

# Newsletter

## Developments in Ghana Intellectual Property Law

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### Contents

- I. Review of the Industrial Designs Act, 2003 (Act 660)
- II. Draft Regulations to implement the Industrial Designs, Act 2003 (Act 660)

The Ministry of Trade and Industry and the Ministry of Justice and Attorney-General's Department in collaboration with the Swiss Federal Institute of Intellectual Property are implementing an Intellectual Property Project. The objective of the project is to bring Ghana's Intellectual Property Rights legal framework in line with international commitments under the WTO agreement on Trade Related Aspects of Intellectual Property Rights (TRIPS). An aspect of the project is the review of the Industrial Designs Act, 2001 (Act 660), the Trademarks Act, 2004 (Act 664) and drafting of their respective regulations.

#### **I. Review of the Industrial Designs Act, 2003 (Act 660)**

The Industrial Designs Act is being reviewed to ensure an up-to-date legal and institutional framework for the protection of industrial designs in the country in line with

the WTO agreement on Trade Related Aspects of Intellectual Property Rights (TRIPS) and the Hague Agreement on the International Registration of Designs.

#### *Definition of Industrial Design*

The current definition of industrial design differentiates between two-dimensional designs, three dimensional designs and textile designs. A definition that is concise and devoid of these distinctions is being proposed: "*Design means the appearance of products or parts of products characterized in particular by the arrangement of lines, colours, contours, surfaces, shape, texture or by the materials used*". In view of the use of the word "product" in this proposed definition, the section on interpretation would be amended by the insertion of a definition for product as follows: "*product includes the creation of industrial or handicraft item and in particular includes packaging, get up, graphic symbols, typographic type-faces and parts intended to be assembled into a complex product*".

#### *Application for Registration*

The section on applications is to be reviewed starting with a proposed change of the title to the section to read "Application

for Registration” instead of only “Application”. Section 5(2)(a) would be broken down into (a) and (b) with the current section 5(2) (b) becoming a new section 5(2)(c). The proposed section 5(2) is as follows:

*“5(2) The application is subject to the payment of the prescribed fees and shall contain*

*(a) a request*

*(b) drawings, photographs or other adequate graphic representation of the design; and*

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

Section 5(4) deals with two optional items that an application may contain. The clauses with the options are connected with an “and”, however since the options do not have to be used together it is proposed that the “and” is deleted and is replaced with an “or”. With this change, section 5(4) will read is as follows:

*“5(4) The application may contain*

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

*(b) a declaration claiming priority, as provided for in the Schedule, of one or more earlier national or regional*

*applications or international deposits filed by the applicant or applicant’s predecessor-in-title in or for a State party to that Convention or member of the World Trade Organisation.”*

Section 5(7) allows two or more designs to be the subject of the same application if they relate to the same class of the International Classification or to the same set or composition of articles. The amendment to this subsection proposes to limit to five the number of designs that may be the subject of the same application.

#### *Publication*

The Act requires the Registrar to register the industrial design and publish a reference to the registration. The proposed amendment relating to publication is an acknowledgement of the fact that owners or applicants of industrial designs may require the existence of the design to be kept secret until such time that they release the design into the market place. The proposed amendment empowers the Registrar to defer publication at the request of the applicant for a maximum of thirty months from the filing date or the priority date. The applicant may request immediate publication at any time during the thirty months period. The Registrar is also mandated to keep confidential the filed design during the period of the deferral.

*International Registration under the Hague Agreement*

Ghana acceded to the Geneva Act of the Hague Agreement in September 2008. The accession allows Ghana to be designated in an international registration under the Geneva Act. There is proposed a new section to actualize Ghana's accession as follows:

*“Hague Agreement*

- (1) The provisions of any international Treaties in respect of Industrial Designs to which the country is a party shall apply to matters dealt with by this Act.*
- (2) (1) The Minister may by order make such provisions as he thinks fit for giving effect in Ghana to the provisions of the Hague Agreement.*
  - (2) Provision may, in particular, be made with respect to-*
    - (a) the making of applications for international registrations;*
    - (b) the procedures to be followed where the Design Registry receives from the International Bureau a request for extension of protection to the Republic of Ghana;*
    - (c) the effects of a successful request for extension of protection to Ghana;*
    - (d) the communication of information to the International Bureau;*

- (e) the payment of fees and amounts prescribed in respect of applications for international registrations, extensions of protection and renewals.*

*Processing international applications in accordance with the Treaty*

- (3) The Industrial Design Registry shall process an international application in accordance with*
  - (a) the Treaty and Regulations under the Treaty; and*
  - (b) the administrative instructions made under the regulations referred to in paragraph (a).*

*Interpretations;-*

*In this Act-*

*“the Hague Agreement” means the Agreement concerning the International Deposit of Industrial Designs, and henceforth renamed the Hague Agreement Concerning the International Registration of Designs.*

*“the International Bureau” means the International Bureau of the World Intellectual Property.*

*“International application (designs)” means an application for international application (sic) which is entitled for protection in Ghana under the Agreement.*

*“International registration” means the international registration of an industrial design effected under the Hague Agreement.*

*“Treaty” means the Hague Agreement Concerning the International Registration of Industrial Designs adopted at Geneva on July 2, 1999.*

*“WIPO” means the World Intellectual property Organization.”*

## **II. Draft Regulations to implement the Industrial Designs, Act 2003 (Act 660)**

Section 25 of the Industrial Designs Act empowers the Minister for Justice to by legislative instrument make Regulations for the effective implementation of the Industrial Designs Act. The draft Regulations to implement the Industrial Designs Act expand on a number of important issues in the Act. These include fees, procedures on filing, marking and examination of applications, examination of the register, procedure for extracting copies from the register, other matters and the requisite forms.

### *Fees*

Under section 5(2) of the Act, an application for the registration of an industrial design is subject to the payment of prescribed fees. Regulation 3 and schedule 1 of the draft Regulations deal with the fees to be paid. These fees include the application fee; registration and publication fee; fee for registration of ownership, assignments,

alteration of registered particulars; fee for obtaining a certified copy of entry in the register; renewal fees; fee for searches and surcharge of late payment of fees. Fees will be specified in US Dollars or, the equivalent in Ghana Cedis.

### *Requirements and Procedures on filing applications*

The application for the registration of an industrial design will be made on Form No. 2 entitled “Application to register one or more designs” and signed by each applicant. The application must contain the applicant’s name, address, nationality and residence. If the applicant is the creator of the design himself, this must be stated in the application. Where the applicant is not the creator of the design, the creator’s name and address must be indicated on the form together with a statement justifying the applicant’s right to register the industrial design. The application should be accompanied by four graphic representations, drawings or tracings of the industrial design which must not exceed 10 centimeters by 20 centimeters and must be affixed on cardboard of A4 size. Drawings and tracings must be in black ink. Specimens must not exceed 20 centimeters by 20 centimeters.

Where the applicant wishes to take advantage of an earlier filing in another country and claim a priority date, there must be declaration claiming priority. The declaration must contain the date and number of the earlier application, the symbol of the international classification for

industrial designs which has been allocated to the earlier application, the country in/for which it was filed and where the earlier application is a regional or international application, the office with which it was filed.

An application that has already been filed can be withdrawn by submitting a written declaration signed by the applicant to the registrar. The application fee is not refundable when an application is withdrawn.

#### *Marking of applications*

When the Registrar receives an application, the Registrar will mark, on each document making up the application, the date of receipt and an application number. The application number will be quoted in all subsequent communications concerning the application.

#### *Examination of applications*

The Registrar will examine the application for registration to determine whether it fulfills the requirement under section 6(1) of the Act, which is, whether it contains indications allowing the identity of the applicant to be established and the required graphic representations of the industrial design.

If the Registrar finds that the conditions set in the Act and the Regulations have not been fulfilled, he will invite the applicant to file the required correction within two months, together with the payment of the prescribed fee, but if the applicant does not comply with the invitation to correct a deficiency, or

where despite corrections submitted by the applicant, the Registrar is of the opinion that the said conditions have not been fulfilled, the Registrar will reject the application and notify the applicant. Refusal of the application will however not affect its filing date which will remain valid.

Where the Registrar decides to grant the application, he will notify the applicant and request the applicant to pay the registration and publication fee within one month from the date of the notification.

#### *Registration, publication and renewal*

Upon payment of the registration and publication fee, the Registrar will register the industrial design and allot to each industrial design a number in the sequential order of registration. The registration will include a representation of the industrial design and specify the number of the design; name and address of the registered owner; name and address of the agent if any; name and address of the creator (unless the creator has asked not to be named in the registration); priority date and country/countries in which an earlier application has been filed (if applicable); and the kind of products for which the industrial design is to be used.

Publication of the reference to registration pursuant to section 8(1) of the Act must contain all the registration particulars specified above.

Registration of an industrial design may be renewed by the registered owner or his agent during the sixth month period preceding the

expiration of the registration. This is done by the payment of the renewal fee or the prescribed surcharge within the grace period allowed under section 10(3) of the Act. The renewal will be recorded in the register and published and the Registrar will issue a certificate of renewal to the applicant.

#### *The Register*

A register for the registration of industrial designs is kept by the Registrar and contains information on the number of the design; name and address of the registered owner; name and address of the agent if any; name and address of the creator; priority date and country/countries in which an earlier application has been filed; and the kind of products for which the industrial design is to be used. Additional information such as the address for service; date on which the industrial design registration expired or was invalidated; any change in name, address, ownership or address for service; and the fact that a license contract has been concluded and recorded pursuant to section 14(1) of the Act.

The register may be consulted subject to the payment of the prescribed fee. Requests for certified copies of extracts from the register or for copies of documents must be made to the Registrar in writing and is subject to payment of the prescribed fee.

#### *Other Matters*

The draft Regulations also deal with matters such as correction of errors, hearings, presenting evidence before the Registrar, time limits and their extension as well as

change in ownership, licence contracts, or address for service.

#### *Forms*

Schedule II of the draft Regulations provide the various forms to be used in registration of industrial designs and related matters. The proposed forms are:

- Appointment or change of agent or contact address
- Application to register one or more designs
- Application to publish one or more designs
- Renewal of design registration
- Application to record a change of ownership or to record or cancel a licence
- Change of proprietor's name or address
- Notice of counter-statement
- Notice by proprietor to cancel a registration
- Request for a search of the Ghana designs register
- Request for a Certified Copy
- Confirmation of convention country priority claim relating to Ghana's application for registered design.

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