

1. Further comments and observation in priority to Areas of convergence no. 1, 2, 5, and 6. by the Kingdom of Lesotho.

POSSIBLE AREA OF CONVERGENCE NO.1 NOTION OF COUNTRY NAME

At least for the purposes of examination of marks, and unless the applicable law specifies otherwise, a country name may cover: the official or formal name of the state, the name that is in common use, translation and transliteration of the name, the short name of the state, as well as use of the name in abbreviated form and as an adjective.

Comments

According to part v – of the Industrial Property Order No. 5 of 1989 (IP Order 1989), Section 26 (2) (c) A mark cannot be validly registered, if it is 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.

Section 26 (2) (d) prohibits registration of a Mark if it is identical with, or is an imitation of, or contains an element, an armorial bearing, flag and other emblem, a name or abbreviation or initial of the name of or official sign or hallmark adopted, by a State, inter-governmental organization created by an international convention, unless authorized by the competent authority of that State or organization.

The above two sections do not define/cover country name explicitly. It is by inference covered by the terms geographical origin, armorial bearing, official sign or hallmark, flags and emblems as they are closely related to country names.

Section 26 (2) (d) further has a proviso to the effect that a name of a State or inter-governmental Organization is registrable if authority is granted by the competent authority of that State or organization.

Our understanding is that official names of States or Intergovernmental Organizations are not registrable, unless authorized by competent State authority of the State concerned. However regarding translations, country

abbreviations/translations or transliterations our examiners may not be well equipped to detect them upon examination therefore it would be necessary to equip them with tools to detect them if they were to be included.

POSSIBLE AREA OF CONVERGENCE NO.2 NON-REGISTRABLE IF CONSIDERED DESCRIPTIVE

At least for the purpose of examination, trademarks consisting solely of a country name should be refused where the use of that name is descriptive of the place of origin of the goods or services.

Comments

The IP Order 1989 prohibits registration of Trademarks likely to mislead as regards geographical origin of goods. A country name that is descriptive as to the origin of goods or services will by the same token be refused.

POSSIBLE AREA OF CONVERGENCE NO.5 INVALIDATION AND OPPOSITION PROCEDURES

The grounds for refusal described in possible areas of convergence no. 2, 3 and 4 above should constitute grounds for invalidation of registered marks, and where the applicable law so provides also grounds for opposition.

Comments

The IP Order 1989 in section 30 (1) provides that any interested person may request the Registrar to invalidate the registration of a Mark. The procedures for invalidation are set out in section 28 (4) that, any interested person may, within the prescribed period and in the prescribed manner, give notice to the Registrar of opposition to the registration of the mark on grounds that one or more of the requirements of section 2, relating to the definition of a mark, section 26 (2) on registrability of mark and the regulations pertaining thereto are not fulfilled. Section 30 (2) provides that, the Registrar shall invalidate the mark if the person making the request proves, amongst others that the mark is

incapable of distinguishing goods or services of an enterprise as defined in section 2, or that the mark is 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. It is therefore, possible to raise opposition and invalidate a registered mark if it is likely to mislead the public or trade circles as regards geographical origin of the goods or services

POSSIBLE AREA OF CONVERGENCE NO.6 INVALIDATION AND OPPOSITION PROCEDURES

Appropriate legal means should be made available for interested parties to prevent the use of country names if such use is likely to deceive the public, for instance as to the nature, quality or geographical origin of the goods or services and to request the seizure of goods bearing false indications as to their source.

Comments

Section 34 (2) of the IP Order 1989, relating to unfair competition makes, it possible to prevent the use of country names likely to deceive the public, as to Geographical place of origin of the goods and services.

The request for seizure of goods bearing false indications as to their source is also a possible remedy when the courts are approached for seizure of goods bearing false indication as to their source.