

Amendment of section 25 of Act 98 of 1978, as amended by section 21 of Act 125 of 1992

56. Section 25 of the Copyright Act, 1978, is hereby amended by the substitution for subsection (2) of the following subsection:

“(2) Before an exclusive licensee or sub-licensee institutes proceedings under subsection (1), he or she shall give notice in writing to the owner of the copyright concerned of the intention to do so, and the owner may intervene in such proceedings and recover any damages he or she may have suffered as a result of the infringement concerned or a reasonable royalty to which he or she may be entitled.”.

Substitution of section 34 of Act 98 of 1978

57. The following section is hereby substituted for section 34 of the Copyright Act, 1978:

“Diffusion service

34. In a dispute concerning the transmission of broadcasts in a diffusion service in the Republic, the tribunal shall disallow any claim under this Act to the extent to which the licences of the broadcaster concerned provide for or include such transmission in a diffusion service.”.

Substitution of certain word in Act 98 of 1978

58. Sections 6(e), 7(d), 8(1)(d) and 10(c) of the Copyright Act, 1978, are hereby amended by the substitution in the Afrikaans text for the word “voortgesit”, wherever it occurs, of the word “bedryf”.

Amendment of section 10 of Act 194 of 1993

59. Section 10 of the Trade Marks Act, 1993, is hereby amended—

(a) by the substitution for paragraph (5) of the following paragraph:

“(5) a mark which consists exclusively of the shape, configuration, [or] colour or pattern of goods where such shape, configuration, [or] colour or pattern is necessary to obtain a specific technical result, or results from the nature of the goods themselves;”;

(b) by the substitution for paragraph (6) of the following paragraph:

“(6) subject to the provisions of section 36(2), a mark which, on the date of application for registration thereof, or, where appropriate, of the priority claimed in respect of the application for registration thereof, constitutes, or the essential part of which constitutes, a reproduction, imitation or translation of a trade mark which is entitled to protection under the Paris Convention as a well-known trade mark within the meaning of section 35(1) of this Act and which is used for goods or services identical or similar to the goods or services in [question] respect of which the trade mark is well-known and where such use is likely to cause deception or confusion;”;

(c) by the substitution for paragraph (8) of the following paragraph:

“(8) (a) a mark which consists of or contains the national flag of the Republic or a convention country, or an imitation from a heraldic point of view, without the authorization of the competent authority of the Republic or convention country, as the case may be, unless it appears to the registrar that use of the flag in the manner proposed is permitted without such authorization;

- (b) a mark which consists of or contains the armorial bearings or any other state emblem of the Republic or a convention country, or an imitation from a heraldic point of view, without the authorization of the competent authority of the Republic or convention country, as the case may be; 5
- (c) a mark which consists of or contains an official sign or hallmark adopted by the Republic or a convention country, or an imitation from a heraldic point of view, and which indicates control and warranty, in relation to goods or services of the same or a similar kind as those in relation to which it indicates control and warranty, without the authorization of the competent authority of the Republic or convention country, as the case may be; 10
- (d) a mark which consists of or contains the flag, the armorial bearings or any other emblem, or an imitation from a heraldic point of view, or the name, or the abbreviation of the name, of any international organization of which one or more convention countries are members, without the authorization of the organization concerned, unless it appears to the registrar that use of the flag, armorial bearings, other emblem or imitation or the name or abbreviation in the manner proposed, is not such as to suggest to the public that a connection exists between the organization and the mark, or is not likely to mislead the public as to the existence of a connection between the organization and the proprietor of the mark; 15
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- Provided that—
- (i) paragraphs (b), (c) and (d) shall apply to a state emblem and an official sign or hallmark of a convention country and an emblem, the name, or the abbreviation of the name, of an international organization only if and to the extent that— 30
- (aa) the convention country or international organization, as the case may be, has notified the Republic in accordance with Article 6ter of the Paris Convention that it desires to protect that emblem, official sign or hallmark, name or abbreviation, as the case may be; 35
- (bb) such notification remains in force; and
- (cc) the Republic has not objected to it in accordance with Article 6ter of the Paris Convention or any such objection has been withdrawn;
- (ii) paragraph (b), (c) or (d) shall apply only in relation to applications for registration made more than two months after receipt of the notification referred to in paragraph (i)(aa); 40
- (iii) paragraph (b) or (c) shall not prevent the registration of a trade mark by a citizen of any country who is authorized to make use of a state emblem or official sign or hallmark of that country, notwithstanding the fact that it is similar to that of another country;” 45
and

- (d) by the substitution for paragraph (17) of the following paragraph: 50
- “(17) a mark which is identical or similar to a trade mark which is already registered and which is well-known in the Republic, if the use of the mark sought to be registered would be likely to take unfair advantage of, or be detrimental to, the distinctive character or the repute of the registered trade mark, notwithstanding the absence of deception or confusion, unless the proprietor of such trade mark consents to the registration of such mark:” 55

Amendment of section 11 of Act 194 of 1993

60. Section 11 of the Trade Marks Act, 1993, is hereby amended by the substitution for subsection (2) of the following subsection:

“(2) Where a trade mark has, either before or after the commencement of this Act, been registered as contemplated in subsection (1) and, during the subsistence of that registration, the prescribed classification in accordance with which the trade mark was registered as aforesaid is revised or is replaced by a new classification, the proprietor of the trade mark [shall, when applying for the renewal of the registration thereof in terms of section 37, at the same time] may, at any time, apply in the prescribed manner for revision, in accordance with the revised or new classification, of the class or classes in which the trade mark is registered.”.

Repeal of section 13 of Act 194 of 1993

61. Section 13 of the Trade Marks Act, 1993, is hereby repealed. 10

Amendment of section 27 of Act 194 of 1993

62. Section 27 of the Trade Marks Act, 1993, is hereby amended—
(a) by the substitution in subsection (1) for the words preceding paragraph (a) of the following words:
“Subject to the provisions of [sections 13 and] section 70(2), a registered trade mark may, on application to the court, or, at the option of the applicant and subject to the provisions of section 59 and in the prescribed manner, to the registrar by any interested person, be removed from the register in respect of any of the goods or services in respect of which it is registered, on the ground either—”; and
(b) by the addition of the following subsection:
“(5) Subsection (1)(a) and (b) does not apply to a trade mark in respect of which protection may be claimed under the Paris Convention as a well-known trade mark within the meaning of section 35(1) of this Act.”.

Amendment of section 30 of Act 194 of 1993 25

63. Section 30 of the Trade Marks Act, 1993, is hereby amended by the substitution for subsection (3) of the following subsection:
“(3) Any association of a trade mark with any other trade mark registered in the name of the same proprietor shall be deemed to be an [associate] association with all trade marks associated with that other trade mark.”. 30

Amendment of section 34 of Act 194 of 1993

64. Section 34(3) of the Trade Marks Act, 1993, is hereby amended—
(a) by the substitution for the words preceding paragraph (a) of the following words:
“Where a trade mark registered in terms of this Act has been infringed, [the court] any High Court having jurisdiction may grant the proprietor the following relief, namely—”; and
(b) by the substitution for paragraph (d) of the following paragraph:
“(d) in lieu of damages, at the option of the proprietor, a reasonable royalty which would have been payable by a licensee for the use of the trade mark concerned, including any use which took place after advertisement of the acceptance of an application for registration and which, if taking place after registration, would amount to infringement of the rights acquired by registration.”

Amendment of section 35 of Act 194 of 1993 45

65. Section 35 of the Trade Marks Act, 1993, is hereby amended—
(a) by the insertion after subsection (1) of the following subsection:

“(1A) In determining for the purposes of subsection (1) whether a trade mark is well-known in the Republic, due regard shall be given to the knowledge of the trade mark in the relevant sector of the public, including knowledge which has been obtained as a result of the promotion of the trade mark.”; and

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(b) by the addition of the following subsection:

“(4) Where, by virtue of section 10(8), the authorization of the competent authority of a convention country or an international organization is required for the registration of a mark as a trade mark, such authority or organization is entitled to restrain the use in the Republic of such a mark without such authorization.”.

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Amendment of section 39 of Act 194 of 1993

66. Section 39 of the Trade Marks Act, 1993, is hereby amended—

(a) by the substitution for subsection (4) of the following subsection:

“(4) [Notwithstanding anything to the contrary contained in subsections (1), (2) and (3), a registered trade mark is not assignable or transmissible if] If, as a result of the assignment or transmission of a registered trade mark, [and] the use of the trade mark by different persons in the Republic or elsewhere [circumstances exist or would exist which give rise or] would give rise to the likelihood of deception or confusion, section 10(13) shall apply.”; and

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(b) by the deletion of subsection (6).

Insertion of section 48A in Act 194 of 1993

67. The following section is hereby inserted after section 48 of the Trade Marks Act, 1993:

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“List of emblems of convention countries and international organizations

48A. (1) The registrar shall keep a list of—

(a) all state emblems and official signs and hallmarks of convention countries; and
(b) all emblems, names and abbreviations of names of international organizations,

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which are protected in terms of the Paris Convention by virtue of notification to the Republic in accordance with Article 6ter of the Convention.

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(2) The list referred to in subsection (1) shall be open at all convenient times during office hours to inspection by the public.”.

Substitution of section 51 of Act 194 of 1993

68. The following section is hereby substituted for section 51 of the Trade Marks Act, 1993:

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“Registration to be *prima facie* evidence of validity

51. In all legal proceedings relating to a registered trade mark (including applications under section [25] 24) the fact that a person is registered as the proprietor of the trade mark shall be *prima facie* evidence of the validity of the original registration of the trade mark and of all subsequent assignments and transmissions thereof.”.

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Amendment of section 1 of Act 195 of 1993

69. Section 1(1) of the Designs Act, 1993, is hereby amended by the deletion of the definition of “personal representative”.