

INDUSTRIAL PROPERTY ACT, 2010

No. 8



of 2010

ARRANGEMENT OF SECTIONS

SECTION

PART I – Preliminary

1. Short title and commencement
2. Interpretation
3. Continuance of Marks, Patents and Designs Office
4. Registrar, Deputy Registrar and Assistant Registrars of Marks, Patents and Designs
5. Functions of Registrar
6. Seal of office
7. Registers for patents, etc.

PART II – Patents

8. Patentable inventions
9. Matter excluded from patent protection
10. Right to an invention
11. Who may apply for patent
12. Application for patent
13. Withdrawal and amendment of application
14. Unity of invention
15. Division of application
16. Joint applicants
17. Right of priority
18. Conversion of patent application into application for utility model certificate
19. Information concerning corresponding foreign applications for patents
20. Filing date of application for patent
21. Publication, observations and opposition
22. Examination of applications
23. Grant of patent
24. Rights conferred by patent
25. Exceptions to rights conferred by patent
26. Transfer of rights to patent
27. Proceedings for infringement of patent
28. Duration and maintenance of patent

A.18

29. HARARE Protocol Patents
30. Joint patentees
31. Compulsory licences in the public interest or for competition
32. Importation of patented products by Government or third party
33. Compulsory licences for failure to exploit patent
34. Licences in respect of dependent patents
35. Termination of contracts relating to licences
36. Invalidation of patents

PART III – *International Application Under the Patent Cooperation Treaty*

37. Effect of international application designating Botswana
38. Office as receiving, designated and elected office
39. National processing
40. Entering national phase
41. Processing of international applications

PART IV – *Utility Model Certificates*

42. Applicability of provisions relating to patents
43. Duration of utility model certificate
44. Conversion of application for utility model certificate into application for patent

PART V – *Industrial Designs*

45. Registrable industrial design
46. Application for registration of design
47. Right of priority
48. Filing date of application
49. Examination of application
50. Registration of design
51. Right to industrial design
52. Transfer of right to design
53. Rights conferred by registration
54. Exceptions to rights conferred by registration
55. Proceedings for infringement of industrial design
56. Duration and renewal of registered design
57. HARARE Protocol Designs
58. Inspection of registered design
59. Invalidation of registration of design

PART VI – *International Registration under the Hague Agreement*

60. Examination and refusal of protection, etc.
61. Effects of an international registration
62. Invalidation of internationally registered design
63. Recordings in the International Register

PART VII – *Layout designs of integrated circuits*

64. Subject matter of protection for layout designs
65. Originality of layout design
66. Application for layout design
67. Filing date of application for layout design
68. Registration of layout design
69. Rights conferred by registration
70. Exceptions to rights conferred by registration
71. Invalidation of registered layout design
72. Duration of protection
73. Importation by persons other than owner

PART VIII – *Marks, Collective Marks and Trade Names*

74. Acquisition of exclusive right to mark
75. Saving of vested rights
76. Application for registration of mark
77. Filing date of application for registration of mark
78. Examination of application for registration of mark
79. Opposition to registration of mark
80. Registration of mark
81. Rights conferred by registration
82. Exceptions to rights conferred by registration
83. Proceedings for infringement of mark
84. Transfer of rights in mark
85. Duration and renewal of registration of mark
86. Invalidation of registration of mark
87. Removal of mark on grounds of non-use
88. Reinstatement of lapsed mark rights
89. Banjul Protocol on marks
90. Collective marks
91. Invalidation of registration of collective mark
92. Licensing of marks and collective marks
93. Trade names

A.20

PART IX – *International Registration under Madrid Protocol*

94. Initial examination of international applications
95. Lapse of basic application or basic registration
96. Initial refusal of registration by Office
97. Refusal of registration by Office
98. Registration under Madrid Protocol
99. Opposition to protection of internationally registered mark
100. Invalidation of internationally registered mark
101. Time limit of notification to International Bureau
102. Collective and certification marks
103. Replacement of internationally registered mark
104. Transformation

PART X – *Geographical Indications*

105. Applicability of provisions relating to marks
106. Acquisition of exclusive right to geographical indication
107. Application for registration of geographical indication
108. Examination of application for registration of geographical indication
109. Opposition to registration of geographical indication
110. Registration of geographical indication
111. Rights of registered owner, etc.
112. Exceptions to rights conferred by registration
113. Invalidation of registration of geographical indication

PART XI – *Acts of Unfair Competition*

114. Acts of unfair competition

PART XII – *Traditional Knowledge and Handicrafts*

115. Registration of traditional knowledge
116. Who may register traditional knowledge
117. Rights conferred by traditional knowledge
118. Notification of registration of traditional knowledge
119. Invalidation of registration of traditional knowledge
120. Expiry of protection of traditional knowledge
121. Specific rights over traditional knowledge
122. Right to institute infringement proceedings
123. Transfer, assigning, etc., of rights over traditional knowledge
124. Exploitation of traditional knowledge rights by others
125. Granting of licences by owners of traditional knowledge
126. Registration of handicrafts
127. Validity of industrial property rights relating to traditional knowledge

PART XIII – *Miscellaneous Provisions*

- 128. Changes in ownership
- 129. Licence contract
- 130. Agents
- 131. Correction of errors
- 132. Exercise of discretionary powers
- 133. Extension of time for applications
- 134. Offences and penalties
- 135. Appeals
- 136. Application of international treaties
- 137. Regulations
- 138. Repeal of Cap. 68:03
- 139. Savings
- 140. Act to bind State

An Act to provide for the protection of industrial property in Botswana, giving effect to various international conventions, treaties and protocols to which Botswana is a party and for matters related thereto.

Date of Assent: 26/04/2010

Date of Commencement: ON NOTICE

ENACTED by the Parliament of Botswana.

PART I – *Preliminary*

1. This Act may be cited as the Industrial Property Act, 2010 and shall come into operation on such date as the Minister may, by Order published in the Gazette, appoint.

Short title and commencement

2. In this Act, unless the context otherwise requires —

“ARIPO” means the African Regional Intellectual Property Organization;

“Banjul Protocol” means the Banjul Protocol on Marks of 27th April, 1994 as last revised or amended;

“basic application” means an application for registration of a mark filed with the Office under section 76;

“basic registration” means the registration of a mark under section 80;

“Budapest Treaty” means the Budapest Treaty of 28 April, 1977 as last revised or amended including the Regulations, on the international recognition of the deposit of micro-organisms for the purposes of patent procedure;

“collective mark” means any visible sign belonging to a collective owner and capable of distinguishing the origin or other common characteristic, including the quality, of goods or services of different enterprises which use the sign subject to the control of that owner;

Interpretation

A.22

- “Common Regulations” means, in respect of industrial designs, the Common Regulations adopted under the Hague Agreement and, in respect of marks, the Common Regulations under the Madrid Protocol;
- “convention country” means a country which is a party to the Paris Convention;
- “Court” means the High Court of Botswana;
- “geographical indication” means an indication or sign which identifies goods as originating in the territory of a country or a region or locality in a country where a quality, reputation or other characteristic of the goods is essentially attributable to that geographical origin;
- “HARARE Protocol” means the Protocol on Patents and Industrial Designs Within the Framework of the African Regional Industrial Property Organization (ARIPO) adopted at Harare, Zimbabwe, on December 10, 1982 as last revised or amended;
- “industrial design” means any composition of lines or colours or any three dimensional form, whether or not associated with lines or colours, which gives a special appearance to a product of industry or handicraft;
- “integrated circuit” means a circuit, in its final or intermediate form, in which the elements, at least one of which is an active element, and some or all of the interconnections are integrally formed in or on a piece of material and that is intended to perform an electronic function;
- “International Bureau” means the International Bureau of the World Intellectual Property Organization (in this Act referred to as “WIPO”);
- “International Classification”, in respect of marks, means the classification according to the Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks, of June 15, 1957, as last revised or amended, and, in respect of industrial designs, means the classification according to the Locarno Agreement concerning the International Classification for Industrial Designs, of October 8, 1968, as last revised or amended;
- “International Patent Classification” means the classification according to the Strasbourg Agreement of March 24, 1971 as last revised or amended;
- “International Register” means the official collection of data concerning international registrations, as maintained by the International Bureau;
- “invention” means an idea of an inventor which permits in practice the solution to a specific problem in the field of technology;
- “Journal” means the journal of marks, patents and designs referred to in section 5 (*e*);

- “Madrid Protocol” means the Madrid Protocol on International Registration of Marks adopted in Madrid on 27th June, 1989 as last revised or amended;
- “mark” means any visible sign capable of distinguishing the goods or services of an enterprise;
- “Master” means the Master of the High Court;
- “Office” means the Patents, Marks and Designs Office referred to in section 3;
- “office of origin” means the office with which the basic application was filed or by which the basic registration was made;
- “Paris Convention” means the Paris Convention for the Protection of Industrial Property of March 20, 1883, as last revised or amended;
- “patent” means a title granted to protect an invention under this Act;
- “Patent Cooperation Treaty” means the Patent Cooperation Treaty of 19th June, 1970, as last revised or amended;
- “patentee” means a person, or a successor-in-title to the person, to whom a patent has been granted under this Act;
- “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;
- “Registrar” means the Registrar of Marks, Patents and Designs appointed under section 4;
- “right of priority” means the right of priority provided for in Article 4 of the Paris Convention;
- “the Hague Agreement” means the Hague Agreement concerning the International Registration of Industrial Designs as last revised or amended;
- “the 1999 Act” means the Act of the Hague Agreement signed in Geneva on July 2, 1999;
- “trade name” means the name or designation by which a business or enterprise is distinguished;
- “traditional knowledge” means an idea, knowledge, practice, use or invention, written or unwritten which, may be associated to biological diversity, is a cultural, traditional or spiritual belief or value of a group of people;
- “TRIPS Agreement” means the Agreement on Trade-related aspects of Intellectual Property contained in Annex 1C of the Agreement establishing the World Trade Organization, concluded on April 15, 1994 as last revised or amended; and
- “utility model” means a technical creation that consists of a new shape or configuration of an object or of a component of an object that increases its functionality or utility.

A.24

Continuance
of Marks,
Patents and
Designs Office
Registrar,
Deputy
Registrar and
Assistant
Registrars of
Marks, Patents
and Designs

Cap. 26:01

Functions of
Registrar

Seal of Office

Registers for
patents, etc.

3. The Marks, Patents and Designs Office established in terms of section 3 of the Act repealed under section 138 of this Act shall continue to exist as if it has been established under this Act.

4. (1) There shall be a Registrar of Marks, Patents and Designs (referred to in this Act as “the Registrar”) who shall —

- (a) be a public officer;
- (b) subject to the control of the Minister, be responsible for the administration of this Act; and
- (c) perform such functions and exercise such powers as may be conferred on him or her by this Act or any other enactment.

(2) The Registrar shall be appointed in accordance with the provisions of the Public Service Act.

(3) There shall be a Deputy Registrar of Marks, Patents and Designs, and such number of Assistant Registrars as it may be necessary to appoint for the efficient functioning of the Marks, Patents and Designs Office.

(4) The Deputy Registrar and Assistant Registrars shall be public officers and shall, likewise, be appointed in accordance with the provisions of the Public Service Act and perform such functions and exercise such powers as the Registrar may lawfully perform or exercise under this Act or any other enactment.

5. Without derogating from the generality of section 4, the Registrar shall —

- (a) process all applications made in terms of this Act;
- (b) grant patents and utility model certificates;
- (c) register industrial designs, marks, collective marks, geographical indications and traditional knowledge;
- (d) administer granted patents and utility model certificates and registered industrial designs, marks, collective marks, geographical indications and traditional knowledge; and
- (e) establish and maintain a Journal of marks, patents, designs, geographical indications and traditional knowledge in which he or she shall publish all matters that are required to be published under this Act.

6. The Registrar shall have a seal of office which shall be affixed to every document issued or granted and to any copy issued in lieu of the original document.

7. (1) The Registrar shall maintain separate registers for patents, utility model certificates, industrial designs, marks, geographical indications and traditional knowledge and shall, in a section of the register of marks created for that purpose, register collective marks.

(2) There shall be entered in the registers referred to in subsection (1) such particulars as are required by this Act and such further particulars as the Minister may, by regulations, prescribe.

(3) Any person may, upon payment of the prescribed fee, and in accordance with any prescribed conditions, consult, inspect or make a copy of, or obtain an extract from, any register referred to in subsection (1).

PART II – *Patents*

8. (1) An invention shall be patentable if it is new, involves an inventive step, and is capable of industrial application.

Patentable
inventions

(2) An invention may be or relate to a product or a process.

(3) An invention is considered to be new if it does not form part of the state of the art.

(4) For the purposes of this Act, the state of the art in relation to an invention, means anything which has been disclosed to the public, whether in Botswana or outside Botswana, in a tangible form, orally, by use or in any other way, prior to the filing or priority date of the application claiming the invention.

(5) For the purpose of determining the novelty of a claimed invention, a matter contained in another application filed with the Office and having an earlier filing or priority date shall form part of the state of the art, if the application is published under this Act.

(6) Disclosure of information which would otherwise affect the patentability of an invention claimed in the application shall not affect the patentability of that invention where the information was disclosed by —

- (a) the applicant or his or her predecessor in title; or
- (b) a third party that obtained the information directly or indirectly from the applicant or his or her predecessor in title, if the disclosure took place —
 - (i) during the twelve months preceding the filing date; or
 - (ii) where priority is claimed, during the twelve months preceding the priority date of the application.

(7) An invention shall be considered as involving an inventive step if, having regard to the state of the art relevant to the application claiming the invention as defined in subsection (4), it would not have been obvious to a person having ordinary skill in the art.

(8) An invention shall be considered as being capable of industrial application if it can be used in trade, or in any kind of industry including handicraft, agriculture, fishery and other services.

9. (1) For the purposes of this Act, the following shall not be regarded as inventions and shall be excluded from patent protection —

Matter
excluded from
patent
protection

- (a) a discovery or a plant, animal, micro-organism or substance as found in nature, including the human body;
- (b) a scientific theory or mathematical method;
- (c) a literary, dramatic, musical or artistic work or other aesthetic creation;
- (d) a scheme, rule or method for doing business, performing a mental act or playing a game;
- (e) a computer program.

(2) For the purposes of this Act, the following shall not be protected by patents, even if they are inventions —

A.26

- Right to an invention
- (a) methods for treatment of the human or animal body by surgery or therapy, as well as diagnostic methods practiced in relation thereto, except products for use in any such methods;
 - (b) an invention the commercial exploitation of which is necessary to protect public order or morality including protection of human or animal health, plant life or to avoid prejudice to the environment;
 - (c) plants and animals other than micro-organisms;
 - (d) essentially biological processes for the production of plants or animals.
- 10.** (1) The right to a patent shall belong to the inventor.
- (2) If two or more persons have made an invention jointly, the right to the invention shall belong to them jointly.
- (3) Where two or more persons have made the same invention but independently of each other, the person whose application bears the earliest filing date, or, if priority is claimed, the person whose application bears the earliest validly claimed priority date shall, unless that application is abandoned, withdrawn or rejected by the Registrar, have the right to the patent.
- (4) Where an invention is made in execution of a contract of employment, the right to the patent shall, in the absence of any agreement to the contrary, belong to the employer.
- (5) The inventor shall be named as such in the patent, unless, in a special declaration in writing signed by him or her and addressed to the Registrar, he or she indicates that he or she wishes not to be named, and any promise or undertaking by the inventor made to any person to the effect that he or she will make such a declaration shall be without legal effect.
- Who may apply for patent
- 11.** (1) An application for a patent in respect of an invention may be made by the inventor or by any other person who has acquired the right to apply from the inventor.
- (2) Unless otherwise agreed, joint inventors may jointly apply for a patent.
- Application for patent
- 12.** (1) Every application for a patent shall be filed with the Registrar and shall contain —
- (a) a request;
 - (b) a description;
 - (c) one or more claims defining the matter for which protection is sought;
 - (d) drawings (where referred to in the description or the claims);
 - (e) an abstract in the prescribed form;
- and shall be accompanied by such fee as may be prescribed.
- (2) A request referred to in subsection (1) shall contain a petition that a patent be granted, the name of and other prescribed information concerning the applicant, the inventor and the agent, if any, and the title of the invention.
- (3) Where the applicant is not the inventor, the request shall be accompanied by a statement justifying the applicant's right to the patent.

(4) The description set out in the application shall disclose the invention in a manner which is sufficiently clear and complete to enable a person having ordinary skill in the art to carry out the invention, and shall indicate at least one mode known to the applicant in which the invention can be performed.

(5) Where an invention refers to or involves the use of biological material that is not available to the public and cannot be described in the patent application in such a manner as to enable the invention to be reproduced by a person skilled in the art, the description shall be regarded as inadequate for the purposes of this Act unless —

- (a) the biological material has been deposited with a depository institution recognised by the Minister no later than the date on which the patent application was filed at the Office;
- (b) the application as filed contains relevant information available to the applicant on the characteristics of the biological material deposited;
- (c) the application states the name of the depository institution and the deposit accession number; and
- (d) other prescribed conditions regarding the formalities for the deposit and the supply of samples of the deposited material are complied with.

(6) For purposes of subsection 5 (a) an international depository authority recognised under the Budapest Treaty shall be recognised without requiring a Minister's decision to recognise it.

(7) A claim referred to in subsection (1) shall be clear and concise and shall be fully supported by the description, and the description and any drawings filed may be used to interpret the claim.

(8) An abstract referred to in subsection (1) shall not be taken into account for the purpose of interpreting the scope of the protection but shall merely serve as technical information.

13. (1) An application for a patent may, at any time before the patent is granted, be withdrawn by the applicant.

Withdrawal
and
amendment of
application

(2) The applicant may, of his or her own initiative at any time before the grant of a patent, amend or correct his or her application.

(3) The applicant shall not, in amending his or her application under this section, include any material matter which was not disclosed in the initial application as filed.

14. (1) An application for a patent shall be in respect of a single invention or, where it is in respect of a group of inventions, the inventions shall be so linked as to form a single general inventive concept or have a unity of invention.

Unity of
invention

(2) The fact that a patent has been granted on an application that did not comply with the requirement of unity of invention shall not be a ground for the invalidation or revocation of the patent.

A.28

Division of
application

15. (1) An applicant may, at any time before the grant of a patent, divide his or her application into two or more applications (in this Act referred to as “divisional applications”), provided that each divisional application shall not include any matter which was not disclosed in the initial application as filed.

(2) The Registrar shall accord each divisional application the same filing date and, where applicable, the same priority date, as the initial application.

(3) The Registrar may require an applicant to divide the applications where the terms of section 14 (1) have not been complied with.

Joint
applicants

16. (1) Where two or more persons make a joint application for a patent, the applicants shall, in the absence of an agreement to the contrary, have equal undivided shares in the application and no one applicant shall deal with the application in any way without the consent of the other applicant or applicants.

(2) Without prejudice to subsection (1), if any steps are required to be taken to save the application from being abandoned, any applicant may, on his or her own behalf as well as on behalf of any other joint applicant, take such steps without recourse to the other applicant or applicants.

Right of
priority

17. (1) An application for a patent made under this Part may contain a declaration, in writing, claiming priority, as provided for in Article 4 of the Paris Convention, of one or more earlier national, regional or international applications filed by the applicant or his or her predecessor in title in any convention country or any member of the World Trade Organization.

(2) Where a declaration of priority is made under subsection (1) the applicant shall, within such time as may be prescribed, furnish the Registrar with a copy of the application earlier filed which copy shall be certified as correct by the patent office with which it was so earlier filed.

(3) Where the earlier application referred to in subsection (2) is not in the English language and the Registrar deems that the validity of the priority claim is relevant to determine whether the invention concerned is patentable, the applicant shall submit an English translation of such earlier application within two months from the date of being notified to that effect by the Registrar.

(4) Where an applicant does not satisfy the requirements of subsections (2) and (3) and any regulations pertaining thereto, the declaration shall be considered as having not been made.

(5) The effect of the declaration referred to in subsection (1) shall be as provided for in Article 4B of the Paris Convention.

(6) The applicant may, in such form as may be prescribed, request the correction or addition of a priority claim, provided the filing date of the application before the Office is not later than the date of the expiration of the priority period calculated from the filing date of the earliest application whose priority is claimed.

(7) Where an application that claims or could have claimed the priority of an earlier application has a filing date that is later than the date on which the priority period expired, the Registrar shall, within two months from that date, upon request being filed as prescribed, restore the right of priority if the request states the reasons for the failure to comply with the priority period.

(8) The Registrar shall restore the right of priority where he or she finds out that the failure to file the subsequent application within the priority period occurred in spite of due care required by the circumstances having been taken.

(9) Where a copy of an earlier application required under subsection (2) is not filed within the prescribed time limit by an applicant, the Registrar may, upon a request being filed by the applicant as prescribed, restore the right of priority if that request is filed within the time limit for filing such copy, provided that —

- (a) the Registrar is satisfied that a request to obtain the copy was filed with the Office that received the earlier application not later than 14 months from the date of filing of that earlier application; and
- (b) a copy of the earlier application is filed with the Registrar within one month from having been obtained from the said Office.

(10) Any request under this section shall be subject to payment of the prescribed fees by the applicant.

18. (1) At any time before the grant or refusal of a patent, an applicant for a patent may, upon payment of the prescribed fee convert his or her application for a patent into an application for a utility model certificate.

(2) No person may convert an application under subsection (1) more than once.

19. (1) An applicant shall indicate in the application for a patent the date and the number of other applications filed by him or her or his or her predecessor in title outside Botswana relating to the same or essentially the same invention as that claimed in the application filed in Botswana.

(2) The applicant shall, when requested by the Registrar, furnish the following documents relating to any of the applications referred to in subsection (1) —

- (a) a copy of any communication received by the applicant concerning the results of any search or examination carried out in respect of such application;
- (b) a copy of the patent or other title of protection granted in respect of such application;
- (c) a copy of the final decision rejecting the application or refusing the grant requested in respect of the application; and
- (d) a copy of the final decision revoking or invalidating the patent or other title of protection granted in respect of such application.

Conversion of patent application into application for utility model certificate
Information concerning corresponding foreign applications for patents

A.30

Filing date of application for patent

20. (1) The filing date of an application for a patent shall be the date on which the application is received by the Office if on the date of its receipt, the application contains —

- (a) an express or implicit indication that the grant of a patent is sought;
- (b) information which will enable the Registrar to establish the identity of the applicant and to contact him or her;
- (c) a part which, on the face of it, appears to be a description of the invention; and
- (d) a part which, on the face of it appears to be a claim of the invention.

(2) For the purposes of establishing the filing date, information mentioned in 1 (a) may be filed in English or Setswana, provided that where the information is filed in Setswana, a translation into English shall be supplied by the applicant upon request by the Registrar.

(3) Where the application does not comply with the requirements of subsection (1), the Registrar shall, in writing, request the applicant to supply the missing information, and the filing date shall be the date on which the missing information is received by the Office.

(4) If an applicant fails to comply with any request made by the Registrar under subsection (2), the application shall be treated as though it had never been filed.

(5) Where a part of the description of the invention appears to be missing from an application for a patent, or the application makes reference to drawings which are not included in the application, the Registrar shall request the applicant to furnish the missing part or drawings within such time as may be prescribed, and the filing date of the application shall be the date on which such part or drawings are received by the Office.

(6) If the applicant fails to comply with any request made by the Registrar under subsection (5), the Registrar shall accord to the application the date on which the application was received by him or her, as the filing date, and shall treat any reference to such part or drawings as being non-existent.

(7) Notwithstanding the provisions of subsection (6) and subject to the prescribed requirements, a reference, made in the application to a previously filed application shall, for the purposes of establishing the filing date of the application, replace the description and any drawings.

Publication, observations and opposition

21. (1) Upon the expiry of 18 months, counted from the date of filing the application for a patent with the Registrar or, where relevant, from the applicable priority date, the Registrar shall, in the prescribed manner and subject to payment of the prescribed fee by the applicant, publish the application in the Journal and thereafter the application shall be open for public inspection.

(2) The applicant may request, in writing, for the application to be published before the expiry of the period under subsection (1) and subject to compliance with the requirements for publication, the Registrar shall publish the application as requested.

(3) The applicant shall be entitled to claim compensation from any person who, after the publication of the application and before the grant of the patent, performs without authorisation from the applicant in respect of the claimed invention any act that would be regarded as an infringement of a patent granted on the invention.

(4) An applicant may claim compensation referred to in subsection (3) where the applicant gives notice to the person concerned and the claim deals with only those acts covered by the patent as published.

(5) Any interested person may, within the prescribed period and in the prescribed manner, submit to the Registrar, an observation or objection against the application for a patent on grounds that —

- (a) the claimed subject matter does not constitute an invention in terms of section 2, or is excluded from patentability under section 9;
- (b) the requirements of sections 8, 12 (1), 12 (4), 12 (5), 12 (7) or 14 have not been satisfied; or
- (c) sections 13 (3) and 15 (1), where applicable, have not been complied with.

(6) The person submitting an observation or objection under subsection (5) shall state the reasons for his or her observation or objection, and attach any documents or other evidence in support of the observation or objection.

(7) The person submitting an observation or objection under subsection (5) shall not become a party to any proceedings under this Act by reason only that he or she submitted an observation or objection under this section.

(8) Where an observation or objection is submitted, the Registrar shall send a copy to the applicant who may, within the prescribed period and in the prescribed manner, send to the Registrar his or her counter-statement.

(9) If the applicant sends a counter-statement, the Registrar shall provide a copy to the person who submitted the observation or objection and the Registrar may, at his or her discretion, hear the parties if either or both wish to be heard.

(10) The Registrar shall consider the observation or objection made under subsection (5) before deciding on the application for a patent.

(11) An interested person referred to in subsection (5) may apply to the High Court, within the prescribed period and in the prescribed manner, on grounds that he or she has been aggrieved by the decision of the Registrar under subsection (10) and in such a case the Registrar shall suspend the patent application proceedings pending a decision on the matter by the Court.

22. (1) The Registrar shall cause the application to be examined for compliance with the requirements of the Act.

(2) The Minister may, by regulations, prescribe the categories of inventions in respect of which an examination under this section shall not cover the requirements of novelty and inventive step.

A.32

- (3) An examination under this section may be undertaken by persons or institutions appointed by the Registrar, including any designated foreign, national or regional industrial property authorities.
- Grant of patent**
- 23.** (1) Where the Registrar is satisfied that the requirements of section 22 have been fulfilled, he or she shall grant the applicant a patent.
- (2) Where there is any requirement or observation that is missing from the application, the Registrar shall notify the applicant, inviting him or her to comply with any missing requirement or submit any observation within the prescribed time limit and where the applicant fails to provide or submit any missing requirement or observation within the prescribed time limit, the Registrar may refuse the application and notify the applicant of that decision.
- (3) Where the Registrar grants a patent, he or she shall —
- (a) issue a certificate of the grant of the patent and a copy of the patent to the applicant;
 - (b) record the patent in the patent register; and
 - (c) publish, in the Journal, a reference to the grant of the patent.
- (4) The Registrar shall, on payment of the prescribed fee, make a copy of any patent granted in terms of this section available to any person who requests such copy.
- (5) The Registrar shall, upon request by the patentee, make changes in the text or drawings of the patent in order to limit the extent of the protection conferred by the patent.
- Rights conferred by patent**
- 24.** (1) The patent confers on the patentee the right to prevent third parties not having such patentee's consent from exploiting the patent in Botswana.
- (2) For the purposes of this section, exploitation of a patent means —
- (a) where the patent has been granted in respect of a product —
 - (i) making, offering for sale, selling or using the product, or
 - (ii) importing the product for the purposes of offering it for sale, selling or using it; and
 - (b) where the patent has been granted in respect of a process —
 - (i) using the process, and
 - (ii) doing any act referred to in paragraph (a) in respect of a product obtained directly by means of the process.
- Exceptions to rights conferred by patent**
- 25.** (1) The rights conferred by a patent shall not extend to —
- (a) acts in respect of articles which have been put on the market in Botswana or abroad by the patentee or by another person acting with the patentee's consent, or having an economic tie to the patentee;
 - (b) the use of articles on aircraft, land vehicles or vessels of other countries which temporarily or accidentally enter the airspace, territory or waters of Botswana;
 - (c) acts done only for experimental purposes relating to the subject-matter of the patented invention;

- (d) use by a farmer in the harvest of a farm produce for propagation or multiplication by the farmer on the farmer's holding, where there has been a sale of plant propagating material to the farmer by the patentee or with the patentee's consent for agricultural use;
- (e) use of an animal or animal reproductive material by a farmer for an agricultural purpose following a sale to the farmer, by the patentee or with the patentee's consent, of breeding stock or other animal reproductive material which constitutes or contains the patented invention;
- (f) an act done in respect of the patented invention for purposes of compliance with regulatory marketing approval procedures for pharmaceutical, veterinary, agrochemical or other products subjected to such procedures;
- (g) the extemporaneous preparation in a pharmacy of a medicine for an individual in accordance with a prescription given by a medical or dental practitioner, and the use of a medicine so prepared;
- (h) acts performed by any person who in good faith, before the filing date or, where priority is claimed, the priority date of the application on which the patent is granted and in Botswana, was using the invention or was making effective and serious preparations for such use;
- (i) acts done solely for academic, scientific research, educational or teaching purposes; or
- (j) acts done for private non-commercial purposes.

(2) An economic tie referred to in subsection 1 (a), exists where one person may exercise, directly or indirectly, on the other a decisive influence with respect to the exploitation of the invention, or where a third party may exercise such an influence on both persons.

(3) The right of prior user referred to in subsection 1 (h) may be transferred or may devolve only together with the enterprise or business, or with that part of the enterprise or business, in which the use of preparations for use have been made.

26. The right to a patent may be transferred by cession, assignment, testamentary disposition or by operation of patent law.

Transfer of
rights to
patent

27. (1) The patentee shall, in addition to any other rights, remedies or actions available to him or her, have the right to institute court proceedings against any person who infringes the patent by performing, without such patentee's consent or authorization, any of the acts referred to in section 24 (2), or who performs any act which makes it likely that infringement will occur.

Proceedings
for
infringement
of patent

(2) The patentee in proceedings for infringement shall be entitled to relief by way of the following —

- (a) an interdict or injunction;
- (b) delivery up or destruction of any infringing product, article or product of which the infringing product forms an inseparable part;
- (c) damages; or
- (d) an account of the profits derived from the infringement.

A.34

(3) In any proceedings for infringement, the defendant may counter-claim for the invalidation of the patent and, by way of defence, rely upon any ground on which a patent may be invalidated.

(4) The patentee, before instituting proceedings, shall give notice to every licensee to the patent in question whose name is recorded in the patent register, and any such licensee shall be entitled to intervene as co-plaintiff.

(5) In any proceedings for infringement, other than criminal proceedings, where the subject matter of the patent is a process for obtaining a product, the burden of establishing that the product was not made by the process shall rest on the defendant if the product obtained by the patented process is new in terms of section 8 (3).

(6) In requiring the production of evidence in proceedings for infringement, the court shall take into account the legitimate interests of the defendant in not disclosing his or her manufacturing secrets.

(7) The court shall, in awarding damages, calculate such damages taking into account the amount of a reasonable royalty which would have been payable by a licensee or sub-licensee in respect of the patent concerned.

(8) The court shall not, in awarding damages under this section, also order, in respect of the same infringement, that the plaintiff be given an account of the profits derived by him or her from the infringement.

Duration and
maintenance of
patent

28. (1) Subject to subsection (2), a patent shall expire 20 years after the filing date.

(2) In order to maintain a patent or patent application, the patentee or the applicant shall pay in advance to the Registrar for each year starting one year after the filing date of the application for the grant of the patent, such annual maintenance fee as may be prescribed.

(3) A patent shall lapse or a patent application shall be deemed to have been withdrawn if the owner fails to pay the prescribed fees under subsection (2).

(4) Where the patentee or the applicant is late in paying the annual maintenance fee, the Registrar shall, upon the payment of a surcharge that may be prescribed, give the patentee or applicant a grace period of six months, within which to pay the late annual maintenance fee.

HARARE
Protocol
Patents

29. A patent in respect of which Botswana is a designated State, granted by ARIPO by virtue of the HARARE Protocol, shall have the same effect and enjoy the same protection in Botswana as a patent granted under this Act unless the Registrar communicates, to ARIPO, in respect of the application therefor, a decision, in accordance with the provisions of the Protocol, that if a patent is granted by ARIPO, that patent shall have no effect in Botswana.

Joint
patentees

30. (1) Where a patent is granted to two or more patentees jointly, the joint patentees shall, in the absence of an agreement to the contrary, be entitled to an equal undivided share in the patent.

- (2) A joint patent shall be exercised subject to the following provisions —
- (a) each joint patentee is entitled to exploit commercially the patent to his or her benefit, but shall be required to pay equitable compensation, fixed by the Court in case of a disagreement, to the other joint patentee who is not directly exploiting the patent or has not granted a licence for exploitation in accordance with paragraph (b);
 - (b) a joint patentee may grant a non-exclusive licence to exploit the patent, but shall be required to pay equitable compensation fixed by the Court in case of a disagreement to the other joint patentee who is not directly exploiting the patent or has not granted the licence for exploitation; the other joint patentee may oppose the grant of such licence provided he or she acquires the share of the joint patentee wishing to grant the licence and on condition that the price of that share shall be fixed by the Court in case of disagreement;
 - (c) an exclusive licence or sole licence to exploit the patent may only be granted by agreement among the joint patentees; and
 - (d) a joint patentee may assign his or her share in the patent, provided that the patentee notifies the other joint patentee of his or her intention and such other joint patentee shall have a right of first refusal to acquire a share during a period of three months computed from the receipt of that notification.
- (3) A joint patentee may institute proceedings for infringement on his or her rights on the patent after giving prior notice to the other joint patentee, and the other joint patentee may join the proceedings as a co-plaintiff and recover any damages in respect of any loss suffered as a result of the infringement.
- (4) If, in any proceedings under subsection (3), a joint patentee does not join the proceedings as a co-plaintiff, damages, if any, shall be awarded to the plaintiff as if he or she were the sole patentee, and the defendant shall not compensate the other patentee in respect of the same infringement.

31. (1) The Minister may, without the consent or authority of the patentee and after giving a hearing to the patentee and any other interested party, authorise a Government agency, other person or body to exploit the patented invention on the payment of adequate remuneration to the patentee where —

- (a) it is in the public interest to do so for purposes of national security, nutrition, health, development of other vital sectors of the national economy, social service; or
- (b) a court or administrative body has determined that the manner of exploitation of the invention by the patentee is anti-competitive or constitutes an abuse of the patent.

(2) In the determination of adequate remuneration under subsection (1), the Minister shall take into account the economic value of the exploitation of the patented invention and the need for the elimination of anti-competitive practices.

Compulsory
licences in the
public interest
or for
competition

(3) The exploitation of the patented invention under subsection (1) shall be for the supply of the domestic market in Botswana only, except where paragraph 1 or 3 of Article 31*bis* of the TRIPS Agreement applies.

(4) Upon request by the patentee, a Government agency, other person or body authorised to exploit a patented invention under subsection (1), the Minister may, after hearing the parties, vary the terms of the decision authorising the exploitation of the patented invention as circumstances may justify.

(5) The Minister may revoke a decision made under subsection (1) where, after hearing all the parties he or she is satisfied that the circumstances which led to his or her decision have ceased to exist and are not likely to recur, or that the agency, person or body has failed to comply with the terms of the decision.

(6) Notwithstanding the provisions of subsection (5), the Minister shall not terminate the authorisation to exploit the patent if he or she is satisfied that public interest as referred to in subsection (1) justifies the maintenance of his or her decision.

(7) Where a third party has been designated by the Minister to exploit a patent under this section, such exploitation may be transferred only within the enterprise or business within which the patented invention is being exploited.

(8) The authorisation to exploit a patent under this section shall not exclude —

- (a) the right by the patentee to grant a licence to another person to exploit the patent; or
- (b) the continued exercise, by the patentee, of his or her rights under section 24 (2).

(9) A request to the Minister under subsection (4) by an agency, other person or body for an authorisation to exploit a patent under this section shall be accompanied by evidence that the patentee has received, from the person seeking the authorisation, a request for a contractual licence, and that such person has been unable, within a reasonable time, to obtain the licence on reasonable commercial terms and conditions.

(10) Subsection (9) shall not apply in cases of national emergency or other circumstances of extreme urgency, nor in the cases mentioned in subsection (1) (a).

(11) Where a competition authority has determined that the manner of exploitation of a patent in the field of semi-conductor technology is anti-competitive, the Minister shall authorise the issuance of a compulsory licence if he or she is satisfied that the issuance of a compulsory licence would remedy such practice.

(12) Any person who is aggrieved by a decision of the Minister under this section may appeal to the High Court against that decision.

32. (1) Subject to section 31, the Minister may issue a licence to a Government agency or any authorised person for the importation of patented products such as generic pharmaceutical products from any legitimate alternative foreign source without the approval of the patentee where —

- (a) it is in the public interest to do so for purposes of national security, nutrition, health, development of other vital sectors of the national economy, social service; or
- (b) the market for the patented product is not being supplied in sufficient quantities or on reasonable terms in relation to market demand.

(2) The importation of the patented product by a Government agency or any authorised person shall be solely for public non-commercial use within Botswana, except where paragraph 1 or 3 of Article 31*bis* of the TRIPS Agreement is applicable.

(3) A licence issued under subsection (1) shall include the name of the pharmaceutical product and an estimate of the quantities of the pharmaceutical product to be imported during the term of the licence: Provided that the estimate shall not limit the quantity of the pharmaceutical product required to address the public health problem that the importation seeks to address.

(4) Where in respect of the pharmaceutical product referred to in subsection (1) a compulsory licence has been granted in the exporting country under the system set out in Article 31*bis* of the TRIPS Agreement and the Annex thereto, and remuneration for the licence has been paid accordingly in the exporting country, the obligation to pay remuneration for the compulsory licence to import that product into Botswana shall not apply.

33. (1) At any time after the expiration of three years from the date of the grant of a patent or four years from the filing date of the application, whichever occurs later, any person may apply to the High Court for an order to be granted a licence under the patent on the grounds that a market for the patent is not being supplied, or is not being supplied on reasonable terms, in Botswana.

(2) Notwithstanding the provisions of subsection (1) an order to issue a compulsory licence shall not be granted if the patentee satisfies the High Court that circumstances exist which justify the non-exploitation or insufficient exploitation of the patent.

(3) Where the High Court grants an order for the issue of a compulsory licence under this section, it shall —

- (a) set out the scope and function of the licence;
- (b) fix the time limit for the exploitation of the patent; and
- (c) set out the conditions and amount of remuneration to be paid to the patentee.

(4) A request for the issue of a compulsory licence shall be made in the prescribed form subject to payment of the prescribed fees.

Importation of patented products by Government or third party

Compulsory licences for failure to exploit patent

34. (1) If the exploitation of a patent (in this section referred to as “the later patent”) is dependent upon the obtaining of a licence under an earlier patent, the patentee in respect of the later patent may apply to the High Court for an order to be issued a licence to exploit the earlier patent, and the order may be granted on such conditions as may be imposed, including a condition that such licence may be used only for the purpose of permitting the later patent to be exploited.

(2) The Court shall not grant an order under this section unless the invention claimed in the later patent involves an important technical advance of considerable economic importance in relation to the invention claimed in the earlier patent.

(3) Where a holder of a plant variety right cannot exploit his or her right without infringing a prior patent, the holder may apply for a compulsory licence for the non-exclusive use of that patent, to the extent necessary to allow the exploitation of the plant variety right.

(4) Where a patentee of a biotechnological invention cannot exploit the patent without infringing a prior plant variety right, the patentee may apply for a compulsory licence for the non-exclusive use of the plant variety right, to the extent necessary to allow the exploitation of such patent.

(5) The High Court may, on an application made to it by the patentee in respect of an earlier patent or plant breeder’s right, as the case may be, grant an order for the issue of a licence to use the invention claimed in the later patent or plant breeder’s right.

(6) A licence granted under this section shall not be transferable except in conjunction with the transfer of the licence in respect of the later patent.

(7) The provisions of section 31 (1) regarding the remuneration due to the owner of the patent shall apply to licences issued under this section.

35. Any contract relating to a licence to exploit a patent shall terminate on the date on which the patent under which the licence was granted expires, is revoked or otherwise ceases to protect such invention.

36. (1) The Registrar or the High Court may, on the application of any interested party, invalidate a patent if it is found —

- (a) that the patent is not an invention within the meaning of the term as defined under this Act;
- (b) that the patentee is not a person entitled, under section 10, to apply for a patent;
- (c) that the patent concerned is not patentable under section 8;
- (d) that the invention is a matter which should have been excluded from patent protection;
- (e) that the patentee’s application did not satisfy the requirements of section 12 (4), (5), (7) and (8) and corresponding regulations, or that the conditions under section 13 (3) or 15 (1), where applicable, were not complied with.

- (f) that the patentee failed to inform the Registrar about any corresponding foreign application filed or furnished information which in any material particular was false; or
- (g) that the patent was obtained on a misrepresentation.
- (2) A claim arising from an invalidated patent shall be regarded as null and void from the date of the grant of the patent.
- (3) Where an application for the invalidation of a patent is made to the High Court, it shall be served on the patentee and lodged with the Court in the manner and within the time prescribed.
- (4) Where subsection (3) applies, the Master shall notify the Registrar of any decision of the Court invalidating the patent and the Registrar shall, within such time and such manner as may be prescribed, publish the invalidation reference in the Journal.

*PART III – International Application Under the Patent
Cooperation Treaty*

37. Subject to the provisions of this Part, an international application designating Botswana shall be treated as an application for a patent filed under this Act and shall have as its filing date the international filing date accorded under the Patent Cooperation Treaty.

Effect of international application designating Botswana Office as receiving, designated and elected office

38. The Office shall be —

- (a) the receiving office in respect of an international application lodged at it by a person who is a resident or citizen of Botswana;
- (b) the designated office in respect of an international application designating Botswana; and
- (c) the elected office, if an applicant in an international application designating Botswana elects Botswana for purposes of an international preliminary examination under Chapter II of the Patent Cooperation Treaty.

39. The Office shall not commence the processing of an international application before the expiration of the time limit referred to in section 40, except where the applicant has filed an express request for early commencement of the processing.

National processing

40. (1) The applicant in respect of an international application designating Botswana shall, before the expiration of 30 months from the date of filing an international application —

Entering national phase

- (a) pay the prescribed fee to the Office; and
- (b) if the international application was not filed in English, or has not been published under the Patent Cooperation Treaty as a translation into English, file with the Office a translation of the international application, containing the prescribed contents in English.

A.40

Processing of international applications

(2) If the applicant does not comply with subsection (1), the international application shall be considered to be withdrawn.

(3) The Registrar may, on an application made before or after expiry of 30 months from the date of filing of an international application, extend the time limit for a further period not exceeding three months.

41. (1) In processing an international application, the Office shall apply the provisions of the Patent Cooperation Treaty, the Regulations and administrative instructions issued under that Treaty, and the provisions of this Act and its regulations.

(2) When processing an international application, the Patent Cooperation Treaty, its Regulations and the administrative instructions issued under it shall, in the event of any conflict, prevail over this Act and its regulations.

PART IV – *Utility Model Certificates*

Applicability of provisions relating to patents
Duration of utility model certificate

42. The provisions of Part II and III, except section 22 (2), shall with necessary modifications apply to utility model certificates and applications.

43. A utility model certificate shall expire seven years after the filing date of the application.

Conversion of application for utility model certificate into application for patent

44. (1) At any time before the grant or refusal of a utility model certificate, an applicant may, upon payment of the prescribed fee, convert his or her application for a utility model certificate into an application for a patent, and the latter application shall be accorded the filing date of the initial application.

(2) No person may convert an application under subsection (1) more than once.

PART V – *Industrial Designs*

Registrable industrial design

45. (1) An industrial design (hereinafter referred to as “a design”) shall be capable of being registered if it is new.

(2) A design shall be deemed to be new if it has not been disclosed to the public anywhere in the world by publication in a tangible form, or by use or in any other way, prior to the filing date or, where applicable, the priority date of the application for registration of such design.

(3) Disclosure of information claimed in an application for registration of a design which would otherwise affect the registrability of a design shall not affect the registrability of that design where the information was disclosed as provided in section 8 (6).

(4) A design which is contrary to public order or morality shall not be registered.

(5) A design shall not be registered where it consists entirely of features dictated solely by functional or technical considerations; however, the degree of freedom of the designer in developing his or her design shall be taken into consideration.

46. (1) An application for the registration of a design shall be made to the Registrar in the prescribed manner and shall be accompanied by —

- (a) a request, in writing, for the registration of the design;
- (b) drawings, photographs or other graphic representations of the article embodying the design;
- (c) a statement, in writing, indicating the kind of products for which the design is to be used; and
- (d) such application fee as may be prescribed.

Application
for
registration of
design

(2) Where the design is two dimensional, the application may be accompanied by a specimen of the article embodying the design.

(3) An applicant for the registration of a design who is not the creator of the design shall furnish to the Registrar, in writing, such proof of his or her title or authority to apply for registration as may be prescribed.

(4) An application for the registration of a design under this section may be in respect of two or more designs, provided that the designs relate to the same class of International Classification or to the same set or composition of articles.

(5) An application for the registration of a design may, at the time of filing, contain a request that the publication of the design, upon registration, be deferred for a period not exceeding twelve months from the date of filing or, if priority is claimed, from the date of priority, of the application.

(6) The applicant may, at any time before the registration of a design, withdraw his or her application.

47. The provisions of section 17 shall apply in relation to a design.

Right of priority

48. (1) The filing date of an application for the registration of a design shall be the date on which the application is received by the Office if at the time of receipt, the application contains information allowing the identity of the applicant to be established and the required graphic representation of the article embodying the design.

Filing date of
application

(2) Where the application does not comply with the requirements of subsection (1), the Registrar shall, in writing, request the applicant to supply the information or representation missing in the application, and shall accord as the filing date, the date on which the missing elements are filed.

(3) If an applicant fails to comply with a request made by the Registrar under subsection (2), the application shall be treated as though it had never been filed.

49. The Registrar shall cause the application to be examined to determine whether —

Examination
of application

- (a) it complies with the requirements of section 46 (1) and (3) and the regulations pertaining thereto;
- (b) it complies with the definition of an industrial design under this Act;
- (c) it complies with the appropriate regulations made in pursuance of this Part;
- (d) the design is not contrary to public order or morality; and
- (e) multiple designs submitted under a single application are in accordance with section 46 (4).

A.42

Registration
of design

50. (1) Where, following the examination referred to in section 49, the Registrar is satisfied that the requirements of this Act have been fulfilled, he or she shall register the design.

(2) Where the Registrar registers a design, he or she shall, within such time as may be prescribed —

(a) issue, to the applicant, a certificate of registration of the design;

(b) record such registration in the register; and

(c) publish, in the Journal, a reference to the registration of the design.

(3) Notwithstanding the provisions of subsection (2), where a request has been made under section 46 (5) for deferment of publication, the representation of the design or any file relating to the application shall not, upon registration of the design, be open for public inspection; and in this case, the Registrar shall publish, in the Journal, a mention of the deferment of the publication of the industrial design and information identifying the registered owner of the design, and indicating the filing date of the application, the length of the period for which deferment has been requested, and such other particulars as may be prescribed.

(4) At the expiry of the period of deferment, the Registrar shall publish, in the Journal, the registered design.

(5) The institution of legal proceedings on the basis of a registered design during the period of deferment of publication shall be subject to the condition that the information contained in the register and in the file relating to the application has been communicated to the person against whom the action is brought.

(6) An application which, owing to any default or neglect on the part of the applicant, has not been completed within the prescribed period shall be deemed to have been abandoned.

Right to
industrial
design

51. (1) The right to a design shall belong to the owner of the design.

(2) If two or more persons have made a design jointly, the right to the design shall belong to them jointly.

(3) Where two or more persons have made the same design but independently of each other, the person whose application bears the earliest filing date, or, if priority is claimed, the person whose application bears the earliest validly claimed priority date shall, unless that application is abandoned, withdrawn or rejected by the Registrar, have the right to the design.

(4) Where a design is made in execution of a contract of employment, the right to the design shall, in the absence of any agreement to the contrary, belong to the employer.

(5) The owner of a design shall be named as such in the design, unless, in a special declaration in writing signed by him or her and addressed to the Registrar, he or she indicates that he or she wishes not to be named, and any promise or undertaking by the owner of the design made to any person to the effect that he or she will make such a declaration shall be without legal effect.

52. The right to a design may be transferred by cession, assignment, testamentary disposition or by operation of law.

Transfer of right to design

53. (1) The registration of a design confers on its registered owner the right to prevent third parties not having the owner's consent from exploiting the design in Botswana, and in particular, from making, importing or selling any article bearing or embodying the registered design or a design not substantially different from the registered design.

Rights conferred by registration

(2) For the purposes of this section, exploitation of a registered design means the doing of any act specified in subsection (1).

54. (1) The exclusive rights conferred by registration of a design shall not extend to the acts specified in section 25 (1), paragraphs (a), (b), (c), (i) and (j).

Exceptions to rights conferred by registration

(2) The exclusive rights in a registered design shall not extend to the parts or features of the design that are dictated solely by functional or technical considerations however in the determination, the degree of freedom of the designer in developing the design, shall be taken into consideration.

(3) The exclusive rights in a registered design shall not extend to features of appearance of a product which must necessarily be reproduced in the exact form and dimensions in order to permit the product in which the design is embodied, or to which it is applied, to be mechanically connected to or placed in, around or against another product so that each product may perform its function.

(4) The exclusive rights in a registered design shall not extend to features of appearance of a product which must necessarily be reproduced in the exact form and dimensions in order to match the overall aspect and appearance of the product in which the design is embodied or to which it is applied.

(5) The rights of an owner of a registered design shall not extend to acts in respect of which articles have been put on the market in Botswana or abroad by the owner, or with his or her consent.

55. (1) An owner of a registered design shall, in addition to any other rights, remedies or actions available to him or her have the right to institute court proceedings against any person performing, without the owner's consent or authorisation, any of the acts referred to in section 53, or who performs acts which make it likely that infringement will occur.

Proceedings for infringement of industrial design

(2) In any proceedings under this section, the court may grant relief by way of damages, interdict, delivery up or destruction of any infringing product, article or product of which the infringing product forms an inseparable part, or account of profits derived from the infringement or otherwise as it may consider necessary.

(3) The court shall not, in awarding damages under this section, also order, in respect of the same infringement, that the plaintiff be given an account of the profits derived by him or her from the infringement.

A.44

Duration and renewal of registered design	<p>(4) In any proceedings under this section, the court shall have jurisdiction to order the revocation of the registration of a design on any of the grounds specified in section 59, and any such grounds may be relied upon by way of defence.</p>
HARARE Protocol Designs	<p>56. (1) The registration in respect of a design shall expire five years after the filing date of the application for its registration, but may, upon payment of such renewal fee as may be prescribed, be renewed for two further consecutive periods of five years each.</p> <p>(2) Where the owner of the design is late in paying the renewal fee, the Registrar shall, upon payment by the owner of a surcharge that may be prescribed, give a grace period of six months within which the owner must pay the late renewal fee.</p>
Inspection of registered design	<p>57. An industrial design in respect of which Botswana is a designated State, registered by ARIPO under the HARARE Protocol, shall have the same effect in Botswana as an industrial design registered under this Act unless the Registrar communicates, to ARIPO, in respect of the registered design, a decision, in accordance with the provisions of the Protocol, that an industrial design registered by ARIPO, shall have no effect in Botswana.</p>
Invalidation of registration of design	<p>58. (1) Subject to the provisions of section 46 (5), the representations, specimens and drawings of a registered design, including all documents lodged in relation thereto shall, upon payment of such fees as may be prescribed, be open to inspection by any person on and after the day on which the certificate of registration is issued, however the right of inspection shall not include the right to make a copy of any such representation, drawing or document by mechanical means.</p> <p>(2) Any person may, upon payment of such fees as may be prescribed, obtain, from the Registrar, a copy of the representations, drawings or documents.</p> <p>(3) Where an application for the registration of a design has been abandoned or refused, the representations, drawings or other documents shall not, at any time, be open for inspection, but shall, after the expiration of 12 months from the date of application for registration, be returned to the applicant if he or she requests that they be so returned.</p> <p>59. (1) Subject to the provisions of this Act, the Registrar or the High Court may, on the application of any interested person, invalidate the registration of a design, either wholly or in part, in respect of any particular article in connection with which the design is registered on any of the following grounds —</p> <ul style="list-style-type: none">(a) that the design was not new;(b) that the applicant for registration was not the owner;(c) that the application was made with the intention of defrauding the owner of the design; or(d) that any grounds on which the Registrar could have refused to register the design has come to light.

(2) Where an application for the invalidation of a design is made to the High Court, it shall be served on the person in whose name the design is registered and lodged with the Court in the manner and within the time prescribed.

(3) Where subsection (2) applies, the Master shall notify the Registrar of any decision of the Court to invalidate a design and the Registrar shall, within such time as may be prescribed, publish a reference thereto in the Journal.

PART VI – *International Registration under the Hague Agreement*

60. (1) Where the Registrar finds that a design that is the subject of an international registration designating Botswana does not satisfy the requirements for protection under this Act, the Registrar shall notify, within 6 months, a refusal of protection to the International Bureau in accordance with the relevant provisions of the 1999 Act and the Common Regulations.

Examination and refusal of protection, etc.

(2) Where a design is refused under subsection (1), the holder of the international registration concerned shall enjoy the same remedies as if the design had been the subject of an application for registration filed directly in Botswana.

61. (1) An international registration of an industrial design that contains a designation of Botswana shall have the same effects, as from the date of the international registration, as an application for registration filed with the Registrar in Botswana under this Act.

Effects of an international registration

(2) If no refusal has been notified by the Registrar to the International Bureau in terms of section 60, or if a refusal was notified but subsequently withdrawn, the international registration shall have the same effect, from the date of the international registration, as if the registration of the industrial design has been granted directly by the Registrar in Botswana under this Act.

62. Where the effect of an international registration is invalidated in Botswana, in part or in whole, and the invalidation is no longer subject to appeal, the Registrar shall, to the extent that he or she is aware of the decision of invalidation, notify the International Bureau in accordance with the relevant provisions of the 1999 Act and the Common Regulations.

Invalidation of internationally registered design

63. Any recording made in the International Register in respect of an international registration, and affecting Botswana as a designated Contracting Party, shall have the same effects as if it had been made in the register of industrial designs of Botswana.

Recordings in the International Register

PART VII – *Layout designs of integrated circuits*

Subject matter of protection for layout designs	<p>64. (1) Protection under this Part may be obtained for layout designs of integrated circuits to the extent that layout designs are original within the meaning of section 65 (1).</p> <p>(2) Registration may only be applied for if the layout design has not been commercially exploited anywhere in the world and, where there has been commercial exploitation, it has not been for more than two years.</p>
Originality of layout design	<p>65. (1) A layout design shall be considered to be original if it is the result of the creator's own intellectual effort.</p> <p>(2) A layout design which, at the time of its creation, is common among creators of layout designs and manufacturers of integrated circuits shall not be considered original except where such a design consists of a combination of elements and interconnections that are common but the combination when taken as a whole is original in terms of subsection (1).</p>
Application for layout design	<p>66. (1) An application for the registration of a layout design shall be made to the Registrar in writing and shall —</p> <ul style="list-style-type: none"> (a) indicate the name, address, nationality and habitual residence of the applicant; (b) contain a copy or drawing of the layout design and information defining the electronic function which the integrated circuit is intended to perform and may omit such parts of the copy or drawing relating to confidential information about the manufacture of the integrated circuit; (c) indicate whether or not there has been exploitation, and where there has been exploitation, specify the date of the first exploitation; (d) where the applicant is to be represented, contain a copy of the power of attorney appointing the representative; and (e) where the person making the application is not the owner of the layout design, furnish the Registrar with such proof of his or her title or authority to apply for registration as may be prescribed. <p>(2) A separate application shall be made for each layout design.</p> <p>(3) The information supplied on the application together with any drawings or copies of the layout design must sufficiently allow for the identification of the layout design.</p> <p>(4) An application for the registration of a layout design shall be made subject to the payment of the prescribed fee.</p>
Filing date of application for layout design	<p>67. (1) The Registrar shall accord, as the filing date of an application for registration of a layout design, the date on which such application is received by the Office if at the time of its receipt, the application complies with the requirements of section 66 (1) (a) and (b).</p> <p>(2) Where the application does not comply with the requirements of subsection (1), the Registrar shall, in writing, request the applicant to supply the information lacking in the application within two months and shall accord to the application, as the filing date, the date on which the further information was filed.</p>

(3) If an applicant fails to comply with any request made by the Registrar under subsection (2), his or her application shall be treated as though it had never been filed.

68. (1) Where the application complies with the requirements of section 66, and the Registrar is satisfied that the requirements of this Act have been fulfilled, the Registrar shall register the layout design.

Registration
of layout
design

(2) Where the Registrar registers a layout design, the Registrar shall, within such time as may be prescribed —

- (a) issue, to the applicant, a certificate of registration of the layout design;
- (b) record the number, title, filing date and any other details pertaining to the layout design in the register; and
- (c) publish, in the Journal, a reference to the registration of the layout design.

(3) An application which, owing to any default or neglect on the part of the applicant, has not been completed for the registration to be effected within the prescribed period shall be deemed to have been abandoned.

69. (1) The registration of a layout design confers on its registered owner the right to prevent third parties who do not have the owner's consent from exploiting the layout design in Botswana, and in particular, from making, importing or selling any article bearing or embodying the registered layout design or a layout design not substantially different from the registered layout design.

Rights
conferred by
registration

(2) For the purposes of this section, exploitation of a registered layout design means the doing of any act specified in subsection (1) including —

- (a) reproducing, whether by incorporation in an integrated circuit or otherwise, a protected layout design in its entirety or any part thereof, except the act of reproducing any part that does not comply with the requirement of originality referred to in section 65; and
- (b) importing, selling or otherwise distributing for commercial purposes a protected layout design or an integrated circuit in which a protected layout design is incorporated.

(3) If two or more persons have created a layout design jointly, the right to that layout design shall belong to them jointly.

(4) The right to a layout design may be transferred by cession, assignment, testamentary disposition or by operation of law.

(5) The provisions of section 11 shall apply to layout designs.

(6) Protection of a layout design shall not depend on whether or not the integrated circuit which incorporates the protected layout design is itself incorporated in an article.

70. (1) The exclusive rights conferred by registration of a layout design shall not extend to the acts specified in section 25 (1) (a), (b), (c), (i) and (j).

Exceptions to
rights
conferred by
registration

(2) Where a third party, on the basis of evaluation or analysis of the protected layout design, creates a layout design that is original as provided in section 65, that third party may incorporate such layout design in an integrated circuit or perform any of the acts referred to in subsection (1) in respect of that layout design without being regarded as infringing the protected layout design.

A.48

(3) The holder of the right may not exercise his or her right in respect of an identical original layout design that was independently created by a third party.

(4) Any person who acquires an integrated circuit or article incorporating an unlawfully reproduced layout design and does not know and has no reasonable grounds to know when acquiring that integrated design or article that it incorporated an unlawfully reproduced layout design shall, upon receiving sufficient notice that the layout design or article he or she has received was unlawfully reproduced, perform any of the acts under section 69 (2) with respect to the stock on hand or ordered before receiving such notice, but shall be liable to pay to the right holder compensation equivalent to a reasonable royalty payable under a freely negotiated licence in respect of such a layout design.

Invalidation of registered layout design

71. (1) Subject to the provisions of this Act, the Registrar or the High Court may, on the application of any interested person, invalidate the registration of a layout design on any of the following grounds —

- (a) that the layout design is not original in terms of section 65;
- (b) that the applicant for registration was not the owner;
- (c) where the layout design has been commercially exploited, that such exploitation occurred more than two years before the filing date accorded to the layout design; or
- (d) on any ground on which the Registrar could have refused to register the layout design.

(2) Where the grounds of invalidation are established only to a part of the layout design, only that part shall be invalidated.

(3) An application for the invalidation of a layout design shall be served on the person in whose name it is registered and, where applicable, lodged with the Court in the manner and within the time prescribed.

(4) Where a layout design is invalidated or transferred to its rightful owner, the Registrar shall, within such time as may be prescribed, publish a reference thereto in the Journal and the invalidated layout design or any part thereof shall be null and void from the date of commencement of its protection.

Duration of protection

72. A layout design for an integrated circuit shall be protected for 10 years from the date of filing of the application for registration or from the first commercial exploitation wherever it occurs in the world, provided that protection shall in all cases lapse 15 years after the creation of the layout design.

Importation by persons other than owner

73. (1) Any person, other than the owner of a layout design, may apply to the Minister to import any product covered by the integrated circuit of a layout design where —

- (a) the product covered by the integrated circuit of a layout design is available in a quantity that is not sufficient to meet the local demand in Botswana, or is available at an unreasonable low quality, or at prices which the Minister deems abusive; or
- (b) for any other reason of public interest.

(2) The Minister may, after hearing the owner of the layout design and any other interested person wishing to be heard, authorise the importation of any product covered by the layout design.

(3) The authorisation to import any products covered by the layout design shall be predominantly for the supply of the domestic market in Botswana.

(4) Upon the request of the owner of the layout design or of any person authorised by the Minister to import the layout design, the Minister may, after hearing the parties, vary the terms of the decision authorising the importation of the layout design to the extent that those changed circumstances justify.

(5) Upon the request of the owner of the layout design, the Minister shall revoke his or her decision if he or she is satisfied, after hearing the parties wishing to be heard, that the circumstances which led to the Minister's decision have ceased to exist and are unlikely to recur, or that the person authorised by the Minister has failed to comply with the terms of the authorisation.

(6) Notwithstanding the provisions of subsection (5), the Minister shall not terminate the authorisation if he or she is satisfied that the need for the adequate protection of the legitimate interest of the person designated by him or her justifies the maintenance of his or her decision.

(7) The authorisation to import products under a layout design shall not exclude —

- (a) the conclusion of licence contracts by the owner of the design; or
- (b) the continued exercise, by the owner of the design, of his or her rights under section 69.

(8) An application for the Minister's authorisation to import products under a layout design shall be accompanied by evidence that the owner of the layout design has received, from the person seeking that authorisation, a request for a contractual licence, but that person has been unable, within a reasonable time, to obtain such a licence on reasonable commercial terms and conditions.

(9) Any person aggrieved by the decision of the Minister may appeal to the High Court against that decision.

PART VIII – *Marks, Collective Marks and Trade Names*

74. (1) The exclusive right to a mark under this Act shall be acquired by registration in accordance with the provisions under this Part.

Acquisition of
exclusive
right to mark

(2) A mark shall not be registered if it is —

- (a) incapable of distinguishing the goods or services of one enterprise or business from those of another enterprise or business;
- (b) contrary to public order or morality;
- (c) likely to mislead the public or trade circles, in particular as regards the geographical origin of the goods or services concerned, or their nature or characteristics;

- (d) a mark that consists exclusively of a sign or indication which may serve in trade to designate the kind, quality, quantity, intended purpose, value, geographical origin or the time of production of the goods or of rendering of the service, or other characteristics of the goods or service;
 - (e) a mark that consists exclusively of a sign or indication which has become customary in the current language or in the bona fide and established practices of the trade in respect of the goods or services for which it is to be registered;
 - (f) a sign that consists exclusively of —
 - (i) the shape which results from the nature of the goods themselves,
 - (ii) the shape of goods which is necessary to obtain a technical result, or
 - (iii) the shape which gives substantial inherent value to the goods;
 - (g) identical to, or is an imitation of, or contains, as an element, an armorial bearing, flag or other emblem, a name, abbreviation or initials of, or official sign or hallmark adopted by, any State, inter-governmental organization or organisation created by an international convention, unless the competent authority of that State or organization has given authorisation for such bearing, flag, emblem, name, abbreviation or initials, official sign or hallmark to be used by an applicant for a registered mark;
 - (h) identical to, or confusingly similar to, or constitutes an imitation, a translation or a transliteration of, a mark or trade name which is well known in Botswana for identical or similar goods or services of another enterprise, or if it is well known in Botswana for goods or services which are not identical or similar to those in respect of which registration is applied for;
 - (i) identical to, confusingly similar to, or constitutes a translation or a transliteration of a geographical indication used to designate or distinguish the same goods for which the mark is to be used, or to designate different goods where the use of that mark would pose a risk of misleading the public as to the origin of the goods or services designated by the mark; or
 - (j) identical to a mark belonging to a different owner of a registered mark and already on the register, or with an earlier filing or priority date, in respect of the same goods or services or closely related goods or services, or if it so nearly resembles such a mark as to be likely to deceive or cause confusion.
- (3) For purposes of subsection (2) (h) —
- (a) the use of the mark in relation to those goods or services should indicate a connection between those goods or services and the owner of the well known mark;
 - (b) the interests of the owner of the well known mark shall not be prejudiced by such use; and

(c) whether that mark is well known in Botswana, due regard shall be given to the knowledge of the mark in the relevant sector of the public, including knowledge which has been attained as a result of the promotion of the mark.

75. Where a mark has been registered in good faith, or where rights in the mark have been acquired through use in good faith either before 1st January, 2000, or before the geographical indication is protected in Botswana, nothing in this Act shall prevent the registration of such mark or interfere with the use of such mark on the basis that the mark is identical to, or similar to, a geographical indication.

76. (1) An application for the registration of a mark, accompanied by such fee as may be prescribed, shall be made to the Registrar in the prescribed manner and shall contain the following —

- (a) a request, in writing, that the mark be registered;
- (b) one or more reproductions of the mark;
- (c) a list of the goods or services for which registration of the mark is requested, listed under the applicable class or classes of the International Classification; and
- (d) other requirements as may be prescribed by regulations.

(2) The provisions of section 17 in respect of the right of priority shall apply.

(3) The applicant may, at any time before his or her mark is registered, withdraw his or her application.

77. The filing date of an application for the registration of a mark shall be the date on which the application is received by the Office containing the following indications and elements, as prescribed —

- (a) an express or implicit indication that the registration of a mark is sought;
- (b) indications allowing the identity of the applicant to be established;
- (c) indications allowing the applicant or its representative, if any, to be contacted by the Office;
- (d) a sufficiently clear representation of the mark whose registration is sought; and
- (e) a list of the goods or services for which the registration is sought.

78. (1) The Registrar shall examine the application to determine whether it complies with the requirements of section 77 and any other requirements as may be prescribed.

(2) The Registrar shall also determine whether the mark complies with the definition of a mark under this Act, and whether it complies with the requirements of paragraphs (a) to (i) of section 74 (2).

(3) The Registrar shall, if he or she is satisfied that the application complies with the requirements of the provisions of this section, accept the application and shall, within such time and in such manner as may be prescribed, publish that application in the Journal subject to the payment of a prescribed publication fee.

Saving of
vested rights

Application
for
registration
of mark

Filing date of
application
for
registration
of mark

Examination
of application
for
registration
of mark

A.52

Opposition to registration of mark

79. (1) Any person may, on the grounds specified in section 74 (2), or on grounds that the mark does not comply with the definition of a mark as specified in this Act, give to the Registrar within such period and in such manner as may be prescribed, notice of his or her opposition to the registration of a mark.

(2) The Registrar shall, as soon as he or she receives such notice, send a copy to the applicant who shall, within such period and in such manner as may be prescribed, submit, to the Registrar, his or her written response (referred to in this section as a “counter-statement”) specifying the grounds on which he or she relies for his or her application.

(3) Where the applicant files his or her counter-statement, the Registrar shall furnish a copy to the person opposing and shall hear the parties, if either wishes to be heard.

(4) Following the publication of an application, and until the registration of the mark, the applicant shall have the same rights and privileges as he or she would have if the mark had been registered, but it shall be a valid defence to an action brought hereunder in respect of an act done after the application was published, if the defendant establishes that the mark could not have been validly registered at the time the act was done.

Registration of mark

80. (1) Where having considered the merits of any opposition and any counter-statement thereto, the Registrar is satisfied that the application for the registration of a mark satisfies the requirements of this Act, the Registrar shall —

- (a) register the mark in the appropriate register;
- (b) issue, to the applicant, a certificate of registration; and
- (c) publish, in the Journal, a reference to the registration of the mark.

(2) Where the requirements for the registration of a mark are not satisfied, or an application for the registration of a mark has been successfully opposed, the Registrar shall refuse to register that mark.

Rights conferred by registration

81. (1) Registration of a mark shall confer on the registered owner, the right —

- (a) to exclusive ownership of that mark;
- (b) to prohibit third parties from using the mark; and
- (c) to institute court proceedings against any person infringing his or her rights.

(2) A person who, without authorisation from the owner of a registered mark —

- (a) affixes the registered mark or a similar distinctive sign on goods for which the mark has been registered, on goods associated with the services for which the mark has been registered or on containers, wrapping or packaging of such goods;
- (b) suppresses or distorts the mark after it has been affixed on the goods for which the mark has been registered for commercial purposes;

- (c) produces, sells, offers for sale, distributes or stocks labels, containers, wrapping, packaging or any other material on which the mark is reproduced;
 - (d) refills or re-uses for commercial purposes, labels, containers, wrapping, packaging or any other material bearing the mark;
 - (e) uses in the course of trade, a sign that is identical or similar to the mark in respect of any goods or services, where such use may cause a risk of confusion or association with the registered mark;
 - (f) uses in the course of trade, a sign identical or similar to the mark in respect of any goods or services where such use may cause unfair economic prejudice to the registered owner through dilution of the distinctive character or advertising value of the mark, or an unfair advantage being taken from the reputation of the registered mark or of its holder; or
 - (g) for non-commercial purposes, uses a sign identical or similar to the mark, where this may cause dilution of the distinctive character or advertising value of the mark, or an unfair advantage being taken of the reputation of the mark or of its holder,
- infringes the rights of the owner of the registered mark.
- (3) The following acts, in particular, shall constitute use of a mark in the course of trade —
- (a) introducing in the market, selling, offering for sale or distributing goods or services with the mark or with reference to the mark;
 - (b) importing, exporting, storing or transporting goods that bear the mark or refer to the mark;
 - (c) use of the mark in advertising, publications, commercial documents, written or oral communication, irrespective of the means of communication used;
 - (d) use of the mark on the internet or other electronic communication media or networks open to the public, where the use is intended for Botswana or has a commercial market in Botswana;
 - (e) adoption or use of the mark as part of a domain name or other similar identification or designation on the internet or other electronic communication media or networks open to the public; and
 - (f) the acts mentioned under paragraphs (a) and (b) performed in respect of labels, tags, packaging or wrapping material and similar products that reproduce or bear the mark.
- (4) The provisions of section 74 (2) (h) shall apply in any action instituted by the owner of a well known mark against any person in respect of the unlawful use of that mark.
- 82.** (1) The rights conferred by registration of a mark may not be invoked to prevent a third party from using, in the course of trade —
- (a) his or her name or address, or that of his or her trading establishment;
 - (b) the mark on goods lawfully bearing that mark after the goods have been put in the market in Botswana or abroad by the registered holder or by a person acting with the holder's consent or having an economic tie to the holder where the goods and the packaging or wrapping in direct contact with the goods has not deteriorated or been altered;

Exceptions to
rights
conferred by
registration

- (c) bona fide indications or information on characteristics of the goods or services produced or marketed by that person, in particular, those referring to quantity, quality, use, geographical origin or price of the goods or services;
- (d) a geographical indication registered under this Act;
- (e) bona fide indications or information on the availability, use, application or compatibility of the goods or services produced or distributed by that person, in particular in relation to spare parts, replacements or accessories if the registered mark is used in good faith to perform legitimate industrial or commercial activities, and is not likely to cause confusion or association in respect of the commercial source of the goods or services.

(2) For the purposes of subsection (1) (b), an economic tie shall exist where one of two persons or more involved may exercise directly or indirectly on the other, a decisive influence with respect to the use of the mark, or where a third party may exercise such an influence on both persons.

(3) Where a mark consists of a sign composed of several elements, protection shall not extend to the elements that are merely descriptive or are of common or necessary use for the purposes of trade.

Proceedings for
infringement of
mark

83. (1) The owner of a mark shall, in addition to any other rights, remedies or actions available to him or her, have the right to institute court proceedings against any person who infringes the mark by using that mark without his or her authorisation or by performing acts which make it likely that infringement will occur.

(2) The right conferred under this section shall extend to the use of a sign similar to the registered mark in relation to goods and services similar to those for which the mark has been registered, where confusion may arise in the public.

(3) The right conferred under this section shall extend to the use of a sign which constitutes a reproduction, an imitation or a translation of a registered mark which is well known in Botswana in relation to goods or services which are not similar to those in respect of which a mark is registered where —

- (a) use of the mark in relation to those goods or services would indicate a connection between those goods or services and the owner of the registered mark; and
- (b) the interests of the owner of the registered mark are likely to be prejudiced by such use.

(4) A plaintiff in proceedings for infringement shall be entitled to relief by way of an interdict, delivery up or destruction of any infringing product, article or product of which the infringing product forms an inseparable part, damages or an account of the profits derived from the infringement.

(5) The court shall not, in awarding damages under this section, also order, in respect of the same infringement, that the plaintiff be given an account of the profits derived by him or her from the infringement.

84. The rights in a mark may be transferred by cession, assignment, testamentary disposition or by operation of law.

Transfer of rights in mark

85. (1) The registration in respect of a mark shall expire 10 years after the filing date of the application for its registration, but may, upon the written request and payment of the prescribed renewal fee, be renewed for consecutive periods of 10 years.

Duration and renewal of registration of mark

(2) Where the owner of a registered mark is late in paying the renewal fee, the Registrar shall, upon payment of such surcharge as may be prescribed, give him or her a period of grace of six months within which he or she must pay the late renewal fee.

(3) The rights of a registered owner shall lapse immediately after the expiry of the six months grace period.

86. (1) Any interested person may apply to the Registrar for the invalidation of the registration of a mark on the grounds specified in section 74 (2) or on the grounds that the definition of a mark as specified under this Act has not been satisfied.

Invalidation of registration of mark

(2) An application for the invalidation of a registration of a mark shall be served on the owner of the mark in the prescribed manner.

(3) Any invalidation of the registration of a mark shall be deemed to have been effective from the date of registration of the mark and a reference thereto shall be published by the Registrar in the Journal as soon as possible.

87. (1) Any interested person may make an application to the Registrar to remove, from the register, a mark in respect of any of the goods or services in respect of which it is registered on the ground that up to one month prior to filing the application, the mark had, after its registration, not been used in Botswana by the registered owner or a licensee during a continuous period of three or more years.

Removal of mark on grounds of non-use

(2) The Registrar shall not remove a mark from the register if the owner of the mark shows that circumstances existed which prevented the use of the mark and that there was no intention not to use the mark in respect of those goods or services, or that there was no intention to abandon the use of the mark in respect of the said goods or services.

(3) An application for the removal of a mark from the register of marks shall be served on the owner and filed with the Registrar in the manner and within the time prescribed.

88. (1) An owner of a mark who loses rights on the mark under section 85 or 87 may apply, within two months, to the Registrar for the reinstatement of his or her rights on the mark, giving reasons.

Reinstatement of lapsed mark rights

(2) The Registrar may reinstate the rights of the owner of the mark where it emerges that failure to comply with the time limit occurred regardless of due care as required by the circumstances having been taken, subject to payment of a re-instatement fee.

A.56

Banjul
Protocol on
marks

89. A mark in respect of which Botswana is a designated State, registered by ARIPO by virtue of the Banjul Protocol, shall have the same effect and enjoy the same protection in Botswana as a mark registered under this Act unless the Registrar communicates to ARIPO, in respect of the application therefor, a decision, in accordance with the provisions of that Protocol, that if a mark is registered by ARIPO, that mark shall have no effect in Botswana.

Collective
marks

90. (1) Subject to subsections (2) and (3), sections 74 to 87 of this Act shall apply to collective marks, except that references therein to a mark shall be read as being references to a collective mark.

(2) An application for the registration of a collective mark shall designate the mark as a collective mark and shall be accompanied by a copy of the rules governing the use of the collective mark.

(3) For purposes of subsection (2), “rules” means the rules made by the person under whose control the collective mark may be used.

(4) The registered owner of a collective mark shall notify the Registrar, in writing, of any changes made in respect of the rules referred to in subsection (2).

Invalidation
of registration
of collective
mark

91. (1) In addition to the grounds set out in section 86 (1), the Registrar shall invalidate the registration of a collective mark if the person requesting the invalidation proves that only the registered owner uses the mark, or that he or she uses or permits its use in contravention of the rules referred to in section 90 (2), or that he or she uses or permits its use in a manner which is liable to deceive those in the trade or the public as to the origin or any other common characteristics of the goods or services concerned.

(2) An application for the invalidation of a collective mark shall be served on the owner of the mark in the manner and within the time prescribed.

Licensing of
marks and
collective
marks

92. (1) Any licence contract made in relation to a mark shall provide for the effective control by the licensor of the quality of the goods or services of the licensee in connection with which the mark is used.

(2) If the licence contract does not provide for quality control referred to in subsection (1), or if the quality control is not effectively carried out, the licence contract may be declared invalid or non-enforceable by the Court.

(3) The registration of a collective mark, or an application therefor, may not be the subject of a licence contract.

(4) A licence holder shall apply, in the prescribed manner and subject to the payment of the prescribed fee, to the Registrar to record, on the register, details about the licence contract made under subsection (1) and for such purpose the Registrar shall not require submission of the licence contract or a translation thereof, nor any indication of the financial terms of the contract.

(5) A single request shall be sufficient to record a licence in respect of more than one registered mark if the registration numbers of all registrations concerned are indicated in the request, the holder of the marks and the licensee are the same for all registrations, and the request indicates, as prescribed, the scope of the licence with respect to all the registrations.

(6) Failure to record a licence at the Office shall not affect the validity of the registration of the mark that is the subject of the licence, or the rights granted by that registration.

(7) Recording of a licence by the Office shall not be required as a condition for any right that the licensee may have to join infringement proceedings initiated by the holder of the registration or to obtain, by way of such proceedings, damages resulting from an infringement of the mark which is the subject of the licence.

(8) Where the use of a mark by a licensee is deemed to constitute any use by the holder of the registration in any proceedings relating to the acquisition, maintenance or enforcement of rights in a mark, the recording of the licence shall not be required as a condition for such use to be recognised.

93. (1) A name or designation may not be used as a trade name if by its nature or the use to which it may be put, it is contrary to public order or morality and if, in particular, it is liable to deceive those in the trade or the public as to the nature of the enterprise identified by that name.

Trade names

(2) Notwithstanding any law providing for any obligation to register a trade name, such name shall be protected, even prior to or without registration, against any unlawful act committed by a third party.

(3) Any subsequent use of the trade name by a third party, whether as a trade name, a mark or a collective mark, or any such use of a similar trade name or mark, which is likely to mislead the public, shall be deemed to be unlawful.

PART IX – *International Registration under the Madrid Protocol*

94. (1) Where an international application is filed with the Office for transmission to the International Bureau, the Office shall verify that Botswana qualifies as the country of origin under the Madrid Protocol in respect of that application, and that the particulars appearing in the international application correspond to the relevant particulars appearing in the basic application or basic registration, as the case may be, in accordance with the provisions of the Madrid Protocol and the Regulations.

Initial examination of international applications

(2) Where the international application complies with the prescribed requirements, the Office shall so certify in the application indicating the date on which it was received, and shall, upon payment of the prescribed handling fee by the applicant, forward the application to the International Bureau.

(3) Any communication, including the international application, submitted to the International Bureau through the Office shall be in English.

(4) Where the international application does not meet the prescribed requirements, the Office shall not forward it to the International Bureau, and shall inform the applicant accordingly.

A.58

Lapse of basic application or basic registration

95. Where, within 5 years from the date of the international registration, the basic application filed in Botswana or the basic registration resulting therefrom ceases to have effect, the Office shall notify the International Bureau accordingly and shall request the cancellation of the international registration in respect of the goods and services affected.

Initial refusal of registration by Office

96. (1) Where the Office finds that the mark that is the subject of an international registration designating Botswana cannot be protected, it shall notify a provisional refusal of protection to the International Bureau complying with the requirements prescribed in the Madrid Protocol and the Regulations.

(2) The holder of the international registration referred to under subsection (1) shall enjoy the same remedies as if the mark had been filed for registration directly with the Office in terms of Part VIII.

Refusal of registration by Office

97. Where the Office determines that the mark does not comply with the requirements specified under section 74 (2), it shall notify the International Bureau in accordance with the relevant provisions of the Madrid Protocol and the Regulations that, to the extent that the requirements are not met, registration and protection in Botswana is refused.

Registration under Madrid Protocol

98. (1) Subject to section 99, a mark which is registered under the Madrid Protocol and contains a designation of Botswana shall be protected in the same manner as if an application for registration had been filed under this Act on the date of its international registration.

(2) The Registrar shall, where there is no refusal under section 97 or where such a refusal has been withdrawn, register the mark in the appropriate register and publish, in the Journal, a reference to the registration of that mark and any recording made in the International Register in respect of an international registration shall, to the extent that it applies to Botswana as a designated party, have the same effect as if it had been recorded in the register of marks at the Office.

Opposition to protection of internationally registered mark

99. (1) Any interested person may, on the grounds that the requirements of section 74 (2) have not been met, or that the mark does not comply with the definition of a mark as specified in this Act, the Madrid Protocol or the Regulations, give to the Registrar, within three months from the publication referred to in section 98 (2) and in such manner as may be prescribed, notice of his or her opposition to the protection of the mark.

(2) The Registrar shall, as soon as he or she receives such notice, notify the International Bureau as prescribed in the Madrid Protocol and the Regulations, that protection in Botswana is provisionally refused pending the outcome of the opposition proceedings.

(3) Where notification is made under subsection (2), the holder of the mark that has been registered internationally shall enjoy the same remedies as if the mark had been filed for registration directly with the Registrar.

(4) Where a final decision is taken by the Office in respect of an opposition filed against an international registration designating Botswana, the Office shall notify that fact to the International Bureau by means of a statement complying with the requirements prescribed in the Madrid Protocol and the Regulations.

100. Where the effects of an international registration are invalidated in Botswana and the invalidation is no longer subject to appeal, the Office shall, provided that it is aware of that decision, notify the International Bureau in accordance with the relevant provisions of the Madrid Protocol and the Regulations.

101. (1) Notifications to the International Bureau referred to in sections 96 (1), 97 and 99 (2) shall be sent by the Registrar not later than one year from the date on which the Registrar was notified of the international registration of the mark.

(2) The Registrar shall inform the International Bureau of any final decision regarding the acceptance or refusal outcome of the opposition proceedings.

102. Where an international registration designating Botswana is of a collective mark or a certification mark, the rules governing the use of the collective mark or certification mark shall be submitted directly by the holder of that international registration to the Office within the prescribed time limit.

103. (1) The Office shall, upon request from the holder of an internationally registered mark, record a note of that international registration in the register of the mark that was registered in Botswana where —

- (a) a mark registered in Botswana is also the subject of an international registration that extends to Botswana;
- (b) the same person is recorded as holder of the registration in Botswana and of the international registration;
- (c) all the goods and services listed in the registration in Botswana are also listed in the international registration in respect of Botswana; and
- (d) the extension of that international registration to Botswana took effect after the date of registration of that mark in Botswana.

(2) A request under subsection (1) shall be subject to the payment of the prescribed fee.

(3) Where the Office has recorded a note of an international registration in accordance with subsection (1), it shall notify the International Bureau accordingly and the notification shall indicate the following —

- (a) the number of the international registration in question;
- (b) where only some of the goods and services listed in the international registration are concerned, those goods and services;
- (c) the filing date and number of the application for registration and the registration date and number of the mark in Botswana;

Invalidation
of
internationally
registered
mark

Time limit of
notification to
International
Bureau

Collective and
certification
marks

Replacement
of
internationally
registered
mark

A.60

- (d) the priority date, if any, of the registration in Botswana; and
- (e) information relating to any rights acquired by virtue of the registration of the mark in Botswana.

Transformation

104. (1) Where an international registration designating Botswana is cancelled at the request of the office of origin in accordance with Article 6 (4) of the Madrid Protocol, in respect of all or some of the goods or services listed in the international registration, the person who was the holder of the international registration at the date of its cancellation may, under Article 9 quinquies of the Madrid Protocol, file with the Office, within three months from the date on which the international registration was cancelled, an application for registration of the same mark in respect of goods or services covered by the cancelled international registration.

(2) An application under subsection (1) shall be treated as if it had been filed on the date of the international registration or on the date of the recording of the territorial extension to Botswana and, if the international registration enjoyed priority, the application shall enjoy the same priority.

(3) Subject to this section, the provisions applicable to an application for registration filed directly with the Office shall apply with necessary modification to an application resulting from transformation under subsection (1).

(4) An application under subsection (2) shall be made on such a form as may be prescribed for application for registration of a mark and shall include the following —

- (a) a statement that the application is made by way of transformation;
- (b) the registration number of the international registration which has been cancelled;
- (c) the date of the international registration, or the date of recording of the territorial extension to Botswana, where applicable;
- (d) the date on which the cancellation of the international registration was recorded; and
- (e) the date of any priority claimed in the international application and recorded in the International Register, where applicable.

(5) An application for registration under this section shall be subject to the payment of the prescribed fee.

(6) Where the mark under the international registration had become protected in Botswana on or before the date on which the international registration was cancelled, and provided that all the requirements relating to an application to register that mark under subsection (1) are met, the mark shall be registered by the Office and such registration shall bear the date of the cancelled international registration or, where applicable, the date of recording of the territorial extension to Botswana, and shall enjoy any priority enjoyed by the cancelled international registration.

(7) Where the mark under the international registration had not become protected in Botswana on or before the date on which the international registration was cancelled, any procedures already undertaken by the Office in respect of the international registration on or before the date on which an application under subsection (1) is filed, shall be —

- (a) considered as having been undertaken for the purposes of the application under subsection (1); and
- (b) deemed to have as its application date the date of the cancelled international registration or, where applicable, the date of recording of the territorial extension to Botswana, and shall enjoy any priority enjoyed by the cancelled international registration.

PART X – Geographical Indications

105. Except as provided under the provisions of this Part, the provisions of Part VIII shall, with the necessary modifications, apply to geographical indications and their registration.

Applicability of provisions relating to marks

106. (1) The exclusive right to a geographical indication under this Act shall be acquired by registration in accordance with the provisions under this Part.

Acquisition of exclusive right to geographical indication

- (2) A geographical indication shall not be registered if it is —
 - (a) incapable of distinguishing goods originating from a particular territory, region or locality or does not possess characteristics attributed to that territory, region or locality in which those goods come from;
 - (b) contrary to public order or morality;
 - (c) likely to mislead the public or those in the trade, as regards the geographical origin of the goods concerned, or their nature or characteristics;
 - (d) in respect to goods, identical with the term usually used in common language as the common name for such goods in Botswana; or
 - (e) not protected, has ceased to be protected or has fallen into disuse in its country of origin.

107. (1) An application for the registration of a geographical indication, accompanied by such fees as may be prescribed, shall be made to the Registrar in the prescribed manner and shall contain the following —

Application for registration of geographical indication

- (a) a request, in writing, that the geographical indication be registered;
- (b) the geographical indication for which registration is sought;
- (c) a specification containing —
 - (i) the name of the products to which the geographical indication applies,
 - (ii) a description of the product, including its raw materials, if appropriate, and principal physical, chemical, microbiological or organoleptic characteristics,
 - (iii) the definition of the geographical area from which the designated product originates,

A.62

- (iv) evidence that the product originates in the defined geographical area,
 - (v) a description of the method of obtaining or producing the product, including as appropriate, the traditional local methods, and information concerning packaging if it is claimed that the packaging is relevant to the claimed characteristics or required to safeguard the quality or ensure the genuine origin of the product,
 - (vi) details bearing out the link between the quality or characteristics of the product and its geographical origin,
 - (vii) the name and address of the authority or body responsible for certifying compliance with the specification, or
 - (viii) other information prescribed by regulation; and
- (d) other requirements prescribed by regulation.
- (2) The applicant may at any time before his or her geographical indication is registered withdraw his or her application.
- 108.** (1) The Registrar shall examine an application for registration of a geographical indication to determine whether —
- (a) it complies with the requirements of section 107 (1) and any other requirements as may be prescribed; and
 - (b) it complies with the requirements of paragraphs (a) to (e) of section 106 (2).
- (2) The Registrar shall, if he or she is satisfied that the application complies with the requirements of the provisions of this section, accept that application and shall, within such time and in such manner as may be prescribed, publish that application in the Journal.
- 109.** (1) Any interested person may, on the ground that the requirements of section 106 (2) have not been satisfied, or that the geographical indication does not comply with the definition of a geographical indication as specified in this Act, give to the Registrar within such period and in such manner as may be prescribed, notice of his or her opposition to the registration of the geographical indication.
- (2) The Registrar shall, as soon as he or she receives a notice under subsection (1), send a copy thereof to the applicant who shall, within such period and in such manner as may be prescribed, send to the Registrar, his or her written response thereto (referred to as a “counter-statement”) specifying the grounds on which he or she relies for his or her application.
- 110.** (1) Where, having considered the merits of any opposition and any counter-statement, the Registrar is satisfied that the application for the registration of a geographical indication satisfies the requirements of this Act, the Registrar shall —
- (a) register the geographical indication in the appropriate register;
 - (b) issue to the applicant, a certificate of registration; and
 - (c) publish in the Journal, a reference to the registration of the geographical indication.

Examination of application for registration of geographical indication

Opposition to registration of geographical indication

Registration of geographical indication

(2) Where the requirements for the registration of a geographical indication are not satisfied, or an application for the registration of a geographical indication has been successfully opposed, the Registrar shall not register the geographical indication.

111. (1) The right to a registered geographical indication shall belong to the registered owner.

Rights of registered owner, etc.

(2) Registration of a geographical indication shall confer on the registered owner the right to prohibit third parties from using the geographical indication, and to institute court proceedings against any person infringing his or her rights.

(3) No person shall, without authorisation from the owner of the registered geographical indication —

- (a) use the registered geographical indication to identify products of the same description but not originating from the place indicated by the geographical indication, even where the true origin is indicated or the geographical indication used is accompanied by disclaimers or expressions such as “kind”, “type”, “style”, “imitation” or the like;
- (b) use the registered geographical indication to indicate that products originate in a geographical region other than their true place of origin; or
- (c) use the registered geographical indication for goods produced in the geographical area specified in the register in respect of the geographical indication that do not possess the quality, reputation or other characteristic specified in the register.

(4) The provisions of section 114 (3) shall apply in any action instituted by the owner of a geographical indication against any person who contravenes subsection (3).

112. The rights conferred by registration of a geographical indication may not be invoked to prevent a national or domiciliary of Botswana who has previously used the geographical indication to identify wines or spirits to continue such use in the same manner, provided such use was undertaken continuously —

Exceptions to rights conferred by registration

- (a) for at least 10 years preceding April 15, 1994; or
- (b) in good faith preceding the date specified under paragraph (a).

113. (1) Any interested person may apply to the Registrar for the invalidation of the registration of a geographical indication on the ground that the requirements of section 106 (2) and the definition of a geographical indication as specified under this Act, have not been satisfied.

Invalidation of registration of geographical indication

(2) An application for the invalidation of a geographical indication shall be served on the owner of the geographical indication in the prescribed manner, and on any other person having the right to use the geographical indication.

(3) Where the application for invalidation is based on the ground that the geographical area specified in the register does not correspond to the geographical indication, or that the indication of the products for which the geographical indication is used or the indication of the quality, reputation or other characteristic of such product is missing or unsatisfactory, the Registrar may order for the rectification of the registration.

PART XI — *Acts of Unfair Competition*Acts of unfair
competition

114. (1) On the request of the owner of a title of protection under this Act, or of any competent authority or any person, association or syndicate, the court may grant an interdict to prevent an act of unfair competition, award damages or grant any other remedy as the court may deem appropriate.

(2) For purposes of this Act any act of competition which is contrary to honest practices in industrial or commercial matters shall constitute an act of unfair competition, and shall be unlawful.

(3) The following, in particular, shall constitute acts of unfair competition —

- (a) any act of such a nature as to create confusion by any means whatever with the establishment, the goods or the industrial or commercial activities of a competitor;
- (b) the making of a false allegation in the course of trade of such a nature as to discredit the establishment, the goods, or the industrial or commercial activities of a competitor;
- (c) the making of allegations which, in the course of trade, is likely to mislead the public as to the nature, the manufacturing process, the characteristics, the suitability for their purpose, or the quantity of the goods of a competitor;
- (d) the use of a geographical indication that identifies specific products of a particular origin to designate products of the same description but not originating from the place indicated by the geographical indication, even where the true origin is indicated or the geographical indication used is accompanied by disclaimers or expressions such as “kind”, “type”, “style”, “imitation” or the like;
- (e) the use of geographical indications to indicate that products originate in a geographical region other than their true place of origin; or
- (f) any act or practice done in the course of industrial or commercial activities that results in obtaining, using or disclosing to third parties undisclosed information without the consent of the rightful holder of that information.

(4) When, as a condition of approving the marketing of a pharmaceutical or agricultural chemical product that utilises new chemical substances, an authority in Botswana requires the submission of undisclosed tests or other data, the origination of which involves a considerable effort, such data shall be protected against unfair commercial use and disclosure and where it is necessary to protect the public, such data shall be disclosed on condition that steps are taken to protect it from unfair commercial use.

(5) For the purposes of this section, information, data or a test shall be considered undisclosed if —

- (a) it is not, as a body or in the precise configuration or assembly of its components, generally known or readily accessible to persons within the circles within which it is normally dealt with;

- (b) it has been subjected to reasonable steps, under the circumstances, to preserve it from disclosure; and
- (c) it has commercial value because it is secret.

PART XII – *Traditional Knowledge and Handicrafts*

- 115.** (1) Traditional knowledge shall be registered together with a description of such knowledge where —
- (a) it has not been disclosed to the public through any means; or
 - (b) if it has been disclosed, such disclosure has not led to any commercial or industrial exploitation in Botswana.
- (2) A description shall disclose traditional knowledge in a manner which is sufficiently clear and complete to permit any third party to reproduce or utilize the traditional knowledge to obtain results similar or identical to those obtained by the holder of such traditional knowledge.
- (3) Any element of traditional knowledge may be registered separately or individually in conformity with its technical characteristics without prejudice to its holistic nature, or as a whole in its integrity combining, if necessary, all elements of traditional knowledge into a single registration.
- 116.** (1) A local traditional practitioner, a representative of any local community or any individual may apply to register traditional knowledge.
- (2) When making an application for registration of traditional knowledge, an applicant may opt to keep all or parts of the elements of traditional knowledge under secrecy.
- (3) Where two or more local communities that occupy the same territory have created and are in possession of identical or similar elements of traditional knowledge, they may register those elements individually, on behalf of each community.
- 117.** (1) Ownership and other rights to traditional knowledge shall belong to the owner of the traditional knowledge.
- (2) Where traditional knowledge is collectively owned, rights over it shall be exercised and enjoyed collectively in accordance with cultural practices.
- (3) Notwithstanding subsection (2), local communities which have registered individually for similar or identical elements of traditional knowledge shall have the option to exercise and enjoy their rights over the traditional knowledge individually.
- (4) An applicant community which comprises of individuals from different countries including Botswana, shall have the right to register and acquire rights over traditional knowledge in Botswana and in the other countries.
- 118.** The Registrar shall cause to be published in the Journal notice of registration of traditional knowledge which shall contain —
- (a) a summary of the registered traditional knowledge, where available;

Registration
of traditional
knowledge

Who may
register
traditional
knowledge

Rights
conferred by
traditional
knowledge

Notification
of registration
of traditional
knowledge

A.66

- (b) the identification of the local community or communities that created the traditional knowledge, and an identification of the geographical distribution of the community and its intrinsic differentiating characteristics where applicable; and
- (c) the date of application.
- 119.** The Registrar or any third party with a legitimate interest may petition the Court for an invalidation of the registration of traditional knowledge where —
- (a) the registered traditional knowledge has not been created by the person or persons who initially applied for registration;
- (b) before registration, the registered traditional knowledge was disclosed to the public and as a result has been commercially or industrially exploited in Botswana; or
- (c) the registered traditional knowledge has lost its value as an element of cultural identification as a result of its explicit abandonment, or of continuous non-use, or continued use in a distorted manner by third parties with the knowledge of the owner.
- 120.** Protection of registered traditional knowledge shall expire when it has lost its value —
- (a) as an element of cultural identification;
- (b) as a result of willful and expressed abandonment by its owner or owners; or
- (c) as a result of non-use or use in a distorted manner by third parties of which the owner or owners are aware.
- 121.** (1) Protection of traditional knowledge under this Act shall confer on the owner the following exclusive rights —
- (a) where the subject matter of protection is a product, the right to prevent third parties without consent from making, using, stocking, offering for sale, selling, commercializing, importing or exporting the product or any element thereof;
- (b) where the subject matter of protection is a domesticated animal, cultivated plant or any micro-organism, the right to prevent third parties without consent from reproducing, multiplying or preparing for reproduction through an offer of sale, sale, importing, exporting or any form of commercialization;
- (c) where the subject matter of protection is a design or an object of a functional or aesthetic nature including any element of handicrafts, the right to prevent third parties without consent from making or reproducing any object with a similar configuration as regards shape, colour, material, technique and the overall style or visual impression of the handicrafts that are characteristic to it;
- (d) where the subject matter of protection is a name, a symbol, an emblem or any distinctive sign of a religious, spiritual, cultural or economic nature, the right to prevent third parties without consent from any kind of use, both in maternal language or any other language that consist of an identical or similar sign on a product or on a product associated with services, making of labels, packages or other material that reproduce or contain the signs for a commercial or any other purpose.

Invalidation of registration of traditional knowledge

Expiry of protection of traditional knowledge

Specific rights over traditional knowledge

(2) No person shall distort a registered traditional knowledge in any way, especially distortion of a spiritual or cultural identity of a community that owns traditional knowledge or any act that implies direct or indirect use of the knowledge for any purpose including scientific or academic research, without the owner's consent:

(3) Notwithstanding the provisions of subsection (1), where the subject matter of protection is a product which has been put in the market in Botswana by either the owner or by a third party with the consent of the owner, commercial acts in respect of the product shall not be regarded as distorting the cultural identity of the community or in any way contribute to it.

(4) Where, upon registration of traditional knowledge, an owner takes reasonable steps to keep part of the elements of the traditional knowledge a secret, no person shall disclose or acquire the undisclosed knowledge in any manner contrary to honest commercial practices.

122. (1) Any proceedings concerning the protection or infringement of rights over traditional knowledge shall be initiated either by the local community or any other owner of that knowledge.

Right to institute infringement proceedings

(2) The Court may order the infringing party to pay to the local community an amount to be prescribed.

123. The rights of local communities over registered traditional knowledge under this Act may not be assigned, ceded or transferred in any manner.

Transfer, assigning, etc., of rights over traditional knowledge

124. (1) The Minister may, on grounds of public interest, after hearing any local community that owns traditional knowledge, authorize the scientific, commercial or industrial exploitation of that knowledge or any element of it, by a third party, where —

Exploitation of traditional knowledge rights by others

(a) the exploitation does not distort or offend the cultural identity of the local community; and

(b) the local community is granted an equitable share of any benefit derived from such scientific, commercial or industrial exploitation.

(2) The exploitation granted under subsection (1) shall be limited by the scope and duration of the authorization and shall expire when it can no longer be justified on the basis of public interest.

125. (1) Local communities may grant licensing agreements to exploit traditional knowledge or any element of it to third parties subject to the following conditions —

Granting of licences by owners of traditional knowledge

(a) payment by the third party, at the discretion of the community, including payment of either a lump sum, royalty fee or participation in the benefits directly or indirectly derived from the exploitation of the knowledge;

(b) conferment by the third party of benefits such as educational grants, medical assistance or any other benefits;

(c) the exploitation does not lead to distortion of any kind; and

(d) registration of the licensing agreement with the Registrar.

A.68

(2) Where, exploitation under this section leads to loss of the traditional knowledge's nature as an element of cultural identification of that particular local community, the licensing agreement shall cease to be valid.

Registration of handicrafts

126. (1) Designs or objects with an aesthetic or functional configuration, including clothing, pottery or any other handicrafts that constitute inseparable elements of culture, the spirituality or the tradition of any local community may be registered —

(a) in the register for traditional knowledge; or

(b) where, even though there has been commercial exploitation prior to registration, the object or design has not lost the essential link identifying the cultural, spiritual or tradition of the local community.

(2) The application shall, subject to section 115, contain a description of the general characteristics of the use, methods of making, the selection, preparation and use of raw materials of each type of product and a general description of the history and evolution of the handicraft.

(3) The local community owning the handicraft may cause to be registered, individual pieces of the product of the handicraft that are created after registration, which pieces may be added to the general registration.

(4) Subject to the provisions of section 120, the exclusive rights in a registered handicraft shall apply to the whole series or types of handicrafts as described in the register, in order to prevent the making, using, stocking, selling, offering for sale, importing or exporting by third parties without consent any products, that may in any manner lead to confusion by consumers as to the origin, creation or making of handicrafts.

Validity of industrial property titles relating to traditional knowledge

127. (1) Any title of industrial property, including but not limited to patents, trade marks, industrial designs or plant variety certificates that are granted, irrespective of any rights of traditional knowledge under this Act, shall not be enforceable against third parties until the written consent of the local community owning the traditional knowledge is obtained.

(2) Local communities may, where applicable and at their discretion, seek protection for the elements of their traditional knowledge in an alternative or complimentary manner by means of other regimes of industrial property without prejudice to the rights and interests protected by this Act.

PART XIII — *Miscellaneous Provisions*

Changes in ownership

128. (1) Any change in the ownership of a patent, a utility model certificate, the registration of an industrial design, mark or collective mark, or in the ownership of an application therefor, shall be in writing and shall, at the request of any interested party made in the prescribed manner, be recorded by the Registrar in the appropriate register, and except in the case of an application, be published by notice in the Journal.

(2) Any change in the ownership of a patent, a utility model certificate, the registration of an industrial design, mark or collective mark or in the ownership of an application therefor, shall have no effect against third parties unless it has been recorded by the Registrar in the appropriate register.

(3) A change in ownership of the registration of a mark or a collective mark shall be invalid if it is likely to deceive or cause confusion particularly in regard to the nature, origin, manufacturing process, characteristics or suitability for their purpose, of the goods or services in relation to which the mark or collective mark is intended to be used or is being used.

(4) Where a change in ownership concerns more than one registered right or more than one pending application of the same person, a single request shall be sufficient to record the change in respect of all of them provided that the parties involved are the same for all the registered rights and pending applications concerned, and the numbers of all the patents, registrations and applications concerned are indicated in the request.

129. (1) Any licence or agreement concerning a patent, a utility model certificate, a registered industrial design or registered mark, traditional knowledge or an application therefor shall have no effect against third parties unless it has been recorded in the appropriate register.

Licence
contract

(2) The provision of subsection 128 (2) shall apply to the recordation of licences in the register.

130. (1) Every person who makes an application under this Act for the grant or registration of a patent, utility model certificate, industrial design, mark, or collective mark, or of any other thing which may be applied for under this Act, and whose ordinary residence or principal place of business is outside Botswana, shall be represented by a legal practitioner who has been enrolled to practise in the courts of Botswana in accordance with the provisions of the Legal Practitioners' Act or such other person as the Minister may prescribe.

Agents

Cap. 61:01

(2) Notwithstanding subsection (1), any interested person may, on his or her own behalf —

- (a) file an application for a patent or utility model for the purposes of the filing date;
- (b) pay any prescribed fee; and
- (c) receive a receipt or an attestation from the Office, in respect of a procedure referred to in paragraph (a) and (b).

131. (1) The Registrar may correct any clerical or other error —

- (a) in translation or transcription in any application filed under this Act;
- (b) in any document filed or lodged in pursuance of an application under paragraph (a); or
- (c) in any register maintained in pursuance of this Act.

Correction
of errors

(2) Subsection (1) shall not be construed as giving the Registrar any power to correct or amend any application, document or register in any material manner.

A.70

(3) A correction made in pursuance of this section shall be made by the Registrar of his or her own accord or upon the request of any interested person.

(4) Where an interested person under subsection (3) requests the Registrar to correct any application or other document filed under this Act, that person shall pay, to the Registrar, such fee as may be prescribed.

Exercise of discretionary powers

132. The Registrar shall give any party to proceedings before the Office an opportunity of being heard and of complying with any missing requirements before making any decision under this Act or the regulations if that decision might adversely affect or prejudice that party.

Extension of time for applications

133. (1) Where anything is required to be done within a prescribed time and, by reason of a delay in the Office, the thing is not done, the Registrar may extend the time for the doing of that thing for such period as may be prescribed, and no fees shall be payable in respect of that extension.

(2) Notwithstanding the provisions of subsection (1), the Registrar may, upon the written request of an interested person, and upon payment of such fee as may be prescribed, extend, for such period as may be prescribed, the time specified for the doing of any act if that person shows good cause as to why he or she did not do that act within the prescribed time.

Offences and penalties

134. (1) Any person who, knowing the same to be false —

- (a) makes or causes to be made a false entry in any register kept in terms of this Act;
- (b) makes or causes to be made any document falsely purporting to be a copy of an entry in any such register; or
- (c) produces, tenders or causes to be produced as evidence an entry acquired under paragraph (b) or a copy thereof,

commits an offence and shall, on conviction, be sentenced to a fine of not less than P5 000 but not more than P10 000, or to imprisonment for a term of not less than one year but not more than three years, or to both.

(2) Any person who —

- (a) for the purpose of deceiving the Registrar or any other officer in the execution of his duties under this Act; or
- (b) for the purpose of procuring or influencing the doing or omission of any act under this Act,

makes a false statement or representation knowing the same to be false, commits an offence and shall, on conviction, be sentenced to a fine of not less than P5 000 but not more than P10 000, or to imprisonment for a term of not less than one year but not more than three years, or to both.

(3) Any person who, knowing the same to be false, makes a false statement or representation that —

- (a) a patent has been granted to him or her or to any other person in respect of any invention;
- (b) he or she or any other person is the owner of any registered design, mark, collective mark or trade name; or
- (c) he or she has been granted an exclusive or compulsory licence to use any patent, registered design, registered mark or collective mark or trade name,

which statement or representation is intended to induce another person to act thereon, commits an offence and shall, on conviction, be sentenced to a fine of not less than P2 000 but not more than P5 000, or to imprisonment for a term of not less than six months but not more than two years, or to both.

(4) Subject to the provisions of sections 25 (1), 31, 32, 33, 55 (4), 81 (2) and 111 (2), the performance of any act referred to in sections 25, 55, 81 and 111 by a person other than the owner of the title of protection and without the agreement of such owner shall constitute an infringement.

(5) The court may, on the application to it by the owner of the title of protection, or by a licensee if he or she has requested the owner to institute court proceedings for a specific relief and the owner has refused or failed to do so, grant an interdict to prevent an infringement or unlawful act referred to in sections 93 (3), 111 (2) and 114 (2).

(6) Any person who intentionally or wilfully performs any act which constitutes an infringement as defined in subsection (4) of this section, or an unlawful act as defined in sections 93 (3), 111(2) and 114 (2) commits an offence and shall be sentenced, on conviction, to a fine of not less than P2 000 but not more than P5 000, or to imprisonment for a term of not less than six months but not more than two years, or to both.

(7) Any person who commits an offence or unlawful act for which no specific penalty has been specified shall be sentenced to a fine of not less than P2 000 but not more than P5 000, or to imprisonment for a term of not less than six months but not more than two years, or to both.

135. A person aggrieved by any decision made under this Act may appeal —

Appeals

- (a) to the Minister in the manner prescribed, and within the time prescribed, if he or she is aggrieved by a decision of the Registrar;
- (b) to the High Court against the decision of the Minister, within such time as may be prescribed; or
- (c) directly to the High Court, as specified, against the decision of the Registrar or the Minister.

136. The provisions of any international treaty in respect of industrial property and any related rights to which the Republic of Botswana is a party shall apply to matters dealt with under this Act, subject to any reservations which the Republic of Botswana has made in relation to those treaties.

Application of international treaties

A.72

Regulations	137. The Minister may, by statutory instrument, make regulations providing for any matter required to be prescribed or which is to be provided for under this Act, or which otherwise relates to the administration of this Act.
Repeal of Cap. 68:03	138. The Industrial Property Act is hereby repealed.
Savings	139. (1) Notwithstanding the repeal under section 138, patents granted, designs and trade marks registered under the repealed Act shall remain in force but shall, subject to subsections (2) and (3), be deemed to have been granted under this Act. (2) Patents granted and industrial designs registered under the repealed Act shall remain in force for the unexpired period of protection provided under this Act subject to payment of maintenance fees. (3) Trademarks already registered and due for renewal shall, upon renewal, be reclassified in accordance with this Act. (4) For the purposes of the payment of annual maintenance fees for patents and patent applications, and of renewal fees for registered industrial designs under subsection (2) hereof, the reference to “the filing date” in sections 28 (2) and 56 (1) respectively, shall be construed as being a reference to the date of registration in Botswana. (5) The Registrar, Deputy Registrar and Assistant Registrars appointed under section 4 of the repealed Act shall be deemed to have been appointed under this Act.
Act to bind State	140. This Act binds the State.

PASSED by the National Assembly this 29th day of March, 2010.

BARBARA N. DITHAPO,
Clerk of the National Assembly.