an imminent infringement, award damages and grant any other remedy as the Court considers appropriate in the circumstances.

(3) Any person who knowingly performs an act which constitutes an infringement as defined in subsection (1) commits an offence and is liable on summary conviction to a fine not exceeding two thousand penalty units or to a term of imprisonment not exceeding two years or to both.

Section 23—Application of International Treaties

Any international treaty in respect of industrial property to which the country is a party is applicable to matters dealt with by this Act and in the case of a conflict with a provision of this Act, the provisions of the international treaty shall prevail.

Section 24—Harare Protocol

An international application may designate Ghana for an industrial design under the Protocol.

Section 25—Regulations

The Minister may by legislative instrument make Regulations for the effective implementation of this Act, and in particular, prescribing

- (a) the fees payable in respect of applications and other matters;
- (b) the details of the requirements and procedures on the filing and examination of applications;
- (c) the details in relation to the consultation of the Register;
- (d) the procedure for extracting copies from the Register; and
- (e) other particulars required to be prescribed under this Act.

Section 26—Interpretation

In this Act unless the context otherwise requires

"Court" means the High Court;

"Creator" means the person who creates the industrial design;

"Harare Protocol" means the Protocol on Patents and Industrial Designs adopted in 1982 in Harare, Zimbabwe and ratified by the Government of Ghana on 20th September, 1983;

"International Classification" means the classification according to the Locarno Agreement of October 8, 1968 establishing an International Classification for Industrial Designs;

"Minister" means the Minister responsible for Justice;

"Paris Convention" means the Paris Convention for the Protection of Industrial Property of March 20, 1883, as 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 Register of Industrial Designs;

"Registered owner" means the registered owner of an industrial design; and

"Registrar" means the Registrar-General.

Section 27—Repeal and saving

(1) The United Kingdom Designs (Protection) Ordinance (Cap 182) and the Textile Designs (Registration) Decree, 1973 (N.R.C.D. 213) are repealed.

(2) Subsidiary legislation made under the repealed laws shall remain in force until revoked.

(3) Notwithstanding the repeal of the Textile Designs (Registration) Decree, 1973 (N.R.C.D. 213), a textile design registered under it and in force immediately before the coming into force of this Act, shall remain in force for the unexpired portion of the period of protection provided under this Act subject to the payment of the renewal fees provided for under this Act.

(4) A person who on the coming into force of this Act is the proprietor of an industrial design which has been registered in the United Kingdom or has filed an application for the registration of an industrial design in the United Kingdom, may, within twelve months from the date of the coming into force of this Act, file an application for the registration of the same industrial design under this Act and the application shall be accorded the filing date or priority date accorded to the application or registration in the United Kingdom.

(5) An industrial design registered under subsection 3 shall, subject to section 10(2), enjoy a term of protection not exceeding five years from the filing date.

SCHEDULE

Article 4

(Section 5 (4) (b) and (5))

[A to 1. Patents, Utility Models, Industrial Designs, Marks, Inventors' Certificates: Right of Priority, - G. Patents: Division of the Application]

A.—(1) Any person who has duly filed an application for a patent, or for the registration of a utility model, or of an industrial design, or of a trademark, in one of the countries of the Union, or his successor in title, shall enjoy, for the purpose of filing in the other countries, a right of priority during the periods hereinafter fixed.

(2) Any filing that is equivalent to a regular national filing under the domestic legislation of any country of the Union or under bilateral or multilateral treaties concluded between countries of the Union shall be recognised as giving rise to the right of priority.

(3) By a regular national filing is meant any filing that is adequate to establish the date on which the application was filed in the country concerned, whatever may be the subsequent fate of the application.

B.—Consequently, any subsequent filing in any of the other countries of the Union before the expiration of the periods referred to above shall not be invalidated by reason of any acts accomplished in the interval, in particular, another filing, the publication or exploitation of the invention, the putting on sale of copies of the design, or the use of the mark, and such acts cannot give rise to any third-party right or any right of personal possession. Rights acquired by third parties before the date of the first application that serves as the basis for the right of priority are reserved in accordance with the domestic legislation of each country of the Union.

C.—(1) The periods of priority referred to above shall be twelve months for patents and utility models, and six months for industrial designs and trademarks.

(2) These periods shall start from the date of filing of the first application; the day of filing shall not be included in the period.

(3) If the last day of the period is an official holiday, or a day when the office is not open for the filing of applications in the country where protection is claimed, the period shall be extended until the first following working day.

(4) A subsequent application concerning the same subject as a previous first application within the meaning of paragraph (2), above, filed in the same country of the Union, shall be considered as the first application, of which the filing date shall be the starting point of the period of priority, if, at the time of filing the subsequent application, the said previous application has been withdrawn, abandoned, or refused, without having been laid open to public inspection and without leaving any rights outstanding, and if it has not yet served as a basis for claiming a right of priority. The previous application may not thereafter serve as a basis for claiming a right of priority.

D.—(1) Any person desiring to take advantage of the priority of a previous filing shall be required to make a declaration indicating the date of such filing and the country in which it was made. Each country shall determine the latest on which such declaration must be made.

(2) These particulars shall be mentioned in the publications issued by the competent authority, and in particular in the patents and the specifications relating thereto.

(3) The countries of the Union may require any person making a declaration of priority to produce a copy of the application (description, drawings, etc.) previously filed. The copy, certified as correct by the authority which received such application, shall not require any authentication, and may in any case be filed, without fee, at any time within three months of the filing of the subsequent application. They may require it to be accompanied by a certificate from the same authority showing the date of filing, and by a translation.

(4) No other formalities may be required for the declaration of priority at the time of filing the application. Each country of the Union shall determine the consequences of failure to comply with the formalities prescribed by this Article, but such consequences shall in no case go beyond the loss of the right of priority.

(5) Subsequently, further proof may be required.

Any person who avails himself of the priority of a previous application shall be required to specify the number of that application; this number shall be published as provided for by paragraph (2), above.

E.—(1) Where an industrial design is filed in a country by virtue of a right of priority based on the filing of a utility model, the period of priority shall be the same as that fixed for industrial designs.

(2) Furthermore, it is permissible to file a utility model in a country by virtue of a right of priority based on the filing of a patent application, and vice versa.

F.—No country of the Union may refuse a priority or a patent application on the ground that the applicant claims multiple priorities, even if they originate in different countries, or on the ground that an application claiming one or more priorities contains one or more elements that were not included in the application or applications whose priority is claimed, provided that, in both cases, there is unity of invention within the meaning of the law of the country.

With respect to the elements not included in the application or application whose priority is claimed, the filing of the subsequent application shall give rise to a right of priority under ordinary conditions.

G.—(1) If the examination reveals that an application for a patent contains more than one invention, the applicant may divide the application into a certain number of divisional applications and preserve as the date of each of the initial application and the benefit of the right of priority, if any.

(2) The applicant may also, on his own initiative, divide a patent application and preserve as the date of each divisional application the date of the initial application and the benefit of the right of priority, if any. Each country of the Union shall have the right to determine the conditions under which such division shall be authorized.

H.—Priority may not be refused on the ground that certain elements of the invention for which priority is claimed do not appear among the claims formulated in the application in the country of origin, provided that the application documents as a whole specifically disclose such elements.

I.—(1) Applications for inventors' certificates filed in a country in which applicants have the right to apply at their own option either for a patent or for an inventors' certificate shall give rise to the right of priority provided for by this Article, under the same conditions and with the same effects as applications for patents.

(2) In a country in which applicants have the right to apply at their own option either for a patent or for an inventor's certificate, an applicant for an inventor's certificate shall, in accordance with the provisions of this Article relating to patent applications, enjoy a right of priority based on an application for a patent, a utility model, or an inventor's certificate.

[Patents: Independence of Patents Obtained for the Same Invention in Different Countries]

(1) Patents applied for in the various countries of the Union by nationals of countries of the Union shall be independent of patents obtained for the same invention in other countries, whether members of the Union or not.

(2) The foregoing provision is to be understood in an unrestricted sense, in particular, in the sense that patents applied for during the period of priority are independent, both as regards the grounds for nullity and forfeiture, and as regards their normal duration.

(3) The provision shall apply to all patents existing at the time when it comes into effect.

(4) Similarly, it shall apply, in the case of the accession of new countries, to patents in existence on either side at the time of accession.

(5) Patents obtained with the benefit of priority shall, in the various countries of the Union, have a duration equal to that which they would have, had they been applied for or granted without the benefit of priority.

Article 4ter

[Patents: Mention of the Inventor in the Patent]

The inventor shall have the right to be mentioned as such in the patent.

Article 4quater

[Patents: Patentability in Case of Restrictions of Sale by Law]

The grant of a patent shall not be refused and a patent shall not be invalidated on the ground that the sale of the patented product or of a product obtained by means of a patented process is subject to restrictions or limitations resulting from the domestic law.

Date of Gazette Notification: 31st December, 2003.