



LEGAL ALERT – THE TRADEMARKS (AMENDMENT) REGULATIONS, 2021

The Trademarks Regulations No.58 of 2012 (the Regulations) passed under the Trademarks Act No.17, 2010 (the Act) were recently amended by the Trademark (Amendment) Regulations No. 9 of 2021 (the Amendment). The Amendment is commendable as it bridges gaps in many practical aspects of the law. It brings changes to twenty-six (26) provisions of the Regulations with the most notable being operationalization of the Register of agents, introduction of an IP journal, and payment for extension of time.

TRADEMARK AGENT

The Amendment revokes the meaning of a trademark agent under the Regulations and replaces it with “an advocate of the High Court **registered by the Registrar as required by regulation 11**”. While this definition is fundamentally the same as before, it specifies registration of trademark agents.

REGISTER OF AGENTS

The Amendment operationalizes the Register of agents required under the Regulations. A person who qualifies as an agent may apply for registration and upon receipt of all requirements the Registrar may enter such person’s name on the Register of agents.

Agents must renew their registration every year. While registration of agents is for individual advocates, a law firm can be recorded as an address for service.

The Registrar will publish a list of trademark agents on its official website. As the space of trademark agents will now be regulated, it is expected that fraudulent trademark agents will be discouraged.

CLASSIFICATION OF MARKS, GOODS & SERVICES

Under the Regulations, for purposes of trademark registration, goods and services are classified in accordance with the **9th Edition** of the International Classification of Goods and Services (Nice Agreement). The Amendment introduces classification of goods and services according to the **current edition of the** International Classification of Goods and Services (Nice Agreement) and the **current edition of the International Classification of Figurative Elements of Marks under the Vienna Agreement**.

PUBLICATION OF APPLICATIONS AND NOTICES

While the Act generally provides for publications, the Regulations expressly provide for publication in the Gazette. The Amendment introduces advertisement in the Gazette **or any other media**

as the Registrar may direct at a fixed fee of USD 80 and UGX 100,000 per publication for foreign and local applicants, respectively.

Accordingly, the Registrar has announced the electronic Uganda Registration Services Bureau IP Journal as ‘any other media’. The journal will be extracted from IPAS weekly, and published in colour. Length of specification is immaterial.

EXTENSION OF TIME

Under the Act and Regulations, an applicant can request an extension of time and the Registrar has the power and discretion to allow or refuse the application. While the Registrar’s powers remain intact, the Amendment introduces a statutory form (Form TM 42A) and fee for an application for extension of time. The extension of time fee is USD 50 and UGX 25,000 for foreign and local applicants, respectively.

REQUEST FOR SEARCH

Previously, trademark register searches have been requested for by ordinary letter or even word of mouth on presentation of proof of payment of the relevant search fee at the Trademarks Registry. However, the Amendment has introduced a statutory form (Form TM 27) for a request for a trademark search.

The ordinary trademark search and its relevant form remain different from the request for preliminary advice by the Registrar as to distinctiveness under Form TM 28.

OTHER AMENDMENTS

An address required under the Act shall include the name of the street, the plot number, a **postal code number, an email address, and a telephone number.**

The second notice of renewal by the Registrar before expiry of a trademark registration is revoked.

Application in Form TM 4 requiring the Registrar to state in writing the grounds of and materials used in arriving at a decision at examination of trademark application is revoked.

APPLICATION OF THE REGULATIONS

The Trademark (Amendment) Regulations No. 9 of 2021 were published by the Uganda Gazette on 5th February 2021. Therefore, as the law does not act retrospectively, all amendments and changes introduced by the Amendment apply to trademark applications and requests filed and made on or after 5th February 2021. The Trademarks Registry will issue guidelines on the practicalities of the amendments.

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