

Legal Alert



NEW TRADEMARK REGULATIONS 2023.

BACKGROUND

The Minister of Justice and Constitutional Affairs has issued new Trademark regulations “Trademark Regulations S.I No. 85 of 2023” which regulations are to take effect today the 2nd of February 2024.

The new Regulations are primarily a consolidation of Trademarks Regulations No.58 of 2012 and the amendments introduced by Trademark (Amendment) Regulations No. 9 of 2021. The regulations have made changes to the Second Schedule containing statutory forms and provisions relating to publication of trademark applications and notices. The 2012 Regulations and their 2021 amendments stand revoked and superseded by the new 2023 Regulations.

CHANGES INTRODUCED

Publication of Applications and Notices

Under the new regulations, publication of trademark applications and notices must be made in the Uganda Gazette which is printed by the Uganda Printing and Publishing Corporation

(UPPC), a statutory corporation. See for example Regulation 25 (1) on publication of trademark applications, and Regulation 49 on publication of non-payment of renewal fees.

Regulation 93 on cessation of publication of trademarks by Registrar General expressly abolishes any publication of applications and notices in URSB Intellectual Property Journal.

Republication of Trademarks

Under Regulation 94 (1), all trademarks previously published in the Uganda Registration service Bureau (URSB) IP Journal, shall within three months from 2nd February 2024 be published in a special supplement of the Gazette in the format in which they appear in the Intellectual Property Journal.

Changes To Statutory Forms

The Second Schedule to the new Regulations makes provision for 48 forms which are largely a reorganization and renumbering of the Forms under the old 2012 regulations and the 2021 amendment. For example, the Form of

Authorization of Agent is now Form TM 2 and the Application for Registration of a Trademark is now Form TM 5 among others.

OBSERVATIONS

Publication.

The 2021 amendment to the old regulations allowed the Registrar of Trademarks to publish in any other media which birthed the IP Journal. Compared to the Uganda Gazette, the IP journal had several advantages including:

- Standard costs of advertisement set in law i.e. of USD 80 for foreign applicants and UGX 100,000 for local applicants compared to the Uganda Gazette whose fees are administratively set and further impacted by the size or length of the advert.
- The IP Journal was operated as an online journal issued weekly, was freely accessible on the URSB website and with wide circulation in this digital era.

Cost of advertisements

The direct consequence of the new regulations is that charges for publication of trademark applications and notices will no longer be standard (as has been in the URSB Journal for USD 80 for foreign applicants and UGX 100,000 for local applicants). But it will only be determined by the UPPC and based on the actual space consumed by the notice in the Uganda Gazette. This will make quotations/cost for the total registration of a trademark fluid.

Republication

Regulation 94(1) of the new regulations implicitly questions the validity of publications legally made in the URSB IP Journal from 2021 until 1st February 2024. Further, the issue of republication raises the following concerns;

Who will bear the cost of republication? Will the republication be prompted by UPPC, URSB or the trademark owners? Will all the republications be made within 3 months and if not, what is the implication on the defaulting trademarks? But most importantly will this republication open previously concluded steps? For example, oppositions and / or completed registrations.

CONCLUSION

The 2023 Regulations are a welcome development to the Trademark practice as they consolidate 2012 and 2021 Regulations. However, the concerns on publication and republication as introduced by the new Regulations need to be addressed by the responsible government stakeholders in collaboration with key industry players. While the URSB Journal has ceased, it came with advantages that facilitated the modernization of trademark practice and increase in the volume of trademarks filed and pursued to registration.

It is imperative that the advantages of the IP Journal are harnessed by the Uganda Gazette for the trademark practice in Uganda not to fall back into the historical challenges surrounding the publication of trademark applications and notices.

To download the regulations, [click here](#).

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